



Intellectual  
Property  
Office

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World Intellectual Property  
Organisation (WIPO)  
International Bureau  
34, Chemin des Colombettes  
1211 Geneva 20  
Switzerland

**Your Reference:**  
**International Registration No:**  
WO0000001406563  
**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:** WO0000001406563  
**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](http://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](http://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](http://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**

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**Trade mark number**

EU005484639

**Status**

Registered

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## **Overview**

### **Trade mark**

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## **Mark details**

**Colours Claimed/Indication**

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

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## **Dates**

**Filing date**

10 November 2006

**Date of entry in register**

07 November 2007

**Renewal date**

10 November 2026

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## Goods and services

### Classes and terms

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Class 6

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Class 9

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Class 12

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Class 16

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Class 18

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Class 25

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Class 28

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Class 37

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## Names and addresses

### Holder's name

**FIAT GROUP MARKETING & CORPORATE COMMUNICATION S.P.A.**

Via Nizza, 250, Torino, 10126, Italy

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### Representative

**JACOBACCI & PARTNERS S.P.A.**

Corso Emilia, 8, Torino, 10152, Italy

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## Publications

### First advert

**Journal**

2007/021

**Date of publication**

28 May 2007

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The information displayed is our version of the details supplied by EUIPO. For the official register of the case please refer to the [EUIPO website](#).

Intellectual Property Office is an operating name of the Patent Office

## Tina Weatherbed

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**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](mailto:gmk@dyoung.com)  
Paralegal Staff:  
Kate Mears [kxm@dyoung.com](mailto:kxm@dyoung.com)

## **D YOUNG<sup>&CO</sup> INTELLECTUAL PROPERTY**

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T: +44 (0)23 8071 9500 F: +44 (0)23 8071 9800 [www.dyoung.com](http://www.dyoung.com)  
**London - Munich - Southampton**

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Intellectual  
Property  
Office

IPO  
SW

22 OCT 2018

NEWPORT

J833957/ 0001 D02246 TM07.....  
23NOV18 200.00 ACCOUNT 0P000414448

J833957/ 0001 D02246 TM07.....  
23NOV18 200.00 ACCOUNT 0P000414448

## Form TM7

### Notice of opposition and statement of grounds

23 OCT 2018

Fee ☐ £100 Opposition based on Section 5(1) and/or 5(2) ONLY



£200

Opposition based on, or including, any other grounds

*Note: If you wish to oppose under Section 5(1) and/or 5(2) and one or more other grounds, the fee will be £200*

Use this form to notify of an opposition to a trade mark application or international registration and to set out the grounds on which you are basing this opposition.

Do not use this form if you wish to file a Fast Track opposition under Section 5(1) and/or 5(2): use Form TM7F.

**1. Trade mark number**

Number of the trade mark you are opposing. If the opposition concerns an International Registration, help us identify the correct trade mark by adding "IR"

1406563

WO 000000 140656 3

**2. Full name of applicant/holder**

Whose trade mark you are opposing

Landtourer Automobile Co., Ltd

**3. Full name of opponent**

Person opposing the trade mark

Ferrari S.p.A.

**Address**

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 complete section 4 below

Via Emilia Est, 1163

Modena

Italy

Postcode I-41100

**Email address**

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

**4. Representative name**

If you have no representative, go to section 5.

D Young & Co LLP

**Address**

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

120 Holborn

London

Postcode EC1N 2DY

**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

tmfilings@dyoung.com

**5. Related proceedings**

If applicable, select location of any related proceedings and enter the case number allocated to the proceedings.

IPO Registry

UK Courts

EUIPO

Number

**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 applicant or holder a reasonable opportunity to withdraw the application, international designation or amendment may result in the opponent being ineligible for an award of costs.

**7. Declaration**

I believe that the facts stated in this form and the attached statement of grounds are true.

Signature

D Young & Co LLP

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.

O051938 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**

Please make sure you have remembered to:

- ☐ Sign and date the form
- ☐ Complete fee sheet (Form FS2)
- ☐ Enclose the fee and fee sheet. Make cheques payable to Intellectual Property Office

**Where to send**

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)



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

☒ 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 covered by the earlier trade mark are relied upon for the opposition?**

☐ All goods and services

☒ Some goods and services *(please specify below, use a continuation sheet if necessary)*

All goods in Class 12

**Q2. 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?**

☒ Yes

No > GO TO Q4

**Q3. Has the trade mark been used?**

☒ Yes

No > GO TO Q3b

**Q3a. 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)*

> GO TO Q4.

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

**DETAILS OF THE TRADE MARK YOU ARE OPPOSING**

**Q4. Which goods or services in the application that you are opposing do you claim are identical or similar 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)*

**Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.**

The trade mark applied for ("the Applicant Mark") should be refused registration under the provisions of Section 5(2)(b) of the Trade Marks Act 1994. The Applicant Mark is visually and conceptually similar to the Opponent's registration ("the 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 under the Opponent Mark in the UK.

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

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 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

454546

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

All goods and services



Some goods and services *(please specify below, use a continuation sheet if necessary)*

All goods in Class 12

**Q2. For which goods or services in the application (you are opposing) would use of the applicant's mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark?**



All goods and services

Some goods and services *(please specify below, use a continuation sheet if necessary)*

**Q3. Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?**



Yes

No

*Use this space to supply any further information*

The Applicant Mark should be refused registration under the provisions of Section 5(3) of the Trade Marks Act 1994. As will be demonstrated in these proceedings, the Opponent enjoys a reputation in the Opponent Mark for the claimed goods protected under its registration. Use of the Applicant Mark is liable to, without due cause, take unfair advantage of, or cause detriment to, the distinctive character or repute of the Opponent Mark. In light of the significant reputation enjoyed in the Opponent Mark, the relevant public is likely to believe that the Applicant Mark and the Opponent Mark originate from the same or economically linked undertakings. Alternatively, consumers may believe that the Opponent and the Applicant have entered into a partnership or commercial venture which permits use of the Opponent Mark by the Applicant. Such a belief may entice consumers to use the goods of the Applicant, believing 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 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. STATEMENT OF USE PROVISION - 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?**

☒ Yes

No > GO TO Q10

**Q8. Has the trade mark been used in the 5 year period ending on the date of publication of the opposed mark?**

☒ Yes

No > GO TO Q9b

**Q9a. 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)*

> GO TO Q10

**Q9b. Please state any proper reasons for non-use.**

**Q10. Use this space to give any further information to explain why you are opposing the application on this ground.**



**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.

<input checked="" type="checkbox"/>	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.
<input type="checkbox"/>	Section 5(4)(b)	An earlier right by virtue of the law of copyright, design right or registered designs.
<input type="checkbox"/>	Section 60	Registered in the name of an agent or representative.
<input type="checkbox"/>	Rule 25(2)	Opposition to amendment after publication.
<input type="checkbox"/>	Rule 29	Regulations for collective or certification marks.
<input type="checkbox"/>	Rule 30(4)	Amendment of regulations for collective or certification marks.
<input type="checkbox"/>	Rule 32(3)	Alteration of registered mark.
<input type="checkbox"/>	Rule 53(2)	Removal of matter from the register.
<input type="checkbox"/>	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 3

**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.



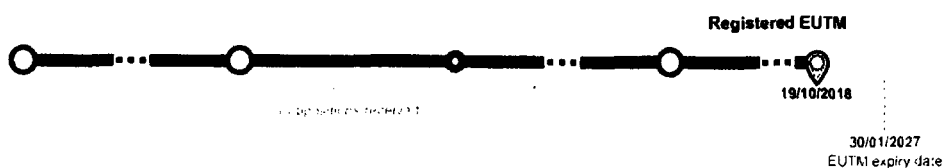
**Protect your intellectual property in the European Union**

**EUTM file information**

**(Trade mark without text)**

**000454546**

## Timeline



### Graphic representation



### Trade mark information

Name	(Trade mark without text)	Filing 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 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; Windcreens; Windscreen wipers; Prams (baby carriages); Dress guards for bicycles, cycles; Saddles for bicycles, cycles or motorcycles; Turbines for land vehicles; Vehicle wheels; Wheelbarrows.

**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	
Organisation	FERRARI S.P.A.	State/country	n/a	FERRARI S.P.A. Via Emilia Est, 1163 I-41100 Modena ITALIA	Can be accessed and changed by authorised user via the User Area
Legal status	Legal entity	Town	Modena		
		Post code	41100		
		Address	Via Emilia Est, 1163		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 &amp; ASSOCIATI S.P.A.

ID	10583	Country	IT - Italy	Correspondence address	
					00 39-0285907777

Organisation	<b>n/a</b>	State/county	<b>n/a</b>	DR. MODIANO & ASSOCIATI	
Legal status	<b>Legal person</b>	Town	<b>Milano</b>	S.P.A.	00 39-0272021062
Type	<b>Association</b>	Post code	<b>20123</b>	Via Meravigli, 16	
		Address	<b>Via Meravigli, 16</b>	I-20123 Milano	uami@modiano.com
				ITALIA	

## Cancellation

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No data

## Appeals

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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.**

<input type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	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

<input type="checkbox"/> UK	<input checked="" type="checkbox"/> EUTM	<input type="checkbox"/> International
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**Representation of your trade mark**

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



**Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?**

All goods and services

☒ Some goods and services *(please specify below, use a continuation sheet if necessary)*

All goods in Class 12

**Q2. 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?**

☒ Yes

No > GO TO Q4

**Q3. Has the trade mark been used?**

☒ Yes

No > GO TO Q3b

**Q3a. 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)*

> GO TO Q4.



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

**DETAILS OF THE TRADE MARK YOU ARE OPPOSING**

**Q4. Which goods or services in the application that you are opposing do you claim are identical or similar 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)*

**Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.**

The trade mark applied for ("the Applicant Mark") should be refused registration under the provisions of Section 5(2)(b) of the Trade Marks Act 1994. The Applicant Mark is visually and conceptually similar to the Opponent's registration ("the 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 under the Opponent Mark in the UK.

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

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 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

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

☐ All goods and services

☒ Some goods and services (please specify below, use a continuation sheet if necessary)

All goods in Class 12

**Q2. For which goods or services in the application (you are opposing) would use of the applicant's mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark?**

☒ All goods and services

☐ Some goods and services (please specify below, use a continuation sheet if necessary)

**Q3. Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?**

☒ Yes

☐ No

*Use this space to supply any further information*

The Applicant Mark should be refused registration under the provisions of Section 5(3) of the Trade Marks Act 1994. As will be demonstrated in these proceedings, the Opponent enjoys a reputation in the Opponent Mark for the claimed goods protected under its registration. Use of the Applicant Mark is liable to, without due cause, take unfair advantage of, or cause detriment to, the distinctive character or repute of the Opponent Mark. In light of the significant reputation enjoyed in the Opponent Mark, the relevant public is likely to believe that the Applicant Mark and the Opponent Mark originate from the same or economically linked undertakings. Alternatively, consumers may believe that the Opponent and the Applicant have entered into a partnership or commercial venture which permits use of the Opponent Mark by the Applicant. Such a belief may entice consumers to use the goods of the Applicant, believing 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 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. STATEMENT OF USE PROVISION - 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?**

☒ Yes

No > GO TO Q10

**Q8. Has the trade mark been used in the 5 year period ending on the date of publication of the opposed mark?**

☒ Yes

No > GO TO Q9b

**Q9a. 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)*

> GO TO Q10

**Q9b. Please state any proper reasons for non-use.**

**Q10. Use this space to give any further information to explain why you are opposing the application on this ground.**

**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.

<input checked="" type="checkbox"/>	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.
<input type="checkbox"/>	Section 5(4)(b)	An earlier right by virtue of the law of copyright, design right or registered designs.
<input type="checkbox"/>	Section 60	Registered in the name of an agent or representative.
<input type="checkbox"/>	Rule 25(2)	Opposition to amendment after publication.
<input type="checkbox"/>	Rule 29	Regulations for collective or certification marks.
<input type="checkbox"/>	Rule 30(4)	Amendment of regulations for collective or certification marks.
<input type="checkbox"/>	Rule 32(3)	Alteration of registered mark.
<input type="checkbox"/>	Rule 53(2)	Removal of matter from the register.
<input type="checkbox"/>	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.





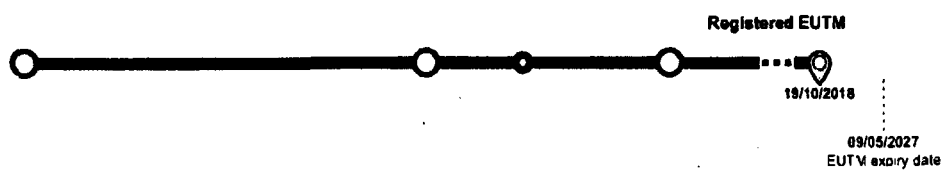
*Protect your intellectual property in the European Union*

## EUTM file information

**Ferrari**  
000539585

### Timeline

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### Graphic representation

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## Trade mark information

Name	<b>Ferrari</b>	Filing date	<b>09/05/1997</b>
Filing number	<b>000539585</b>	Registration date	<b>19/11/1998</b>
Basis	<b>EUTM</b>	Expiry date	<b>09/05/2027</b>
Date of receipt	<b>09/05/1997</b>	Designation date	
Type	<b>Figurative</b>	Filing language	<b>Italian</b>
Nature	<b>Individual</b>	Second language	<b>English</b>
Nice classes	<b>12, 37 ( Nice Classification )</b>	Application reference	<b>C000851</b>
Vienna Classification	<b>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 ( Vienna Classification )</b>	Trade mark status	<b>Registered</b>
		Acquired distinctiveness	<b>No</b>

## 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 belts; 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.

**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	
Organisation	<b>FERRARI S.P.A.</b>	State/country	n/a	FERRARI S.P.A. Via Emilia Est, 1163 I-41100 Modena ITALIA	Can be accessed and changed by authorised user via the User Area
Legal status	<b>Legal entity</b>	Town	<b>Modena</b>		
		Post code	<b>41100</b>		
		Address	<b>Via Emilia Est, 1163</b>		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	Country	IT - Italy	Correspondence address	
Organisation	<b>n/a</b>	State/country	<b>n/a</b>	DR. MODIANO & ASSOCIATI S.P.A. Via Meravigli, 16 I-20123 Milano ITALIA	00 39-0285907777
Legal status	<b>Legal person</b>	Town	<b>Milano</b>		00 39-0272021062
Type	<b>Association</b>	Post code	<b>20123</b>		
		Address	<b>Via Meravigli, 16</b>		uami@modiano.com

## Cancellation

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

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.



**Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?**

All goods and services



Some goods and services *(please specify below, use a continuation sheet if necessary)*

All goods in Class 12

**Q2. 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?**



Yes

No > GO TO Q4

**Q3. Has the trade mark been used?**



Yes

No > GO TO Q3b

**Q3a. 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)*

> GO TO Q4.

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

**DETAILS OF THE TRADE MARK YOU ARE OPPOSING**

**Q4. Which goods or services in the application that you are opposing do you claim are identical or similar 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)*

**Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.**

The trade mark applied for ("the Applicant Mark") should be refused registration under the provisions of Section 5(2)(b) of the Trade Marks Act 1994. The Applicant Mark is visually and conceptually similar to the Opponent's registration ("the 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 under the Opponent Mark in the UK.

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

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 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

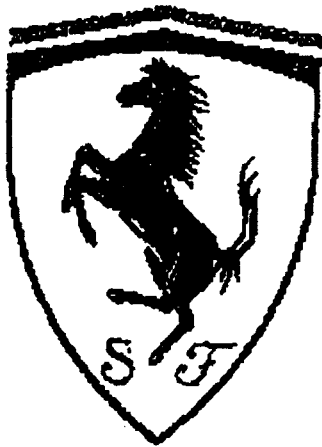
☐ UK

☒ EUTM

☐ International

**Representation of your trade mark**

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



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

All goods and services

☒ Some goods and services (please specify below, use a continuation sheet if necessary)

All goods in Class 12

**Q2. For which goods or services in the application (you are opposing) would use of the applicant's mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark?**

☒ All goods and services

☐ Some goods and services (please specify below, use a continuation sheet if necessary)

**Q3. Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?**

☒ Yes

☐ No

Use this space to supply any further information

The Applicant Mark should be refused registration under the provisions of Section 5(3) of the Trade Marks Act 1994. As will be demonstrated in these proceedings, the Opponent enjoys a reputation in the Opponent Mark for the claimed goods protected under its registration. Use of the Applicant Mark is liable to, without due cause, take unfair advantage of, or cause detriment to, the distinctive character or repute of the Opponent Mark. In light of the significant reputation enjoyed in the Opponent Mark, the relevant public is likely to believe that the Applicant Mark and the Opponent Mark originate from the same or economically linked undertakings. Alternatively, consumers may believe that the Opponent and the Applicant have entered into a partnership or commercial venture which permits use of the Opponent Mark by the Applicant. Such a belief may entice consumers to use the goods of the Applicant, believing 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 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. STATEMENT OF USE PROVISION - 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?**

☒ Yes

No > GO TO Q10

**Q8. Has the trade mark been used in the 5 year period ending on the date of publication of the opposed mark?**

☒ Yes

No > GO TO Q9b

**Q9a. 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)*

> GO TO Q10

**Q9b. Please state any proper reasons for non-use.**

**Q10. Use this space to give any further information to explain why you are opposing the application on this ground.**

**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.

<input checked="" type="checkbox"/>	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.
<input type="checkbox"/>	Section 5(4)(b)	An earlier right by virtue of the law of copyright, design right or registered designs.
<input type="checkbox"/>	Section 60	Registered in the name of an agent or representative.
<input type="checkbox"/>	Rule 25(2)	Opposition to amendment after publication.
<input type="checkbox"/>	Rule 29	Regulations for collective or certification marks.
<input type="checkbox"/>	Rule 30(4)	Amendment of regulations for collective or certification marks.
<input type="checkbox"/>	Rule 32(3)	Alteration of registered mark.
<input type="checkbox"/>	Rule 53(2)	Removal of matter from the register.
<input type="checkbox"/>	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; 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" 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.

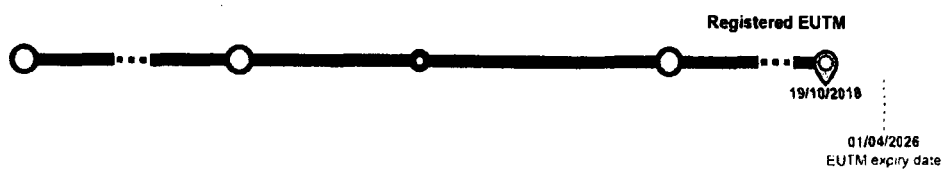
Evidence pertaining to the above will be presented during the adversarial stages of the Opposition.

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.

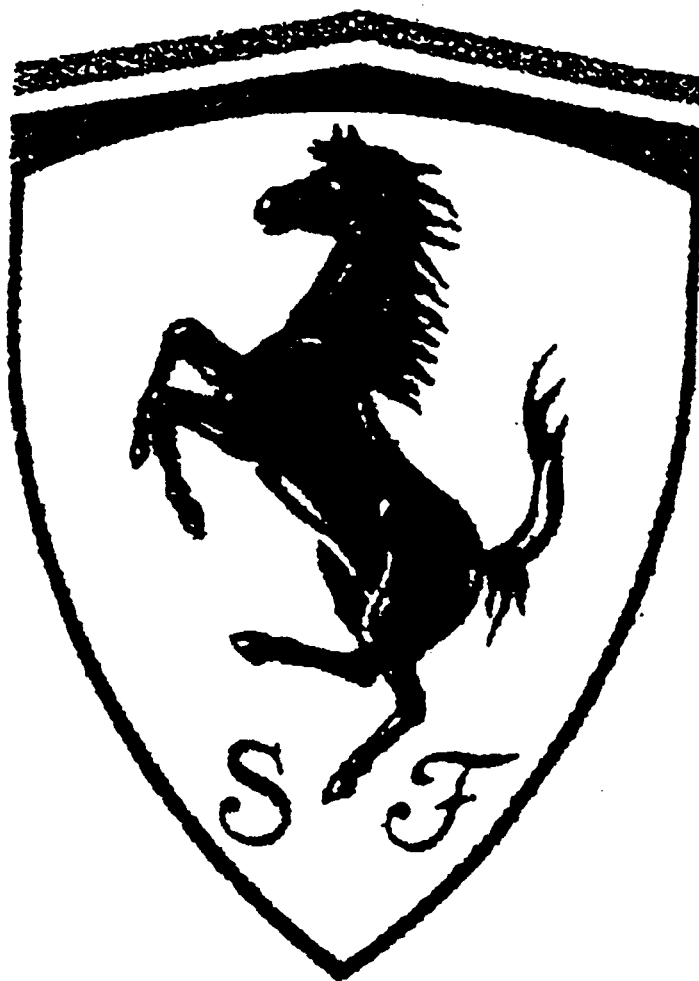
## EUTM file information

**SF**  
**000161984**

### Timeline



### Graphic representation



**Trade mark information**

Name		Filing date	01/04/1996
Filing number	000161984	Registration date	02/10/1998
Class	EUTM	Expiry date	01/04/2026
Date of receipt	01/04/1996	Designation date	
Type	Figurative	Filing language	Italian
Nature	Individual	Second language	English
Nice class(es)	12, 37 ( Nice Classification )	Application reference	C000034
Vienna Classification	03.02.26, 03.03.01, 03.03.17, 24.01.09 ( Vienna Classification )	Trade mark status	Registered
		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; Belts 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.**

ID	<b>7308</b>	Country	<b>IT - Italy</b>	Correspondence address	
Organisation	<b>FERRARI S.P.A.</b>	State/country	<b>n/a</b>	FERRARI S.P.A. Via Emilia Est, 1163 I-41100 Modena ITALIA	Can be accessed and changed by authorised user via the User Area
Legal status	<b>Legal entity</b>	Town	<b>Modena</b>		
		Post code	<b>41100</b>		
		Address	<b>Via Emilia Est, 1163</b>		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	<b>10583</b>	Country	<b>IT - Italy</b>	Correspondence address	
Organisation	<b>n/a</b>	State/country	<b>n/a</b>	DR. MODIANO & ASSOCIATI S.P.A. Via Meravigli, 16 I-20123 Milano ITALIA	00 39-0285907777
Legal status	<b>Legal person</b>	Town	<b>Milano</b>		00 39-0272021062
Type	<b>Association</b>	Post code	<b>20123</b>		
		Address	<b>Via Meravigli, 16</b>		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.**

<input type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	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.



**Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?**



All goods and services

Some goods and services *(please specify below, use a continuation sheet if necessary)*

**Q2. 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?**



Yes

No > GO TO Q4

**Q3. Has the trade mark been used?**



Yes

No > GO TO Q3b

**Q3a. 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)*

> GO TO Q4.

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

**DETAILS OF THE TRADE MARK YOU ARE OPPOSING**

**Q4. Which goods or services in the application that you are opposing do you claim are identical or similar 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)*

**Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.**

The trade mark applied for ("the Applicant Mark") should be refused registration under the provisions of Section 5(2)(b) of the Trade Marks Act 1994. The Applicant Mark is visually and conceptually similar to the Opponent's registration ("the 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 under the Opponent Mark in the UK.

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

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 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

924922

**Type of mark**

Please tick

<input checked="checked" type="checkbox"/> UK	<input type="checkbox"/>	<input type="checkbox"/> EUTM	<input type="checkbox"/> International
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**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?**



All goods and services

Some goods and services (please specify below, use a continuation sheet if necessary)

**Q2. For which goods or services in the application (you are opposing) would use of the applicant's mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark?**



All goods and services

Some goods and services (please specify below, use a continuation sheet if necessary)

**Q3. Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?**



Yes



No

Use this space to supply any further information

The Applicant Mark should be refused registration under the provisions of Section 5(3) of the Trade Marks Act 1994. As will be demonstrated in these proceedings, the Opponent enjoys a reputation in the Opponent Mark for the claimed goods protected under its registration. Use of the Applicant Mark is liable to, without due cause, take unfair advantage of, or cause detriment to, the distinctive character or repute of the Opponent Mark. In light of the significant reputation enjoyed in the Opponent Mark, the relevant public is likely to believe that the Applicant Mark and the Opponent Mark originate from the same or economically linked undertakings. Alternatively, consumers may believe that the Opponent and the Applicant have entered into a partnership or commercial venture which permits use of the Opponent Mark by the Applicant. Such a belief may entice consumers to use the goods of the Applicant, believing 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 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 affecting the economic behaviour of the relevant public.

**Q7. STATEMENT OF USE PROVISION - 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?**

☒ Yes

No > GO TO Q10

**Q8. Has the trade mark been used in the 5 year period ending on the date of publication of the opposed mark?**

☒ Yes

No > GO TO Q9b

**Q9a. 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)*

> GO TO Q10

**Q9b. Please state any proper reasons for non-use.**

**Q10. Use this space to give any further information to explain why you are opposing the application on this ground.**

[Skip to main content](#)

## **Intellectual Property Office**

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**Trade mark number**

UK00000924922

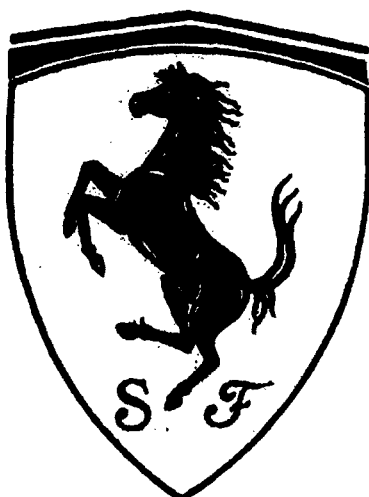
**Status**

Registered

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### **Overview**

#### **Trade mark**



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### **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".

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### **Dates**

#### **Filing date**

09 May 1968



**Date of entry in register**

23 February 1970

**Renewal date**

09 May 2023

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**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

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**IPO representative name**

D. Young & Co. LLP

120 Holborn, London, EC1N 2DY, United Kingdom

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**Publications**

**First advert**

**Journal**

4766

**Date of publication**

01 January 1970

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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

☒ 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 covered by the earlier trade mark are relied upon for the opposition?**

All goods and services



Some goods and services *(please specify below, use a continuation sheet if necessary)*

All goods in Class 12

**Q2. 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?**



Yes

No > GO TO Q4

**Q3. Has the trade mark been used?**



Yes

No > GO TO Q3b

**Q3a. 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)*

> GO TO Q4.

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

**DETAILS OF THE TRADE MARK YOU ARE OPPOSING**

**Q4. Which goods or services in the application that you are opposing do you claim are identical or similar 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)

**Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.**

The trade mark applied for ("the Applicant Mark") should be refused registration under the provisions of Section 5(2)(b) of the Trade Marks Act 1994. The Applicant Mark is visually and conceptually similar to the Opponent's registration ("the 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 under the Opponent Mark in the UK.

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

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 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

☒ 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?**

All goods and services



Some goods and services *(please specify below, use a continuation sheet if necessary)*

All goods in Class 12

**Q2. For which goods or services in the application (you are opposing) would use of the applicant's mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark?**



All goods and services

Some goods and services *(please specify below, use a continuation sheet if necessary)*

**Q3. Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?**



Yes

No

*Use this space to supply any further information*

The Applicant Mark should be refused registration under the provisions of Section 5(3) of the Trade Marks Act 1994. As will be demonstrated in these proceedings, the Opponent enjoys a reputation in the Opponent Mark for the claimed goods protected under its registration. Use of the Applicant Mark is liable to, without due cause, take unfair advantage of, or cause detriment to, the distinctive character or repute of the Opponent Mark. In light of the significant reputation enjoyed in the Opponent Mark, the relevant public is likely to believe that the Applicant Mark and the Opponent Mark originate from the same or economically linked undertakings. Alternatively, consumers may believe that the Opponent and the Applicant have entered into a partnership or commercial venture which permits use of the Opponent Mark by the Applicant. Such a belief may entice consumers to use the goods of the Applicant, believing 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 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. STATEMENT OF USE PROVISION - 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?**

☒ Yes

No > GO TO Q10

**Q8. Has the trade mark been used in the 5 year period ending on the date of publication of the opposed mark?**

☒ Yes

No > GO TO Q9b

**Q9a. 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)*

> GO TO Q10

**Q9b. Please state any proper reasons for non-use.**

**Q10. Use this space to give any further information to explain why you are opposing the application on this ground.**



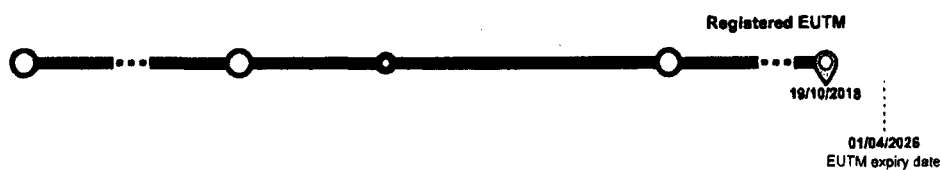


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## EUTM file information

**Ferrari**  
000162065

### Timeline



### Graphic representation



### Trade mark information

Name	<b>Ferrari</b>	Filing date	<b>01/04/1996</b>
Filing number	<b>000162065</b>	Registration date	<b>26/10/1998</b>
Basic	<b>EUTM</b>	Expiry date	<b>01/04/2026</b>
Date of receipt	<b>01/04/1996</b>	Designation date	
Type	<b>Figurative</b>	Filing language	<b>Italian</b>
Nature	<b>Individual</b>	Second language	<b>English</b>
Nice classes	<b>12, 37 ( Nice Classification )</b>	Application reference	<b>C00000035</b>
Vienna Classification	<b>03.02.26, 03.03.01, 03.03.17, 26.04.02, 26.04.05, 26.04.22 ( Vienna Classification )</b>	Trade mark status	<b>Registered</b>

Acquired distinctiveness

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; 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; Windcreens; 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.

ID	7308	Country	IT - Italy	Correspondence address	
Organisation	<b>FERRARI S.P.A.</b>	State/country	<b>n/a</b>	FERRARI S.P.A. Via Emilia Est, 1163 I-41100 Modena ITALIA	Can be accessed and changed by authorised user via the User Area
Legal status	<b>Legal entity</b>	Town	<b>Modena</b>		
		Pos. code	<b>41100</b>		
		Address	<b>Via Emilia Est, 1163</b>		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	Country	IT - Italy	Correspondence address	
Organisation	<b>n/a</b>	State/country	<b>n/a</b>	DR. MODIANO & ASSOCIATI S.P.A. Via Meravigli, 16	00 39-0285907777
Legal status	<b>Legal person</b>	Town	<b>Milano</b>		00 39-0272021062

Type	<b>Association</b>	Postcode	<b>20123</b>	I-20123 Milano	
		Address	<b>Via Meravigli, 16</b>	ITALIA	<a href="mailto:uami@modiano.com">uami@modiano.com</a>

## Cancellation

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No data

## Appeals

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No data

**SECTION C: Opposition is based on Section 5(4)(a) of the Trade Marks Act, where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.**

*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  
"throughout UK" if used nationally

Throughout the UK

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

**Please see the attached continuation sheet**

### DETAILS OF THE TRADE MARK YOU ARE OPPOSING

**Q3. For which goods or services (of the application that you are opposing) do you consider that use of the applicant's mark would amount to passing off?**

✓	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

**Q4. Why would use of the applicant's trade mark be contrary to law, particularly the law of passing off?**

**The Applicant Mark should be refused registration under the laws relating to passing off. The Rearing Horse trade mark has been used by the Opponent in the UK since at least 1968. The Opponent enjoys a significant reputation in its trade mark in the UK and consumers within the UK recognise products bearing these trade marks as originating from the Opponent.**

It is submitted that use of the Applicant Mark will constitute a misrepresentation to the UK public that there is an association between the goods applied for and the Opponent. It is submitted that given the Opponent's strong reputation in their trade mark, consumers, when presented with the Applicant Mark, will assume a collaboration, endorsement or association between the parties. Such a misrepresentation would lead to damage to the Opponent, and the goodwill that it has built up in its trade mark in the UK. This would consist of damage to the distinctive character and reputation of the Opponent's trade mark and potentially damage to the reputé of its business and the understanding among the public of the high quality that the Opponent's trade mark represents. This damage may also manifest in loss of sales, which the Opponent would otherwise have enjoyed under its trade mark had it not been for the existence of the Applicant Mark.

**SECTION C:** Opposition is based on Section 5(4)(a) of the Trade Marks Act, where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

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

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**Date used:**

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at least since 1968

**Where used:**

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

Throughout the UK

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

**Please see attached continuation sheet**

### DETAILS OF THE TRADE MARK YOU ARE OPPOSING

**Q3. For which goods or services (of the application that you are opposing) do you consider that use of the applicant's mark would amount to passing off?**

✓	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

**Q4. Why would use of the applicant's trade mark be contrary to law, particularly the law of passing off?**

The Applicant Mark should be refused registration under the laws relating to passing off. The Rearing Horse trade mark has been used by the Opponent in the UK since at least 1968. The Opponent enjoys a significant reputation in its trade mark in the UK and consumers within the UK recognise products bearing these trade marks as originating from the Opponent.

It is submitted that use of the Applicant Mark will constitute a misrepresentation to the UK public that there is an association between the goods applied for and the Opponent. It is submitted that given the Opponent's strong reputation in the trade mark, consumers, when presented with the Applicant Mark, will assume a collaboration, endorsement or association between the parties. Such a misrepresentation would lead to damage to the Opponent, and the goodwill that it has built up in its trade mark in the UK. This would consist of damage to the distinctive character and reputation of the Opponent's trade mark and potentially damage to the reputé of its business and the understanding among the public of the high quality that the Opponent's trade mark represents. This damage may also manifest in loss of sales, which the Opponent would otherwise have enjoyed under its trade mark had it not been for the existence of the Applicant Mark.



**SECTION C: Opposition is based on Section 5(4)(a) of the Trade Marks Act, where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.**

*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  
"throughout UK" if used nationally

Throughout the UK

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

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

**DETAILS OF THE TRADE MARK YOU ARE OPPOSING**

**Q3. For which goods or services (of the application that you are opposing) do you consider that use of the applicant'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?**

The Applicant Mark should be refused registration under the laws relating to passing off. The Rearing Horse trade mark has been used by the Opponent in the UK since at least 1968. The Opponent enjoys a significant reputation in its trade mark in the UK and consumers within the UK recognise products bearing these trade marks as originating from the Opponent.

It is submitted that use of the Applicant Mark will constitute a misrepresentation to the UK public that there is an association between the goods applied for and the Opponent. It is submitted that given the Opponent's strong reputation in their trade mark, consumers, when presented with the Applicant Mark, will assume a collaboration, endorsement or association between the parties. Such a misrepresentation would lead to damage to the Opponent, and the goodwill that it has built up in its trade mark in the UK. This would consist of damage to the distinctive character and reputation of the Opponent's trade mark and potentially damage to the repute of its business and the understanding among the public of the high quality that the Opponent's trade mark represents. This damage may also manifest in loss of sales, which the Opponent would otherwise have enjoyed under its trade mark had it not been for the existence of the Applicant Mark.

**SECTION C: Opposition is based on Section 5(4)(a) of the Trade Marks Act, where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.**

*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  
'throughout UK' if used nationally

Throughout the UK



**SECTION C:** Opposition is based on Section 5(4)(a) of the Trade Marks Act, where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

*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  
"throughout UK" if used nationally

Throughout the UK

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

**Please see attached continuation sheet**

### DETAILS OF THE TRADE MARK YOU ARE OPPOSING

**Q3. For which goods or services (of the application that you are opposing) do you consider that use of the applicant's mark would amount to passing off?**

✓	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

**Q4. Why would use of the applicant's trade mark be contrary to law, particularly the law of passing off?**

**The Applicant Mark should be refused registration under the laws relating to passing off. The Rearing Horse trade mark has been used by the Opponent in the UK since at least 1997. The Opponent enjoys a significant reputation in its trade mark in the UK and consumers within the UK recognise products bearing these trade marks as originating from the Opponent.**

It is submitted that use of the Applicant Mark will constitute a misrepresentation to the UK public that there is an association between the goods applied for and the Opponent. It is submitted that given the Opponent's strong reputation in their trade mark, consumers, when presented with the Applicant Mark, will assume a collaboration, endorsement or association between the parties. Such a misrepresentation would lead to damage to the Opponent, and the goodwill that it has built up in its trade mark in the UK. This would consist of damage to the distinctive character and reputation of the Opponent's trade mark and potentially damage to the reputé of its business and the understanding among the public of the high quality that the Opponent's trade mark represents. This damage may also manifest in loss of sales, which the Opponent would otherwise have enjoyed under its trade mark had it not been for the existence of the Applicant Mark.

## 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; 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 waggon; 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 section 1(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:**

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**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:

Please refer to Continuation Sheet 2



**Other** State any other part of section 3 you rely on and give your grounds:

**State which of the applicant's goods or services you oppose under Section 3 grounds**



All goods and services

Some goods 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.