

TRADE MARKS ACT, 1963

Decision in Hearing under Section 26

IN THE MATTER OF an application for registration of Trade Mark No. 146025 and in the matter of an Opposition thereto.

MANUFACTURE DES MONTRES JAGUAR S.A. Applicant

JAGUAR CARS LIMITED and
THE JAGUAR COLLECTION LIMITED Opponents

The application

1. On 4 December, 1991, MANUFACTURE DES MONTRES JAGUAR S.A., a Joint Stock Company incorporated under the laws of Switzerland, c/o Pierre-André L'Epée, 3 Rue Louis-Favre, 2000 Neuchâtel, Switzerland, Watch Manufacturers and Agents, made application (No. 91/6050) to register the word "JAGUAR" as a Trade Mark in Part A of the Register in Class 14 in respect of the following goods:

"watches and parts thereof"
2. The Application was subsequently advertised as accepted for registration in Part A of the Register under No. 146025 in Journal No. 1717 on 22 September, 1993.
3. Notice of Opposition to the registration of the mark pursuant to Section 26 of the Act was filed on 4 November, 1993 by JAGUAR CARS LIMITED and THE JAGUAR COLLECTION LIMITED, both British companies of Browns Lane, Allesley, Coventry CV5 9DR, England. The Applicant filed a counter-statement on 4 February, 1994 and evidence was, in due course, filed by the parties under Rules 37, 38, 39 and 40 of the Trade Mark Rules, 1963.
4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 19 December, 2003. The parties were notified on 25 February, 2004 that I had decided to dismiss the opposition and to allow the mark to proceed

to registration. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of Opposition

5. In their Notice of Opposition the Opponents cite a number of facts and grounds of opposition, which may be summarised as follows:

- (i) Jaguar Cars Limited is the proprietor of the internationally renowned trade marks JAGUAR and a device of a jaguar, which marks are synonymous with high quality products including motor vehicles, articles of sports clothing, games, playthings, gymnastic and sporting articles, spectacles, sun-glasses, spectacle frames, articles of leather or imitation leather, bags, handbags, purses and watches.
- (ii) The Jaguar Collection Limited is a wholly owned subsidiary of Jaguar Cars Limited with particular responsibility for the marketing and sale of non-automotive products under the JAGUAR trade marks.
- (iii) Because of the international reputation of the JAGUAR trade marks and their association with Jaguar Cars Limited, use by the Applicant of the trade mark JAGUAR is likely to deceive or cause confusion and would lead to the Applicant's goods being passed off as those of the Opponents.
- (iv) Jaguar Cars Limited have used the JAGUAR trade marks in relation to watches and other horological instruments for many years and use by the Applicant of the trade mark JAGUAR in relation to watches will lead to confusion, deception and passing-off.
- (v) The mark that the Applicant has sought to register would be disentitled to protection in a court of law and registration would, therefore, be contrary to the provisions of Section 19 of the Act.
- (vi) The Opponents are the registered proprietors, or applicants for registration, of a number of trade marks (details provided) containing the word "JAGUAR" or the device of a jaguar and registered, or applied for, in Classes 9, 12, 18, 25, 28 and 37.
- (vii) The mark that the Applicant has sought to register resembles the marks that are the subject of the Opponents' earlier registrations and applications and the respective goods are goods of the same description; accordingly,

there is a likelihood of confusion or deception and registration of the Applicant's mark would be contrary to the provisions of Section 20 of the Act.

- (viii) The Applicant is not the *bona fide* owner of the mark that it has applied to register and did not, at the date of application, have a present and definite intention of using the mark in the State; accordingly, the application does not meet the requirements of Sections 2 and 25 of the Act.
- (ix) The mark sought to be registered is neither adapted to distinguish nor capable of distinguishing the Applicant's goods and is ineligible for registration under either Section 17 or Section 18 of the Act.
- (x) The adoption of the mark by the Applicant is a deliberate attempt to derive benefit from the Opponents' reputation and registration of the mark in favour of the Applicant would prejudice and embarrass the Opponents in the conduct of their respective businesses. For these reasons, registration should be refused in the exercise of the Controller's discretion.

Counter-statement

6. In its Counter-Statement the Applicant denies most of the assertions contained in the Notice of Opposition, admitting only the Opponents' proprietorship of some (but not all) of the trade mark registrations referred to therein. In particular, the Applicant states that,

- (i) it has carried on its business as manufacturer and merchant of watches and parts thereof for many years,
- (ii) the mark that it seeks to register is inherently and in fact adapted to distinguish its goods and it is used or intended to be used for that purpose,
- (iii) it has used and registered its JAGUAR trade mark in connection with its goods in a number of countries throughout the world and this has not led to any confusion,
- (iv) if the Opponents have sold watches or other horological instruments under their marks, then such sales have been recent and of small extent and have not established any reputation.

The evidence

Rule 37

7. Evidence submitted by the Opponents under Rule 37 consisted of –
- a Statutory Declaration (and Exhibits JCL1-JCL15) dated November, 1994 of Teresa Carmel Friend, authorised signatory of Jaguar Cars Limited and Company Secretary of The Jaguar Collection Limited, and
 - a Statutory Declaration (and Exhibits JDI1-JDI3) dated 20 June, 1995 of Gerard O’Farrell, General Manager of Jaguar Daimler Ireland Limited.

Rule 38

8. Evidence submitted by the Applicant under Rule 38 consisted of a Statutory Declaration (and Exhibits MJ1-MJ7), which is not dated but appears to have been made on 14 or 15 November, 1995, of Luciana Taillefumier, President of Manufacture Des Montres Jaguar S.A.

Rule 39

9. Evidence submitted by the Opponent under Rule 39 consisted of a Statutory Declaration (an Exhibits ABC1 – ABC10) dated 22 May, 1996 of Anthony Brian Cundy, Chartered Patent Agent and Registered Trade Mark Agent (U.K.).

Rule 40

10. Evidence submitted by the Applicant under Rule 40 consisted of –
- a further Statutory Declaration (and Exhibits MJ7 and MJ8), again undated but apparently made on 8 October, 1996, of Luciana Taillefumier, and
 - a Statutory Declaration (and Exhibits MJ9 – MJ11) dated 7 October, 1998 of Claudio Cocca, Director of Manufacture Des Montres Jaguar S.A.
11. Evidence submitted by the Opponent under Rule 40 consisted of a further Statutory Declaration (and Exhibits ABC11 – ABC14) dated 20 August, 1997 of Anthony Brian Cundy.
12. The foregoing evidence was extremely voluminous and wide-ranging in nature and much of it was, in my opinion, quite irrelevant to the matters really at issue between the parties. These parties have previously crossed swords in other

jurisdictions and the present proceedings are part of a long running dispute concerning the Applicant's entitlement to use the trade mark JAGUAR in relation to watches that has been played out in a number of other countries. In those circumstances, it is perhaps not surprising that the "evidence" submitted contains almost as many allegations, claims, charges and counter-charges as it does hard facts but it is regrettable, nevertheless. For the purposes of this decision and in order to put the matter in context, I have chosen to summarise in the following paragraphs the basic facts that are established in the evidence. I will refer in more detail to particular aspects of the evidence when I consider the opposition against the application for registration under the specific Sections of the Act cited by the Opponents.

The factual background

13. The first Opponent is an internationally renowned motor car manufacturer that has been in existence since the 1930's. Its cars are sold under the trade mark JAGUAR (word mark) and a device mark consisting of a leaping jaguar. Those marks have become very famous over the years and the Jaguar brand is among the most well recognised and valuable brands in the motor industry. The second Opponent is a wholly owned subsidiary of the first and has as its primary object the marketing and sale of prestige non-automotive products under the trade marks JAGUAR (word) and the device of a jaguar. The items marketed under those marks include watches, clocks, items of clothing, umbrellas, picnic baskets, jewellery, leather goods and travel goods. The extension of the Jaguar brand to such items is part of a merchandising strategy that seeks to realise the value of the brand and reinforce its association with the concepts of quality, style and sophistication.

14. The Applicant claims succession in title from an entity called Fabrique d'Horlogerie Sindaco S.A., which secured a registration of the trade mark JAGUAR in relation to watches in Switzerland in 1945. That registration, together with others, was assigned to a company called Achor S.A. in 1985 and subsequently assigned to the Applicant, which now holds registrations of the mark in many different countries throughout the world.

The hearing

15. At the Hearing the Opponents were represented by Paul Coughlan, BL instructed by Tomkins & Co., Trade Mark Agents and the Applicant by Brian O'Moore, SC instructed by L.K. Shields, Solicitors. Mr. Coughlan, for the Opponents, did not canvass all of the grounds of opposition cited in the Notice of Opposition, but constructed his argument against registration on three main pillars, viz., (i) that the Opponents, and not the Applicant, are the true proprietors of the mark in Ireland by virtue of first user, (ii) that the use of the mark by the Applicant would be likely to cause confusion and, (iii) that the application for registration was wanting in *bona fides*. In response, Mr. O'Moore disputed the Opponents' claim to have used their mark in the State in relation to watches prior to the date of the present application for registration, denied the alleged likelihood of confusion and rejected the claim of *mala fides*. Both Counsel provided me with written outlines of their submissions, which were very helpful to me in considering the matter and which is a practice to be encouraged.

The issues

16. It was evident from the arguments presented at the hearing that the only grounds of opposition being pursued on behalf of the Opponents were those under Sections 2 and 25 and Section 19 of the Act. I have confined my consideration of the matter to those Sections only.

Section 2 and Section 25(1) – is the Applicant the proprietor of the mark?

17. I look first at the objections based on Sections 2 and 25(1) of the Act. The relevant parts of those two Sections are as follows:

Section 2

‘ “trade mark” means a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark’;

Section 25

“(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Controller in the prescribed manner for registration either in Part A or Part B of the register.”

18. In the course of their evidence, the Opponents disputed the validity of the Applicant’s claim to be the successor in title of the original proprietor of the 1945 Swiss registration of the trade mark JAGUAR in respect of watches. A substantial part of the evidence filed by both sides related to proceedings in Switzerland in which the validity of the legal transfer of title was put in issue. Indeed, the evidence shows that criminal proceedings were instituted against Luciana Taillefumier in connection with an alleged fraud for interference with legal transfer documents. Anthony Brian Cundy (for the Opponents) refers to these proceedings, which he says are “in progress”, in his Statutory Declaration of 20 August, 1997 and Claudio Cocca (for the Applicant) responds in his Statutory Declaration of 7 October, 1998, stating that those charges had been dismissed by a decision of the relevant court dated 24 May, 1996, which was upheld on appeal by a decision dated 26 November, 1996. I found it extraordinary that the Opponents were still referring in their evidence to a matter that had apparently been resolved in favour of the Applicant some nine months earlier. In the event, Counsel for the Opponents accepted at the hearing that the outcome of the proceedings in Switzerland had been the dismissal of the charges against Ms. Taillefumier and, while the Opponents’ challenge against the validity of the legal transfer of title of the opposed mark remained, no further argument was presented in support of it and I took it that it was not being seriously pursued. In the circumstances, I think it is sufficient to say that the evidence filed by the parties does not prove conclusively that the transfer of title was invalid under Swiss law and the Opponents have not shown that the Applicant is disentitled to claim rights in the mark that was originally registered in Switzerland in 1945.

19. That is not the end of the matter, however, as an alternative argument for refusal of the application on the ground that the Applicant is not the proprietor of the mark was presented by Mr. Coughlan at the hearing. That argument is based on

the long established principle that the owner of a mark is the party that first uses it in the jurisdiction (as affirmed by O’Sullivan J in the High Court in *Montex Holdings Ltd. v. Controller* [2000] 1 IR 577). Mr. Coughlan pointed, in this regard, to the Opponent’s evidence under Rule 37, being the Statutory Declarations of Ms. Friend and Mr. O’Farrell in which both deponents make statements about the sale of non-automotive products, including watches, under the JAGUAR trade mark. Mr. Coughlan contrasted this evidence with that put in by the Applicant, which contained no claim to have used the mark in this jurisdiction and which, in fact, specifically omits Ireland from the list of countries in which it is using the mark.

20. The Opponents’ claim is, therefore, that they are the true proprietors in this jurisdiction of the trade mark JAGUAR in relation to watches because they were the first to use the mark in relation to those goods here. The Applicant does not claim to have used the mark here but, in making its application, it signalled an intention to do so on 4 December, 1991 and the question of proprietorship turns on whether or not the Opponents can establish use of the mark here on the relevant goods before that date. The evidence in this regard was subjected to close scrutiny at the hearing, which scrutiny focussed on the statements of Ms. Friend and Mr. O’Farrell referred to in the preceding paragraph. The relevant statements are as follows:

Ms. Friend in November, 1994

“The Trade Marks JAGUAR and the Device of a leaping Jaguar were first used in relation to watches in 1982 and there have been continuous sales internationally of watches bearing the said Trade Marks up to the present time. I understand that there have been a number of sales of watches bearing the Trade Marks JAGUAR and a Device of a leaping Jaguar in Northern Ireland and the Republic of Ireland during the last decade through JCL’s (Jaguar Cars Limited) Irish Distributors, Jaguar Daimler Ireland Limited of Long Mile Road, Dublin 12, Republic of Ireland. Due to the absence of full clear records, it is impossible to quantify the exact monetary value of such sales. However, attached hereto and marked “Exhibit JCL6A” are a collection of invoices relating to the sale of watches bearing the trade

mark Jaguar and/or a device of a Jaguar in Northern Ireland and the Republic of Ireland since 1984.”

Mr. O’Farrell in June, 1995

“It is estimated that JDI (Jaguar Daimler Ireland) have sold products bearing the Trade Marks JAGUAR and the Device of a leaping Jaguar to the value of IR£12,399,866 during the period 1986 to 1994 inclusive in the Republic of Ireland. The majority of such sales relate to “motor vehicles” but my Company have made sales of accessories which are sold under the collection entitled “THE JAGUAR COLLECTION”, as illustrated in the brochure shown to me and exhibited hereto marked “Exhibit JDII” including watches. The Trade Marks JAGUAR (word) and the Device of a Jaguar are prominently displayed on the analogue clock which forms part of the specification of the Jaguar XJS model car which has been on sale since October, 1993, some sales of which have taken place in the Republic of Ireland.”

21. There are, essentially, two separate claims to use of the mark in Ireland in relation to watches and clocks; firstly, there is the claim that watches were sold here through the Irish distributors of Jaguar motor cars and, secondly, there is the reference to the fact that the JAGUAR mark appears on the analogue clock of the Jaguar XJS, which has been sold here since 1993. The second of these claims is, I think, fanciful in the extreme. Apart from the simple fact that the claimed use post-dates the present application for registration, the suggestion that a car manufacturer’s trade mark appearing on the clock that is part of the car dashboard display constitutes use of the mark in relation to clocks is simply not supportable. Such use of a mark is in relation to the car and not the clock, which cannot, of course, be separately purchased or taken away and is indivisible from the complex product of which it is a part.

22. As to the Opponents’ claim to have sold watches bearing their marks here, the exhibit referred to in Ms. Friend’s statement is relevant. That exhibit, (Exhibit JCL6A) consists of 12 pages, each appearing to be a copy of an invoice. Only one of the copy invoices (that which appears fourth in the bundle and is dated 6-12-87)

is relevant as the remainder are either in respect of sales to dealers in Northern Ireland or are in respect of transactions occurring after the relevant date. The copy invoice in question refers to 3 watches with the reference numbers JMM1150, JMM1147 and JMM1148, respectively. The latter is a ladies watch that is provided free of charge so that only JMM1150 (£90) and JMM1147 (£36) have been charged for and the total value of the invoice, including V.A.T., is £145.90. The invoice is not directed to a specific address but bears the words “For Jaguar/Daimler Ireland” at the bottom and this is taken to be a reference to the company of which Mr. O’Farrell is (or was) General Manager.

23. Now it seems to me that this is very flimsy evidence on which to base a claim to proprietorship of a trade mark by virtue of first user in the jurisdiction in the context of an opposition against another’s application for registration of the mark. All that is established by this evidence is that three watches, one of which was given *gratis*, were dispatched to an Irish distributor of Jaguar motor cars. It is not established whether those watches were subsequently sold on, or given free of charge, to customers of that car distributor or, indeed, whether they were retained by the person in question. It is certainly not evidence of goods bearing the mark having been put on the market here in such a way as to be likely to have come to the notice of the public generally or even of a very small subset of it, i.e., all those who bought Jaguar cars. I think that, in order for a claim to proprietorship of a mark based on use to succeed, the use must be genuine use of the mark as a trade mark for the relevant goods and that use must be more than mere token use. I was urged by Counsel for the Opponents to look not only at the invoices exhibited, which the Opponents say do not show the whole picture, but to consider also the statements made by the deponents to the effect that watches bearing the mark have been sold in this jurisdiction over a period of years. However, when I look at those statements, I find them to be very vague and to be lacking in specific information as to when, precisely, sales of watches bearing the Opponents’ marks commenced here, approximately how many such watches were sold prior to the date of the present application, approximately what was the value of those sales and through what trade channels in this jurisdiction were those watches marketed and, thereby, brought to the notice of the public. In the absence of any such information from the Opponents, I am left really with just the copy invoices and I

am forced to conclude that there was effectively no use by the Opponents of the disputed mark as a trade mark for watches in this jurisdiction prior to the date of the present application for registration. That being the case, the Opponents' objection to registration on the grounds that they are the true proprietors of the mark in relation to the relevant goods is not supported and I dismiss it accordingly.

Section 19 – would the mark be disentitled to protection in a court of law?

24. Section 19 of the Act reads as follows:

“It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design.”

25. The standard test for an objection under Section 19 is that set down by Evershed J in the *Smith Hayden & Co. Ltd.* application [1946] RPC 97, as adapted by Lord Upjohn in the *Bali* case [1969] RPC 472. For the present purposes, that test may be expressed as follows:

Having regard to the user of the Opponents' marks, is the Hearing Officer satisfied that the mark applied for, if used in a normal and fair manner in connection with watches and parts thereof, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons.

26. The first thing that must be established, therefore, is whether there has been use of the Opponent's marks and I think it is fair to say that this is not in dispute. The Opponents have provided ample evidence of use of their marks and Counsel for the Applicant did not deny their reputation under those marks, although he contended that that reputation was limited to the field of motoring. The question at issue between the parties is whether the use by the Applicant of the trade mark JAGUAR in relation to watches is likely to lead to confusion in the minds of the public by virtue of the Opponents' existing reputation under that mark here. The Applicant says that the very significant differences in the respective goods, motor

cars and watches, means that consumers will not be confused or misled while the Opponents argue that it is a common practice for car manufacturers to seek to exploit their brands through their extension onto other goods, including watches, and that the public, being aware of that practice, will be confused if the Applicant uses the mark. Again, the relevant date on which the question should be judged is the date of the application for registration and it must, therefore, be determined whether, in December, 1991, the sale by the Applicant in this jurisdiction of watches bearing the mark JAGUAR would result in a real tangible danger that a substantial number of people would be caused to wonder whether those watches were, in fact, the goods of the Opponents.

27. I should say, first of all, that I regard it as unnecessary for me to go into an analysis of the similarities and differences between watches and motor cars as regards their composition, uses, end-users, channels of trade, etc. I think it is obvious to any reasonable person that a watch is an entirely different product from a motor car and the Opponents have not suggested otherwise. Notwithstanding that fact, it may be that the use of a mark, particularly a well-known mark, on goods that are different from those in respect of which the mark has come to be known, may still cause confusion if consumers are apt to expect (or, at least, to not discount the possibility of) the extension of the brand name in question to the relevant goods. It is in this regard that the Opponents' evidence as to the alleged practice among motor car manufacturers of extending their brands to include other goods becomes relevant. That evidence includes a statement by Anthony Brian Cundy in his Statutory Declaration dated 22 May, 1996 given as evidence under Rule 39 in which he says that the concept of brand extension "*is prevalent throughout the motor industry, especially amongst the manufacturers of vehicles regarded as stylish, quality products with brand names which are readily perceived by the purchasing public as affording kudos to the vehicle owner*". In support of this assertion, he exhibits at ABC9 extracts from product brochures of a number of car manufacturers showing the use of their brand names on non-automotive products, especially watches. The brands in question are MG, Rover, Land Rover, Quattro (Audi), BMW and Mercedes Benz and the brochures bear dates for the years, 1994, 1995 and 1996. While these dates are later than the date of this application, I expect that this is because these were the brochures available

to Mr. Cundy when he made his Statutory Declaration and I am inclined to accept them as evidence of a practice that was most probably ongoing at the time when the application was made. There is also, of course, the evidence provided by the Opponents of the fact that they, themselves, have engaged in brand extension and this includes evidence that they had extended their brand to watches as far back as 1982. On the whole, I conclude that the practice of brand extension existed in the motor industry at the time when this application for registration was made and that that practice involved the application to goods such as watches of the marks of well-known car manufacturers, such as the present Opponents.

28. Having regard, therefore, to the considerable differences between the goods of the parties but allowing for the fact that there has been a practice of brand extension of the type just described, what then was the likelihood of confusion between the marks at the relevant date? I think that question requires consideration of the impression that would be likely to be formed in the mind of the average consumer on encountering watches for sale under the mark JAGUAR. While that person is not, in my opinion, likely to seriously wonder whether the well known car manufacturer has gone into the watch business, I would not discount the possibility that he might think that the product bearing the mark is offered for sale under the authority of the owner of the motor car trade mark or is marketed as part of a promotional campaign in support of that entity's core business. The Opponents have provided evidence of at least one instance of confusion of this type in Exhibit ABC attached to Mr. Cundy's 1996 Statutory Declaration. That exhibit includes a copy of a letter dated 28 December, 1994 sent to the Opponents by a Mr. D.F. Roberts of Surrey, England, who complains about a "Jaguar" watch that he bought while on holiday in Gran Canaria in the mistaken belief that it emanated from the Opponents. While I would not deny that that is clear evidence of an instance of confusion between the marks of the parties, neither do I regard it as conclusive as to the likelihood of confusion between them among Irish consumers. Mr. Roberts bought his watch in what he describes as a "high-class" jewellers, "*displaying all the "names" that you would expect to see on such a business, "Jaguar", "Longines", "Loris", etc.*". From that statement, it appears to me that Mr. Roberts had a pre-conception of JAGUAR as a brand that one would expect to see in a jewellers and, presumably, as one that one would expect

to see used in relation to watches. I am not certain that the average Irish consumer would have such a pre-conception.

29. There is also the mark itself to consider. The word “Jaguar”, while admittedly a famous brand of motor car, is an ordinary English word and one that consumers would not, I think, be surprised to find applied to goods other than those of the Opponents. The names of animals, indeed, the names of big cats are quite commonly used as trade marks for a wide variety of goods; offhand, I can think of “Puma” sportswear, “Tiger” beer and “Lion” chocolate bars. The Opponents’ marks are somewhat different from those of some of their competitors in this regard. I cannot imagine a “Mercedes Benz” or “BMW” watch being taken as anything other than a product of, or related to, the car manufacturer of that name, especially if accompanied by the distinctive device marks that have come to be associated with those companies. A “Jaguar” watch is a different matter and I think it is far from certain how the use of the mark in that way would be perceived by the average consumer. In making the assessment of the likelihood of confusion, it is established that one must consider a “normal and fair use” of the mark as a trade mark for the goods of the application. In the present instance, that would involve the sale of watches under the mark through the trade channels that are normally used for such products, viz., primarily jewellers’ shops. Nor can it be assumed that there will be any misrepresentation as to the origin of the marked goods as that would not constitute a fair use. I would suggest, in fact, that the use by the Opponents of their trade marks in relation to watches is not something that would come to the attention of the average consumer in the ordinary course of the purchase of a watch. A person who purchases a watch bearing the Opponents’ mark does so, I think, as an act of allegiance to or identification with the Opponents’ brand, made famous by their motor cars. Such a person is not engaged in the ordinary purchase of a watch through normal trade channels but has actually set out to purchase a product bearing the Opponents’ brand as much for the brand as for the product.

30. An appropriate scenario to consider is, therefore, the sale of “Jaguar” watches through jewellers’ stores alongside other watches bearing different trade marks with no other indication or suggestion as to the commercial origin of the products

in question. In that scenario, I would accept that the average consumer, on perceiving the trade mark, is likely to be reminded of the well-known brand of motor car and it is *possible* that he might think that there is a connection between the owners of that brand and the undertaking that has produced the watch. Whether it is *likely* is not certain but, having considered the matter carefully in light of the various factors set out above, I have come to the conclusion that it is not sufficiently likely to warrant refusal of the application for registration under Section 19 of the Act.

Section 25(2) – should the application be refused in exercise of the Controller’s discretion?

31. Section 25(2) of the Act provides that the Controller may refuse an application for registration or accept it absolutely or subject to such amendments, modifications, conditions or limitations as he may think right. That Section confers a general discretion on the Controller to refuse to register a trade mark that has satisfied all the positive requirements of the Act but that discretion must be exercised judicially on reasonable grounds which are capable of being clearly stated (see *RAWHIDE* Trade Mark [1962] RPC 133). The Opponents in the present case invite me to exercise the Controller’s discretion adversely to the Applicant on the ground that the Applicant has used the trade mark JAGUAR in such a way as to associate their products in the minds of the public with Jaguar cars. For that reason, the Opponents allege that the application for registration is lacking in *bona fides* and should be rejected.

32. The Opponents’ case on this point is founded on two main grounds; firstly, that the Applicant has adopted a typeface and manner of presentation of the word “Jaguar” that is identical with that used by the Opponents and, secondly, that the Applicant has used a device of a bounding jaguar, which is a well-known trade mark of the Opponents, in certain of its advertisements. As to the first of these points, it has to be said that the typeface used by the Opponents in the presentation of the word “Jaguar” is not especially unusual or distinctive. The Opponents point to the fact that the “J” drops slightly below the bottom line of the other letters and that there is varying thickness in the stems of the “A”s and the “U” and that these features are replicated exactly in the majority of the examples of the use by the

Applicant of the mark JAGUAR in relation to watches. That appears to be the case but I was inclined to think that the lettering in question must form part of a standard typeface, in which case the identity of the presentations of the marks would be attributable to the fact that the Applicant chose the same typeface as that used by the Opponents rather than that the Applicant had copied the Opponents' mark, in the normal sense of "copying". Indeed, as I write up this decision, I have access on my personal computer to a number of different typefaces and a brief experiment shows that the typeface that is known as "Book Antiqua", if applied to the word "jaguar" in upper case bold lettering, gives the following result: **JAGUAR**. That is, in fact, the manner of presentation of their mark used by the Opponents and, frequently, by the Applicant. Now I do not discount the Opponents' objection to the Applicant's use of the same typeface on its identical trade mark, but I do not regard it as nearly as serious as if the Applicant had copied a distinctive and unique style of lettering that the Opponents had devised for their mark. Of itself, I do not consider the Applicant's use of the typeface in question as sufficient grounds to refuse registration of its mark in exercise of the Controller's discretion, particularly given that I have accepted as valid the Applicant's entitlement to claim rights in the mark itself over a long number of years.

33. With regard to the use by the Applicant of the device of a bounding jaguar in conjunction with the word mark in some of the advertisements of its watches that have been exhibited in evidence, I have to say that this has given me cause for concern as to the Applicant's *bona fides* in its commercial practices and I have some reservations as to whether the Applicant can put up a credible defence against the Opponents' charges in this regard. In its evidence, it has not offered any information or explanation of its occasional use of the device in question and, at the hearing, Mr. O'Moore could only say that I should not judge the Applicant too harshly because of the odd "mistake" that may have occurred in other jurisdictions. That being said, I have to keep in mind that the present application for registration is in respect of the word mark only and I am not being asked to give some form of official endorsement of an alleged sharp practice of the Applicant in accompanying the use of that mark with the device mark that has become associated with the Opponents. If I am to exercise the Controller's

discretion adversely to the Applicant because of the fact that it has sometimes used a device of a bounding jaguar in conjunction with the trade mark JAGUAR, it seems to me that I would be saying to the Applicant that it cannot have a registration of the trade mark JAGUAR, to which I am satisfied it is otherwise entitled, because its previous practice in relation to the use of another mark suggests that it is likely to abuse the rights that will stem from the registration requested. I am not satisfied that that would constitute a clear statement of reasonable grounds for exercising the Controller's discretion to refuse registration. As Mr. O'Moore pointed out at the hearing, the registration of the mark propounded in this application will not give the Applicant any license to use the Opponents' device mark and will not avail the Applicant in the defence of any action that may be taken against it on foot of any such deceptive or misleading use that it may undertake in the future. I think it would be going too far for me to assume, on the basis of the evidence presented, that the Applicant will engage in disreputable commercial practices and, on the basis of such an assumption, to refuse to register a mark that I have found to be registrable otherwise. For the foregoing reasons I am not prepared to refuse the application in exercise of the Controller's discretion.

Tim Cleary
Acting for the Controller

5 March, 2004