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No defence for the Land Rover Defender

United Kingdom - [Morgan, Lewis & Bockius UK LLP](#)

- **The High Court has upheld a UKIPO decision allowing oppositions against Jaguar Land Rover's applications to register the shapes of two Defender models**
- **The hearing officer was correct to decline to place significant weight on the distinctive nature of the shapes to motoring specialists, long-term owners or Defender aficionados**
- **The shape was not operating as a guarantee of origin for purchasers of modified Defenders**

In [Jaguar Land Rover Limited v Ineos Industries Holdings Limited](#) ([2020] EWHC 2130 (Ch), 3 August 2020), the High Court dismissed Jaguar Land Rover's (JLR) appeal against the refusal of four UK trademark applications to register two Land Rover Defender models as shape marks.

The shape marks were initially published by the UK Intellectual Property Office on the basis that they had acquired distinctiveness through use, but were subsequently opposed by Ineos on a number of grounds, the most significant to the appeal being that they are descriptive and non-distinctive pursuant to Sections 3(1)(b) and (c) Trademarks Act 1994.

In relation to the inherent distinctiveness of the shape marks, JLR submitted that the hearing officer did not apply the test of whether they "depart significantly from the norms and customs of the sector" as adopted in *London Taxi Corporation Limited v Fraser-Nash Research Limited* ([2017] EWCA Civ 1729).

JLR submitted that the "arrow shot" rear windows and alpine side windows as shown in the marks are completely different to standard design features of passenger cars, leading to a conclusion such features are distinctive. The hearing officer disagreed, noting that, while such features were "unusual, if not unique" at the relevant dates, they were nonetheless "minor variations" only from the norms and customs of the passenger car sector.

Noting that the hearing officer had undertaken a multifactorial assessment with which the court should show a real reluctance to interfere, the court held that, particularly given the level of generality required for the assessment of inherent distinctiveness, the hearing officer was entitled to find that such features amounted to minor variations only.

JLR also submitted that the hearing officer was wrong not to take into account statements provided by those related to the motor industry when considering inherent distinctiveness. The court disagreed, determining that the hearing officer was correct to decline to place significant weight on the distinctive nature of the shape of the trademarks to motoring specialists, long-term owners or Defender aficionados when distinctiveness is to be considered through the eyes of the average consumer of passenger cars.

Turning to acquired distinctiveness, JLR appealed on the basis that the hearing officer did not correctly apply the test set out in [Windsurfing Chiemsee](#) (Joined Cases C-108 and C-109/97), in particular in relation to survey evidence and the evidence of Defenders modified and sold by a third party.

JLR submitted that *Windsurfing* requires an "overall assessment of the evidence", whereas the hearing officer considered the *Windsurfing* factors before considering the survey evidence. JLR asserted that this led to a situation wherein the survey evidence had to be sufficient to demonstrate acquired distinctiveness in isolation rather than merely reinforcing the other evidence.

However, the court noted that *Windsurfing* refers to the use of surveys as "guidance" for a judgment and accepted Ineos' submission that the hearing officer could make a determination of acquired distinctiveness without considering survey evidence at all. Accordingly, the court concluded that it is perfectly permissible to reach a provisional conclusion on acquired distinctiveness without considering survey evidence.

JLR also submitted that consumers purchase modified Defenders (where the original badging has been removed) because they know they are JLR Defenders and, accordingly, that these consumers rely on the shape alone to indicate the origin of the base vehicles. However, the court rejected this position, stating that, while the modified vehicle may be based on a Defender, what drive the transaction are the modifications made by the third party (otherwise the buyer would purchase a Defender). The court concluded that, accordingly, the shape is not operating as a guarantee of origin for purchasers of such modified Defenders.

The decision is a further reminder to trademark owners that, without branding, even if a shape might be considered iconic, famous or easily recognisable, a conclusion that the shape is capable of indicating the origin of the goods or services claimed is far from certain.

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