

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2170497
BY D JACOBSON & SONS LIMITED TO REGISTER
THE MARK ROY OF THE ROVERS IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50425
BY EGMONT FONDEN**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2170497
by D Jacobson & Sons Limited to register
the mark Roy Of The Rovers in Class 25**

and

**IN THE MATTER OF Opposition thereto under No 50425
by Egmont Fonden**

DECISION

1. On 25 June 1998 D Jacobson & Sons Limited applied to register the mark ROY OF THE ROVERS in respect of 'footwear' in Class 25. The application is numbered 2170497.
2. On 23 November 1999 Egmont Fonden filed notice of opposition to this application. They refer to their proprietorship of registration No. 1420776 for ROY OF THE ROVERS in Classes 9 and 16 and use of the mark on a range of goods. Objection is said to arise under Sections 3(6), 5(2)(b), 5(3) and 5(4)(a). The wording of the objection in each case largely reproduces the wording of the Act without further elaboration. There is also a reference to Section 40(1) of the Act but this Section does not have a bearing on opposition proceedings.
3. The applicants filed a counterstatement denying the above grounds.
4. Both sides ask for an award of costs in their favour.
5. Both sides filed evidence as follows

Opponents' Evidence

Statutory Declaration by Michael Main with exhibits MM1 - MM6

Applicants' Evidence

Statutory Declaration by Harvey Jacobson with exhibits HJ1 - HJ7

Opponents' Evidence in reply

Witness Statement by Rob McMenemy with exhibits RM1 - RM6

6. Neither side has asked to be heard but written submissions have been received from Wilson Gunn M'Caw on behalf of the applicants and Dechert on behalf of the opponents. Acting on behalf of the Registrar and with all the above material in mind I give this decision.

Background

7. ROY OF THE ROVERS is the name of a comic strip story which first appeared in 'Tiger - The Sport and Picture Story Weekly' in September 1954. The title ROY OF THE ROVERS derives from the name of the hero of the stories, Roy Race, and the team he played for, Melchester Rovers. The comic strip continued through to 1976 when a ROY OF THE ROVERS comic was launched. The comic itself closed in March 1993. I will come to the opponents' evidence as to use of the name since 1993 and their claims as to its wider exploitation in due course.

8. The opponents have raised a number of grounds of opposition. Their statement of grounds referred to one registration only, No. 1420776. This was for the mark ROY OF THE ROVERS and covered a range of goods in Classes 9 and 16. By a decision dated 30 April 2001 that registration was revoked in its entirety. Although the removal of that registration occurred after the filing date of the application now under attack I take the view that No. 1420776 ceases to have effect as an earlier trade mark (TRANSPAY Trade Mark [2001] RPC 191). Consistent with that approach I accept the view contained in the applicants' written submissions that the grounds based on the existence of an earlier trade mark, that is to say Sections 5(2)(b) and Section 5(3) can no longer be sustained. The remaining grounds are those based on Sections 5(4)(a) and 3(6). The opponents' written submissions make reference to the application not fulfilling the requirements of Section 1(1) of the Act. I do not understand the basis for such an objection and in any case it was never pleaded.

9. I propose to deal with the Section 5(4)(a) ground first. The relevant part of the statute reads

"5.-(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 an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

10. The conventional test for determining whether an opponent has succeeded under this Section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

- (2) that there is a misrepresentation by the applicants (whether or nor intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

11. Although the opponents failed to save their registration No. 1420776 in the face of the non-use attack by the current applicants that is not necessarily fatal to their cause. Pennycuik V.C. said in *Ad-Lib Club Ltd v Granville*, [1972] RPC 673 that "where a trader ceases to carry on his business he may none the less retain for at any rate some period of time the goodwill attached to that business". Residual goodwill may thus exist or be capable of being revived. Despite their failure in the revocation action the opponents have filed evidence to show continuing use. Before coming to the detail of this evidence I should say that it concentrates largely on the period from the early 1990s and is silent as to past usage. Thus I have been given no information to indicate the nature and size of the trade in the ROY OF THE ROVERS comic or other material which might have helped to establish the extent of the past reputation. Nevertheless I am prepared to accept for present purposes that generations of people from the mid 1950s onwards have been familiar with the character. It may be (I simply cannot tell from the evidence) that ROY OF THE ROVERS was at the height of its fame decades ago but knowledge of the character lingers on. Mr Jacobson, who has given evidence for the applicants, confirms for instance, that he was aware of the cartoon strip in the 1980s. Various internet references in his Exhibit HJ7 confirm that the name of the character still has some currency in the language ("Roy of the Rovers style story" "a Roy of the Rovers figure" etc).

12. The opponents' evidence as to more recent activity under the ROY OF THE ROVERS name comes in Mr Main's statutory declaration and Mr McMenemy's witness statement. Both are directors of Egmont Magazines Ltd (formerly Egmont Fleetway), a subsidiary of Egmont Holdings Ltd and ultimately owned by Egmont Fonden. The Egmont companies appear to be the owners of the copyright in the ROY OF THE ROVERS comic strip. Egmont Fonden was also previously the proprietor of the now revoked No. 1420776.

13. Mr Main says that the trade mark ROY OF THE ROVERS has been used in relation to a variety of products through the following licensing arrangements.

Licensee	Contract Term	Articles
Gremlin Graphics	01.10.88 - 30.09.91	Computer Games
Leisure Company	01.07.91 - 30.06.92	Football Shirts
Lennard Associates	01.07.94 - 30.06.99	Official Autobiography
Palcom Ltd	01.04.92 - 30.06.93	Board Game
Ravette Publishing	01.01.93 - 31.12.94	Comic Strip Books

Sam Tam Publishing	01.01.92 - 31.03.93	Football Kits, Shirts, Socks, Gloves
Scottish TV	01.12.92	Use of Material for TV Programme
Egmont World	01.01.93 - 31.12.93	Hardback/Paperback Story Books

14. In support of this he exhibits at MM1 copies of the covers and introductory pages of the autobiography published by Queen Anne Press (a division of Lennard Associates referred to above) and at MM2 a copy of the comic strip book published by Ravette Publishing.

15. Reference is also made to the following

- a magazine entitled 'Roy of the Rovers - The Playing Years' published by Queen Anne Press in 1994 (MM3)
- a syndication deal with Future Publishing in 1997 whereby the character was used on Playstation magazine (MM3)
- a two page picture strip in each month's edition of the BBC's 'Match of the Day' magazine (MM3). Mr McMenemy's evidence subsequently provides further copies of extracts from the magazine from 1997 to 2001 (the material date is 25 June 1998). He places the agreement with the BBC in March 1997 but the copy document filed is undated and only signed by one side
- the shirt worn by the character in the 'Match of the Day' magazine has also been sponsored by McDonalds

16. The remaining material is after the material date. I find it extremely difficult to draw any meaningful conclusions from the material outlined above.

17. In *South Cone Incorporated v Jack Bessant and others*, HC 2000 App 00617, Mr Justice Pumfrey said

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

18. Although the above material makes a number of claims as to what was produced it provides no substantiating detail in terms of numbers of the various publications that have been sold, the method/outlets through which they have been sold, the value of the trade or any other indicators to establish that the goods had any presence in the marketplace. Most of the published works appear to be in the nature of one-off publications. The main exception is the comic strip insert in the Match of the Day magazine which appears to have started in 1997. However I cannot reliably date the extracted pages save for a copyright date at the foot of the page. What impact this would have made given that the comic strip is but one item in the magazine is uncertain.

19. The evidence as to any sort of trade in goods other than publications featuring the comic strip character is in my view little more than bare assertion. Most of the licences referred to above were of relatively short duration and ceased some time ago. No licence agreements are exhibited. Even accepting that licences were granted there is no evidence that any goods were produced and sold and no indication of licensing income or royalties received.

20. In short I consider that the opponents' use since the early 1990s has been sporadic and is unquantified in terms of size and uncertain in terms of impact on the marketplace. That is not to say, there is no residual awareness of the character ROY OF THE ROVERS. But it is unlikely that the use shown would have done more than kept alive any existing awareness of the comic strip character.

21. The opponents thus face severe evidential difficulties in establishing their position under Section 5(4)(a). They also face a difficulty in terms of the law. The English Courts have been slow to accept that a protectable goodwill can exist in fictional characters - see *Tavener Rutledge Ltd v Trexapalm Ltd* [1975] FSR 479 (*Kojak*), *Lyngstad v Annabas Products Ltd* [1977] FSR 62 (*Abba*) and *Wombles Ltd v Womble Skips Limited* [1977] RPC 99 (*Wombles*). The view that emerged from these cases was that the use of the names of well known fictional characters on goods did not suggest to consumers that the manufactures or suppliers of those goods had a trade connection with the deviser of the character.

22. The Australian Courts have taken a somewhat different view of the matter - see *Children's Television Workshop Inc. v Woolworths (New South Wales) Ltd* [1981] RPC 187 (*Muppets*) and *Fido Dido Inc v Venture Stores (Retailers) Proprietary Ltd*, 16 I.P.R. 365 (*Fido Dido*). Both the Australian cases and the three UK cases were considered by *Browne-Wilkinson V.C.* in *Mirage Studios v Counter-Feat Clothing Ltd* [1991] FSR 145 (*Ninja Turtles*) in ordering interlocutory relief against the defendants who had made drawings of humanoid turtle characters similar in appearance to those of the plaintiffs. The *Ninja Turtles* case might be thought to represent a shift in the view of the English Courts which would be helpful to the opponents. However the *Ninja Turtles* case turned on its own facts including the fact that the

plaintiffs were in the business of licensing the copyright in the drawings of the cartoon turtle characters and the fact that at the time of the application over 150 licences had been granted.

23. The Vice-Chancellor distinguished the Ninja Turtle case from the preceding cases both in terms of the evidence as to public perception of licensing arrangements and the specific circumstances before him. His view of the Wombles case, in so far as it is relevant to the issues before me (the name point) was

"As to the other ground (namely that there was only the use of the name) the decision may still be good law. There is no copyright in a name. If Wombles be a name, as the judge thought it was, then it is hard to see what business the plaintiffs could have been carrying on in licensing the copyright in the name and the name alone. Here, on the contrary, the plaintiffs are carrying on the business of licensing the copyright in the drawings of the Ninja Turtles in which copyright does exist."

24. The issue before me does not turn on use of copyrighted drawings. It remains the position that there is no copyright in a name. There is, of course, no reason why, in principle, the name ROY OF THE ROVERS should not attract goodwill in its own right in addition to copyright in the comic strip (the latter is acknowledged in the books and Match of the Day magazine material). Whether it does so is a question of fact. On the evidence before me the opponents struggle to make out a case even in relation to printed matter (the comic strip material etc) and have certainly failed to substantiate that any claim to goodwill extends beyond this to other goods areas whether by means of licensing or otherwise. On that basis the opposition seems to me to be bound to fail under Section 5(4)(a).

25. Section 3(6) reads

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

26. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 Lindsay J said (page 379):

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context: how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

27. More recently there are also the following comments of Mr Simon Thorley QC, acting as the Appointed Person in *Eicher Ltd Royal Enfield Motor Units v Matthew Scott Holder* (BL 0-363-01)

"An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning MR in Associated Leisure v Associated Newspapers (1970) 2QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see Davy v Garrett (1878) 7 Ch D 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under Section 3(6). It should not be made unless it is distinctly proved and this will rarely be possible by a process of inference. Further I do not believe that it is right that an attack based upon Section 3(6) should be relied on as an adjunct to a case raised under another section of the Act. If bad faith is being alleged, it should be alleged up front as a primary argument or not at all."

28. The Section 3(6) ground has been pleaded in the following terms

"Fleetway [Egmont Fonden] submits that registration of the trade mark the subject of application would be contrary to the provisions of section 3(6) of the Trade Marks Act ("The ACT"), that the application is made in bad faith in view of the use made by Fleetway of the registration and of the reputation generated thereby."

29. That seems to me to amount to an attempt to run the Section 5(4)(a) objection under another guise (an adjunct to a case raised under another Section as Mr Thorley put it) rather than identifying any genuine cause of action based on bad faith. In the light of my findings and decision on Section 5(4)(a) it is in any case unlikely to succeed.

30. I should, however, touch on an aspect of the objection that arises not from the opponents' pleaded case but from the applicants' response. Briefly, Mr Jacobson, in his evidence, indicates that he was aware of the comic strip entitled ROY OF THE ROVERS. More particularly, in 1996 his company acquired the rights to the trade mark GOLA, which is used in relation to a range of sports footwear including football boots. It seems that the ROY OF THE ROVERS character Roy Race was at one time depicted in the comic strip wearing a GOLA shirt in order to simulate a sponsorship deal as Mr Jacobson puts it. The use of GOLA is said to have been with the express authority of the then owners of the GOLA trade mark. Mr Jacobson goes on to say that

"Given the interest of my company in sports footwear and football boots under the GOLA brand, and given the previous historical link between the comic strip character Roy Race, and GOLA, it was a logical step to consider using the term ROY OF THE ROVERS on GOLA branded sports footwear, and in particular football boots. A search of the trademarks register did not disclose any conflicting applications or registrations for the trade mark for footwear, and trade enquiries did not disclose use of the term on footwear by any third parties."

31. Mr Jacobson's explanation is fully and openly expressed and I have little doubt that it represents his honestly held view of the matter. That in itself might not be enough if I considered the application was otherwise open to objection under Section 3(6). Mr Geoffrey Hobbs QC has made it clear in Demon Ale Trade Mark [2000] RPC 345 that a finding of bad faith may be fully justified even in a case where an applicant sees nothing wrong in his own

behaviour. The test is thus primarily an objective one having regard to "the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined."

32. However I do not think Mr Jacobson's explanation of the background is relevant to the Section 3(6) case. The fact that the GOLA brand, which featured on Roy Race's shirt, was acquired by the applicants could not in itself have brought with it trade mark rights in relation to the mark or sign ROY OF THE ROVERS. The true position is that the opponents have failed to substantiate their claim to an earlier right of their own or certainly not one which would extend to footwear. Further they have not pointed to any circumstances that suggest they are entitled to succeed under Section 3(6) when they have failed in relation to Section 5(4)(a).

33. The opposition therefore fails. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £535. This sum is to be paid within seven days of 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 21ST day of March 2002

**M REYNOLDS
For the Registrar
the Comptroller-General**