

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF Application N°: 2163372**

**by Didier Vuillemin and Roger Alfaro**

**to register a Trade Mark and**

### **IN THE MATTER OF Opposition N°: 49968**

**by IMCOA Licensing America Incorporated.**

1. On 6<sup>th</sup> April 1998 Didier Vuillemin and Roger Alfaro of La Longeville, F-25650 Montbenoit, and 16 rue de la Pernotte, 25000 Besancon, France, applied to register INDIAN MOTORCYCLE for the following goods:

- Class 3: 'Soaps; perfumes, colognes, toilet waters, essential oils, cosmetics, hair lotions, body lotions, preparations for the bath and shower, talcum powder; anti-perspirants and deodorants, all for personal use; toothpaste'.
- Class 6: 'Common metals and their alloys; ironmongery, key rings'.
- Class 8: 'Cutlery; side arms; razors'.
- Class 9: 'Helmet; fridge magnets; computer games'.
- Class 11: 'Ceiling light fixture; bedside lamps; table lamps; flashlights; pocket lights; bicycle lights; illuminated wall signs'.
- Class 14: 'Precious metals and their alloys; rings; bracelets and bracelets charms; earrings; necklaces; ornamental pins and jewellery pins; ornamental boot toe and heel tips made in precious metal or coated therewith; key chains in precious metal'.
- Class 16: 'Picture cards, printed matter, magazines; calendars; posters; books; collector cards; catalogues; instructional and teaching materials; but not including any goods relating to, or bearing representations of motorcycles produced in India; paper; cardboard articles and goods made from these materials, cardboard, diaries, stationery, adhesives for stationery greeting cards, playing cards, pens; pencils, paint brushes'.
- Class 20: 'Furniture; mirrors; picture frames; ornamental plates, wall plaques of metal, wall plaques of plastic, wall plaques of wood, wall plaques of glass, ornamental signs of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl; meerschaum and substitutes for all these materials or of plastics'.
- Class 21: 'Wine glasses, juice glasses, water glasses, beer mugs, coffee mugs, tea mugs, tea pots, coffee pots, pots for cooking, dinner plates, bread plates, bowls, cups, saucers, serving platters, serving dishes, ashtrays, ornamental plates'.

- Class 26: 'Embroidery; needles; pins (not in precious metal)'.
- Class 27: 'Doormats; mats; carpets; non-textile wall coverings; wallpaper'.
- Class 28: 'Games and playthings; miniature cars, trucks, motorcycles and all vehicles (as toys for children or collectibles); model cars, motorcycles, trucks and all vehicles'.
- Class 32: 'Beers; mineral and aerated waters and other non alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages'.
- Class 33: 'Alcoholic beverages (except beers).'
- Class 34: 'Tobacco; smokers articles, matches'.
- Class 42: 'Computer programming; reporter services; catering for the provision of food and drink; restaurant services; bar services; hotel services; hotel reservation services'.

2. The opponents are IMCOA Licensing America Incorporated and their grounds for objection are under ss. 5(2)(a) and (b), 5(3), 5(4)(a) and 3(6) of the Act.
3. A Counter Statement was provided by the applicants, in which the grounds of opposition are denied. Both parties ask for costs to be awarded in their favour.
4. The matter came to be heard on 26<sup>th</sup> October 2001, where the applicants were represented by Mr. Vuillemin, and the opponents by Mr. Hackney of Mewburn Ellis.

### Evidence

5. The applicants did not submit any evidence, prior to the hearing. However, in response to Mr. Hackney's submissions, Mr. Vuillemin spoke at length, giving what can only be described as evidence, not argument. There was much repetition, but essentially Mr. Vuillemin seemed to be saying that the original Indian Motorcycle Company ceased to exist in the USA in 1953, and that the revival of its name since then has had little to do with the original organisation, and more to do with a marketing opportunity, 'cashing in' on the kudos associated with the original manufacturer of the motorcycles, which were, better than 'Harley-Davidson' – who also started making motorcycles around the same time as the Indian Motorcycle Company. Mr. Vuillemin pointed out that the present owners of Harley-Davidson had taken advantage of the reputation possessed in that name by diversifying their marketing into a range of products, including clothing, and something similar was underway with the mark in suit. Mr. Vuillemin appeared to be saying that no one had any unequivocal right to the INDIAN MOTORCYCLE name, himself, or the opponents: it represented a commercial opportunity to be exploited.
6. Mr. Hackney was, in my view rightly, concerned about this very late production of evidence. He felt it should not be admitted unless he was able to respond in full, which would, of course, involve consultation with his clients, and delay to the proceedings.

7. I was not prepared to do that at this stage. I do not believe the summary I have given above, of Mr. Vuillemin's words, prejudices the opponents' case to any measurable degree. I have excluded other material – about various negotiations between the parties in this matter and others. Its inclusion would have, in the interests of fairness, have necessitated a response from the opponents and, as stated, I was not prepared to allow that at such a late date. If this material was of such importance to the applicants, it should have been included in the evidence rounds. Anyhow, I think that was not particularly relevant to the matter at hand. Which I consider can be judged on the material I have before me.
  8. This is because, I believe, that this matter turns on prior rights - by registration or otherwise - and that depends on the evidence the opponents have enclosed. Nothing Mr. Vuillemin said disturbed that. Trade mark rights are property rights and can be bought, sold and passed on in like manner to all property. The question here is not whether the 'original' manufacturers of motorcycles under the name have vanished into history leaving an 'open field', but whether the opponents are the proprietors of registrations, and the other property rights, which they are entitled to protect, however they came by them. This point is the basis of the claim in the first paragraph of the opponents' Statement of Grounds:

‘The Opponent is the true proprietor in the United Kingdom and elsewhere internationally of the trade mark INDIAN MOTORCYCLE and a trade mark consisting of the device of a head of an Indian chief in traditional headdress superimposed or not with the word “Indian” in script. Both trade marks are classic marques and have a history of use internationally reaching back through many decades beginning with design classic motorcycles which have enjoyed immense popularity since earlier this century. *Evidence will be adduced that the Opponent has acquired all legitimate rights to the trade marks from its predecessor in title*’. (Emphasis mine).
  9. In view of this, I believe, I need to establish from the opponents' evidence the measure of their rights under the name.
  10. The opponents are registered proprietors of, or applicants for, the marks in the ANNEXES. This is the extent of their registered rights - earlier marks by virtue of s. 6 - and will be relevant to the grounds under ss. 5(1), (2) and (3). The opponents also mention in their Statement of Grounds that they are also aware of mark N<sup>o</sup>. 1505713 INDIAN MOTORCYCLE, registered on 4<sup>th</sup> July 1992, for:

‘Bath linen; bed clothes, bed covers, bed linen; cotton fabrics; fabric, all for boots and shoes; fabric of imitation animal skin; flags; flannel; handkerchiefs; labels; lining fabric, all for boots and shoes; woollen cloth, woollen fabric; all included in Class 24.’
- However, this mark has expired, and I have not considered it further.
11. The opponents also claim rights in the name following use that has been made of the mark in the UK. This evidence appears in the Statutory Declaration give by Yoshiko Inoue, a trademark counsel based in the USA, working for the opponents. Mr. Inoue refers (Exhibit A) to ‘.. invoices that reflected evidence of use in the United Kingdom of the INDIAN mark by Indian Manufacturing Limited, a subsidiary of Indian Motorcycle Corp...’ which appears to be based in Toronto, Canada.
  12. I have examined this invoice evidence in detail, and note the following:

- Some 11 invoices are present (some are copies), all directed to one organisation called Clem De Sousa, based in London. They are:

Date	Amount	Goods
24/05/96	2013.0	Clothing (?)
21/08/96	1082.9	Clothing, belts?, buckles, headgear, lighters?
21/08/96	1558.5	Clothing
09/09/96	557.0	Clothing, gloves, jewellery
26/08/96	1102.0	Clothing
11/09/96	2900.0	Clothing, buckles, headgear
01/10/96	8368.9	Clothing, belts, jewellery, key-rings, buckles, cigarette cases, headgear
08/11/96	813.0	Clothing
08/11/96	62.0	Clothing (?)
10/12/96	2131.0	Clothing, jewellery (?)
09/01/97	1610.0	?

I am not told whether the above figures are British pounds or Canadian dollars. I assume the latter. Clothing forms by far and away the main items on the invoices and is very varied, including trousers, dresses, jeans, jackets, T-shirts etc.

- ! Also included are four faxes, two from Indian Motorcycle in Canada, two from the agents in the UK, variously asking for information on orders, about orders or actually ordering items. One (dated 10/12/96) refers to a shipment of lighters. I note that the London agent calls itself the 'Indian Motorcycle Clothing Co.' Two other invoices/faxes are undated.

- ! Throughout the invoices are headed with the following device



There is no indication of the trade marks they were sold under, such as might have been provided by examples of goods and labels that accompanied them etc. However, some of the buckles (see invoice dated 11/09/96) are called 'Indian Emblem Buckle'.

- ! There is little explanation of how these products were marketed, sold on or otherwise disposed of, apart from one invoice to REDISCOVERED ORIGINALS, Whitehouse Street, Hunslet, Leeds. This document carries the devices above, and the UK address to which the above products were sent from Canada. It is a far from perfect photocopy. I transpose it as:

Style	Description	Price	Quantity
CPA10A	CAP	7.5	130
CPA02A	CAP	7.5	130
LIGC08A	Lighter	9.75	42

13. There is further evidence from the opponents, from the Statutory Declaration of James J. Kelly, Jr., Vice President and Chief Financial Officer of Indian Motorcycle Corp. (the opponents are, apparently, a subsidiary). Mr Kelly provides a company history, and some background.
14. The Indian brand of motorcycle was originally manufactured in 1901 by the Hendee Manufacturing Company, based in Springfield, Massachusetts. Hendee were the first US manufacturer of motorcycles and was the primary supplier to the US Army of military motorcycles for use during World Wars I and II. Apparently the Indian Motorcycle was the most well-known and well-reputed US manufactured motorcycle until approximately just after World War II. Hendee stopped manufacturing motorcycles in 1953, but continued to manufacture apparel and motorcycle accessories until 1959 and eventually went out of business in 1961. Mr. Kelly understands that there are ‘..approximately 30,000-40,000 original Indian motorcycles presently in working condition throughout the world’.
15. He further explains that, from the early 1970s, several companies attempted to revive the INDIAN trademark. By the 1990s many of those companies, had fallen into bankruptcy and, with other businesses with interests in the name, were purchased by the opponents. Mr. Kelly says:

‘By this purchase, IMCOA essentially purchased all of the rights in the United States to the trademarks related to the manufacture and promotion of the Indian motorcycle. - In addition, IMCOA also acquired a wide range of international trademark applications and registrations..’
16. Since IMCOA’s purchase of these trademark rights, the Indian Motorcycle Corp., through license from IMCOA, has manufactured motorcycles bearing the INDIAN trademark for model years 1999 and 2000. Other trade mark rights have been purchased around the world.

### Decision

17. S. 5 (2) of the Act states:

‘A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

18. The opponents UK registrations (ANNEX A) relate to the s. 5(2)(a) ground, their CTM application (ANNEX B) to that under s. 5(2)(b).
19. There is quite a lot of goods to compare here, and I think it best to begin by excluding those goods for which the opponents have little chance of success, under s. 5(2). I include in this the items in Classes 3, 6, 8, 9, 11, 16, 20, 21, 26, 27 and 28. In my view, the goods listed are

simply too far apart for confusion to occur, despite the complete identity between the applicants' mark, and the opponents' UK registered mark.

20. In his skeleton argument, Mr. Hackney argued that the goods under Class 14 were similar to those specified with registration N<sup>o</sup>: 2023572, that is, 'Watches and parts and fittings therefor' with 'Precious metals and their alloys; rings; bracelets and bracelets charms; earrings; necklaces; ornamental pins and jewellery pins; ornamental boot toe and heel tips made in precious metal or coated therewith; key chains in precious metal'.
21. *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR counsels the following in reference to the Article in the Directive which inspired s. 5(2):

'It is ... important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar'.

22. As Mr Hobbs Q.C., sitting as the Appointed Person in *Raleigh International* (SRIS 0-253-00) stated:

'Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.'

23. The tests for similarity of goods is that given by Jacob J in *British Sugar plc v James Robertson & Sons Ltd.* [1996] 9 RPC 281. The latter have been confirmed in *Canon*:

'In assessing the similarity of the goods or services concerned... all the relevant factors relating to those goods or services themselves should be taken into account...includ[ing], *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary...'

To this list, Jacob J included the respective trade channels through which the services are supplied.

24. In my view watch 'parts' are more likely to relate to their inner workings, while 'fittings' will include watch straps.
25. I do not believe I can accept any degree of similarity between the opponents' goods in Class 14 and 'precious metals and their alloys'. Though watches can be made from such raw materials, their nature is different, as are their end users, method of use and trade channels.
26. '..Rings; bracelets and bracelets charms; earrings; necklaces; ornamental pins and jewellery pins..' might be collectively called 'jewellery'. As to their nature - that is their physical nature - this can be the same or similar to watches. Both jewellery and watches are constructed from metal of varying value. For example, a 'Rolex' might be fashioned from gold, costume jewellery from stainless steel. Obviously, the use of a watch is to tell the time, but they are also, like

jewellery, items of adornment, principally so in certain cases, the 'Rolex' (again) being a particular, if very expensive (but hardly exceptional) example.

27. Also of key significance here is that both products are very typically sold to the public through the same trade channels (jewelers). They are neither in competition nor complementary. In conclusion, there is some degree of similarity between watches and jewellery, though I would not regard it as self-evident. I discuss 'ornamental boot toe and heel tips made in precious metal or coated therewith and key chains in precious metal' below.
28. With these deliberations in mind, turning again to the case law, it is clear that a greater degree of similarity between the marks may be offset by a lesser degree of similarity between the goods (*Canon*, paragraph 17) and, further, there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either *per se* or because of the use that has been made of it (*Sabel BV v Puma AG* [1998] RPC 199, at paragraph 24). The latter raises the issue of the reputation of the mark in this country. I discuss the mark's reputation below; following that discussion, I do not believe the opponents cannot take advantage of enhanced distinctiveness by virtue of the use of their mark in the UK.
29. Having said that, INDIAN MOTORCYCLE is inherently distinctive for these goods. And the marks are identical. Will the average consumer - in this case an ordinary member of the public (see paragraph 31) - be confused? Such a creature is deemed to be reasonably well informed and reasonably circumspect and observant, that is, neither too clever, nor too careless (*Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77, paragraph 27). Taking a global appreciation of the matter (*Sabel* page 224), I think confusion is probable for the jewellery goods as defined above. In my view a member of the public coming upon INDIAN MOTORCYCLE jewellery in a jewellers, and also seeing watches for sale under the same mark, would be confused into believing they came from the same source. I think the same would be the case for 'key chains in precious metal', for which it is reasonable to assume, may also be on sale in such establishments.
30. I do not believe I can come to the same conclusion for precious metals and their alloys, and for 'ornamental boot toe and heel tips made in precious metal or coated therewith'. The former are simply too different, and, as for the latter, I cannot conclude that they have the necessary similarity, without further evidence.
31. I might have come to a different conclusion if, here, the nature of the 'average consumer' had been more clearly defined for me. *Sabel* qualifies the latter as consumers of the goods in question. It occurs to me that the possibility of confusion might be enhanced if the goods at issue were targeted as a 'sub-class' of consumer such as those interested in motor-biking. 'Channels of trade' and 'users of the goods' are 'an essential part of the comparison called for by s. 5(2)(b)' (*South Cone Incorporated v Jack Bessant and Others*, unpublished, High Court, Chancery Division, 16<sup>th</sup> May 2001). However, such material was lacking. And it is not up to me to make up such a deficiency (see the Decision of the Appointed Person in *Reemtsma's Application*, SIRIS O/334/00).
32. Turning, now, to s. 5(2)(b) and the opponents' CTM application (ANNEX B), Mr. Hackney, in his skeleton argument, said the marks were 'similar', and referred, in particular, to 'identical' goods in Classes 32, 33, 34 and 42. With the exception of the last, for which some clarification is required (see next paragraph) I agree that these goods are identical. I will concentrate them as, if the opponents cannot win here, they are unlikely to do so in relation to the applicants' other products.

33. The parties specify the following in Class 42:

Applicants

‘Computer programming; reporter services; catering for the provision of food and drink; restaurant services; bar services; hotel services; hotel reservation services’.

Opponents

‘Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming’.

At the hearing, Mr. Vuillemin explained that ‘reporter services’ were ‘journalistic services’. I do not regard these as identical to anything within the opponents’ specification. ‘Temporary accommodation’ may be viewed as equivalent to ‘hotel services’, and ‘Providing of food and drink’ as encompassing restaurant and bar services, and may also include ‘hotel reservation services’. The latter are typically provided by large hotel chains.

34. Again, before a comparison of the marks, a reference to the case law is needful. The importance of the average consumer is, again, emphasised in *Sabel*, when a comparison of marks is made:

‘That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive ‘...there exists a likelihood of confusion on the part of the public...’ shows *that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion*. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details’. (Emphasis mine).

*Lloyd* (page 84, paragraph 27) adds that the average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind. With this in mind, for ease of reference only, I note that the applicants’ mark is INDIAN MOTORCYCLE, and the opponents’ is:



35. Again, I must refer to my discussion of the reputation the opponents possess in their marks (see below) and note, again, that they do not enjoy an enhanced reputation due to the use they have made of this mark in the UK. I have thus only a *prima facie* comparison to consider.

36. The opponents’ mark - word and device taken together - can only bring to mind the idea of an American Indian. The applicants mark, on the other hand, to my first impression, suggested a motorcycle from India. Perhaps I am peculiar in this respect, but even if INDIAN in both marks is taken to have the same meaning, I still believe their conceptual impression is quite different. One suggests a race of people, the other, a thing.



37. Aurally one might refer to the opponents' mark as 'the Indian device' or the 'Indian mark'. The other will only and always be the INDIAN MOTORCYCLE mark. This is rather different.
38. And visually I also see them somewhat dissimilar. One is a picture, the other words. I must therefore come to the conclusion that, despite the identity of the goods cited by Mr. Hackney, there is no likelihood of confusion between the marks.
39. The opponents opposition to registration under s. 5(2) thus fails, excepting the items in Class 14 discussed above.
40. This seems to be a good point at which to discuss the evidence relating to the reputation of the marks, before turning to the grounds under s. 5(3) and 5(4). At the hearing, Mr. Hackney stated:
- '.. Indian is a well known brand of motorcycle. I am sure the applicants would not disagree with that despite having no sales until recently for a very long time. I think it is beyond doubt that it is still a very well known classic motorcycle'.
41. I am not sure this follows from the evidence. There is nothing demonstrating the notoriety of the mark in the UK and I do not find the material submitted (paragraph 11ff) convincing of a trade under the mark INDIAN MOTORCYCLE, or for the Indian device, for any of the products cited. The most significant trade is in clothing, but there is some other minimal trade. However, there is nothing showing how the mark was used in this jurisdiction. The Declaration by Yoshiko Inoue submitting Exhibit A (the invoices) says that these documents reflect use of the INDIAN mark. This is unclear – is the mark in suit being discussed, or the mark for which the opponents have applied for a CTM in ANNEX B – the Indian device? Were either used on the products sold? At the hearing, Mr. Hackney said that the mark was over a 100 years old, and some 40, 000 motorbikes made by the original manufacturer were still in existence. He was not able to tell me how many of these were in the UK, if any.
42. Of course the trader to whom the items in the Exhibit A were sold - Clem De Sousa – would be aware of the product – this organisation appears to have traded to at least one customer under the name 'Indian Motorcycle Clothing Co.', however, I do not believe that this is, by itself, enough to raise the reputation of the name in the UK above that of *de minimis*, either amongst other traders, or the public.
43. At the hearing, Mr. Hackney produced some books, which he purchased that very day from a UK bookshop, about Indian Motorcycles. He said:
- 'Since you are considering the addition of further evidence, we have all merrily referred to these books lying here. Can I ask you to consider just accepting that books on these bikes are readily available in this country?'
44. Mr. Vuillemin did not object. Of course, without information on sales, this tells me little about the extent of knowledge of the name in the UK. Mr. Vuillemin confirmed the notoriety of the marque, but did not admit that that fame extended to the UK.
45. This conclusion is fatal to the opponents' case under s. 5(3). This states:

‘3) A trade mark which

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’.

46. In *Daimler Chrysler AG v ALAVI* [2001] ETMR 1069 All ER (D) 189 Pumfrey J said that the enquiry (under s. 10(3), which is equivalent to s. 5(3)) is as follows:

‘(1) Does the proprietor’s mark have a reputation? If so,

(2) Is the defendant’s sign sufficiently similar to it that the public are either deceived into the belief that the goods are associated with the proprietor so that use of the sign takes unfair advantage of the mark, or alternatively causes detriment in their minds to either:

a) the repute;

b) the distinctive character of the mark, or

3) Even if they are not confused, does the sign nonetheless have this effect and

4) Is the use complained of nonetheless with due cause?’.

*General Motors Corporation v Yplon SA* [2000] RPC 572 defines reputation:

‘In order to enjoy protection extending to non-similar products or services, a registered trademark must be known by a significant part of the public concerned by the products or services which it covers’.

47. The next ground is passing off, under s. 5(4)(a). This states:

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

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

48. The accepted reference at this point is the decision of Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] 14 RPC 455 in which he gave a summary of the law of passing off. Essentially, the opponents need to show that at the relevant date (6<sup>th</sup> April 1998): (i) they had acquired goodwill under their mark, (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods/services; and (iii) that such confusion is likely to cause real damage to their goodwill.

49. At the risk of repetition, the evidence submitted by the opponents does not allow to assess the nature of the goodwill under the mark, or conclude that it is of sufficient extent. This, again,

is fatal to the opponents' case, and this ground must also fail. Even if I were to assume that the trade recorded by the invoices in Exhibit A was all under the sign in the third bullet point of paragraph 11 under – a hybrid of the opponents' marks in the ANNEXES – I think I could only conclude that this amounted to some very small reputation in clothing, and little else, and not enough to engender a protectable goodwill.

50. What of the remaining grounds? S. 3(6) places a significant onus on the opponents to prove their case. Mr. Hackney cited the following factors:

- Earlier registrations for the identical mark.
- The fact that the term INDIAN MOTORCYCLE itself is unusual and distinctive for a wide range of goods and that no evidence has been filed as to why Applicant devised/adopted this particular mark.
- The term INDIAN MOTORCYCLE forms part of the acronym of the Opponents' company name, and part of the company names, e.g. the Opponents' parent company, Indian Motorcycle Corp.
- Evidence of overseas registrations in Opponents' name.

This is not, in my view, enough to support a submission amounting to bad faith. The nature of this ground is such that simply raising a presumption of bad faith is not enough to shift the burden of proof onto the applicants; it must be supported by positive evidence and argument. I do not think I can infer bad faith from the points raised by Mr. Hackney.

51. I might have been able to approach this ground differently if the opponents had shown that the mark possess some reputation or right in the UK, on which the applicants had deliberately and consciously trespassed. There is not enough here to suggest that. The lack of explanation in evidence of why the applicants choose the mark, of course, is unhelpful – Mr. Vuillemin provided an explanation of sorts (see paragraph 7) – but even without this I do not think that silence from an applicant, against whom bad faith has been alleged, as to why a mark was picked, is enough to find bad faith, without other evidence (see my *Ivana* Decision SIRIS O/393/00, pages 9 and 10). This ground fails.

52. Finally, the ground under s. 56 was dropped at the hearing, as it placed the opponents in no better position than under the grounds already cited.

53. The applicants have been mostly successful. However, for their application to proceed, they must amend their specification of goods in Class 14, removing: rings; bracelets and bracelets charms; earrings; necklaces; ornamental pins and jewellery pins; key chains in precious metal. If the applicants do not file a TM21 within one month of the end of the appeal period for this decision restricting the specification as set out above the application will be refused in its entirety.

54. As to costs, the applicants have been mostly successful, and I order the opponents to pay them £400. This sum is to be paid within seven days the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 20<sup>th</sup> Day of November 2001.**

**Dr W J Trott  
Principal Hearing Officer  
For the Registrar, the Comptroller General**


ANNEX A

UK Registrations

Mark	Number	Filing date	Goods
INDIAN MOTORCYCLE	1505711	04.07.1992 (Registered)	'Eye glasses, eyeglass cases, eyeglass chains, eyeglass cords, eyeglass frames; parts and fittings for all the aforesaid goods; all included in Class 9'.
	1505712	04.07.1992 (Registered)	'Attaché cases, bags for campers, bags for climbers, bandoleers, beach bags, brief cases, canes, cane handles, cases of leather or leather board, chain mesh purses, handbags, linings of leather, all for boots and shoes; parasols, pocket wallets, purses, saddlery, school bags, school satchels, shopping bags, travelling bags, travelling trunks, trunks, umbrellas, valises, vanity cases, wallets; all included in Class 18'.
	1505714	04.07.1992	'Bath sandals, bath slippers, beach clothing, beach shoes, esparto shoes, esparto sandals; coats; football boots, football shoes, gymnastic shoes; hats; pullovers, sandals, shawls; shirts; jeans; shorts; T-shirts, vests, cardigans, sweaters, waistcoats; skirts; slippers; stockings; underwear, wooden shoes; all included in Class 25.=
	2023572	10.06.1995	Class 14: 'Watches and parts and fittings therefor'.

ANNEX B

Community Trade Mark:

Mark	Number	Filing date	Goods
	287904	11.07.1996 (Application)	<p>Class 4: 'Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candies, wicks'.</p> <p>Class 12: 'Vehicles; apparatus for locomotion by land, air or water'.</p> <p>Class 32: 'Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages'.</p> <p>Class 33: 'Alcoholic beverages (except beers)'.</p> <p>Class 34: 'Tobacco; smokers' articles; matches'.</p> <p>Class 42: 'Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming'.</p>