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World Intellectual Property Organisation (WIPO) International Bureau 34, Chemin des Colombettes 1211 Geneva 20 Switzerland Your Reference: International Registration No: WO000001406563 Examiner: Katy Sweet

Direct Telephone: +44(0)1633814971

Date: 03 December 2018

Dear Sirs,

Please reply by 4 February 2019 quoting the International Registration number

Intl Reg No: WO000001406563

Mark: (Figurative)

Holder: LANDTOURER AUTOMOBILE CO., LTD

Class(es): 12

I am writing to inform you that following receipt of an opposition to the above trade mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the TM7 'Notice of Opposition', which includes details of any marks referred to in the statement of case, which was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

If the holder of the International Registration wishes to file a counterstatement, they must complete the form TM8 'Notice of defence and counterstatement', which is available at ipo.gov.uk/tmforms and return it to this office within two months of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a TM8 will result in the provisional refusal being upheld.

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the TM8 can be extended for a further seven months by the filing the form TM9c 'Request for a cooling off period, which is available at ipo.gov.uk/tmforms

The TM8 should be received on or before the date requested above unless a cooling off period is entered into by the parties.

The holder of the International Registration must provide us with an address for correspondence in the United Kingdom, another EEA state or the Channel

Islands on a form TM33 'Appointment or change of agent or contact address', which is available at ipo.gov.uk/tmforms within this two month period.

If one is not provided within this time the refusal will be made final.

Katy Sweet

Trade Marks Registry

Skip to main content

Intellectual Property Office

Trade mark number EU005484639

Status

Registered

Overview

Trade mark



Mark details

Colours Claimed/Indication

Red, white, grey, silver, black, brown.

Dates

Filing date

10 November 2006

Date of entry in register

07 November 2007

Renewal date

10 November 2026

Goods and services

Classes and terms
Class 6
Class 9
Class 12
Class 16
Class 18
Class 25
Class 28
Class 37
Names and addresses
Holder's name
FIAT GROUP MARKETING & CORPORATE COMMUNICATION S.P.A.

Via Nizza, 250, Torino, 10126, Italy

Representative

JACOBACCI & PARTNERS S.P.A.

Corso Emilia, 8, Torino, 10152, Italy

Publications

First advert

Journal

2007/021

Date of publication

28 May 2007

The information displayed is our version of the details supplied by EUIPO. For the official register of the case please refer to the <u>EUIPO website</u>.

Intellectual Property Office is an operating name of the Patent Office

Tina Weatherbed

From:

Amber Matiatos <axm@dyoung.com> on behalf of Gemma Kirkland

<gmk@dyoung.com>

Sent:

22 October 2018 11:52

To:

Tribunalsection

Cc:

Amber Matiatos

Subject:

UK designation of International Registration No. 1406563 Rearing Horse Device in

the name of Landtourer Automobile Co., Ltd and opposition thereto by Ferrari

S.p.A. [DY-ACTIVE.FID4370178]

Attachments:

FS2 and TM7.PDF

Our Ref: 0051938 GMK AXM

Dear Sirs

Please see the attached form TM7 filing opposition against the UK designation of International Registration No. 1406563 Rearing Horse Device in the name of Landtourer Automobile Co., Ltd. We also attach an FS2 in respect of the official fee.

Please acknowledge safe receipt of these instructions.

Yours faithfully

Gemma Kirkland
Partner, Trade Mark Attorney
gmk@dyoung.com
Paralegal Staff:
Kate Mears kxm@dyoung.com

D YOUNG®CO INTELLECTUAL PROPERTY

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IPO SW

2 2 OCT 2018

NEWPORT

F	orm TM7		
		ion and statement of	
_	`r		2 3 OCT 2018
Fe	£100	Opposition based on Se	ection 5(1) and/or 5(2) ONLY
	√ £200		r including, any other grounds Inder Section 5(1) and/or 5(2) and one or more other grounds, the fee will be £200
		fy of an opposition to a tra are basing this opposition	de mark application or international registration and to set out the n.
D	o not use this form	n if you wish to file a Fast T	Track opposition under Section 5(1) and/or 5(2): use Form TM7F.
1.	Number of the trade mopposition concerns as	Der ark you are opposing. If the International Registration, rect trade mark by adding "IR"	1406563 WO 000000 1466563
2.	Full name of app Whose trade mark you		Landtourer Automobile Co., Ltd
3.	Full name of opp Person opposing the tr		Ferrari S.p.A.
	Address		

Email address

Complete if you have no representative and would like us to correspond with you by email

If the address is not within the United Kingdom,

European Economic Area (EEA - which includes the European Union) or the Channel Islands you must

have a representative in one of these regions and

4. Representative name
If you have no representative, go to section 5.

complete section 4 below

Address

The address provided in this section must be in the UK, European Economic Area (EEA) or the Channel Islands.

NOTE: We will communicate with the representative if this section has been completed.

Email address

Complete if you would like us to correspond with you by email

D Young & Co LLP

Via Emilia Est, 1163

Modena

Italy

120 Holborn

London

Postcode EC1N 2DY

Postcode

I-41100

tmfilings@dyoung.com

ត្រប់ព្រះ ស្រុកក្រុក ប្រុស្ស (១០៩)	5.	Related proceedings	IPO Registry	UK Courts	EUIPO
The reserve of the state of the		proceedings and enter the case number allocated to the proceedings.	Number		· ·
		•	,	••	i
6		Opposition notification date If you have informed the applicant/holder of an intention to oppose the trade mark application, designation — enter the date you notified them. [**See Note]	19 September 2018	•	
		**Note: An opposition launched without giving the appli designation or amendment may result in the opponent	cant or holder a reasonable opport being ineligible for an award of cos	tunity to withdraw the applicate.	cation, international
7	7.	Declaration	I believe that the facts s statement of grounds ar		the attached
		Signature	D tang &	COLLP	
		Name (BLOCK CAPITALS)	D YOUNG & CO LLP		
		Date	22 October 2018		
8		Your reference Complete if you would like us to quote this in communications with you, otherwise leave blank.	0051938 GMK KXM		
•		Contact details Name, daytime telephone number of the person to contact in case of query.	Gemma Kirkland		
			023 8071 9500		
		Number of sheets attached to this form	75		
				•	
		Checklist	Where to se	end	

Please make sure you have remembered to:

☐ Sign and date the form

☐ Complete <u>fee sheet</u> (Form FS2)

☐ Enclose the fee and fee sheet. Make

cheques payable to Intellectual Property Office

Intellectual Property Office Trade Marks Registry

Concept House Cardiff Road

Newport South Wales

NP10 8QQ

Please tick on what grounds you are opposing the trade mark and continue to the relevant section(s)

1

Opposition is based on Sections 5(1) or 5(2): The trade mark is either identical or similar to an earlier trade mark and is to be registered for identical and/or similar goods and services.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark.

> COMPLETE SECTION A



Opposition is based on Section 5(3): The trade mark is either identical or similar to an earlier trade mark which has a reputation. Using the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION B



Opposition is based on Section 5(4)(a): Where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier right. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION C



Opposition is based on Section 3: The trade mark is excluded from registration because it describes the goods/services, or is not distinctive, or consists of signs that are customary within the trade, or the application was made in bad faith.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION D



Opposition is based on other grounds.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION E

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark

5(2)(a) It is Identical with an earlier mark and for similar goods or services as the earlier mark.

5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

454546

Type of mark Please tick

UK

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



Which goods or services covered by the earlier trade mark are relied upon for the opposition? **Q1.** All goods and services Some goods and services (please specify below, use a continuation sheet if necessary) All goods in Class 12 STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the application you wish to oppose? No > GO TO Q4 Q3. Has the trade mark been used? No > GO TO Q3b For which of the goods and services listed at Q1 is trade mark use being claimed? All goods and services Some goods and services (please specify below, use a continuation sheet if necessary)

:	
:	
, L	
DETA	NILS OF THE TRADE MARK YOU ARE OPPOSING
Q4. simil	Which goods or services in the application that you are opposing do you claim are identical or ar to those covered by the earlier mark which you have listed at Q1 or Q3a (whichever is applicable)?
1	All goods and services
	Some goods and services (please specify below, use a continuation sheet if necessary)
!	
•	
	•
	en e
Q5. confu	Use this space to supply any further information about why you consider there is a likelihood of sion and e.g. why you consider the respective marks or goods and/or services to be similar.
the Toppo or jun	rade mark applied for ("the Applicant Mark") should be refused registration under the provisions of Section 5(2)(b) of rade Marks Act 1994. The Applicant Mark is visually and conceptually similar to the Opponent's registration ("the nent Mark"), as both the Applicant Mark and the Opponent Mark depict an image of a horse facing left in a rearing apping position. The Applicant Mark will therefore merely be seen as indicating that the contested goods are offered the Opponent Mark in the UK.
	dition, the Applicant Mark covers goods which are identical and similar to the goods covered by the Opponent Mark.

Opponent Mark is very well known around the world including in the UK, and has been extensively used, and as such enjoys a high degree of inherent and acquired distinctive character. As will be demonstrated later in these proceedings,

In view of the above, the Opponent submits that should the Applicant Mark proceed to registration, a likelihood of confusion including a likelihood of association would arise on the part of the public in the UK between the Opponent Mark

the Opponent Mark is highly recognised by consumers as indicating luxury and reliable goods.

and the Applicant Mark.

Q3b. Please state any proper reasons for non-use.

SECTION B: Opposition is based on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending trade mark, that is identical with or similar to an earlier mark which has a reputation.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

454546

Type of mark Please tick

UK

EUTN

International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



	All goods and services					
, √	Some goods and services (please specify below, u	ise a conti	nuation sheet i	f necessary)		
	All goods in Class 12					
1						
!						
:						
Q2. take mark	For which goods or services in the applice unfair advantage of, or be detrimental to, the k?	ation (y e distinc	ou are opp tive charac	osing) would cter or reputat	use of the ap don of the ear	plicant's mark lier trade
1	All goods and services					
	Some goods and services (please specify below, u	ıse a conti	nuation sheet i	f necessary)		
1						. —
!				•		

)			•			
Q3.	Is it claimed that the similarity between t	ho sonu	lad andiar	trada mark an	d the leter tre	de merk le
such	h that the relevant public will believe that the conomic connection between the users of th	y are us	ed by the s	ame undertal	dng or think t	hat there is
	Yes	ļ	No			
Use ti	this space to supply any further information				•	
As wind daim advantage and to believe the control of the control o	Applicant Mark should be refused registration unwill be demonstrated in these proceedings, the Owned goods protected under its registration. Use antage of, or cause detriment to, the distinctive chificant reputation enjoyed in the Opponent Mark the Opponent Mark originate from the same or ever that the Opponent and the Applicant have end of the Opponent Mark by the Applicant. Such a eving them to be connected in some way with the	Opponent of the A characte , the rele economi ntered in belief m	t enjoys a re pplicant Ma r or repute o evant public cally linked to a partner ay entice co	eputation in the rk is liable to, v of the Opponer is likely to beli- undertakings. ship or comme- onsumers to us	e Opponent Ma without due can at Mark. In light eve that the Ap Alternatively, arcial venture wase the goods o	ork for the cuse, take unfair of the oplicant Mark consumers may which permits of the Applicant.

For which goods or services covered by your earlier trade mark does it have a reputation?

Q1.

QUESTIONS 4 TO 6 SHOULD BE ANSWERED IF THERE IS ANY OTHER BASIS FOR YOUR CLAIM OTHER THAN FOR YOUR ANSWER TO Q.3

Q4. Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair.

Unfair advantage is taken by the applicant as a result of the use of a closely similar sign. In the present case, the trade marks are similar, therefore the image of the Opponent Mark is transferred to the goods designated under the Applicant Mark. The Opponent submits that the Applicant Mark immediately calls the Opponent Mark to the mind of the average consumer. The Opponent Mark enjoys a significant reputation for and is recognised by consumers as denoting luxury goods in the UK. If registered, the Applicant Mark will unfairly benefit from the power of attraction that the Opponent Mark enjoys, and will unfairly exploit this reputation without the Applicant having made the associated investment.

Q5. Is there any other basis for your claim of detriment to the reputation of the earlier mark? If so, please explain what the detriment would be and how it would occur.

Degradation to an earlier trade mark is caused when the goods or services for which the later sign is used may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The Opponent Mark has been used for many years and is synonymous with the luxury goods offered under the trade mark. The reputation in the Opponent Mark will be tarnished by the use of a highly similar trade mark for inferior quality goods. Use of the Applicant Mark may have a negative influence on the reputation of the Opponent Mark, which may diminish the power of attraction the Opponent Mark enjoys. If the Applicant Mark is registered, the exclusivity conferred by the Opponent Mark, and the ability of the Opponent to control and identify goods bearing the Opponent Mark as originating from the Opponent, will be weakened.

Q6. Is there any other basis for your claim of detriment to the distinctive character of the earlier mark? If so, please explain what the detriment would be and how it would affect the economic behaviour of the relevant public.

Dilution is caused when a trade mark's ability to identify the goods or services for which it is registered are weakened. This can be demonstrated in the present case, where use of the Applicant Mark leads to a dispersion of the identity and hold that the Opponent Mark has upon the public mind. If the Applicant Mark is registered, the Opponent will have no control over how the Applicant Mark is used by the Applicant. This will inevitably weaken the Opponent's position and seriously damage the exclusivity of the Opponent Mark. If the Opponent Mark's exclusivity is weakened, consumers may no longer be able to rely on the Opponent Mark as a mark of quality and trust and may therefore choose not to use the goods offered under the Opponent Mark, thereby effecting the economic behaviour of the relevant public.

Q7. mark	Q7. STATEMENT OF USE PROVISION - Was the registration or protection process for the earlier trade nark completed 5 years or more before the publication date of the application you wish to oppose?									
	√	Yes				No > GO TO	O Q10			
Q8. Has the trade mark been used in the 5 yearmark?					5 year period	ending on t	he date o	f publicat	ion of the	opposed
	\	Yes				No > GO TO	O Q9b			
Q9a.	For w	vhich of th	e goods an	d services	listed at Q1 is	s trade mark	use bein	g claimed	17	
√	All goo	ods and ser	vices		·					
	Some	goods and	services (ple	ase specify be	low, use a continu	etion sheet if ne	cessary)			· -
	•									
ı										
·										
	O TO Q									
Q 9b.	Pleas	se state an	y proper re	asons for r	ion-use.	· .				
					•					
 - -										
Q10. this ar	Use to	his space	to give any	further info	ormation to e	xplain why y	you are o	pposing t	he applic	ation on
A.	24.161									
							'.			

SECTION E: Opposition is based on any other grounds

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Use this sheet if you are basing your opposition on any other grounds and tick the appropriate box.

/	Section 5(1),(2),(3)	If the opponent is claiming protection for an earlier trade mark under Section 6(1)(c) which is a well known trade mark as defined in Section 56(1). See ††Note below.
	Section 5(4)(b)	An earlier right by virtue of the law of copyright, design right or registered designs.
	Section 60	Registered in the name of an agent or representative.
	Rule 25(2)	Opposition to amendment after publication.
	Rule 29	Regulations for collective or certification marks.
	Rule 30(4)	Amendment of regulations for collective or certification marks.
	Rule 32(3)	Alteration of registered mark.
	Rule 53(2)	Removal of matter from the register.
	Others	

†† For opposition on these grounds the following details should be supplied in the area below:

- Representation of the mark
- Details of any reference number and related jurisdiction if relevant Details of goods and services covered by the earlier mark
- Details of goods and services (in the application) which you consider to be similar identical to those covered by the earlier mark.

Alternatively you may wish to adapt Section A and Section B of this form.

Give details (including details of any right relied upon) to support the application under these grounds (Use a continuation sheet if necessary)

Section E:

Section 56(1) Continuation Sheet 3

EUTM Registration No. 454546 is an earlier mark under the provisions of Section 6(1)(c) and is a well known mark as defined in Section 56(1).

It is registered and used in respect of "Vehicles; Apparatus for locomotion by land, air or water; In particular automobiles, spare parts and accessories for automobiles, only included in class 12; Tire patches; Air bags [safety devices for automobiles]; Pumps (Air -) [vehicle accessories]; Anti-glare devices for vehicles; Anti-skid chains; Anti-theft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Baskets adapted for bicycles; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Frames for bicycles, cycles; Cycle saddles; Bicycle stands; Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brake segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol [gas] tanks; Casings for pneumatic tires [tyres]; Casters for trolleys [vehicles] [carts (Am.)]; Cleaning trolleys; Cleats [nautical]; Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankcases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels; Cycle mudguards; Pumps for bicycles, cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Driving chains for land vehicles; Driving motors for land vehicles; Ejector seats for aircraft; Motors for land vehicles; Fenders for ships; Flanges for railway wheel tires [tyres]; Freewheels for land vehicles; Funnels for locomotives; Funnels for ships; Gear boxes for land vehicles; Gearing for land vehicles; Gears for cycles; Trolleys; Head-rests for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats; Inner tubes for pneumatic tires; Jet engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars; Paddles for canoes; Panniers adapted for cycles; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outfits for inner tubes; Reversing alarms for vehicles; Rims for vehicle wheels; Rims for bicycles, cycles; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screw-propellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Shopping trolleys [carts (Am.)]; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Tailboard lifts [parts of land vehicles]; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries [trucks]; Tires for vehicle wheels; Torque converters for land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires [tyres]; Treads for vehicles [roller belts]; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires [tyres]; Vehicle bumpers; Vehicle chassis; Vehicle covers [shaped]; Vehicle running boards; Vehicle

seats; Vehicle suspension springs; Vehicle wheel spokes; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Dress guards for bicycles, cycles; Saddles for bicycles, cycles or motorcycles; Turbines for land vehicles; Vehicle wheels; Wheelbarrows" in Class 12.

As set out in the preceding pages of this Opposition, the Applicant Mark should be refused registration under the provisions of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 for the reasons stated therein. The Opponent Mark is well known throughout the UK, EU and worldwide and is considered to be among the most famous in the world.

It is also to be noted that the Opponent Mark is not only used in relation to vehicles but also in relation to a large range of merchandising goods such as perfumes, watches, leather items and other luxury goods.

Further, the Opponent is and has been for many decades, one of the strongest protagonist's of Formula 1 Racing, one of the most popular car sports worldwide.

Evidence pertaining to the above will be presented during the adversarial stages of the Opposition.

Accordingly, the registration of Application No. 1406563 should be prevented in light of the Opponent's trade mark being well known in the UK as being the trade mark of the Opponent.



Protect your intellectual property in the European Union

EUTM file information

(Trade mark without text)

Timeline



30/01/2027 EUTM expiry date

Graphic representation



Trade mark information

Name	(Trade mark without text)	Fiting date	30/01/1997
Filing number	000454546	Registration date	07/11/2000
Basis	EUTM	Expiry date	30/01/2027
Date of receipt	30/01/1997	Designation date	
Type	Figurative	Filing language	Italian
Nature	Individual	Second language	English
Nice classes	12, 37 (Nice Classification)	Application reference	C000739
Vienna Classification	03.03.01, 03.03.17 (Vienna	Trade mark status	

Classification)

Registered

Acquired distinctiveness

No

Goods and services

English (en)

12 Vehicles; Apparatus for locomotion by land, air or water; In particular automobiles, spare parts and accessories for automobiles, only included in class 12; Tire patches; Air bags [safety devices for automobiles]; Pumps (Air -) [vehicle accessories]; Anti-glare devices for vehicles; Anti-skid chains; Anti-theft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chains; Automobile chains; Automobile hoods; Tyres for motor vehicles; Axle bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Baskets adapted for bicycles; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Frames for bicycles, cycles; Cycle saddles; Bicycle stands; Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brakes segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol [gas] tanks; Casings for pneumatic tires [tyres]; Casters for trolleys [vehicles] [carts (Am.)]; Cleaning trolleys; Cleats [nautical]; Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankcases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels; Cycle mudguards; Pumps for bicycles, cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Driving chains for land vehicles; Driving motors for land vehicles; Ejector seats for aircraft; Motors for land vehicles; Frannels for ships; Flanges for railway wheel tires [tyres]; Freewheels for land vehicles; Funnels for land vehicles; Hoods for vehicle engines; Hoods for vehicle sheels; for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats; Inner tubes for pneumatic tires; Jet engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars; Paddles for canoes; Panniers adapted for cycles; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outfits for inner tubes; Reversing alarms for vehicles; Rims for vehicles wheels; Rims for bicycles, cycles; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screw-propellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Shopping trolleys [carts (Am.)]; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Tailboard lifts [parts of land vehicles]; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries [trucks]; Tires for vehicle wheels; Torque converters for land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires [tyres]; Treads for vehicles [roller belts]; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires [tyres]; Vehicle bumpers; Vehicle chassis; Vehicle covers [shaped]; Vehicle running boards; Vehicle seats; Vehicle suspension springs; Vehicle wheel spokes; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Dress guards for bicycles, cycles, Saddles for bicycles, cycles or motorcycles; Turbines for land vehicles; Vehicle wheels;

37 Construction, repair and maintenance services for motor vehicles, all included in class 37.

Owners

FERRARI S.P.A.

Organisation

Legal status

ID

7308

FERRARI S.P.A.

Legal entity

Country State/count Lown

Post code

Address

IT - Italy n/a Modena

FERRARI S.P.A. Via Emilia Est, 1163 I-41100 Modena 41100 ITALIA

Via Emilia Est. 1163

Correspondence address

Can be accessed and changed by authorised user via the User Area

Can be accessed and changed by authorised user via the User Area

Can be accessed and changed by authorised user via the User Area

Representatives

DR. MODIANO & ASSOCIATI S.P.A.

10583

Country

IT - Italy

Correspondence address

00 39-0285907777

Organisation

Lagal status

*ype

Legal person Association

Post code Adaress

State/county

Milano

n/a

20123 Via Meravigli, 16 DR. MODIANO & ASSOCIATI S.P.A. Via Meravigli, 16 I-20123 Milano ITALIA

00 39-0272021062

uami@modlano.com

Cancellation

No data

Appeals

No data

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark

5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.

/

5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

539585

Type of mark Please tick

UK

/ EUTM

International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



Q1.	Which goods or services co	overed by the earlier trade mark are relied upon for the oppositio	n?
!	All goods and services		
	≨ o Ta	se specify below, use a continuation sheet if necessary)	. .
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A	Il goods in Class 12		
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Q2.	STATEMENT OF USE - Was	the registration or protection process for the earlier trade mark	
com	Dieted 5 years or more before t	he publication date of the application you wish to oppose?	
	Yes	No > GO TO Q4	
Q3.	Has the trade mark been us	sed?	
	√ Yes	No > GO TO Q3b	
	(<u></u>)		
Q3a.	For which of the goods and	services listed at Q1 is trade mark use being claimed?	
1	All goods and services		
;	Some goods and services (pleas	se specify below, use a continuation sheet if necessary)	
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DET/	AILS OF THE TRADE MARK YOU ARE OPPOSING
Q4. simil	Which goods or services in the application that you are opposing do you claim are identical or ar to those covered by the earlier mark which you have listed at Q1 or Q3a (whichever is applicable)?
	All goods and services
; •	Some goods and services (please specify below, use a continuation sheet if necessary)
.•	Some goods and services (please specify below, use a continuation sneet if necessary)
;	· -
:	· ·
1	
1	
:	·
.	<u>. </u>
Q5. confi	Use this space to supply any further information about why you consider there is a likelihood of usion and e.g. why you consider the respective marks or goods and/or services to be similar.
the T Oppo or jur	trade mark applied for ("the Applicant Mark") should be refused registration under the provisions of Section 5(2)(b) of trade Marks Act 1994. The Applicant Mark is visually and conceptually similar to the Opponent's registration ("the onent Mark"), as both the Applicant Mark and the Opponent Mark depict an image of a horse facing left in a rearing imping position. The Applicant Mark will therefore merely be seen as indicating that the contested goods are offered in the Opponent Mark in the UK.
in ad This	dition, the Applicant Mark covers goods which are identical and similar to the goods covered by the Opponent Mark. serves to increase the overall degree of similarity between the Opponent Mark and the Applicant Mark. The

Opponent Mark is very well known around the world including in the UK, and has been extensively used, and as such enjoys a high degree of inherent and acquired distinctive character. As will be demonstrated later in these proceedings,

In view of the above, the Opponent submits that should the Applicant Mark proceed to registration, a likelihood of confusion including a likelihood of association would arise on the part of the public in the UK between the Opponent Mark

the Opponent Mark is highly recognised by consumers as indicating luxury and reliable goods.

and the Applicant Mark.

Q3b. Please state any proper reasons for non-use.

SECTION B: Opposition is based on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending trade mark, that is identical with or similar to an earlier mark which has a reputation.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need:

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

539585

Type of mark Please tick

 UK	1	EUTM	 International
	•		

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



Q1.	For which goods or services covered by your earlier trade mark does it have a reputation?
Į į	All goods and services
√	Some goods and services (please specify below, use a continuation sheet if necessary)
:	All goods in Class 12
į	
r :	
•	
i	
	-
Q2. take mari	For which goods or services in the application (you are opposing) would use of the applicant's mark unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade is?
Ā	All goods and services
	Some goods and services (please specify below, use a continuation sheat if necessary)
; !	
1	
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1	
	•
	Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is that the relevant public will believe that they are used by the same undertaking or think that there is conomic connection between the users of the trade marks?
	√ Yes No
Use t	his space to supply any further information
As w claim adva signi and belie use o	Applicant Mark should be refused registration under the provisions of Section 5(3) of the Trade Marks Act 1994. It is demonstrated in these proceedings, the Opponent enjoys a reputation in the Opponent Mark for the ned goods protected under its registration. Use of the Applicant Mark is liable to, without due cause, take unfair ntage of, or cause detriment to, the distinctive character or repute of the Opponent Mark. In light of the ficant reputation enjoyed in the Opponent Mark, the relevant public is likely to believe that the Applicant Mark the Opponent Mark originate from the same or economically linked undertakings. Alternatively, consumers may be that the Opponent and the Applicant have entered into a partnership or commercial venture which permits of the Opponent Mark by the Applicant. Such a belief may entice consumers to use the goods of the Applicant, ving them to be connected in some way with the reliable and luxury goods offered under the Opponent Mark.

QUESTIONS 4 TO 6 SHOULD BE ANSWERED IF THERE IS ANY OTHER BASIS FOR YOUR CLAIM OTHER THAN FOR YOUR ANSWER TO Q.3

Q4. Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair.

Unfair advantage is taken by the applicant as a result of the use of a closely similar sign. In the present case, the trade marks are similar, therefore the image of the Opponent Mark is transferred to the goods designated under the Applicant Mark. The Opponent submits that the Applicant Mark immediately calls the Opponent Mark to the mind of the average consumer. The Opponent Mark enjoys a significant reputation for and is recognised by consumers as denoting luxury goods in the UK. If registered, the Applicant Mark will unfairly benefit from the power of attraction that the Opponent Mark enjoys, and will unfairly exploit this reputation without the Applicant having made the associated investment.

Q5. Is there any other basis for your claim of detriment to the reputation of the earlier mark? If so, please explain what the detriment would be and how it would occur.

Degradation to an earlier trade mark is caused when the goods or services for which the later sign is used may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The Opponent Mark has been used for many years and is synonymous with the luxury goods offered under the trade mark. The reputation in the Opponent Mark will be tamished by the use of a highly similar trade mark for inferior quality goods. Use of the Applicant Mark may have a negative influence on the reputation of the Opponent Mark, which may diminish the power of attraction the Opponent Mark enjoys. If the Applicant Mark is registered, the exclusivity conferred by the Opponent Mark, and the ability of the Opponent to control and identify goods bearing the Opponent Mark as originating from the Opponent, will be weakened.

Q6. Is there any other basis for your claim of detriment to the distinctive character of the earlier mark? If so, please explain what the detriment would be and how it would affect the economic behaviour of the relevant public.

Dilution is caused when a trade mark's ability to identify the goods or services for which it is registered are weakened. This can be demonstrated in the present case, where use of the Applicant Mark leads to a dispersion of the identity and hold that the Opponent Mark has upon the public mind. If the Applicant Mark is registered, the Opponent will have no control over how the Applicant Mark is used by the Applicant. This will inevitably weaken the Opponent's position and seriously damage the exclusivity of the Opponent Mark. If the Opponent Mark's exclusivity is weakened, consumers may no longer be able to rely on the Opponent Mark as a mark of quality and trust and may therefore choose not to use the goods offered under the Opponent Mark, thereby effecting the economic behaviour of the relevant public.

8. Has the trade mark been used in the 5 year period ending on the date of publication of the orark? Ves No > GO TO Q9b 9a. For which of the goods and services (isted at Q1 is trade mark use being claimed? All goods and services Some goods and services (please specify below, use a continuation sheet if necessary) GO TO Q10 9b. Please state any proper reasons for non-use.	goods and services (isted at Q1 is trade mark use being claimed? ices ervices (please specify below, use a continuation sheet if necessary) proper reasons for non-use.	Yes	,	No > GO TO Q10	
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		0. Use this space to give any f	jurther information to ex		sing the application on
		*	iurther information to ex		sing the application on
		-	further information to ex	plain why you are oppo	sing the application on

SECTION E: Opposition is based on any other grounds

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Use this sheet if you are basing your opposition on any other grounds and tick the appropriate box.

√	Section 5(1),(2),(3)	If the opponent is claiming protection for an earlier trade mark under Section 6(1)(c) which is a well known trade mark as defined in Section 56(1). See ††Note below.				
	Section 5(4)(b)	An earlier right by virtue of the law of copyright, design right or registered designs.				
	Section 60	Registered in the name of an agent or representative.				
	Rule 25(2)	Opposition to amendment after publication.				
	Rule 29	Regulations for collective or certification marks.				
	Rule 30(4)	Amendment of regulations for collective or certification marks.				
	Rule 32(3)	Alteration of registered mark.				
	Rule 53(2)	Removal of matter from the register.				
	Others					

†† For opposition on these grounds the following details should be supplied in the area below:

- Representation of the mark
- · Details of any reference number and related jurisdiction if relevant
- Details of goods and services covered by the earlier mark
- · Details of goods and services (in the application) which you consider to be similar identical to those covered by the earlier mark.

Alternatively you may wish to adapt Section A and Section B of this form.

Give details (including details of any right relied upon) to support the application under these grounds (Use a continuation sheet if necessary)

Please refer to Continuation Sheet 4

Section E:

Section 56(1) Continuation Sheet 4

EUTM Registration No. 539585 is an earlier mark under the provisions of Section 6(1)(c) and is a well known mark as defined in Section 56(1).

It is registered and used in respect of "Vehicles; Apparatus for locomotion by land, air or water; In particular automobiles, spare parts and accessories for automobiles, only included in class 12; Tire patches; Air bags [safety devices for automobiles]; Pumps (Air -) [vehicle accessories]; Anti-glare devices for vehicles; Anti-skid chains; Anti-theft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Baskets adapted for bicycles; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Frames for bicycles, cycles; Cycle saddles; Bicycle stands; Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brake segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol [gas] tanks; Casings for pneumatic tires [tyres]; Casters for trolleys [vehicles] [carts (Am.)]; Cleaning trolleys; Cleats (nautical); Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankcases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels; Cycle mudguards; Pumps for bicycles, cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Driving chains for land vehicles: Driving motors for land vehicles; Ejector seats for aircraft; Motors for land vehicles; Fenders for ships; Flanges for railway wheel tires [tyres]; Freewheels for land vehicles; Funnels for locomotives; Funnels for ships; Gear boxes for land vehicles; Gearing for land vehicles; Gears for cycles; Trolleys; Head-rests for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats: Inner tubes for pneumatic tires; Jet engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars; Paddles for canoes; Panniers adapted for cycles; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outfits for inner tubes; Reversing alarms for vehicles; Rims for vehicle wheels; Rims for bicycles, cycles; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screw-propellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Shopping trolleys [carts (Am.)]; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Tailboard lifts [parts of land vehicles]; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries [trucks]; Tires for vehicle wheels; Torque converters for land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires [tyres]; Treads for vehicles [roller belts]; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires [tyres]; Vehicle bumpers; Vehicle chassis; Vehicle covers [shaped]; Vehicle running boards; Vehicle

seats; Vehicle suspension springs; Vehicle wheel spokes; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Dress guards for bicycles, cycles; Saddles for bicycles, cycles or motorcycles; Turbines for land vehicles; Vehicle wheels; Wheelbarrows" in Class 12.

As set out in the preceding pages of this Opposition, the Applicant Mark should be refused registration under the provisions of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 for the reasons stated therein. The Opponent Mark is well known throughout the UK, EU and worldwide and is considered to be among the most famous in the world.

It is also to be noted that the Opponent Mark is not only used in relation to vehicles but also in relation to a large range of merchandising goods such as perfumes, watches, leather items and other luxury goods.

Further, the Opponent is and has been for many decades, one of the strongest protagonist's of Formula 1 Racing, one of the most popular car sports worldwide.

Evidence pertaining to the above will be presented during the adversarial stages of the Opposition.

Accordingly, the registration of Application No. 1406563 should be prevented in light of the Opponent's trade mark being well known in the UK as being the trade mark of the Opponent.

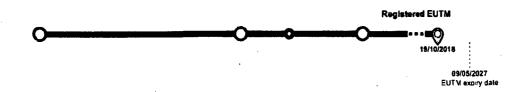


Protect your intellectual property in the European Union

EUTM file information

Ferrari

Timeline



Graphic representation



Trade mark information

Name	Ferrari	Filing date	09/05/1997	
Filing number	000539585	Registration date	19/11/1998	
Basis	EUTM	Expiry date	09/05/2027	
Date of receipt	09/05/1997	Designation date		
Туре	Figurative	Filing language	Italian	
Nature	Individual	Second language	English	
Nice classes	12, 37 (Nice Classification)	Application reference	C000851	
Vienna Classification	03.02.26, 03.03.01, 03.03.17, 26.04.02, 26.04.05, 26.04.22, 26.04.98, 26.04.99, 26.11.08 (Trade mark status	Registered	
	Vienna Classification)	Acquired distinctiveness	No	

Goods and services

English (en)

12 Vehicles; Apparatus for locomotion by land, air or water; In particular automobiles, spare parts and accessories for automobiles, only included in class 12; Tire patches; Air bags [safety devices for automobiles]; Pumps (Air -) [vehicle accessories]; Anti-glare devices for vehicles; Anti-skid chains; Anti-theft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Baskets adapted for bicycles; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Frames for bicycles, cycles; Cycle saddles; Bicycle stands; Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brake segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol

[gas] tanks; Casings for pneumatic tires [tyres]; Casters for trolleys [vehicles] [carts (Am.)]; Cleaning trolleys; Cleats [nautical]; Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankcases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels; Cycle mudguards; Pumps for bicycles, cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Driving chains for land vehicles; Driving motors for land vehicles; Ejector seats for aircraft; Motors for land vehicles; Fenders for ships; Flanges for railway wheel tires [tyres]; Freewheels for land vehicles; Funnels for locomotives; Funnels for ships; Gear boxes for land vehicles; Gearing for land vehicles; Gears for cycles; Trolleys; Head-rests for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats; Inner tubes for pneumatic tires; Jet engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars; Paddles for canoes; Panniers adapted for cycles; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outlits for inner tubes; Reversing alarms for vehicles; Rims for vehicle wheels; Rims for bicycles, cycles; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screw-propellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Shopping trolleys [carts (Am.)]; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Tailboard lifts [parts of land vehicles]; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries [trucks]; Tires for vehicle wheels; Torque converters for land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires (tyres); Treads for vehicles [roller belts]; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires [tyres]; Vehicle bumpers; Vehicle chassis; Vehicle covers (shaped); Vehicle running boards; Vehicle seats; Vehicle suspension springs; Vehicle wheel spokes; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Dress guards for bicycles, cycles; Saddies for bicycles, cycles or motorcycles; Turbines for land vehicles; Vehicle wheels;

37 Construction, repair and maintenance services for motor vehicles, all included in class 37.

Owners

FERRARI S.P.A.

ID	7308	Country	IT - Italy	Correspondence address	, 5 6 d a d
Organisation	FERRARI	State/county	n/a	FERRARI S.P.A.	Can be accessed and changed by authorised use
	S.P.A.	Town	Modena	Via Emilia Est, 1163	via the User Area
egal status	Legal entity	Past code	41100	I-41100 Modena ITALIA	
		Address	Via Emilia Est, 1163		Can be accessed and changed by authorised use via the User Area
					Can be accessed and changed by authorised use via the User Area

Representatives

DR. MODIANO & ASSOCIATI S.P.A.

כו	10583	Country	IT - Italy	Correspondence address	00 39-0285907777
Organisation	n/a	State/county	n/a	DR. MODIANO & ASSOCIATI	00 33-0283307777
Legal status	Legal person	Town	Milano	S.P.A. Via Meravigli, 16	00 39-0272021062
Туре	Association	Post code	20123	I-20123 Milano	00 3,5 02,1002
		Address	Via Meravigli, 16	ITALIA	uami@modiano.com

Cancellation

No dara

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark

5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.

/

5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

161984

Type of mark Please tick

UK

/ E

M

International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



	•	
	All goods and services	
✓	Some goods and services (please	specify below, use a continuation sheet if necessary)
A	ll goods in Class 12	
; ;		
1		
:		
i	•	
Q2.	STATEMENT OF USE - Was the	e registration or protection process for the earlier trade mark
com		publication date of the application you wish to oppose?
	Yes	No > GO TO Q4
Q3.	Has the trade mark been used	· 1?
	5 - 2.0	-
	Yes	No > GO TO Q3b
Q3a.	For which of the goods and se	ervices listed at Q1 is trade mark use being claimed?
Q3a.	,	ervices listed at Q1 is trade mark use being claimed?
Q3a.	All goods and services	
Q3a.	All goods and services	ervices listed at Q1 is trade mark use being claimed?
Q3a.	All goods and services	
Q3a.	All goods and services	
Q3a.	All goods and services	
Q3a.	All goods and services	
Q3a.	All goods and services	
Q3a.	All goods and services	
Q3a.	All goods and services Some goods and services (please to	
Q3a.	All goods and services Some goods and services (please to	
Q3a.	All goods and services Some goods and services (please to	specify below, use a continuation sheet if necessary)
Q3a.	All goods and services Some goods and services (please to	specify below, use a continuation sheet if necessary)
Q3a.	All goods and services Some goods and services (please to	specify below, use a continuation sheet if necessary)
Q3a.	All goods and services Some goods and services (please to	specify below, use a continuation sheet if necessary)
Q3a.	All goods and services Some goods and services (please to	specify below, use a continuation sheet if necessary)

> GO TO Q4.

1	
DET	AILS OF THE TRADE MARK YOU ARE OPPOSING
Q4. simi	Which goods or services in the application that you are opposing do you claim are identical or lar to those covered by the earlier mark which you have listed at Q1 or Q3a (whichever is applicable)?
1	All goods and services
	Some goods and services (please specify below, use a continuation sheet if necessary)
;	
1	
1	
} 	
1	
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ļ 1	
Q5. confi	Use this space to supply any further information about why you consider there is a likelihood of usion and e.g. why you consider the respective marks or goods and/or services to be similar.
the T	trade mark applied for ("the Applicant Mark") should be refused registration under the provisions of Section 5(2)(b) of frade Marks Act 1994. The Applicant Mark is visually and conceptually similar to the Opponent's registration ("the onent Mark"), as both the Applicant Mark and the Opponent Mark depict an image of a horse facing left in a rearing

or jumping position. The Applicant Mark will therefore merely be seen as indicating that the contested goods are offered

In addition, the Applicant Mark covers goods which are identical and similar to the goods covered by the Opponent Mark. This serves to increase the overall degree of similarity between the Opponent Mark and the Applicant Mark. The Opponent Mark is very well known around the world including in the UK, and has been extensively used, and as such enjoys a high degree of inherent and acquired distinctive character. As will be demonstrated later in these proceedings,

In view of the above, the Opponent submits that should the Applicant Mark proceed to registration, a likelihood of confusion including a likelihood of association would arise on the part of the public in the UK between the Opponent Mark

the Opponent Mark is highly recognised by consumers as indicating luxury and reliable goods.

Q3b. Please state any proper reasons for non-use.

under the Opponent Mark in the UK.

and the Applicant Mark.

SECTION B: Opposition is based on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending trade mark, that is identical with or similar to an earlier mark which has a reputation.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

161984

Type of mark Please tick

· UK

/ EUTM

International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



i i	All goods and services
1	Some goods and services (please specify below, use a continuation sheet if necessary)
!	All goods in Class 12
•	
!	
1	
Q2. take	For which goods or services in the application (you are opposing) would use of the applicant's mark unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade
	All goods and services
Ā	Some goods and services (please specify below, use a continuation sheet if necessary)
Q3. such	Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is in that the relevant public will believe that they are used by the same undertaking or think that there is conomic connection between the users of the trade marks?
	✓ Yes No
Use	this space to supply any further information
As we claim advantage sign and believes	Applicant Mark should be refused registration under the provisions of Section 5(3) of the Trade Marks Act 1994. vill be demonstrated in these proceedings, the Opponent enjoys a reputation in the Opponent Mark for the ned goods protected under its registration. Use of the Applicant Mark is liable to, without due cause, take unfair antage of, or cause detriment to, the distinctive character or repute of the Opponent Mark. In light of the ificant reputation enjoyed in the Opponent Mark, the relevant public is likely to believe that the Applicant Mark the Opponent Mark originate from the same or economically linked undertakings. Alternatively, consumers may eve that the Opponent and the Applicant have entered into a partnership or commercial venture which permits of the Opponent Mark by the Applicant. Such a belief may entice consumers to use the goods of the Applicant, eving them to be connected in some way with the reliable and luxury goods offered under the Opponent Mark.

For which goods or services covered by your earlier trade mark does it have a reputation?

Q1.

QUESTIONS 4 TO 6 SHOULD BE ANSWERED IF THERE IS ANY OTHER BASIS FOR YOUR CLAIM OTHER THAN FOR YOUR ANSWER TO Q.3

Q4. Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair.

Unfair advantage is taken by the applicant as a result of the use of a closely similar sign. In the present case, the trade marks are similar, therefore the image of the Opponent Mark is transferred to the goods designated under the Applicant Mark. The Opponent submits that the Applicant Mark immediately calls the Opponent Mark to the mind of the average consumer. The Opponent Mark enjoys a significant reputation for and is recognised by consumers as denoting luxury goods in the UK. If registered, the Applicant Mark will unfairly benefit from the power of attraction that the Opponent Mark enjoys, and will unfairly exploit this reputation without the Applicant having made the associated investment.

Q5. Is there any other basis for your claim of detriment to the reputation of the earlier mark? If so, please explain what the detriment would be and how it would occur.

Degradation to an earlier trade mark is caused when the goods or services for which the later sign is used may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The Opponent Mark has been used for many years and is synonymous with the luxury goods offered under the trade mark. The reputation in the Opponent Mark will be tarnished by the use of a highly similar trade mark for inferior quality goods. Use of the Applicant Mark may have a negative influence on the reputation of the Opponent Mark, which may diminish the power of attraction the Opponent Mark enjoys. If the Applicant Mark is registered, the exclusivity conferred by the Opponent Mark, and the ability of the Opponent to control and identify goods bearing the Opponent Mark as originating from the Opponent, will be weakened.

Q6. Is there any other basis for your claim of detriment to the distinctive character of the earlier mark? If so, please explain what the detriment would be and how it would affect the economic behaviour of the relevant public.

Dilution is caused when a trade mark's ability to identify the goods or services for which it is registered are weakened. This can be demonstrated in the present case, where use of the Applicant Mark leads to a dispersion of the identity and hold that the Opponent Mark has upon the public mind. If the Applicant Mark is registered, the Opponent will have no control over how the Applicant Mark is used by the Applicant. This will inevitably weaken the Opponent's position and seriously damage the exclusivity of the Opponent Mark. If the Opponent Mark's exclusivity is weakened, consumers may no longer be able to rely on the Opponent Mark as a mark of quality and trust and may therefore choose not to use the goods offered under the Opponent Mark, thereby effecting the economic behaviour of the relevant public.

111611	_	rears or more be	nore the publicati	on date of the applicatio	n you wish to oppose?
	Yes			No > GO TO Q10	
Q8. mark	Has the trac	de mark been use	ed in the 5 year p	eriod ending on the date	of publication of the opposed
	Yes			No > GO TO Q9b	
Q9a.	For which o	f the goods and	services listed at	Q1 is trade mark use be	eing claimed?
√	All goods and	services			
: F	Some goods a	and services (pleas	e specify below, use a	continuation sheet if necessary)	
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> (60 TO Q10				
Q9b.	Please state	e any proper reas	sons for non-use.		
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(
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Q10, this g	Use this spa ground.	ice to give any fi	urther information	n to explain why you are	opposing the application on
!					

STATEMENT OF USE PROVISION - Was the registration or protection process for the earlier trade

Q7.

SECTION E: Opposition is based on any other grounds

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Use this sheet if you are basing your opposition on any other grounds and tick the appropriate box.

✓	Section 5(1),(2),(3)	If the opponent is claiming protection for an earlier trade mark under Section 6(1)(c) which is a well known trade mark as defined in Section 56(1). See ††Note below.
	Section 5(4)(b)	An earlier right by virtue of the law of copyright, design right or registered designs.
	Section 60	Registered in the name of an agent or representative.
	Rule 25(2)	Opposition to amendment after publication.
	Rule 29	Regulations for collective or certification marks.
	Rule 30(4)	Amendment of regulations for collective or certification marks.
	Rule 32(3)	Alteration of registered mark.
	Rule 53(2)	Removal of matter from the register.
	Others	

†† For opposition on these grounds the following details should be supplied in the area below:

- Representation of the mark
- Details of any reference number and related jurisdiction if relevant Details of goods and services covered by the earlier mark
- Details of goods and services (in the application) which you consider to be similar identical to those covered by the earlier mark.

Alternatively you may wish to adapt Section A and Section B of this form.

Give details (including details of any right relied upon) to support the application under these grounds (Use a continuation sheet if necessary)

Please refer to Continuation Sheet 5

Section E:

Section 56(1) Continuation Sheet 5

EUTM Registration No. 161984 is an earlier mark under the provisions of Section 6(1)(c) and is a well known mark as defined in Section 56(1).

It is registered and used in respect of "Vehicles; Apparatus for locomotion by land, air or water, in particular cars and components and fittings therefor; Pumps (Air -) [vehicle accessories]; Anti-glare devices for vehicles; Anti-skid chains; Anti-theft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Chains for bicycles, cycles; Frames for bicycles, cycles; Handle bars for bicycles, cycles; Pumps for bicycles, cycles; Rims for wheels of bicycles, cycles; Cycle saddles; Spokes for bicycles, cycles; Bicycle stands; Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brake segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol [gas] tanks; Casings for pneumatic tires [tyres]; Cleats [nautical]; Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankçases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels; Cycle mudguards; Pumps for bicycles, cycles; Crank mechanisms for bicycles; Saddles for cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction indicators for bicycles, cycles and the like; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Dress guards for bicycles, cycles; Driving chains for land vehicles; Driving motors for land vehicles; Ejector seats for aircraft; Tailboard lifts [parts of land vehicles]; Motors for land vehicles; Flanges for railway wheel tires [tyres]; Freewheels for land vehicles; Funnels for locomotives; Funnels for ships; Gear boxes for land vehicles; Gearing for land vehicles; Gears for cycles; Trolleys; Handle bars for bicycles, cycles; Head-rests for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats; Inner tubes for bicycles, cycles; Inner tubes for pneumatic tires; Jet engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars; Paddles for canoes; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outfits for inner tubes; Reversing alarms for vehicles; Rims for vehicle wheels; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screwpropellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries [trucks]; Tires for vehicle wheels; Torque converters for land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires [tyres]; Treads for vehicles [roller belts]; Tubeless tires [tyres] for bicycles, cycles; Turbines for land vehicles; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires [tyres]; Vehicle bumpers; Vehicle chassis; Vehicle running boards; Vehicle

seats; Vehicle suspension springs; Vehicle wheel spokes; Vehicle wheels; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Stroller covers; Vehicle covers [shaped]; Wheelbarrows" in Class 12.

As set out in the preceding pages of this Opposition, the Applicant Mark should be refused registration under the provisions of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 for the reasons stated therein. The Opponent Mark is well known throughout the UK, EU and worldwide and is considered to be among the most famous in the world.

It is also to be noted that the Opponent Mark is not only used in relation to vehicles but also in relation to a large range of merchandising goods such as perfumes, watches, leather items and other luxury goods.

Further, the Opponent is and has been for many decades, one of the strongest protagonist's of Formula 1 Racing, one of the most popular car sports worldwide.

Evidence pertaining to the above will be presented during the adversarial stages of the Opposition.

Accordingly, the registration of Application No. 1406563 should be prevented in light of the Opponent's trade mark being well known in the UK as being the trade mark of the Opponent.

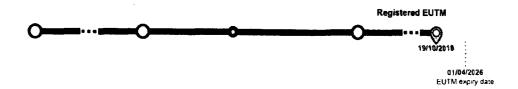


Protect your intellectual property in the European Union

EUTM file information

SF 000161984

Timeline



Graphic representation



01/04/1996

Trade mark information

000161984 02/10/1998 Registration date **EUTM** 01/04/2026 4.15.5 eventy date 01/04/1996 Designation date Cate of the emo Italian **Figurative** Eding time age Tytie English Second language Nature Individual 12, 37 (Nice Classification) Application reference C000034 Registered Vienna Classification 03.02.26, 03.03.01, 03.03.17, Trade mark status 24.01.09 (Vienna

Classification)

Eding date

Acquired distinctiveness No

Goods and services

English (en)

12 Vehicles; Apparatus for locomotion by land, air or water, in particular cars and components and fittings therefor; Pumps (Air -) [vehicle accessories]; Anti-glare devices for vehicles; Anti-skid chains; Anti-theft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Chains for bicycles, cycles; Frames for bicycles, cycles; Handle bars for bicycles, cycles; Pumps for bicycles, cycles; Rims for wheels of bicycles, cycles; Cycle saddles; Spokes for bicycles, cycles; Bicycle stands; Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brake segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol [gas] tanks; Casings for pneumatic tires [tyres]; Cleats [nautical]; Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankcases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels; Cycle mudguards; Pumps for bicycles, cycles; Crank mechanisms for bicycles; Saddles for cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction indicators for bicycles, cycles and the like; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Dress guards for bicycles, cycles; Driving chains for land vehicles; Driving motors for land vehicles; Ejector seats for aircraft; Tailboard lifts [parts of land vehicles]; Motors for land vehicles; Flanges for railway wheel tires [tyres]; Freewheels for land vehicles; Funnels for locomotives; Funnels for ships; Gear boxes for land vehicles; Gearing for land vehicles; Gears for cycles; Trolleys; Handle bars for bicycles, cycles; Head-rests for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats; Inner tubes for bicycles, cycles; Inner tubes for pneumatic tires; Jet engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars; Paddles for canoes; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outfits for inner tubes; Reversing alarms for vehicles; Rims for vehicle wheels; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screw-propellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries [trucks]; Tires for vehicle wheels; Torque converters for land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires [tyres]; Treads for vehicles [roller belts]; Tubeless tires [tyres] for bicycles, cycles; Turbines for land vehicles; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires [tyres]; Vehicle bumpers; Vehicle chassis; Vehicle running boards; Vehicle seats; Vehicle suspension springs; Vehicle wheel spokes; Vehicle wheels; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Stroller covers; Vehicle covers [shaped]; Wheelbarrows.

37 Repairs and maintenance services for motor vehicles, included in class 37.

Owners

FERRARI S.P.A.

Organisation

7308 FERRARI S.P.A. Legal entity

Country
State/county
Town

Post code

Address

n/a Modena 41100 Via Emilia Est.

1163

IT - Italy

FERRARI S.P.A.
Via Emilia Est, 1163
I-41100 Modena
ITALIA

Can be accessed and changed by authorised user via the User Area

Can be accessed and changed by authorised user via the User Area

Can be accessed and changed by authorised user via the User Area

Representatives

DR. MODIANO & ASSOCIATI S.P.A.

ID 10583
Organisation n/a
Legal status Legal person
Type Association

State/county Lown Post code

Country

Post code 20123
Address Via Meravigli, 16

IT - Italy

Milano

n/a

Correspondence address

DR. MODIANO & ASSOCIATI S.P.A. Via Meravigli, 16 I-20123 Milano ITALIA 00 39-0285907777

00 39-0272021062

uami@modiano.com

Cancellation

No data

Appeals

No data

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

5(1) It is Identical with an earlier mark and for IdentIcal goods or services as the earlier mark

5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.

/

5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

924922

Type of mark Please tick **√** Uk

EUTM

International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



All goods and services	
Some goods and services (pleas	se specify below, use a continuation sheet if necessary)
	•
•	•
STATEMENT OF USE - Was to	the registration or protection process for the earlier trade mark
eted 5 years or more before the	he publication date of the application you wish to oppose?
√ Yes	No > GO TO Q4
	i i
Has the trade mark been us	ed?
Yes	No > GO TO Q3b
Paradisk state and the	
For which of the goods and	services listed at Q1 is trade mark use being claimed?
All goods and services	
All goods and services Some goods and services (pleas)	e specify below, use a continuation sheet if necessary)
	e specify below, use a continuation sheet if necessary)
	e specify below, use a continuation sheet if necessary)
	e specify below, use a continuation sheet if necessary)
	e specify below, use a continuation sheet if necessary)
Some goods and services (pleas	e specify below, use a continuation sheet if necessary)
Some goods and services (pleas	e specify below, use a continuation sheet if necessary)

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DETA	NILS OF THE TRADE MARK YOU ARE OPPOSING	
Q4.	Which goods or services in the application that you are opposing do you claim a	re identical or
	ar to those covered by the earlier mark which you have listed at Q1 or Q3a (whiche	ver is applicable)?
,	· · · · · · · · · · · · · · · · · · ·	
\	All goods and services	
[•		
, :	Some goods and services (please specify below, use a continuation sheet if necessary)	
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Q5.	Use this space to supply any further information about why you consider there i	s a likelihood of
confu	usion and e.g. why you consider the respective marks or goods and/or services to	
:	· · · · · · · · · · · · · · · · · · ·	
The t	rade mark applied for ("the Applicant Mark") should be refused registration under the provis	ions of Section 5(2)(b) of
the T	rade Marks Act 1994. `The Applicant Mark is visually and conceptually similar to the Oppon- ment Mark"), as both the Applicant Mark and the Opponent Mark depict an image of a horse	ent's registration ("the :
or jur	right wark.), as both the Applicant wark and the Opponent wark depict an image of a noise riping position. The Applicant Mark will therefore merely be seen as indicating that the conte	ested goods are offered
	r the Opponent Mark in the UK.	-
in ad	dition, the Applicant Mark covers goods which are identical and similar to the goods covered	I by the Opponent Mark
	serves to increase the overall degree of similarity between the Opponent Mark and the Appl	

Opponent Mark is very well known around the world including in the UK, and has been extensively used, and as such enjoys a high degree of inherent and acquired distinctive character. As will be demonstrated later in these proceedings,

In view of the above, the Opponent submits that should the Applicant Mark proceed to registration, a likelihood of confusion including a likelihood of association would arise on the part of the public in the UK between the Opponent Mark

the Opponent Mark is highly recognised by consumers as indicating luxury and reliable goods.

and the Applicant Mark.

Q3b. Please state any proper reasons for non-use.

SECTION B: Opposition is based on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending trade mark, that is identical with or similar to an earlier mark which has a reputation.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

924922

Type of mark Please tick

	,	 1		
! √	₹UK	EUTM		International
. •		 1	l l	

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



		ds and services							
	Some g	goods and services	S (please specify be	elow, use a con	tinuation she	et if necessar	ry)		
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	nfair ac	hich goods or se Ivantage of, or be	ervices in the a	pplication (o, the distin	you are o ctive cha	pposing) v racter or r	would us eputation	e of the app of the earl	ilicant's mark Ier trade
mark?					e elec				
√	All good	ds and services							
	Some g	goods and services	S (please specify be	slow, use a con	tinuation she	et if necessa	ry)		
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	hat the	ialmed that the s relevant public v connection betw	will believe that	t they are u	sed by th	er trade m e same un	ark and t	he later trac g or think th	ie mark is nat there is
such t	1	Yes	•	ļ .	No				
such t an eco	s space to	Yes supply any further info	formation	;	No				

Q1. For which goods or services covered by your earlier trade mark does it have a reputation?

QUESTIONS 4 TO 6 SHOULD BE ANSWERED IF THERE IS ANY OTHER BASIS FOR YOUR CLAIM OTHER THAN FOR YOUR ANSWER TO Q.3

Q4. Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair.

Unfair advantage is taken by the applicant as a result of the use of a closely similar sign. In the present case, the trade marks are similar, therefore the image of the Opponent Mark is transferred to the goods designated under the Applicant Mark. The Opponent submits that the Applicant Mark immediately calls the Opponent Mark to the mind of the average consumer. The Opponent Mark enjoys a significant reputation for and is recognised by consumers as denoting luxury goods in the UK. If registered, the Applicant Mark will unfairly benefit from the power of attraction that the Opponent Mark enjoys, and will unfairly exploit this reputation without the Applicant having made the associated investment.

Q5. Is there any other basis for your claim of detriment to the reputation of the earlier mark? If so, please explain what the detriment would be and how it would occur.

Degradation to an earlier trade mark is caused when the goods or services for which the later sign is used may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The Opponent Mark has been used for many years and is synonymous with the luxury goods offered under the trade mark. The reputation in the Opponent Mark will be tarnished by the use of a highly similar trade mark for inferior quality goods. Use of the Applicant Mark may have a negative influence on the reputation of the Opponent Mark, which may diminish the power of attraction the Opponent Mark enjoys. If the Applicant Mark is registered, the exclusivity conferred by the Opponent Mark, and the ability of the Opponent to control and identify goods bearing the Opponent Mark as originating from the Opponent, will be weakened.

Q6. Is there any other basis for your claim of detriment to the distinctive character of the earlier mark? If so, please explain what the detriment would be and how it would affect the economic behaviour of the relevant public.

Dilution is caused when a trade mark's ability to identify the goods or services for which it is registered are weakened. This can be demonstrated in the present case, where use of the Applicant Mark leads to a dispersion of the identity and hold that the Opponent Mark has upon the public mind. If the Applicant Mark is registered, the Opponent will have no control over how the Applicant Mark is used by the Applicant. This will inevitably weaken the Opponent's position and seriously damage the exclusivity of the Opponent Mark. If the Opponent Mark's exclusivity is weakened, consumers may no longer be able to rely on the Opponent Mark as a mark of quality and trust and may therefore choose not to use the goods offered under the Opponent Mark, thereby effecting the economic behaviour of the relevant public.

Q7. mark			SE PROVISION - W more before the					
	: 🗸	Yes			No > GO TO Q1	0		
Q8. mark?		the trade mark	been used in the	5 year period	ending on the da	ate of publ	ication of th	e opposed
	√	Yes			No > GO TO Q9	b		
Q9a.	For v	which of the go	ods and services	listed at Q1 is	trade mark use	being clai	med?	
1	All god	ods and services	S	•				
	Some	goods and serv	ices (please specify be	elow, use a continu	ation sheet if necessa	(עיו		
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Q9b.	Pleas	se state any pr	oper reasons for	non-use.	•			
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Q10.		this space to g	ive any further in	formation to e	xplain why you a	are opposi	ng the appi	ication on
this g	round.				•			
; {			•			-		

Skip to main content

Intellectual Property Office

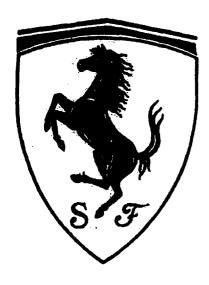
Trade mark number UK00000924922

Status

Registered

Overview

Trade mark



Mark details

Mark Description/Limitation

The Trade Mark is limited to colours the green, white, red, black and yellow, as shown in the representation on the form of application.

Disclaimer

Registration of this Trade Mark shall give no right to the exclusive use of the letters "SF".

Dates

Filing date

09 May 1968

Da	te	of	ent	гу	in	reg	ister
23	Fe	bn	uary	1	97	0	

Renewai date

09 May 2023

Goods and services

Classes and terms

Class 12

Motor cars, and parts and fittings therefor included in Class 12.

Names and addresses

Owner(s) name

Ferrari S.p.A.

Via Emilia Est 1163, 41100 Modena, Italy

Country of Incorporation

Italy

IPO representative name

D. Young & Co. LLP

120 Holborn, London, EC1N 2DY, United Kingdom

Publications

First advert

Journal

4766

Date of publication

01 January 1970

Intellectual Property Office is an operating name of the Patent Office

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark

5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.

/

5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

162065

Type of mark Please tick

UK



International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



Q1.	Which goods or services cover	red by the earlier trade mark are relied upon for the opposition?
	All goods and services	
1	Some goods and services (please sp	ecify below, use a continuation sheat if necessary)
A	Il goods in Class 12	
•		
	· ·	
!		
Q2. comp	STATEMENT OF USE - Was the pleted 5 years or more before the p	registration or protection process for the earlier trade mark publication date of the application you wish to oppose? No > GO TO Q4
Q3.	Has the trade mark been used?	7
	Yes	No > GO TO Q3b
Q3a.	For which of the goods and ser	vices listed at Q1 is trade mark use being claimed?
√	All goods and services	
,	Some goods and services (please sp	ecify below, use a continuation sheet if necessary)
•	•	
: •		

:TA	ILS OF THE TRADE MARK YOU ARE OPPOSING
nila	Which goods or services in the application that you are opposing do you claim are identical or ar to those covered by the earlier mark which you have listed at Q1 or Q3a (whichever is applicable)?
/	All goods and services
	Some goods and services (please specify below, use a continuation sheet if necessary)
	i
	·

Opponent Mark"), as both the Applicant Mark and the Opponent Mark depict an image of a horse facing left in a rearing or jumping position. The Applicant Mark will therefore merely be seen as indicating that the contested goods are offered

In addition, the Applicant Mark covers goods which are identical and similar to the goods covered by the Opponent Mark. This serves to increase the overall degree of similarity between the Opponent Mark and the Applicant Mark. The Opponent Mark is very well known around the world including in the UK, and has been extensively used, and as such enjoys a high degree of inherent and acquired distinctive character. As will be demonstrated later in these proceedings,

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the Opponent Mark is highly recognised by consumers as indicating luxury and reliable goods.

Q3b. Please state any proper reasons for non-use.

under the Opponent Mark in the UK.

and the Applicant Mark.

SECTION B: Opposition is based on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending trade mark, that is identical with or similar to an earlier mark which has a reputation.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number Your trade mark

162065

Type of mark Please tick

UK



International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



√	Some goods and services (please specify below, use a	a continuation sheet if necessary)	
!			
	All goods in Class 12		
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1			
i			
Q2. take mark	For which goods or services in the application unfair advantage of, or be detrimental to, the disk?	on (you are opposing) would use of the ap stinctive character or reputation of the ea	pplicant's mark rlier trade
	1		
∀	All goods and services		a
	Some goods and services (please specify below, use a	continuation sheet if necessary)	
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egs. such an ec	Is it claimed that the similarity between the interest the relevant public will believe that they are conomic connection between the users of the tr	e used by the same undertaking or think	
	√ Yes	No	
Use t	this space to supply any further information		
As w claim adva signifi and t belief use of	Applicant Mark should be refused registration under rill be demonstrated in these proceedings, the Opportude goods protected under its registration. Use of the intage of, or cause detriment to, the distinctive characteristic enjoyed in the Opponent Mark, the the Opponent Mark originate from the same or econous that the Opponent and the Applicant have enter of the Opponent Mark by the Applicant. Such a believing them to be connected in some way with the re	onent enjoys a reputation in the Opponent Mark is liable to, without due can recter or repute of the Opponent Mark. In light a relevant public is likely to believe that the Anomically linked undertakings. Alternatively, ed into a partnership or commercial venture in light may entice consumers to use the goods of	ark for the luse, take unfair ht of the pplicant Mark consumers may which permits of the Applicant.

For which goods or services covered by your earlier trade mark does it have a reputation?

Q1.

All goods and services

QUESTIONS 4 TO 6 SHOULD BE ANSWERED IF THERE IS ANY OTHER BASIS FOR YOUR CLAIM OTHER THAN FOR YOUR ANSWER TO Q.3

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		_	stration or protection process for the ea date of the application you wish to oppo	
-	√ Yes	•	No > GO TO Q10	
Q8. I mark?	Has the trade mark	been used in the 5 year perio	od ending on the date of publication of t	ne opposed
	Yes		No > GO TO Q9b	
Q9a. F	For which of the go	ods and services listed at Q	is trade mark use being claimed?	,
√ Al	goods and services	• •		
So	ome goods and servi	Ces (please specify below, use a con-	tinuation sheet if necessary)	
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> GO 1	TO Q10		. ••• •	
		oper reasons for non-use.		
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Q9b. F	Please state any pro		o explain why you are opposing the app	lication on
Q9b. F	Please state any pro		o explain why you are opposing the app	lication on
Q9b. F	Please state any pro		o explain why you are opposing the app	lication on

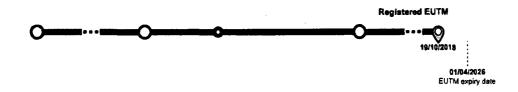


Protect your intellectual property in the European Union

EUTM file information

Ferrari

Timeline



Graphic representation



Trade mark information

Name Ferrari Filing date 01/04/1996 Filing number 000162065 Registration date 26/10/1998 Basis **EUTM** 01/04/2026 Expiry date Date of rere pr 01/04/1996 Designation date **Figurative** Filing anguage Туре Italian Nature Individual English Second language Nice classes 12, 37 (Nice Classification) C00000035 Application reference 03.02.26, 03.03.01, 03.03.17, 26.04.02, 26.04.05, 26.04.22 (Vienna Classification) Vienna Ciassification Frade mark status Registered Acquired distinct veness

No

Goods and services

English (en)

12 Vehicles; Apparatus for locomotion by land, air or water; In particular cars and components thereof; Pumps (Air -) (vehicle accessories); Anti-glare devices for vehicles; Anti-skid chains; Anti-theft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Chains for bicycles, cycles; Frames for bicycles, cycles; Handle bars for bicycles, cycles; Pumps for bicycles, cycles; Rims for wheels of bicycles, cycles; Cycle saddles; Spokes for bicycles, cycles; Bicycle stands; Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brake segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol [gas] tanks; Casings for pneumatic tires [tyres]; Cleats [nautical]; Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankcases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels, Cycle mudguards, Pumps for bicycles, cycles; Crank mechanisms for bicycles; Saddles for cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction indicators for bicycles, cycles and the like; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Dress guards for bicycles, cycles; Driving chains for land vehicles; Driving motors for land vehicles; Ejector seats for aircraft; Tailboard lifts (parts of land vehicles); Motors for land vehicles; Flanges for railway wheel tires (tyres); Freewheels for land vehicles; Funnels for locomotives; Funnels for ships; Gear boxes for land vehicles; Gearing for land vehicles; Gears for cycles; Trolleys; Handle bars for bicycles, cycles; Head-rests for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats; Inner tubes for bicycles, cycles; Inner tubes for pneumatic tires; let engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars: Paddles for canoes; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outfits for inner tubes; Reversing alarms for vehicles; Rims for vehicle wheels; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screw-propellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries (trucks); Tires for vehicle wheels; Torque converters for land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires [tyres]; Treads for vehicles [roller belts]; Tubeless tires [tyres] for bicycles, cycles; Turbines for land vehicles; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires (tyres); Vehicle bumpers; Vehicle chassis; Vehicle running boards; Vehicle seats; Vehicle suspension springs; Vehicle wheel spokes; Vehicle wheels; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Stroller covers; Vehicle covers [shaped]; Wheelbarrows.

37 Construction, repair and maintenance services for motor vehicles, all included in class 37.

Owners

FERRARI S.P.A.

Organisation

Legal status

ID

7308 FERRARI

S.P.A. Legal entity Country State/county

Town
Pas: code
Address

IT - Italy n/a Modena

41100 Via Emilia Est, 1163 Correspondence address

FERRARI S.P.A. Via Emilia Est, 1163 1-41100 Modena ITALIA Can be accessed and changed by authorised user via the User Area

Can be accessed and changed by authorised user via the User Area

Can be accessed and changed by authorised user via the User Area

Representatives

DR. MODIANO & ASSOCIATI S.P.A.

Organisation
Legal status

10583

Legal person

Country
State/counts

lowe

IT - Italy n/a Milano Correspondence address

DR. MODIANO & ASSOCIATI

S.P.A. Via Meravigli, 16 00 39-0285907777

00 39-0272021062

Association

Address

I-20123 Milano ITALIA

Via Meravigii, 16

uami@modiano.com

Cancellation				
No data				
Appeals				

No data

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER UNREGISTERED TRADE MARK

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



Q1. When and where was the earlier right first used in the UK?

Date used: Enter date of first use

since at least 1968

Where used:

Enter name of city/region or specify 'thoughout UK' if used nationally

PI	ease see the attached continuation sheet
DETA	ILS OF THE TRADE MARK YOU ARE OPPOSING
23. he a _l	For which goods or services (of the application that you are opposing) do you consider that use of pplicant's mark would amount to passing off?
√	All goods and services
	Some goods and services (please specify below, use a continuation sheet if necessary)
Q4.	Why would use of the applicant's trade mark be contrary to law, particularly the law of passing off?
mark its tra	Applicant Mark should be refused registration under the laws relating to passing off. The Rearing Horse trade has been used by the Opponent in the UK since at least 1968. The Opponent enjoys a significant reputation in ade mark in the UK and consumers within the UK recognise products bearing these trade marks as originating the Opponent.
assoreputendo and to chare unde also	submitted that use of the Applicant Mark will constitute a misrepresentation to the UK public that there is an ciation between the goods applied for and the Opponent. It is submitted that given the Opponent's strong ration in their trade mark, consumers, when presented with the Applicant Mark, will assume a collaboration, resement or association between the parties. Such a misrepresentation would lead to damage to the Opponent, the goodwill that it has built up in its trade mark in the UK. This would consist of damage to the distinctive racter and reputation of the Opponent's trade mark and potentially damage to the repute of its business and the restanding among the public of the high quality that the Opponent's trade mark represents. This damage may manifest in loss of sales, which the Opponent would otherwise have enjoyed under its trade mark had it not for the existence of the Applicant Mark.

On which goods or services has the earlier right been used for?

Q2.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER UNREGISTERED TRADE MARK

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



Q1. When and where was the earlier right first used in the UK?

Date used: Enter date of first use

at least since 1968

Where used: Enter name of city/region or specify 'thoughout UK' if used nationally

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)FT/	ILS OF THE TRADE MARK YOU ARE OPPOSING
23. he a	For which goods or services (of the application that you are opposing) do you consider that use of pplicant's mark would amount to passing off?
√	All goods and services
_	Some goods and services (please specify below, use a continuation sheet if necessary)
-	
······································	Why would use of the applicant's trade mark be contrary to law, particularly the law of passing off?
The A	Applicant Mark should be refused registration under the laws relating to passing off. The Rearing Horse trade
The Anark	Applicant Mark should be refused registration under the laws relating to passing off. The Rearing Horse trade has been used by the Opponent in the UK since at least 1968. The Opponent enjoys a significant reputation in the Mark in the UK and consumers within the UK recognise products bearing these trade marks as originating the Opponent.
The Amark ts tra rom t is s associated	Applicant Mark should be refused registration under the laws relating to passing off. The Rearing Horse trade has been used by the Opponent in the UK since at least 1968. The Opponent enjoys a significant reputation in ade mark in the UK and consumers within the UK recognise products bearing these trade marks as originating the Opponent. Submitted that use of the Applicant Mark will constitute a misrepresentation to the UK public that there is an ciation between the goods applied for and the Opponent. It is submitted that given the Opponent's strong ation in the trade mark, consumers, when presented with the Applicant Mark, will assume a collaboration, reement or association between the parties. Such a misrepresentation would lead to damage to the Opponent,
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On which goods or services has the earlier right been used for?

Q2.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER UNREGISTERED TRADE MARK

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



Q1. Wh	en and	where wa	s the	earlier ri	aht	first	used	in	the l	JK?
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Date used:

Enter date of first use

since at least 1968

Where used:

Enter name of city/region or specify thoughout UK if used nationally

Q2.	On which goods or services has the earlier right been used for?
M	lotor cars, and parts and fittings therefor included in Class 12
j	
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DET	ALL S OF THE TRADE MARK YOU ARE OPPOSING
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Q3.	
U16 6	sphirent a mark would amount to bassing out
\	All goods and services
-	Some goods and services (alease energy helpsy use a continuation cheef if necessary)
Q4.	Why would use of the applicant's trade mark be contrary to law, particularly the law of passing off?
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its tr	DF THE TRADE MARK YOU ARE OPPOSING or which goods or services (of the application that you are opposing) do you consider that use of ant's mark would amount to passing off? goods and services ne goods and services (please specify below, use a continuation sheet if necessary) and Mark should be refused registration under the laws relating to passing off. The Rearing Horse trade been used by the Opponent in the UK since at least 1968. The Opponent enjoys a significant reputation in that in the UK and consumers within the UK recognise products bearing these trade marks as originating poponent. Itted that use of the Applicant Mark will constitute a misrepresentation to the UK public that there is an in their trade mark, consumers, when presented with the Applicant Mark, will assume a collaboration, ent or association between the pacies. Such a misrepresentation would lead to damage to the Opponent, or the UK public that there is a proposed in their trade mark, consumers, when presented with the Applicant Mark, will assume a collaboration, ent or association between the parties. Such a misrepresentation would lead to damage to the Opponent, codwill that it has built up in its trade mark in the UK. This would consist of damage to the distinctive and reputation of the Opponent's trade mark and potentially damage to the repute of its business and the
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	n for the existence of the Applicant Mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER UNREGISTERED TRADE MARK

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



Q1. When and where was the earlier right first used in the UK?

Date used:

Enter date of first use

since at least 1997

Where used:

Enter name of city/region or specify 'thoughout UK' if used nationally

Q2.	On which goods or services has the earlier right been used for?		
Dia	ease see the attached continuation sheet		2 10 10 10 10
	230 See the stated of this state.		
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			we way 1184
DET#	AILS OF THE TRADE MARK YOU ARE OPPOSING		
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✓	All goods and services		
	Some goods and services (please specify below, use a continuation sheet if necessary	n .	
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You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER UNREGISTERED TRADE MARK

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



Q1.	When and	where was t	he earlier ri	ght first used	l in the UK?
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Date used: Enter date of first use

since at least 1997

Where used: Enter name of city/region or specify 'thoughout UK' if used nationally

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DETA	AILS OF THE TRADE MARK YOU ARE OPPOSING
Q3. the a	For which goods or services (of the application that you are opposing) do you consider that use of pplicant's mark would amount to passing off?
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unde	rstanding among the public of the high quality that the Opponent's trade mark represents. This damage may
	manifest in loss of sales, which the Opponent would otherwise have enjoyed under its trade mark had it not for the existence of the Applicant Mark.
	and desired of the primarie mains

On which goods or services has the earlier right been used for?

Q2,

Please see attached continuation sheet

SECTION C

Q2: On which goods or services has the earlier right been used for?

Vehicles; Apparatus for locomotion by land, air or water; In particular automobiles, spare parts and accessories for automobiles, only included in class 12; Tire patches; Air bags [safety devices for automobiles]; Pumps (Air -) [vehicle accessories]; Anti-glare devices for vehicles; Anti-skid chains; Antitheft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Baskets adapted for bicycles; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Frames for bicycles, cycles; Cycle saddles; Bicycle stands: Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brake segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol [gas] tanks; Casings for pneumatic tires [tyres]; Casters for trolleys [vehicles] [carts (Am.)]; Cleaning trolleys; Cleats [nautical]; Clutches for land vehicles: Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankcases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels; Cycle mudguards; Pumps for bicycles, cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Driving chains for land vehicles; Driving motors for land vehicles; Ejector seats for aircraft; Motors for land vehicles; Fenders for ships; Flanges for railway wheel tires [tyres]; Freewheels for land vehicles; Funnels for locomotives; Funnels for ships; Gear boxes for land vehicles; Gearing for land vehicles; Gears for cycles; Trolleys; Head-rests for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats; Inner tubes for pneumatic tires; Jet engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars; Paddles for canoes; Panniers adapted for cycles; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outfits for inner tubes; Reversing alarms for vehicles; Rims for vehicle wheels; Rims for bicycles, cycles; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screw-propellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Shopping trolleys [carts (Am.)]; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Tailboard lifts [parts of land vehicles]; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries (trucks): Tires for vehicle wheels: Torque converters for land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires [tyres]; Treads for vehicles [roller belts]; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires [tyres]; Vehicle bumpers; Vehicle chassis; Vehicle covers [shaped]; Vehicle running boards; Vehicle seats; Vehicle suspension springs; Vehicle wheel spokes; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Dress guards for bicycles, cycles; Saddles for bicycles, cycles or motorcycles; Turbines for land vehicles; Vehicle wheels; Wheelbarrows.

SECTION D: Opposition is based on section 3 of the Trade Marks Act on the basis that the trade mark fails to satisfy certain requirements of a trade mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need Please tick and complete the relevant section(s) that apply. (Use a continuation sheet if necessary) 3(1)(a) It is a sign that does not satisfy the requirements of section1(1) because: 3(1)(b) It is a trade mark that is devoid of any distinctive character because: 3(1)(c) It is a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services because: 3(1)(d) It is a trade mark which consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade because:

	✓	3(6)	It is a trade mark which should not be registered for some or all of the goods and services in the application as the application was made in bad faith;
Pleas	se refer t	o Contini	uation Sheet 2
		Other	State any other part of section 3 you rely on and give your grounds:
ate	which o	f the ap	olicant's goods or services you oppose under Section 3 grounds
	All good	ls and se	rvices
	Some g	oods and	Services (please specify below, use a continuation sheet if necessary)
			•

Section D

Section 3(6): Continuation Sheet 2

The Applicant Mark should be refused under the provisions of Section 3(6). The Applicant Mark is for the device of a left facing horse in a jumping position, set within a badge in relation to Class 12 goods. The distinctive element of the Applicant Mark is the image of the horse, which is highly similar to the Opponent's sign and trade mark(s).

As will be demonstrated through these proceedings, the Opponent has an extensive reputation in its trade marks worldwide, including in the UK for Class 12 goods and its trade marks for and including the Rearing Horse device are well known and considered to be among the most famous in the world. It is also to be noted that the Opponent's trade marks are not only used in relation to vehicles but also in relation to a large range of merchandising goods such as perfumes, watches, leather items and other luxury goods. Further, the Opponent is and has been for many decades, one of the strongest protagonist's of Formula 1 Racing, one of the most popular car sports worldwide.

In light of this reputation and the notoriety of its trade mark, it is submitted that the Applicant must have been aware of the Opponent when adopting its trade mark, and did so in an attempt to align itself with the Opponent, or worse, block sales of the Opponent's goods.

Evidence supporting the Opponent's claims for bad faith will be presented during the adversarial stages of the Opposition.

Accordingly, the Applicant's application for registration of Application No. 1406563 falls short of the standards of acceptable commercial behaviour, and is dishonest, such that the Applicant Mark can only be deemed to have been made in bad faith.