



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The Boards of Appeal
The Registry

R420a

Alicante, 18/05/2011
R1689/2008-2

LORENZ SEIDLER GOSSEL
Widenmayerstr. 23
D-80538 München
ALEMANIA

Subject: Appeal No. R1689/2008-2
Your ref.: 00008-07 Bo/smk

Notification of a decision of the Second Board of Appeal

Please find enclosed the decision of the Second Board of Appeal dated 15/04/2011 concerning the appeal filed on 25/11/2008 in the name of LAND ROVER (private unlimited company).

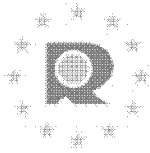
Article 65 of the Regulation on the Community Trade Mark provides that an action may be brought before the Court of Justice of the European Union (General Court) in Luxembourg against decisions of the Boards of Appeal within 2 months after notification of the decision.

Your attention is drawn to the fact that the proceedings before the European Court of Justice are regulated by specific requirements stated in the *Statute of the Court of Justice of the European Union*, in the *Rules of Procedure of the General Court* as well as in the *Court of First Instance Practice Directions to parties*. Further information concerning the proceedings before the General Court may be obtained on the homepage of the European Court of Justice 'curia.europa.eu' under *General Court / Procedure / Court of First Instance Practice Directions to parties* or by phone from the Registry of the General Court (Tel: +352 4303 3477).

To the extent that you are adversely affected by the attached decision and you nonetheless decide not to challenge it, we would appreciate you informing us accordingly as soon as possible.

Florence PIASER
Registry

Enc.: 1 (+ 30 pages)
Sent to fax no.: 00498929010100



**DECISION
of the Second Board of Appeal
of 15 April 2011**

In Case R 1689/2008-2

LAND ROVER (private unlimited company)

Banbury Road

Gaydon

Warwick, Warwickshire CV35 0RR

United Kingdom

Opponent / Appellant

represented by Lorenz Seidler Gossel, Widenmayerstr. 23, DE-80538 München,
Germany

v

LWMC Ltd.

Mishagen 55

BE-2930 Brasschaat

Belgium

Applicant / Respondent

represented by Lawton Brands, Lage Mosten 7, NL-4822 NJ, Breda, Netherlands

APPEAL relating to Opposition Proceedings No B 1 128 208 (Community trade mark
application No 4 499 604)

THE SECOND BOARD OF APPEAL

composed of T. de las Heras (Chairperson), G. Bertoli (Rapporteur) and H. Salmi
(Member)

Registrar: P. López Fernández de Corres

gives the following

Decision

Summary of the facts

- 1 By an application filed on 15 July 2005, LWMC Ltd. ('the applicant') sought to register the word mark

LANDWIND

for the following list of goods and services:

- Class 9: Scientific, photographic and optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; automatic steering apparatus for passenger cars; speed control apparatus for passenger cars; apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, data processing equipment and computers, software; fire-extinguishing appliances; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, including relays, batteries, accumulators, battery chargers, starter cables, switches, fuses and voltage regulators and parts for the aforesaid goods; electrical apparatus and instruments for vehicles, including speedometers, revolution counters, fuel, ignition and engine improvement systems, fuel cells and; anti-theft alarm installations and parts for the aforesaid goods; all the aforesaid goods relating to passenger cars and the manufacture of passenger cars; Spectacles, sunglasses and spectacle cases;
- Class 11: Lighting apparatus, including lamps, floodlights, equipment and installations for lighting vehicles and lighting units for vehicles; apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, including apparatus, equipment and installations for heating, refrigerating, air conditioning and ventilating vehicles, apparatus, equipment and installations for defrosting vehicles;
- Class 12: Vehicles; apparatus for locomotion by land; cars, namely passenger cars and parts, components and accessories therefor, included in this class, including engines for vehicles and their parts, gearboxes, vehicle seats and their parts including car seats for children, transmission components for motor vehicles; vehicle brake mechanisms, suspension components for motor vehicles, steering systems, bodies for vehicles, chassis, shock absorbers and their parts, wheels, rims, hub caps, brakes, tyres, airbags, seat belts and other safety provisions, mirrors, tow hooks, roof-racks, roof boxes, fuel tanks for vehicles, tank caps, bumpers, mudguards, couplings (trailer hitches), luggage carriers, sun roofs for vehicles, windows, windshield wipers, anti-skid apparatus for vehicles, grill emblems, car hoods;
- Class 35: Advertising and publicity activities; business management; business administration; office functions; retail services, namely the sale of cars, car components and car accessories; commercial mediation and consultancy with regard to the sale of cars, car components and car accessories; market canvassing, research and analysis; wholesaling, namely import and export of cars, car components and car accessories; business consultancy relating to the import and export of cars, car components and car accessories; business mediation and consultancy in the trade of motor vehicles; business management consultancy in the establishment and operation of dealer networks; mediation in obtaining vehicle registration certificates and other administrative records for vehicles;

Class 36: Insurance; financial affairs; financial consultancy; financing services; financing services and insurance brokerage; Leasing of vehicles;

Class 37: Construction, repair, servicing, maintenance, care, cleaning and spraying of vehicles, engines and parts therefor, including vehicle repair; finishing and tuning of motor vehicles, included in class 37.

2 The application was published in the Community Trade Marks Bulletin No 049/2006 of 4 December 2006.

3 On 5 March 2007, LAND ROVER ('the opponent') filed an opposition against the above application based on the following earlier rights:

- Community trade mark registration No 143 644 of the word mark '**LAND ROVER**', filed on 1 April 1996, registered on 19 July 2000 and subsequently renewed for the following goods and services:

Class 2: Paints, varnishes, lacquers, and rust preventatives;

Class 6: Fixed dispensers for towels, tissues, seat covers, carpet protectors, disposable covers, wheel protectors, car covers, vehicle bodywork protectors, bags, sacks, mats, paper, paper articles, and/or for plastic film and sheet materials and articles; locks, keys, key rings, key fobs, badges, emblems, signs, and nameplates; struts, plates, tubes, tubing, bars, beams, rods, rails, angle pieces, channels, sections, brackets, joints, junctions, couplers, studs, plugs, clips, sockets, collars, panels, hangers, hooks, arms, and holders, all for use in construction and assembly; baskets, bins, racks, racking, stands, platforms, containers, money boxes, security boxes, and vehicle safes; screws, nuts, bolts, washers, fasteners, and fixings; metal hardware, pipes, piping, pipework, and tubing, all for automotive use; all made wholly or principally of common metals or their alloys;

Class 7: Parts and components for internal combustion engines; winches, pumps, and parts and components therefor; exhausts and turbochargers for motors and engines; machines and machine tools for automotive use;

Class 8: Hand tools and implements; penknives;

Class 9: Electrical, electronic, measuring, checking (supervision), testing, gauging, signalling, telephone, optical, photographic, fire extinguishing, control, diagnostic, and safety apparatus and instruments; direction and location finding apparatus and instruments; apparatus, gloves and clothing, all for use in protection against accident or injury; meters and gauges; sound recording and sound reproducing apparatus and instruments, radio apparatus and instruments, and combinations thereof; parts, components and accessories for all the aforesaid goods; vehicle breakdown warning triangles; spectacles, sunglasses and driving glasses; computer software; video, audio and audio-visual tapes and discs; amusement apparatus and apparatus for games, all for use with television receivers or monitors; calculators;

Class 11: Lighting, heating, cooling, ventilating, air conditioning, and refrigerating apparatus and instruments; and parts, components and accessories therefore;

Class 12: Land vehicles and their engines; military vehicles; police vehicles; trailers; parts, components and accessories for all the aforesaid goods; shaped covers for steering wheels, vehicle seats, spare wheels, and for land vehicles; shaped or fitted mats and floor coverings for motor land vehicles; pumps for inflating vehicle tyres; sun blinds, roof racks, luggage carriers and nets, cycle carriers, sail board carriers, ski carriers, and snow chains, all for land vehicles;

- Class 14: Clocks, watches, and other horological and chronometric instruments; cuff links, tie pins, tie clips, and jewellery; silver key fobs, and other goods (not included in other classes) in precious metals or coated therewith;
- Class 16: Printed matter, stationery, maps, travel guides, books, and printed publications, office requisites (other than furniture); instructional and teaching materials (other than apparatus); writing and drawing instruments and materials; paper; articles made wholly or principally of paper, card and/or cardboard; drink mats, photographs, stickers, labels, decalcomanias, playing cards, rulers, postcards, bookmarks, bookends, erasers, paperweights, and book covers; diaries, notebooks, appointment books, address books, combinations of such goods, and covers therefor, business card holders, cheque book covers, and passport covers and holders; folders, holders and covers, all intended for or containing notebooks, notepads, paper, pens, pencils, and/or erasers; road and vehicle tax disc holders made of plastic film or sheet materials; towels, napkins, serviettes, mats, coasters, hankerchiefs, tissues, cloths, absorbent wipes, and sanitary and hygienic materials, all made wholly or principally of paper and/or paper derivatives; wrapping and packing materials made wholly or principally of paper or plastics; plastic cling film; bags, sacks, and disposable covers all made wholly or principally of paper and/or plastic film or sheet materials; disposable paper protectors for carpets and seats; sheet materials wholly or principally of paper and/or paper derivatives for protecting, preserving and/or for storage purposes; disposable protectors for steering wheels and road wheels, all made of polythene or of plastic film or sheet materials;
- Class 17: Plastics in the form of sheets, foam, film, or of shaped pieces; covers made wholly or principally from the aforesaid materials for protecting, preserving and/or for storage purposes; plastic covers for use in protecting vehicle paintwork and/or bodywork during repair, maintenance, and/or servicing; plastic sheets with self-adhesive strip for use in protecting vehicle interiors and/or trim during repair, maintenance and/or servicing; clutch linings; seals, caps and covers, all for weatherproofing and insulating engine components; flexible hose (not being wholly or principally metallic); adhesives tape (other than stationery and not for medical or household purposes); sleeves, sleeving and washers, all made wholly or principally of rubber or of synthetic rubber; grommets, pipes, piping, tubes and tubing, all made wholly or principally of plastics, rubber or synthetic rubber; parts and fittings, all made of rubber or synthetic rubber, or of plastics, for motor land vehicles;
- Class 18: Bags, hold-alls, cases, satchels, purses, wallets, umbrellas, parasols, and walking sticks, key fobs made wholly or principally of leather; articles (not included in other classes) made wholly or principally of leather or imitation leather;
- Class 20: Locks, keys, key rings, key fobs, badges, emblems, signs, and nameplates; struts, plates, tubes, tubing, bars, beams, rods, rails, angle pieces, channels, sections, brackets, joints, junctions, couplers, studs, plugs, clips, sockets, collars, panels, hangers, hooks, arms, and holders, all for use in construction and assembly; baskets, bins, racks, racking, stands, platforms, containers, and money boxes; screws, nuts, bolts, washers, fasteners, and fixings; all made wholly or principally of plastics and/or wood; storage and display furniture; showroom and reception furniture; shelves, shelving and display stands; display units, racks and racking, all in the nature of furniture; parts and fittings, all for dispensers, storage and display furniture, racks, racking, stands, display units, shelves, shelving, containers and platforms; plastic hardware for automotive use; clothes hangers and mannequins;
- Class 21: Crockery, mugs, tankards, napkin holders and rings, trays, mats, bottle and can openers, corkscrews, coasters, ornaments, combs, and brushes; small domestic utensils and containers; glassware, porcelain, tableware and earthenware; cloths and sponges; articles and materials for cleaning purposes; moneyboxes made

wholly or principally of glass, porcelain or earthenware; portable coolers and flasks, all for foodstuffs and/or beverages; small portable containers for money and/or personal possessions;

Class 22: Tents, tarpaulins, awnings, covers for vehicles and towropes;

Class 24: Travelling rugs; bed covers; bedspreads, bed clothes and bed linen; table covers and table linen; mats and towels of textile materials; curtains; textile piece goods;

Class 25: Articles of outerclothing, overalls, coveralls, footwear, headgear, gloves, ties and t-shirts;

Class 26: Badges for wear (not of precious metal); textile badges; ornamental novelty badges in the form of buttons or pins; brooches and buckles being clothing accessories; heat adhesive patches for decoration of textile articles;

Class 27: Carpets, rugs, mats, and floor coverings;

Class 28: Toys, games, and playthings; scale model vehicles and kits therefor; balloons; sporting articles;

Class 34: Lighters, matches, and smokers requisites;

Class 36: Financial, insurance, warranty, credit and leasing services; vehicle hire-purchase and financing services; banking and money-lending services;

Class 37: Repair, maintenance, reconditioning, remanufacturing and servicing, all relating to motor vehicles and parts and fittings therefore;

Class 39: Leasing, rental and hire services for motor vehicles, storage facilities for motor vehicles, parts and apparatus; arranging and/or providing holiday travel, safari travel, travel and off-road driving; tour arranging and tour operating services; arranging transportation of vehicles, drivers and passengers; travel agency, tourist agency, and travel information and advice services; booking of seats and issuing of tickets for travel; seat, berth and travel ticket reservation services; escorting of travellers;





Class 41: Off-road driving instruction and tuition; education in four-wheel driving techniques, mechanics, map-reading, safety, and environmental matters; driving academy services; club services; training, educational and entertainment services relating to motor vehicles.

- Community trade mark registration No 2 271 500 of the word mark '**LAND ROVER**', filed on 22 June 2001 and registered on 7 October 2002 for 'vehicles; bicycles; parts, fittings and accessories for all the aforesaid goods' in Class 12.
- German trade mark registration No 39 507 030 of the word mark '**LAND ROVER**', filed on 16 February 1995, registered on 17 January 1997 and subsequently renewed for goods and services in Classes 2, 6, 7, 8, 9, 11, 12, 14, 16, 18, 20, 21, 22, 24, 25, 26, 27, 28, 36, 37, 39 and 41.
- German trade mark registration No 39 507 031 of the figurative mark



, filed on 16 February 1995, registered on 17 January 1997 and

subsequently renewed for the following goods and services in Classes 6, 7, 9, 11, 12, 14, 16, 18, 20, 21, 24, 25, 27, 28, 36 and 37.

- United Kingdom trade mark registration No 663 199 of the word mark ‘**LAND ROVER**’, filed and registered on 11 October 1947 and subsequently renewed for goods in Class 12.
 - United Kingdom trade mark registration No 1 378 118 of the figurative mark , filed on 21 March 1989, registered on 4 September 1992 and renewed for services in Class 36.
 - United Kingdom trade mark registration No 1 378 120 of the figurative mark , filed on 21 March 1989, registered on 4 September 1992 and renewed for goods in Classes 2-9, 11, 14, 16-18, 20, 22, 24, 25, 27 and 28.
 - United Kingdom trade mark registration No 2 104 556 of the figurative mark , filed on 4 July 1996, registered on 21 February 1997 and renewed for goods in Classes 1 and 9.
 - United Kingdom trade mark registration No 1 378 096 of the word mark ‘**LAND ROVER**’, filed on 21 March 1989, registered on 21 August 1992 and renewed for goods and services in Classes 2-8, 11, 14, 18, 20, 27, 35-37, 39.
 - United Kingdom trade mark registration No 1 539 836 of the word mark ‘**LAND ROVER**’, filed on 26 June 1993, registered on 9 June 1995 and renewed for goods in Class 9.
 - United Kingdom trade mark registration No 1 579 651 of the word mark ‘**LAND ROVER**’, filed on 26 July 1994, registered on 9 February 1996 and renewed for goods in Class 12.
 - United Kingdom trade mark registration No 2 010 672 of the figurative mark , filed on 10 February 1995, registered on 29 December 1995 and renewed for goods and services in Classes 12 and 37.
- 4 The opposition is based on all of the goods and services covered by the earlier marks and it was directed against all the goods and services applied for.
 - 5 The grounds of the opposition are those laid down in Article 8(1)(b) and 8 (5) of CTMR.
 - 6 On 9 and 13 July 2007, the opponent filed its observations and several documents to support the compliance with all the requirements under Article 8(5) CTMR,

mainly the alleged reputation of its marks, not only in the UK and Germany but all over Europe and throughout the world.

- 7 After a further exchange of observations between the parties, on 16 October 2008, the Opposition Division issued the decision ruling on opposition No B 1 128 208 ('the contested decision'), rejecting the opposition in its entirety and ordering the opponent to bear the costs. The arguments of the Opposition Division can be summarized as follows:

Article 8(1)(b) CTMR

- The evaluation of the opposition will proceed first on the basis of the earlier Community trade mark No 143 644 and will only proceed further with examination of the other earlier rights if necessary.
- The relevant territory is the European Union.
- Visually, the signs to be compared are the word marks 'LAND ROVER' and 'LANDWIND'. They share only 4 letters, namely 'L-A-N-D'. The second part of both marks is completely different, being constituted respectively by a separate word, 'R-O-V-E-R', in the case of the earlier trade mark and the letters 'W-I-N-D', forming part of the same word, in the case of the contested trade mark. Although the first four letters are the same this fact does not make a profound impression because 'LAND' is a standalone element in the earlier mark whereas in the later mark 'LAND' is merely the first four letters of a longer word. Moreover, the structure of the contested mark, with the repetition of 'ND', gives it an entirely different overall appearance to that of 'LAND ROVER', which has no elements whatsoever in common between its first and second parts. Bearing in mind the foregoing the Office considers that from a visual point of view the two signs in conflict share only a low degree of similarity.
- Aurally, the signs coincide in their first syllable, namely 'LAND'. In the case of the earlier trade mark the second word is composed of two syllables, namely 'RO' and 'VER', while in the contested trade mark the second part of the sign is composed of the syllable 'WIND'. The two signs will be pronounced in a rather different manner by all of the relevant public, irrespective of the different national pronunciation rules. Thus, the Office considers that there is a low degree of similarity between the two marks in conflict, due only to the coincidence of the first syllable.
- Conceptually, both parts of the two signs have a meaning in English which is one of the languages spoken by part of the relevant public. Parts of them have also a meaning in some other European languages. Accordingly, in the *Oxford English Dictionary* the word 'LAND' means respectively: 1. the part of the earth's surface that is not covered by water; 2. an area of ground in terms of its ownership or use; 3. (the land) ground or soil as a basis for agriculture; 4. a country or state. The word 'LAND' also possesses the aforesaid meanings in some other European languages such as German,

Dutch, Danish and Swedish. Furthermore, the second word of the earlier trade mark, namely 'ROVER', possesses two meanings, in this case only in English, namely 'a person who spends time wandering' and 'a vehicle for driving over rough terrain'. On the other hand, the contested trade mark is composed of two conjoined words. The conjoined word *per se* has no meaning. However, speakers of English, German, Dutch, Danish and Swedish will understand clearly enough, that the sign is made up of two words, that is to say 'LAND' and 'WIND'. The meaning of 'LAND' has already been defined while the word 'WIND' indicates the 'movement of air usually caused by convection or differences of air pressure'. The overall meaning thus arrived at is of a wind over land, this is a slightly unusual and notable concept. Therefore, speakers of these languages will understand the two marks as being conceptually different. The Office also recognizes that a significant part of the relevant public will not perceive the two signs in conflict as having any meanings. For this part of the public no conceptual comparison can be made.

- Hence the two marks are considered to have a low level of similarity from the aural and visual point of view. Conceptually, differences between the marks will be apparent to those consumers who identify meanings within them.

- 'Measuring, checking (supervision), signalling, photographic and optical apparatus and instruments; software; fire-extinguishing appliances; spectacles, sunglasses' in Class 9, 'lighting apparatus; apparatus for heating, refrigerating, ventilating' in Class 11, 'vehicles; apparatus for locomotion by land' in Class 12, 'advertising and publicity activities; business management' in Class 35, 'financing services, insurance, insurance brokerage, leasing of vehicles' in Class 36 and 'construction, repair, servicing, maintenance, care, cleaning and spraying of vehicles, engines and parts therefor, including vehicle repair; finishing and tuning of motor vehicles' in Class 37 are identical to the goods and services covered by the earlier mark. Concerning all the others goods and services under comparison, it must be pointed out that some other items may be considered similar and that for reason of economy in the procedure, the Office deems that it is not necessary to analyze in detail all of them.

- The relevant consumer is the average consumer of this kind of goods in the European Union and the level of attention of the public when dealing with the goods and services in dispute will be fairly higher than average because the products concerned are relatively expensive and the services are rather infrequently provided. In the present case, it is to be expected that the average consumer will not buy the goods and services in dispute in the same way as he or she would buy articles of daily use. The average consumer will be an informed one, taking all relevant factors into consideration, for example, price, consumption, insurance costs, personal needs or even prestige. For some of the goods in conflict, vehicles for example, the level of attention will be very high indeed because vehicles always represent a major purchase requiring careful consideration.

- In the earlier mark, the word ‘LAND’ is an element having limited distinctive character vis-à-vis goods in Class 12. It is a feature of the vehicles sector that being able to travel over all kinds of land (as opposed to just on roads) may be a positive selling point. Although not all consumers will understand this English word clearly it is nevertheless the case that it is a very basic word of English vocabulary, which is likely to be recognised widely (especially due to its appearance in such contexts as: ENGLAND; SCOTLAND; MARYLAND; NEWFOUNDLAND).
- As to the distinctive character of the earlier mark, the opponent claimed that its mark is particularly distinctive by virtue of intensive use or reputation. It should be noted that the opponent has submitted evidence and demonstrated that the earlier trade mark enjoys a high degree of distinctiveness as a result of its long standing and intensive use/high degree of recognition. However, the opponent only demonstrated it for goods in Class 12, namely vehicles. It is precisely in relation to these goods that the common element between the marks (namely ‘LAND’) is regarded as weakly distinctive for the reasons given above.
- For all the abovementioned reasons, the Office considers that, despite the high distinctiveness acquired by the earlier marks and the identity or similarity of some of the goods and services in dispute, the dissimilarity between the marks are sufficient to exclude a likelihood of confusion in the territory where the earlier mark is protected on the part of the relevant public. Therefore, the opposition must be rejected.
- The other earlier rights invoked by the opponent are even less similar to the contested trade mark. This is because they contain further figurative elements which are not present in the contested Community trade mark application. *A fortiori*, no likelihood of confusion exists with respect to those other earlier rights.

Article 8(5) CTMR

- It is clear that the similarity of the marks is also a condition for the application of Article 8(5) CTMR. As has already been held above, the conflicting marks are considered similar only to a low extent. Although it has been demonstrated that the earlier mark has a reputation in respect of goods in Class 12 it has not been demonstrated how unfair advantage or detriment could come about as a result of this reputation. It is therefore superfluous to proceed with the examination of whether or not the other conditions of Article 8(5) CTMR are fulfilled.
- 8 On 25 November 2008, the opponent filed the notice of appeal and on 30 January 2009 the statement of grounds.
 - 9 The appeal was forwarded to the Opposition Division for consideration pursuant to Article 62 CTMR and was remitted to the Boards of Appeal on 18 February 2009.

- 10 On 24 August 2009, the applicant filed its observations, which were followed by a reply from the opponent filed on 21 October 2009 and by a rejoinder of the applicant filed on 4 January 2010.

Submissions and arguments of the parties

- 11 The opponent requested the Board to annul the contested decision and to reject the contested trade mark in its entirety. It considers that the contested decision infringes Article 8(1)(b) and 8(5) CTMR and that, since the contested decision does not respond to the arguments and evidence brought forward by the opponent with regard to Article 8(5) CTMR, it also infringes Article 52(1) CTMR. Its arguments can be summarised as follows:

In relation to Article 8(1)(b) CTMR

- The Opposition Division correctly found some goods and services applied for to be identical to those covered by the earlier mark. However, it did not make a complete enumeration of the identical goods and services covered by both marks (the opponent lists those considered to be the most obvious cases of product identity). The remaining non-identical goods and services are at least highly similar.
- The Opposition Division correctly found that trade marks ‘LAND ROVER’ possess a high degree of distinctiveness as a result of their long-standing and intensive use/high degree of recognition, as well as having a reputation in respect of goods in Class 12. However, it also found that ‘LAND’ only possesses a limited degree of distinctiveness due to its descriptive meaning. The opponent points out that the limited scope of protection of a trade mark composed of a descriptive element will be compensated by its successful and effective use on the market and the higher degree of recognition going along with it.
- The average consumer does not see the first element ‘LAND’ in the opposition trade mark ‘LAND ROVER’ as a descriptive and non-distinctive element. That is supported by the fact that the owners of vehicles manufactured by the Opponent refer to their cars as ‘landy’s’ (see Exhibit A filed on 12 September 2007). The limited scope of protection of a trade mark consisting of descriptive elements will be compensated by the effective and successful use of the mark as a trade mark on the market and the higher degree of recognition going along with it.
- The coincidence of the trade mark ‘LAND ROVER’ and the younger mark ‘Landwind’ in their respective beginnings, which is more important for the overall impression of a mark than its ending, leads to conclude that the signs are phonetically and visually similar to a medium degree. The Opposition Division did not apply, to the present case, the rule relating to the imperfect recollection of the marks.

- As the Opposition Division recognised, speakers of English, German, Dutch, Danish and Swedish will understand that ‘Landwind’ is composed of the elements ‘LAND’ and ‘WIND’, the fact that they are written as one word should not have any importance for the assessment of similarity of signs. The conceptual identity in the respective first elements constitutes at least certain conceptual similarities of the conflicting marks as a whole. In the case that the specific meanings of the conflicting marks were not understood by a part of the targeted public in the European Union, no conceptual comparison could be made at all and conceptual differences could not counter-act existing visual and phonetic similarities. The repetition of ‘ND’ in the younger sign does not contradict this finding of similarity because even if a small part of the relevant public perceives this repetition, it will not be considered a fanciful and highly memorable creation of the trade mark owner, but a mere coincidence.

- The average consumer’s level of attention has to be assessed for each individual product. Thus, the Opposition Division erroneously transferred its finding that consumers’ attentiveness was high while purchasing vehicles against all the other goods and services relevant in the present case. Moreover, the consumer’s higher degree of attention is not sufficient to prevent likelihood of confusion in cases as the present one, where the signs are similar at least to a medium degree; the goods and services are identical or highly similar and the older trade marks possess a very high degree of distinctiveness.

In relation to Article 8(5) CTMR

- The Opposition Division did not put forward any argument to rebut the opponent’s line of argumentation regarding Article 8(5) CTMR contained in its substantiation brief of 13 July 2007, but simply stated that the requirements of this article are not fulfilled.

- The Opposition Division has explicitly confirmed that the opposing trade marks ‘LAND ROVER’ are trade marks with reputation in respect of their Class 12 goods. It has also recognised that the opposing trade marks possess a high degree of distinctiveness as a result of their long-standing and intensive use/high degree of recognition.

- As regards the requirement of similarity of signs, the similarities between the signs involved in the present case are significant enough to find likelihood of confusion within the meaning of Article 8(1) CTMR. Nevertheless, even if there was no likelihood of confusion, the similarities between the signs at hand would still be sufficient for Article 8(5) CTMR to be applied as all the relevant factors for the global assessment of the existence of an established link between the marks as set forth by the European Court of Justice in its decision ‘INTEL’ are fulfilled (the goods involved and the relevant section of the public are identical; the witness statements and exhibits submitted show that the reputation of the opponent’s trade marks is extremely high and that these marks possess a very high degree of distinctiveness, these issues being

recognised by the Opposition Division; there is a medium degree of similarity between the confronted trade marks; and there exists even likelihood of confusion on the relevant part of the public). Exhibit F (a printout of an internet blog, which concerns the ‘landwind cars’ disastrous testing results as demonstrated in Exhibit D) proves that the relevant public already established a connection between ‘LAND ROVER’ and ‘Landwind’, which confirms that the signs are sufficiently similar.

- According to the European Court of Justice, the existence of one of the types of injury stated in Article 8(5) CTMR (or the risk that they will occur in future) must be assessed globally, taking into account all the relevant factors, which include the criteria relevant for the assessment of the establishment of a link between the marks. As these criteria are fulfilled to a very high degree in the present case, there is no doubt that there exists at least a serious likelihood that an injury to the opposition trade marks will come about in the future by the applicant’s use of the trade mark applied for. One of those factors is the strength of the reputation and the degree of distinctive character of the earlier mark. In the present case, the opponent demonstrated that its marks ‘LAND ROVER’ do not only possess an exceptionally high degree of distinctiveness due to their long-standing and intensive use on the market and their high degree of recognition, but also that they possess a very high reputation, which already indicates a non-hypothetical future risk of injury of the opposing trade marks.
- The extraordinarily high repute and goodwill of the opponent’s trade marks is proved by the two witness statements and the exhibits referred to therein. It has also been confirmed in the contested decision. The average consumer is confronted with the opponent’s trade marks everyday (he sees them on vehicles, in advertisements and in connection with sports and charity events) and is accustomed to them. Use of the sign applied for in connection with identical products would cause a severe risk of a significant reduction of this high degree of distinctiveness. Exhibit B shows that the applicant uses the contested trade mark for a van, i.e. for an almost identical kind of vehicle for which the opposition trade marks are especially famous. Exhibit F demonstrates that the public actually establishes a connection between the vehicles distributed by the opponent and the applicant due to the similarity of the signs.
- Both marks cover identical goods, in particular cars. The vehicles branded with the opposition trade marks are extraordinarily reputed for their superior quality, in particular their durability and longevity (see Exhibit MS1 and Exhibit C). There is a severe risk that this positive image of the opposing trade marks will be damaged by the use without due cause of the contested trade mark for identical goods which do not show the same characteristics. Exhibit D, which consists of an article from a 2005 issue of the German automotive magazine ‘ADAC motorwelt’ detailing striking quality and safety deficiencies of the ‘Landwind’ car, confirms that the risk of a future damage for the opposition trademarks’ reputation is not only a hypothetical risk.

- As regards the unfair advantage taken of the distinctive character or the repute of the earlier mark, the goods are, in the present case, identical and as a result, the groups of clients are also identical. It goes without saying that use of the similar sign applied for unduly helps the applicant in marketing its own cars. For example, the contested sign will be listed in immediate connection with the opponent's 'LAND ROVER' marks in third parties' alphabetical listings of cars. This will necessarily draw the attention of the relevant public to the very similar sign 'Landwind' and the products branded therewith.
 - The applicant has not demonstrated that there is due cause for its use of the sign applied for.
 - To complete the picture of the applicant's strategy to improve its own market success by taking unfair advantage of third parties' trade marks and other intellectual property, the opponent submits Exhibit G (it details a conflict between the manufacturers of the 'Landwind' vehicles and General Motors) and Exhibit H (which contains a comparison between different genuine products designated with well-known trade marks and products of Chinese origin that rather blatantly imitate these originals).
- 12 The applicant in its observations requested the Board to reject the appeal and confirm the contested decision. Its arguments are as follows:

In relation to Article 8(1)(b) CTMR

- The relevant public is the end consumer found in the European Union. In view of the nature of land vehicles and in particular their price and highly technological character, the degree of attention of the relevant public at the time of purchase is particularly high.
- The Opposition Division came to the conclusion that most of the goods and services under comparison are identical or highly similar. The applicant does not contest this finding.
- Visually, the marks have their first four letters 'LAND' in common and the fact that they consist of two words. However, these identical letters form a word in the earlier mark whereas they are merely the first four letters of the word 'Landwind'. The marks have different length, composition and structure. In the present case, although the beginning of the marks is identical, it is irrelevant because consumers will pay less attention to it as they will immediately and without any doubt understand the prefix/first word 'LAND' as descriptive of some characteristics of the goods and services, namely that it concerns land vehicles. Moreover, the use of the word 'Land' is very common for the particular category of goods and services as the attached Exhibits 1-5 show. Therefore, the comparison should only focus on the other elements (-wind and Rover), which are different, these differences being sufficient, in the overall visual assessment of the marks, to outweigh the similarity of the first four shared letters. Since the level of attention and

knowledge of consumers purchasing a land vehicle is deemed to be higher than average, they are likely to pay more attention to the dominant elements of the signs (specially their different endings and not the descriptive prefix 'Land').

- Phonetically, in spite of the fact that the first four letters are the same, the different pronunciation of the suffixes is sufficient to distinguish the trade marks irrespective of the different national pronunciation rules.
- English is an official language of the European Union and the statement that part of the European public will not understand the word 'land' is not convincing, nor is it true. It could be assumed from the public's high level of attention and knowledge that the relevant public are capable of distinguishing and understanding the descriptive component 'Land' in the two marks involved as a reference to 'land vehicles' and not as an indication of the commercial origin. A fact that contributes to the assertion that 'land' is descriptive for the goods is that apart from the off-road vehicle 'Land-Rover', there is another off-road vehicle from Toyota (the 'Landcruiser'), which is also registered as a Community trade mark and is only used, as 'Land Rover', for Sport Utility Vehicles (see Exhibit 1).
- Bearing in mind the interdependence principle, that marks with a highly distinctive character enjoy a broader protection than marks with a less distinctive character and due to the particularly careful examination by consumers at the moment of purchasing a car, it cannot be assumed that there is likelihood of confusion at the present case.
- The opponent's Exhibit F cannot be used as evidence because it is very questionable since it only consists of an opinion of one person and it has a highly unprofessional character. Moreover, this document does not show that the users of the internet blog are independent, well informed and/or objective. Nevertheless, when analyzing the blog discussion (few sentences are reproduced for that purpose), it is quite clear that the general public distinguishes the two conflicting marks very well and that there is no likelihood of confusion.

In relation to Article 8(5) CTMR

- The opponent's appeal under Article 8(5) CTMR is unfounded because the first of the cumulative conditions settled in this article is not fulfilled, i.e. the marks are not similar.
- However, even if the Board would find that the trade marks are somewhat similar, the appeal must fail anyway because the opponent has not proved that there is a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark, is not fulfilled.

- The opponent’s documents submitted in order to prove its considerable advertising investments to promote its products and services can only possibly prove that the earlier mark has a reputation. That the mark ‘LAND ROVER’ has reputation for land vehicles is not disputed at all.
 - There can only be a risk of unfair advantage being taken of the distinctive character or the repute of the earlier mark ‘Land Rover’ if the relevant public is particularly attracted to goods or services with solely the ‘Landwind’ mark because it is identical or similar (which it is not) to the earlier mark. This is stated but not proven by the opponent.
 - The risk of ‘dilution’ and ‘gradual whittling away’ of the mark ‘Land Rover’ is absent or limited because the term ‘Land’ is an English word, meaning land/ground, and it is widely and frequently used both internationally and nationally.
 - The opponent has neither cited nor proved any characteristic or quality of the products and services covered by the trade mark ‘Landwind’ capable of establishing the likelihood of detriment to the repute of the earlier mark ‘Land Rover’.
- 13 In the opponent’s reply, the opponent insists on the content of its previous observations and points out:

Infringement of Article 8(1)(b)CTMR

- The applicant admits that the goods and services involved are identical or highly similar and that the marks ‘Land Rover’ have reputation without it contesting the finding that the opponent’s trade marks possess a high degree of distinctiveness. In cases where the earlier mark has a distinctive character and the goods are identical, even remote similarities between the marks are sufficient to find likelihood of confusion.
- The trade mark element ‘LAND’ is not descriptive for any of the goods and services covered by the confronted trade marks (as confirmed by the consumer’s designation practices shown in Exhibit A). In any case, the descriptive meaning of the word ‘LAND’ as a description of the ability of those goods to travel over all kind of land would be absolutely trivial. Those trivialities cannot lead to a lack of distinctiveness since the average consumer will never derive any information on specific features of the designated goods and services therefrom. Moreover, the applicant’s opinion that elements with a limited degree of distinctiveness cannot dominate the overall impression of a trade mark is wrong.
- The existence of the CTM registration ‘LANDCRUISER’ presented by the applicant also proves that the element ‘LAND’ cannot be deemed as directly descriptive because if it were descriptive and non-distinctive, its combination with the descriptive element ‘CRUISER’ could not lead to the degree of

distinctiveness necessary for the registration of that Community trade mark for, *inter alia*, motor vehicles.

- The applicant has not proved its statement that ‘the word ‘LAND’ is very common for the particular category of goods and services. It has only cited the low amount of five Community trade mark applications/registrations comprising the element ‘LAND’. One of them does not cover goods with a connection to the automotive sector whereas the use to a significant extent of the remaining ones has not been proved (one of these has not even been registered). The applicant’s Exhibits 1-5 are therefore irrelevant.
- Whether English is an official language of the European Union is not relevant and the only relevant question is whether or not all parts of the relevant public understand the conceptual differences between the English terms at issue.

In relation to Article 8(5) CTMR

- The evidence submitted as Exhibit F is admissible. The passages from OHIM’s Opposition Guidelines quoted by the applicant refer to documents submitted to prove reputation and are not applicable to documents submitted in order to prove that the public establishes a link between two conflicting signs.
 - The fact that the author of this statement as well as other authors of further blog articles differentiate between ‘Land Rover’ vehicles and ‘Landwind’ vehicles does not mean that these authors do not establish a link between the signs. Their discussion about the different quality characteristics of these two vehicles supports that they perceive a specific relationship between them.
 - The reasons why all the risks under Article 8(5) actually exist have already been shown in the previous observations. Thus, regarding the unfair advantage of the repute of the earlier trade mark, the image and message conveyed by this mark (e.g. their robustness and longevity) can easily also apply to the products covered by the contested application since they are identical (vehicles). There is also a damage to the reputation of the earlier trade marks since their image and message for, for example, durability and longevity, can be seriously harmed by the use of the similar sign ‘LANDWIND’ for a SUV which shows such striking quality and safety deficiencies as the vehicle tested by the German automobile club ADAC (see Exhibit D). In relation to the risk of dilution of the opposing trade mark, the applicant referred to the European Court of Justice’s decision ‘SPA FINDERS’, which has nothing to do with the present case because, as it can be seen in its paragraph 49, the difference found between the goods was important.
- 14 In the applicant’s rejoinder, the applicant insists on its previous allegations and denies the applicability to this case of some decisions quoted by the opponent. It mainly points out the following:

In relation to Article 8(1)(b) CTMR

- The finding that most of the goods and services are identical or highly similar is not disputed. However, whether similarity between the goods leads to confusion will depend on the degree of similarity between the signs and other factors involving likelihood of confusion.
- The reputation of the opponent's trade mark 'LAND ROVER' is conceded but only for land vehicles.
- Although the applicant does not have to prove the meaning, and thus descriptiveness, of the word 'Land', it submitted Exhibits 1-5 for that purpose. Moreover, the English word 'Land' has the same meaning in the Netherlands, Germany, Belgium and Luxemburg. Descriptiveness in those countries would already be enough to conclude that the mark is descriptive for the whole EU territory (according to Article 7(2) CTMR). Bearing in mind the unitary character of the Community trade mark, when a trade mark has a limited distinctiveness in part of the Community, this would lead to the conclusion that the trade mark, as a whole, has limited distinctive character.

In relation to Article 8(5) CTMR

- The applicant maintains its previous lines of argumentation and remarks that it recognises reputation of the earlier mark only for goods in Class 12 and that the opponent did not convincingly prove that there is a serious risk of the applicant taking an unfair advantage of or for the use of the contested mark being detrimental to the repute or distinctive character of 'Land Rover' as explained in the INTEL case.

Reasons

- 15 The appeal complies with Articles 58, 59 and 60 CTMR and Rule 48 of CTMIR. It is, therefore, admissible.

Assessment of likelihood of confusion

- 16 Pursuant to Article 8(1)(b) CTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered 'if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.'
- 17 It is clear from that provision that the likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered by the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions

are cumulative (judgment of 12 October 2004, C-106/03, 'Hubert', para. 51). Therefore, if the signs are completely different it is possible in principle, without examining the goods in question, to take the view that there is no likelihood of confusion (judgment of 23 November 2005, T-396/04 'Nicky', paras 26-27).

- 18 According to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion. According to the same line of case-law, the likelihood of confusion on the part of the public must be assessed globally, according to the relevant public's perception of the signs and of the goods and services in question, and taking into account all factors relevant to the circumstances of the case, including the interdependence between the similarity of the signs and that of the goods or services covered. In the light of that interdependence, even a lesser degree of similarity between the marks may be offset by a higher degree of similarity between the designated goods or services and vice versa (see judgment of 9 July 2003, T-162/01, 'Giorgio Beverly Hills', paras 30 to 33).
- 19 The perception of marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The likelihood of confusion must be determined by the means of a global appraisal of the visual, phonetic and conceptual similarity of the marks, on the basis of the overall impression given by the marks, bearing in mind in particular their distinctive and dominant components (see judgment of 11 November 1997, C-251/95, 'Sabèl', para. 23). Furthermore, the average consumer normally perceives a mark as a whole and does not proceed to analyze its various details. In addition, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but has to place his trust in the imperfect image of them that he has retained in his mind.
- 20 For the purposes of that global assessment, the average consumer of the products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also 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 (judgment of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', paras 25-26).
- 21 The earlier marks are protected in the European Union, in Germany and in the UK, which constitute consequently the relevant territories for the purposes of applying Article 8(1)(b) CTMR. The goods and services covered by the mark applied for and the goods and services covered by the earlier marks encompass goods and/or services which can be aimed both at the general public and at professionals in the corresponding fields. In the present case, not only the professional's level of attention is high. The level of attention of the general public when dealing with the goods in Class 9 (e.g. Scientific apparatus or spectacles), 12 (e.g. vehicles) and 14 (e.g. jewellery) will be fairly high because these products are technical or relatively expensive and they always represent a major purchase requiring careful consideration. The level of attention of the general public will also be high in relation to the services involved (e.g. financial services) because



these services are not contracted on a daily basis and they may involve significant investments.

Comparison of the goods and services

- 22 In assessing the similarity of the goods, all the relevant factors relating to those goods should be taken into account, including, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary (see judgment of 29 September 1998, C-39/97, ‘Canon’, para. 23). According to the case-law, goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking (see judgment of 1 March 2005, T-169/03, ‘Sissi Rossi’, para. 60). Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see judgment of 21 April 2005, T-164/03 ‘monBeBé’, para. 53).
- 23 The Opposition Division has found the goods and services involved partially identical and partially similar. The applicant has explicitly mentioned in its statement of grounds for the appeal that it does not dispute this finding. Bearing this mind, the Board considers that the finding of the Opposition Division was correct.

Comparison of the signs

- 24 The signs to be compared are the following:

<i>Earlier trade marks</i>	<i>CTM applied for</i>
1) LAND ROVER  2)  3)	LANDWIND

- 25 The earlier trade mark under number 1) is registered in the European Union, the earlier mark under number 2) is registered in Germany and in the UK and the earlier trade mark under number 3) is only registered in the UK. Therefore, the relevant territories are the European Union, Germany and the UK respectively.
- 26 The Court of Justice has held that the assessment of the similarity between two marks must be based on the overall impression created by them, in light, in particular, of their distinctive and dominant components. Furthermore, when a sign consists of both figurative and word elements, it does not automatically follow that the word element must always be regarded as dominant.

- 27 It must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it. It should be made clear that that approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components. With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark. (see judgment of 23 October 2002, T-6/01, ‘Matratzen’, paras 33-35). In that regard, the word element can hold a position equivalent to the figurative element (see judgment of 12 December 2002, T-110/01, ‘Hubert’, para. 53). In addition, even in circumstances where two marks are composed of similar word elements, that fact does not, by itself, support the conclusion that there is a visual similarity between the signs. The presence, in one of the signs, of figurative elements set out in a specific and original way can have the effect that the overall impression conveyed by each sign is different (see judgment of 24 November 2005, T-3/04, ‘KINJI by SPA’, para. 48).
- 28 From a phonetic point of view, the earlier marks will be pronounced as ‘LAND ROVER’ and the CTM applied for will be pronounced as ‘LANDWIND’. Therefore, the marks only share the pronunciation of the first four letters, the pronunciation of remaining letters being totally different (‘ROVER’/‘-WIND’). Moreover, the pronunciation of the letters that they have in common has a different rhythm and intonation due to the fact these letters form a word in the earlier marks whereas they are a prefix followed by different letters within the same word in the case of the mark applied for. Therefore, the Board finds the marks phonetically dissimilar despite their identical first four letters.
- 29 From a visual point of view, the earlier marks consist of two words (‘LAND ROVER’) whereas the mark applied for consists of a single word (‘LANDWIND’). The first word of the earlier word mark (‘LAND’) is identical to the beginning of the mark applied for. However, these four identical letters are followed by four additional ones within the same word only in the case of the mark applied for, which provide it with a longer visual impression. Moreover, the second word of the earlier marks (‘ROVER’) does not form part of the contested mark. Therefore, their different structure and composition is enough to render these two marks visually dissimilar from an overall perspective. The same reasoning is applicable to the earlier figurative trade marks as their verbal elements are identical to those of the earlier word mark, although this visual dissimilarity is

even higher when they are compared with the mark applied for because of their different natures (figurative/verbal). The presence of figurative elements, and the disposition of the verbal elements of the earlier marks in two lines in particular, strength the dissimilar visual overall impression.

- 30 From a conceptual point of view, there are European languages, such as English, where the words 'LAND', 'ROVER' and 'WIND' would be understood and consequently perceived in the corresponding trade marks. However, there are countries, such as France, Italy or Spain, where, at least, the words 'LAND' and 'ROVER' are not understood. Thus, in those countries where the word 'LAND', which is formed by the only four letters that the marks have in common, is not understood, the dissimilar visual and phonetic impression of the mark cannot be affected by any conceptual perception. In those countries where the word 'LAND' is understood and, consequently, can be perceived in both marks, the Board considers that this sector of the relevant public will be able to perceive the limited distinctive character of the word 'LAND' in relation to 'apparatus for locomotion by land' and will also be able to understand additional meanings in one or both trade marks ('ROVER' or 'WIND') which are not in common. Therefore, in those countries the conceptual coincidence in the meaning of 'LAND' is not enough to overcome in those countries the conceptual dissimilarities as well as the dissimilar visual and phonetic overall impression of the marks.
- 31 The above mentioned visual, phonetic and, in some languages, even conceptual dissimilarities are considered sufficient to provide the marks with a dissimilar overall impression despite of the similarities that exist between the marks because of the first four letters they have in common. Moreover, these dissimilarities will be particularly perceived by the relevant public with a high level of attentiveness.
- 32 According to Article 8(1)(b) CTMR, the similarity of the signs is a condition for a finding of likelihood of confusion. Since the signs are dissimilar, Article 8(1)(b) CTMR is not applicable.
- 33 The opponent has alleged that its trade marks enjoy an enhanced distinctive character and even reputation. In this regard, it should be pointed out that although these are important elements to take into consideration in the overall assessment of the likelihood of confusion, such assessment is only required where the two cumulative conditions for the application of Article 8(1)(b) CTMR are fulfilled (see judgement of 7 October 2010, T-244/09, 'Acsensa', para. 27), which does not occur in the present case.

Article 8(5) CTMR

- 34 Under Article 8(5) CTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered 'where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due

cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.’

- 35 According to the interpretation given by the Court, where the sign is used for identical or similar goods or services, a mark with a reputation must enjoy protection which is at least as extensive as where a sign is used for non-similar goods or services (see judgment of 9 January 2003, C-292/00, ‘Davidoff’, paras 24 to 26, and see judgment of 23 October 2003, C-408/01, ‘Adidas’, paras 19 to 22). Therefore, Article 8(5) CTMR must be interpreted as meaning that it may be relied on in support of an opposition lodged against an application for a Community trade mark covering goods and services which are not identical and not similar to those described by the earlier mark as well as against an application for a Community trade mark covering goods which are identical or similar to those of the earlier mark.
- 36 In order to better define the risk referred to by Article 8(5) CTMR, it must be pointed out that the primary function of a mark is unquestionably that of an ‘indication of origin’. The fact remains that a mark also acts as a means of conveying other messages concerning, *inter alia*, the qualities or particular characteristics of the goods or services which it covers or the images and feelings which it conveys, such as, for example, luxury, lifestyle, exclusivity, adventure, youth. To that effect the mark has an inherent economic value which is independent of and separate from that of the goods and services for which it is registered. The messages in question which are conveyed *inter alia* by a mark with a reputation or which are associated with it confer on that mark a significant value which deserves protection, particularly because, in most cases, the reputation of a mark is the result of considerable effort and investment on the part of its proprietor. Consequently, Article 8(5) CTMR ensures that a mark with a reputation is protected with regard to any application for an identical or similar mark which might adversely affect its image, even if the goods or services covered by the mark applied for are not similar to those for which the earlier mark with a reputation has been registered (see judgment of 22 March 2007, T-215/03, ‘Vips’, para. 35).
- 37 It must be noted that the purpose of Article 8(5) CTMR is not to prevent registration of any mark which is identical or similar to a mark with a reputation. The objective of that provision is, notably, to enable the proprietor of an earlier mark with a reputation to oppose the registration of marks which are likely either to be detrimental to the repute or the distinctive character of the earlier mark or to take unfair advantage of that repute or distinctive character. In that connection, it should be made clear that the proprietor of the earlier mark is not required to demonstrate actual and present harm to his mark. He must however adduce *prima facie* evidence of a future risk, which is not hypothetical, of unfair advantage or detriment (see judgment of 25 May 2005, T-67/04 ‘Spa-Finders’, para. 40).
- 38 In cases covered by Article 8(5) CTMR, the relevant section of the public makes a connection, that is to say, establishes a link, between the marks at issue without, however, confusing them. Therefore, the existence of a likelihood of confusion is not a condition for the application of that provision (see judgment of 22 March 2007, T-215/03 ‘Vips’, para. 41 *in fine*).

- 39 The public to be taken into account in order to determine whether registration of the later mark may be declared invalid pursuant to Article 8(5) CTMR varies depending on the type of injury alleged by the proprietor of the earlier trade mark. The existence of injury consisting of detriment to the distinctive character or the repute of the earlier mark must be assessed by reference to average consumers of the goods and services for which that mark is registered, who are reasonably well informed and reasonably observant and circumspect. As regards injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, in so far as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, the existence of such injury must be assessed by reference to average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect.
- 40 It is apparent from the wording of Article 8(5) CTMR that its application is subject to the following conditions: first, that the marks at issue are identical or similar; secondly, that the earlier mark cited in opposition has a reputation and, thirdly, that there is a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. Those conditions are cumulative and failure to satisfy one of them is sufficient to render that provision inapplicable (see judgment of 25 May 2005, T-67/04 ‘Spa-Finders’, para. 30, and judgment of 22 March 2007, T-215/03 ‘Vips’, para. 34).
- 41 As to the similarity of the signs, although in order to create a link between them in the mind of the public it is not necessarily required that their similarity is so important as to give rise to a likelihood of confusion on the part of the relevant section of the public (see judgment of 18 June 2009, C-487/07, ‘L’Oréal’, para. 36), the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public (see judgment of 27 November 2008, C-252/07, ‘Intel’, para. 44).
- 42 The first condition for the wider protection provided for in Article 8(5) CTMR implies that the earlier trade mark is known by a significant part of the public concerned by the product or services covered by that mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see judgment of 14 September 1999, C-375/97, ‘Chevy’, paras 24 and 26).
- 43 The second condition is that use without due cause of a sign identical with or similar to a registered mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark (see judgment of 27 November 2008, C-252/07, ‘Intel’, para. 26)
- 44 The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the European Union. In view of the facts of the proceedings, the territory of a Member State may be

considered to constitute a substantial part of the territory of the Union (see judgment of 6 October 2009, C-301/07 'Pago', paras 24, 27 and 30).

- 45 In the present case, the opposition was based on two Community trade marks, two German trade marks and eight UK trade marks. Therefore, it is necessary to ascertain, whether the earlier mark enjoys a reputation in those territories; whether the relevant consumers establish a link between the marks; whether the use by the applicant of the mark applied for would take unfair advantage of or cause detriment to the distinctive character or the repute of the earlier mark and finally, if appropriate, whether the applicant has due cause for the use of the mark for which it seeks registration.
- 46 It must be borne in mind that, according to the second part of Article 76(1) CTMR, in proceedings relating to relative grounds for refusal of registration, OHIM's examination is to be restricted to the facts, evidence and arguments provided by the parties and the relief sought. That provision has been interpreted as meaning that the departments of OHIM, including the Board of Appeal, when ruling on opposition proceedings, may base their decision only on the relative grounds for refusal which the party concerned has relied on and the related facts and evidence it has presented (see judgment of 23 September 2003, T-308/01, 'Kleencare', para. 32, and judgment of 22 June 2004, T-185/02 'Picaro', para. 28). However, it has also been held that the restriction of the factual basis of the examination of the opposition does not preclude the taking into consideration, in addition to the facts expressly put forward by the parties during the opposition proceedings, of facts which are well known, i.e. that are likely to be known by anyone or which may be learnt from generally accessible sources judgment of 22 June 2004, T-185/02 'Picaro', para. 29).
- 47 As said above, the existence of a link between the mark applied for and the earlier mark is an essential condition for the application of Article 8(5) CTMR. The harm referred to in that provision, where it occurs, is the consequence of a certain degree of similarity between the mark applied for and the earlier mark, by virtue of which the public concerned makes a connection between them, that is, establishes a link between them (see judgment of 25 May 2005, T-67/04 'Spa-Finders', para. 41).
- 48 The existence of that link must be appreciated globally, taking into account all factors relevant to the circumstances of the case. Those factors include: the degree of similarity between the conflicting marks; the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; the strength of the earlier mark's reputation; the degree of the earlier mark's distinctive character, whether inherent or acquired through use; the existence of the likelihood of confusion on the part of the public (see judgment of 27 November 2008, C-252/07, 'Intel', para. 42).
- 49 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which

has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind. Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration (see judgment of 27 November 2008, C-252/07, 'Intel', paras 44 and 54-55).

- 50 In examining whether the requirement of reputation is fulfilled, all the relevant facts of the case must be taken into account, in particular the market share held by the trade mark, the intensity, the geographical extent and the duration of the use of the trade mark, as well as the size of the investment made by the undertaking to promote it (see judgment of 14 September 1999, C-375/97, 'Chevy', para. 27).
- 51 The evidence submitted by the opponent to support the reputation of its mark 'LAND ROVER' consisted of two witness statements made by Mr Mark S. Sparschu, Chief Trademark counsel of Ford Motor Company, and 21 exhibits to which these statements explicitly refer, these being the following:
- Exhibit MS1: Pages from the website www.landrover.co.uk which provide detail regarding the history of the LAND ROVER vehicle;
 - Exhibit MS2: A table illustrating the volume of vehicles sold under the LAND ROVER mark throughout Europe for the period 2000-2006.
 - Exhibit MS3: A list of Land Rover dealers in the United Kingdom, France, Germany and Spain.
 - Exhibits MS4, MS5 and MS6: A list of the countries in which Land Rover has a web presence; print-outs showing the home page of some of them; and a table detailing the visitors to some of them.
 - Exhibit MS7: A selection of brochures which Land Rover has used in the past to promote its vehicles
 - Exhibits MS8 and MS9: copy advertisements together with a table detailing the advertisements; and a table detailing further publications in the UK during the year 2004 and their associated advertising expenditure.
 - Exhibit MS10: Photographs and web pages confirming the participation of Land Rover in different European automobile shows.
 - Exhibit MS11: pages from www.landroverg4challenge.com giving information about the Land Rover G4 Challenge, which is an international driving competition organised by Land Rover. It includes details of the competitors and their nationality for the 2003 and 2006 competitions.
 - Exhibit MS12: pages from www.landroverexperience.uk.com . The opponent explains that Land Rover Experience is a programme that offers customers challenging activities and that is also involved in fund raising initiatives and charity events.

- Exhibit MS13: pages from www.landrover.com.uk detailing sponsorship activities of Land Rover.
 - Exhibit MS14: pages taken from different Land Rover enthusiasts' websites.
 - Exhibit MS15: pages from www.landrovercentre.com which list overseas Land Rover clubs together with pages printed from the aforementioned sites.
 - Exhibits MS16 and MS17: print outs from the amazon.co.uk, amazon.fr and amazon.de websites showing the result of searches carried out in the book section using the term 'land rover'.
 - Exhibit MS18: a print-out dated December 2002 from the website dedicated entirely to LAND ROVER books www.landroverbookshop.com together with a more recent one from the same website.
 - Exhibit MS19: print outs from magazines for sale dedicated to Land Rover vehicles.
 - Exhibit MS20: pages printed from www.brandchannel.com which confirms the appearance of LAND ROVER vehicles in top films.
 - Exhibit MS21: Details concerning Land Rover's promotional and advertising activities.
- 52 The Board observes that relevant information, such as the volume of vehicles sold under the 'LAND ROVER' trade mark throughout Europe for the period 2000-2006, the marketing budget for the years 2003-2005 in Europe, the Land Rover turnover in Europe for the period 2003-2005, or the list of Land Rover dealers in different countries within the European Union, is directly provided by the opponent. Moreover, most of the websites referred to in the affidavit are the opponent's websites. However, even though statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence, the Board considers that, in the present case, the content of these statements is sufficiently supported by the attached exhibits.
- 53 Among the relevant information, the Board observes that, according to the witness statement, the trade mark 'LAND ROVER' was first used in relation to a four wheel drive vehicle at least as early as 1948 and it has been used continuously since that date, this information being also contained in its website (Exhibit MS1). The table contained in Exhibit MS2 provided by the opponent shows a constant volume of vehicles sold under the trade mark 'LAND ROVER' for the period 2000-2006 in several countries within the European Union. This sale volume is around 100,000 units per years, of which almost 50% being sold within the UK. This is a considerable amount bearing in mind the price of a vehicle. Thus, the witness statement indicates that 'LAND ROVER' turnover in Europe for the years 2003-2005 is between US\$ 3500 and US\$ 4700 million per year. The marketing budget for the years 2003 to 2005 for Land Rover's national sales companies in Europe was in excess of US\$100 million. All this information is in line with the content of some of the exhibits which come from an independent source.

- 54 Thus, the constant presence of 'LAND ROVER' vehicles on the market and its growing business value (e.g. *'the company finished last year with worldwide sales of around 91,000, up nearly a quarter on the 73,500 record of 1993. At present production rates, this year's total will be in excess of 110,000 – three times higher than it as a decade earlier. (...) Over the longer term, though, Land Rover production will have to grow substantially. Solihull could be producing 200,000 vehicles a year by the end of the century'* (article titled 'Land Rover climbs to production peak' contained in the Car magazine of March 1995), *'within a month of Ford buying the firm from BMW, work started on the T5 platform on which this car is built and which will give foundation to four cars: this one, the new Range Rover Sport, the new Defender and probably the next Range Rover, too. The car will tell us if Ford has understood Land Rover; its sales will tell Ford if the \$2.7bn (£1.5bn) it paid for Land Rover was a wide investment'* (www.autocar.co.uk 24 August 2004) or *'Britain Loves the Land Rover Discovery. The current model - the one that's been on sale since 1999, has its roots in the 1970 Range Rover and trails its best rivals by some considerable distance – is having one of its most successful sales years, with over 8300 finding homes to date. (To put that into context, it outsold the BMW 5-series last month)'* (www.autocar.co.uk 24 August 2004)) can be inferred from the content of the articles about 'Land Rover' vehicles found in the specialised magazines submitted.
- 55 These specialised magazines also inform about the technical development carried out along the years by the opponent and its impact on the resulting 'LAND ROVER' models (e.g. *'early doubts about owning a classic-look Land Rover are finally being swept away by the flawed charm of the rough, gutsy 4x4'* (Autocar magazine of 31 May 2000), *'Shock treatment. Talking of monsters, how do you fancy a Land Rover with a 5.7-litre V8 under the bonnet? Meet the Overfinch 570 HSi'* (Evo magazine April 2002) or *'Discovery 3 is a dynamic quantum leap after previous model; air-sprung ride majestically compliant over cats' eyes and coarse surfaces alike; body control impressive for such a tall, heavy car but roll pronounced and pock-marked roads upset ride; steering very precise'* (www.autocar.co.uk of 24 August 2004)) as well as about the position of the opponent's vehicles in relation to others identified as their direct rivals (e.g. *'Off-road, on-the-pace, here comes the Freelander, the 'baby' Land Rover. It's a style-4x4 with substance, but is it substantial enough to drive into a market dominated by 'established' players like RAV4 and CRV?'* (Car magazine, October 1997), *'So here they are, some of the best 4x4s in the world – and the new Land Rover Discovery. You've read how good it is on its own, now see how it fares in the mud-wrestling and on the road with the Toyota Land Cruiser, Volkswagen Touareg, BMW X5 and Volvo XC90'* (Discovery Group Test. www.autocar.co.uk 24 August 2004)); or the autocar road test contained in www.autocar.co.uk of 16 November 2004, where the Land Rover Discovery TDV6 HSE is identified as *'OUR CHOICE'* after being compared with BMW X5 3.0d, Mercedes Benz ML270 CDi, Toyota Land Cruiser LC5 3.0 D-4d, Volkswagen Touareg V6 TKi and Volvo XC90 D5 SE).
- 56 Further to the above-mentioned articles in specialised car magazines and the advertisements shown in them, the widespread knowledge of this trade mark in the motor industry sector is also supported by the presence of 'Land Rover' vehicles

in International Motor Shows within the European Union such as the Birmingham International Motor Show 2002 or Frankfurt Motor Show 2005 (Exhibit MS10). Moreover, it is possible to conclude that this knowledge goes even beyond the specialised sector and reaches the general public. To support this finding the Board observes that ‘Land Rover’ vehicles are the subject matter of several books available in the European Union (print-outs from www.amazon.co.uk show the result of 226 when a search using the term ‘land rover’ is carried out in the field of ‘books’ sorted by ‘bestselling’) and that there is a publication, namely the ‘LRM Land Rover monthly’ magazine, which is targeted to Land Rover drivers (‘enthusiasts’) and can be ordered on-line from different websites, some of them being independent ones such as www.mags-uk.com or www.greatmagazines.com.uk (a page with a list of the issues edited in the UK per year since 1998 to 2007 is contained in Exhibit MS19 and, although there is no information about the number of issues sold, the Board notices that there are four issues with the indication of ‘sold out’). Moreover, the opponent’s extensive promotional and sponsorship activities are clear opportunities to put the general public in contact with the trade mark ‘LAND ROVER’. In this regard, the Board considers particularly relevant, first, the organisation of the international competition ‘Land Rover G4 Challenge’ in 2003 and 2006 (contained in Exhibit MS11) which lasts four consecutive weeks and consists of different activities, one of them being off-road driving where ‘Land Rover’ vehicles are supplied; secondly, the 4x4 courses offered by ‘Land Rover’ aimed at the general public (contained in Exhibit MS12), which are organised according to different levels: from one hour course that is suitable for e.g. a birthday present to specialist courses); and thirdly, the fact that ‘LAND ROVER’ is the official vehicle of ‘England Rugby’ since 2002 and sponsors three of the world’s leading equestrian events, one of them being ‘The Royal Windsor Horse Show’ (information contained in Exhibits MS13).

- 57 Bearing all this in mind, the Board concludes that the trade mark ‘LAND ROVER’ enjoys a high reputation in relation to *‘apparatus for locomotion by land, namely 4x4 vehicles’*. Consequently, from the assessment of the evidence submitted, and independently whether the earlier mark has an inherent distinctive character or not, the Board confirms that the mark ‘LAND ROVER’ has an enhanced distinctiveness acquired through its use. This acquired enhanced distinctiveness cannot be considered diminished by the fact that the word ‘LAND’ exists in different European languages, such as English. The enhanced distinctiveness of the earlier mark ‘LAND ROVER’ affects the mark as a whole as it is a direct consequence of its use as a unit on the market, i.e. the relevant sector of the public will recognise the whole sign as a trade mark and because of that, will not perceive the word ‘LAND’ as additional information about the goods involved.
- 58 Finally, it is relevant to determine the degree of similarity that exists between the marks in conflict.
- 59 In the present case, the earlier word marks consist of two words, the first one (‘LAND’) being identical to the beginning of the word mark applied for (‘LANDWIND’). However, these marks have a different structure and

composition. The earlier figurative trade marks also have a different nature, and consequently differ in the figurative elements, when compared to the mark applied for. It has already been found above (see para. 32) that the signs at issue are not similar. The fact that the word 'LAND' is not an element on its own in the mark applied for as well as the different composition of the marks, introduce important visual and phonetic differences in the overall impression of the marks. Thus, the similarities between the conflicting trade marks cannot enable consumers to establish a link between them since the 'LAND' element of the earlier marks has no independent distinctive role in the sign applied for. The beginning 'LAND' in the contested mark will not be considered by the consumer in isolation but as an integrating part of the sole word 'LANDWIND'. Moreover, as explained above, the enhanced distinctiveness of the earlier marks affects the mark 'LAND ROVER' as a whole and not the 'LAND' element alone. Consequently, the Board considers that the mere coincidence of the marks in their beginnings based on these four letters, taking into account their role in the overall impression of the signs, cannot lead to conclude that the public will establish a link between the marks, even when they identify identical goods on the same market (see for this reasoning, judgment of 17 February 2011, T-10/09, 'F1 Live', para. 67).

- 60 As one of the conditions for the applicability of Article 8(5) CTMR (i.e. the similarity of the signs leading the relevant public to make a connection between the signs) is not fulfilled, the opponent's claim based on such a provision must be rejected without it being necessary to examine the other conditions, namely the existence of the injuries foreseen therein or the existence of due cause for the use of the earlier mark.
- 61 In view of the foregoing, the appeal must be rejected in its entirety.

Costs

- 62 Since the opponent is the losing party within the meaning of Article 85(1) CTMR, it must bear the fees and costs pursuant to Article 85(6) CTMR. It follows that it must also bear the representation costs of the applicant in the appeal proceedings of the amount of EUR 550 specified in Rule 94(7)(d) CTMIR.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the opponent to bear the costs of the applicant in the appeal proceedings of EUR 550.**

Signed

T. De Las Heras

Signed

G. Bertoli

Signed

H. Salmi

Registrar:

Signed

P. López Fernández De
Corres

