

TRADE MARKS ACT 1994

**IN THE MATTER OF an application No. 2024714
by Tom Sperring, Paul Sperring and Jason Lambert
to register the mark BMF in class 25**

and

**IN THE MATTER OF opposition thereto under No. 44520
by The British Motorcyclists Federation (Enterprises) Limited**

TRADE MARKS ACT 1994

IN THE MATTER OF an application, No. 2024714, by Tom Sperring, Paul Sperring and Jason Lambert to register the mark BMF in class 25

5 **and**

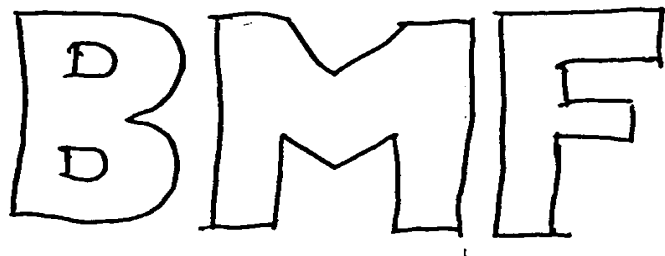
IN THE MATTER OF opposition thereto under No 44520 by The British Motorcyclists Federation (Enterprises) Limited

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DECISION

On 22 June 1995 Tom Sperring, Paul Sperring and Jason Lambert applied under the provisions of Section 32 of the Act to register the trade mark shown below:

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The application is in respect of Class 25 for the following specification of goods:

“Casual wear for men, women and children, to include headgear and footwear”.

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The application is numbered 2024714.

On 3 May 1996, the British Motorcyclists Federation (Enterprises) Limited, filed notice of opposition to this application. The grounds of opposition are in summary that:

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(a) the mark applied for offends against Section 3(6) of the Act because it has been applied for in bad faith;

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(b) the mark applied for offends against Section 5(4)(a) in that the opponents have a trade mark which is an unregistered trade mark protected by the law of passing off.

The opponents ask for their costs.

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5 The applicants did not file a counter-statement nor did they file evidence in support of the application. However, in a letter dated 22 July 1997 Mr Sperring, one of the applicants, states “it was not intended to use the mark until it had been successfully registered”. The opponent filed evidence and both sides have agreed to seek the Registrar’s decision on the basis of the papers filed in these proceedings, without recourse to a hearing. Acting on the Registrar’s behalf, and after a careful study of the papers I now give this decision.

Opponents Evidence (Rule 13(3))

10 The opponents filed in evidence a Statutory Declaration by Alan Bridgeman of 54 Wrecclesham Hill, Farnham, dated 21 April 1997. Mr Bridgeman states that he is a director of the British Motorcyclists Federation (Enterprises) Ltd (formerly the British Motorcyclists Federation Limited), a position he held between 17 October 1976 and 11 October 1981 and again from 15 January 1994 to date. The British Motorcyclists Federation Limited was incorporated on 18 June 1970 and changed its name to the British Motorcyclists Federation (Enterprises) Limited on 15 12 February 1985.

Mr Bridgeman states that the company has used trade marks comprising the letters BMF and the letters BMF together with the device of a motorcycle and rider in the UK on articles of clothing since the mid 1970's. The trade marks have been used on articles of clothing which include: 20 caps, sweatshirts, shirts, belts, T-shirts, anoraks and weatherwear. An application to register the trade mark was filed at the Registry on 5 October 1995 (application no. 2040066).

Exhibits demonstrating use of the trade marks are provided by Mr Bridgeman and include extracts from Motorcycle Rider magazine, advertising leaflets and sample invoices. From a 25 study of these it is clear that all of the advertising has been focussed upon motorcyclists.

Mr Bridgeman goes on to give details of the turnover figures for the five years immediately prior to the date of the application in suit as follows:

| 30 | Year | Turnover |
|----|-------------|-----------------|
| | 1990 | £25,825 |
| | 1991 | £24,548 |
| | 1992 | £24,746 |
| 35 | 1993 | £54,958 |
| | 1994 | £63,637 |

The following sums were spent promoting the trade mark in the three years prior to the application:

| 40 | Year | Advertising Expenditure |
|----|-------------|--------------------------------|
| | 1992 | £5,000 |
| | 1993 | £7,000 |
| 45 | 1994 | £8,000 |

With this evidence in mind I turn to consider the grounds of opposition, starting with Section 5(4)(a) of the Act, which reads as follows:

“5(4)(a) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

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- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade

10 The opposition, if it is to succeed, requires the opponents to demonstrate that they are the owners of an unregistered trade mark which could succeed in a passing-off action.

The authoritative statement of the elements necessary for a successful passing-off action, as set down by Lord Fraser of Tulleybelton, is found in the “Advocaat” case “Warninck v Townend) 15 [1980] RPC 31, at pages 105-106. Lord Fraser said:

“It is essential for the plaintiff in a passing-off action to show at least the following facts:

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1. That his business consists of, or includes, selling in England a class of goods to which the particular trade name applies;
2. That the class of goods is clearly defined, and that in the minds of the public, or a section of the public, in England, the trade name distinguishes the class from other similar goods;
- 25 3. That because of the reputation of the goods, there is goodwill attached to same;
4. That he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England which is of substantial value;
- 30 5. That he has suffered, or is likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached”.

35 I turn to consider the opponents claims against these criteria.

The evidence shows that the opponents have used on articles of clothing, since the mid 1970s, the trade marks shown below.

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In the five years prior to the date of this application sales under these trade marks amounted to £1.9 million and advertising expenditure amounted to £20,000 for the three years 1992-1994.

In my view there is little doubt that the trade marks have built up a reputation for the goods in question, albeit in a fairly specialised section of the marketplace - motorcyclists. In my view the trade marks used by the opponent over the years have varied a little but, nevertheless they consist predominantly of the letters BMF, which is the trade mark the subject of the application. In my view, if the applicants trade mark was to be registered, given that the trade marks of the applicants and the opponents are essentially the same, and the goods identical, a section of the public would be deceived and confused into thinking that the goods were from the same source. That being so the opponent could well suffer damage to his business through a loss of goodwill caused by the applicant selling goods which would be associated, in the minds of the public, with those of the opponent.

In my view, in the absence of any defence by the applicant, and therefore no challenge to the opposition, and on the basis of the evidence filed in these proceedings, the opponent meets the criteria set out earlier in this decision for a successful action for passing off in relation to their BMF trade marks. The opponents are therefore successful in their grounds of opposition under Section 5(4)(a) of the Act.

The opponents also asked the Registrar to refuse the application under the provisions of Section 3(6) which reads as follows:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith”.

The opponents however have provided no evidence that the applicant applied for the registration of this trade mark in bad faith therefore I formally find that they fail in these grounds of their opposition.

As the opponents succeed in this opposition I order the applicants to pay to them the sum of £500 as a contribution towards their costs.

Dated this 4th day of March 1998

M KNIGHT
For the Registrar
the Comptroller General