

TRADE MARKS ACT 1994

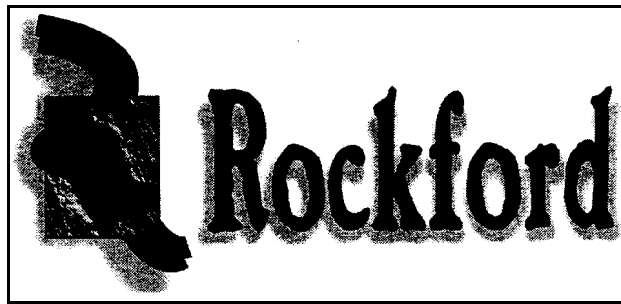
**IN THE MATTER OF APPLICATION No 12426
BY ROCKPORT (EUROPE) B.V. FOR A DECLARATION
OF INVALIDITY IN RESPECT OF REGISTRATION No 2172923
STANDING IN THE NAME OF TERENCE BALL**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 12426
by Rockport (Europe) B.V. for a declaration
of Invalidity in respect of registration No 2172923
standing in the name of Terence Ball**

DECISION

1. The following mark is registered under No. 2172923 in respect of “footwear, clothing, headgear”:



2. It has a filing date of 23 July 1998.

3. By application dated 21 March 2001 Rockport (Europe) B.V. applied for this registration to be declared invalid. They are the proprietors of the various UK and CTM registrations, brief details of which appear in the Annex to this decision. It will suffice to say at this point that one of those registrations (No. 1472734) is for the word ROCKPORT and is for goods identical to those of registration No. 2172923. On this basis objection is raised under Section 47(2)(a) and Section 5(2)(b).

4. The applicants also say that they have used the trade mark ROCKPORT in the UK since as early as 1992 in respect of footwear and footwear accessories (e.g. shoe care products) and since 1996 in respect of apparel. On the basis of the common law rights arising from this use objection is said to arise under Section 47(2)(b) and Section 5(4)(a). Finally the applicants say:

“In particular, Mr Ball has filed also for the registration of the trade mark ROCKFORT (which, of course, is a little closer to ROCKPORT than is ROCKFORD); Mr Ball is selling goods bearing the ROCKFORD trade mark through his own retail outlets in such a way that the same are adjacent to ROCKPORT goods; Rockport believes that Mr Ball is using sub-brands that are the same or similar to those used in connection with products that bear the ROCKPORT mark; and the style of goods being sold by Mr Ball under the ROCKFORD mark is very similar to the style of goods sold by Rockport under the ROCKPORT mark.”

5. On this basis objection is taken under Section 47(1) and Section 3(6).
6. The registered proprietor filed a counterstatement acknowledging the existence of the applicants’ registrations but suggesting that the respective marks are not confusingly similar. The ground under Section 47(2)(a)/5(2)(b) is, therefore denied. The applicants are also put to proof as to their claims under Section 47(2)(b)/5(4)(a). This ground is also denied.
7. Furthermore the proprietor does not admit the allegations under Section 47(1)/3(6) and indicates that:

“Evidence will be given by or on behalf of the Registered Proprietor concerning the display of goods in his own retail outlets as well as in other retail outlets and concerning the style of goods sold under the ROCKFORD & Device mark as compared to those sold under the ROCKPORT mark and in the footwear industry at large. Also, evidence will be given concerning the packaging and general get up of the Registered Proprietor’s goods as compared to those bearing the ROCKPORT mark and other footwear generally.”

8. The registered proprietor also claims to have used the trade mark ROCKFORD and device in respect of footwear since at least 1993 without confusion arising with the applicants’ mark. Finally reference is made to a number of other trade marks in the footwear industry commencing with the word or prefix ROCK.
9. Both sides ask for an award of costs in their favour.
10. Both sides filed evidence.
11. The matter came to be heard along with another action between the parties on 10 September 2002 when the registered proprietor was represented by Mrs M Arnott of Mathys & Squire and the applicants by Mr M Edenborough of Counsel instructed by RGC Jenkins & Co.

Applicants’ evidence

12. The following evidence has been filed on behalf of the applicants:

Witness Statement by Ian Wilkes and exhibits A, B & C
Witness Statement by Jane Telford and exhibit A

Witness Statement by Roy Lane and exhibit A
Witness Statement by John Banse and exhibit A

13. Mr Wilkes is a trade mark attorney in the firm of RGC Jenkins & Co and represents the applicants in these proceedings. He exhibits:

- A - a listing of the various ROCKPORT registrations;
- B - the results of a search into other ROC - or ROK - prefixed marks;
- C - a copy of a witness statement prepared in connection with opposition No. 51495 to application No. 2228668. The latter was an application by Mr T Ball for the mark ROCKFORT (and device). This application was also the subject of observations under Section 38 of the Act which were acted upon by the Trade Marks Examiner at the Registry. I gather that the application now stands withdrawn.

14. Jane Telford is Operations Manager of The Rockport Company (UK). She exhibits a copy of her witness statement prepared in connection with the aforementioned opposition to application No. 2228668. In this earlier evidence Ms Telford indicates that ROCKPORT has been used in the UK since 1992 in relation to footwear and from 1995 in relation to apparel.

15. A retail catalogue (for Spring-Summer 1999) is exhibited at JT1. The mark is said to feature prominently on the goods as well as appearing on point of sale materials (JT2). UK sales have been as follows:

Year	Net Value (£)
1995	5,512,742
1996	9,227,000
1997	16,269,000
1998	22,174,000
1999	22,067,000

16. The goods are promoted by means of:

- advertisements in fashion and lifestyle magazines;
- strategically placed hoardings in major towns and cities;
- television advertisements;
- cinema advertisements.

17. Examples of the above are exhibited at JT3 to 5.

18. Ms Telford goes on to elaborate on her company's promotional and advertising activities. Magazine advertisements have appeared in Esquire, Focus, GC, Mens Health, New Scientist, FHM and various sports based publications. Advertisements have also appeared in national and local newspapers. The ROCKPORT mark has appeared on hoardings, bus stops, bus sides, tubes, tube stations and such like in Edinburgh, Manchester, Glasgow, Doncaster, Liverpool, Blackpool and London. Television advertising has taken place on Discovery, Granada Plus, History, National Geographic, Paramount, Sky One, Sky Cinema, Sky News, Sky Premier, Sky Sports, Sky Sports 2, Sky Sports 3, TNT, UK Gold, UK Horizons, VH-1, Boomerang, MTV, MTV Base, MTV Extra, Total Cartoon Network, Total Fox Kids, Total Nickelodeon and Trouble. Cinema advertisements have appeared in locations throughout the UK. Total advertising spend for 1999 is said to have been £2.4 million but it is not clear whether this relates to a calendar year, financial year or other period (the material date is 23 July 1998).

19. Mr Lane is an investigator with Carratu International. He too exhibits a copy of a witness statement submitted in connection with the intended opposition to the now abandoned application No. 2228668. Mr Lane's enquiries on that occasion were primarily directed towards use of the mark ROCKFORT (the subject of No. 2228668). As that mark is not in issue in the present proceedings I do not propose to record the results of Mr Lane's investigations in this respect. His enquiries did, however, reveal use of the mark ROCKFORD. He summarises his findings as follows in his report dated 25 April 2001:

- “4.2 I did, however, find extensive use of the trade mark ROCKFORD;
- 4.3 Shoes bearing the trade mark ROCKFORD were displayed alongside shoes bearing the ROCKPORT trade mark;
- 4.4 The style of the ROCKFORD shoes was similar to that of shoes bearing the ROCKPORT mark;
- 4.5 In the retail outlet named “Ball” that I visited subsequent to my visit to the warehouse premises, a member of staff made particular reference to the fact that the ROCKFORD moccasins that were on sale were “just like” ROCKPORT shoes, she said that the only difference was that the ROCKFORD shoes did not have a yellow bubble on the back.”

20. In a separate witness statement dated 30 April 2001 (again in connection with No. 2228668) Mr Ball refers to an earlier report only the cover page of which is exhibited. In particular he records the outcome of contact with one of the companies with which Mr Ball is associated during which a Mrs McDonald refers to ROCKFORT shoes previously sold in the shop in question as being a ‘direct copy’ of shoes sold under the brand ROCKPORT.

21. The final witness statement is from Mr John Banse, Corporate Counsel of The Rockport Company LLC. He too exhibits a witness statement prepared in connection with the opposition to No. 2228668. He says that the Rockport organisation has, for several years, used the names of various states of the United States in catalogues and advertisements providing the ROCKPORT brand products and on labels and packaging materials for those

products. He exhibits a 1999 catalogue illustrating such usage. He notes that Mr Lane's report refers to the registered proprietors' ROCKFORD brand goods also being identified by the names of US States. He expresses the view that use of such designations exacerbates the likelihood of confusion.

Registered proprietor's evidence

22. The following evidence has been filed:

Witness Statement by Terence Ball and exhibits TB1-3
Witness Statement by Richard Burkhardt and exhibit RB1
Witness Statement by Geoffrey Robert Ainsworth and exhibit GRA1
Witness Statement by Barry Rushden and exhibits BR1
Witness Statement by Darren Paul Turner and exhibits DPT1-3
Witness Statement by Margaret Jane Arnott and exhibits MJA1-2

23. Mr Ball is the registered proprietor of the mark at issue. He says he has been in the business of the retail of footwear in the UK for over 30 years. His business is operated via various limited companies which are permitted to use his marks and which are controlled by him. In view of the nature of the objections in this case and the claims made by the applicants, it will be convenient to record Mr Ball's description of his business in his own words:

“By way of background, my companies specialise in the buying of surplus branded and unbranded footwear from suppliers all over the world, and then selling them to the public at discounted prices. I use the pronouns “we/us” to refer to my group of companies generally. We buy the surplus stock from different sources, for example mail order companies, and act in accordance with the requirements of our supplier in each instance. Mostly, the surplus footwear we buy is “end of line” or unsold that season which has to be cleared to make way for our supplier’s new stock. Sometimes, we are allowed to sell the shoes with the labelling intact, so that customers will know the source of those shoes. Sometimes we are required to debrand the shoes by removing the labels. Sometimes the shoes are totally unbranded when we receive them. As goods sell better if they have a name or brand, we give the unbranded or debranded shoes a name of our own. If the shoes have to be debranded we remove the existing labels and replace them with our own labels. In general when we debrand/rebrand, we put a sticky label bearing a brand name on the sock. If there is remedial work to do, we sometimes insert a new sock (again bearing a brand name). This surplus footwear is sold in a chain of shops operated by my company Ball Shoes Limited under the trading names Ball Shoes, Shoe Sellers and Shoe Carnival. These shops are in the north of England.”

24. After giving details of the location of his various existing and past retail outlets Mr Ball continues:

“3. Footwear retail has proved to be an increasingly difficult area to operate in as many more organisations have begun to venture into what was once a niche

market. Many high street stores and shopping chains, such as Marks & Spencer, Tesco and Asda have encroached into the footwear market. For this reason, I decided to move into the wholesale market approximately six years ago. This side of the business was originally handled by Ball Shoes Limited, but is now operated by another company set up specifically for wholesale operations, S-Mart Trade Warehouses Limited. The footwear is manufactured to my specification by factories in India and Portugal. It is then imported into the UK and sold via my exclusive distributor, Lyndhurst Shoe Company Ltd., to high street stores, such as The Officers Club, and to independent footwear shops.

4. The trade mark ROCKFORD and Device was first used by us in about 1992. I decided to use the name ROCKFORD because I was a fan of the television series "The Rockford Files" and thought Rockford would be a good name to use. At first, we used the name ROCKFORD on unbranded or debranded footwear sold in my shops as explained in paragraph 2 above. The ROCKFORD labels were all made in our warehouse using our own facilities and were applied to numerous different styles of footwear (mainly men's and boys) including leather dress shoes, boat shoes, boots and slippers. An example of a label is now attached and marked "TB1". Later, about five years ago, we had a batch of adhesive labels made from textile materials by our Portuguese supplier. Some of these labels were supplied ready for us to use in-house. We also had a batch of shoes made to order with the labels stitched and stuck into the socks. Attached at "TB2" is a sock we have found from that order with the label stitched and stuck into it. In addition, at the outset, we also had footwear bearing the ROCKFORD brand manufactured to order, to supplement the range of choice in my shops. In the early years from about 1992 to 1995, we worked with a number of factories (mainly in Portugal, Spain and India). When those factories had surplus materials or spare manufacturing capacity, we sometimes arranged for them to manufacture footwear for us. Also, if we had insufficient stocks in our shops of shoes of a certain type e.g. men's leather dress shoes, we would arrange for them to manufacture footwear of that type for us. Some of this footwear was branded ROCKFORD. From 1995 onwards, we had more footwear made to order due to the development of the wholesale side of our business (see paragraph 5).
5. When I decided to go into the wholesale market in about 1995, I decided to develop the ROCKFORD brand by putting together a range of shoes bearing that name. We also developed other ranges such as FOOT LOVERS for women's shoes, TOMMY FISH for casual summer shoes and WALKER & GUNN for men's dress shoes. Since 1995 ROCKFORD footwear has been not only sold in "Ball Shoes" shops in the North of England, but has also been sold via Lyndhurst Shoe Company Limited in retail stores such as "The Officers Club", which is a nationwide chain of shops selling men's clothing and footwear.

6. *It is difficult for me to give turnover figures for sales of ROCKFORD footwear in the UK from the early years because of the nature of my business at that time. Names were given to our unbranded and debranded footwear simply in order to give customers the impression they were buying a branded product and not with any intention of creating a brand with a reputation. I therefore did not separate out the figures for sales of ROCKFORD footwear from those of other footwear at that time. However, I have attempted to estimate the value of the sales of ROCKFORD footwear. The way in which it is estimated is that I have taken the figure for mail order clearance footwear in each year and have then assumed that 20% of that footwear had to be debranded/rebranded in each year because this is the average amount taken over the last 10 years or so. I have then estimated that the ROCKFORD brand was used on 50% of that debranded/rebranded footwear in each year, which I believe to be approximately right. The figures are as follows:-*

<u>Year</u>	<u>Value</u>
1994	£200,000
1995	£195,000
1996	£175,000
1997	£160,000
1998	£150,000
1999	£275,000 (part estimated/part actual sales figure).

My company no longer holds figures for the years 1992 and 1993 and so I am unable to provide any estimates for those years.”

25. In response to the applicants’ evidence Mr Ball makes the following main points:

- he was unaware of the trade mark ROCKPORT when he first decided to use ROCKFORD for footwear in about 1992;
- no instances of confusion between the marks has come to light;
- in relation to the now withdrawn ROCKFORT mark, he says he filed the application “with the intention of strengthening my protection around ROCKFORD and did not think about the application being at risk because it might more easily be confused with the trade mark ROCKPORT. This was a mistake on my part and, when I became aware of Rockport’s opposition to my application for ROCKFORT, I abandoned that application”;
- the mark ROCKFORT has never been used. This casts doubt on the comments attributed to Mrs McDonald;
- Mr Lane’s conversation with an assistant in the Preston shop cannot be verified because her name is not given;

- he was unaware that Rockport had used the names of various US states to identify styles of footwear. He admits that his companies have used the names NEBRASKA, UTAH and BALTIMORE for styles of shoes but he says that this is because they were already marked this way by the suppliers;
- his companies have also been using ROCKWELL since 1999 for footwear to supercede ROCKFORD in relation to the rebranding/debranding of surplus mail order stock.

26. Mr Burkhardt was a partner in a graphic design and marketing firm called Burkhardt Gibson. He says he recollects Mr Ball approaching him in the early 1990s with a request to design a logo containing the word ROCKFORD. He adds that he knows it was in the early 1990s because his firm ceased to trade in 1993. He identifies the mark of the registration in suit as being the logo he designed.

27. Mr Ainsworth is an employee at Ball Shoes Ltd and has been so employed for over 20 years. He confirms that in the early 1990s he was asked to procure a printing machine that would allow the company to print their own labels for the purpose of branding footwear. He says that one of the first labels to be printed was the ROCKFORD logo which was used to brand footwear that had to be debranded from their original makers' mark. From his own knowledge he says the ROCKFORD brand has been in use for about 10 years (his witness statement is dated 22 February 2002).

28. Mr Rushden is employed as a sales representative by Pacific Brands UK Ltd specialising in the selling of clearance lines of footwear. He has known Mr Ball for about 25 years. He says he has seen the ROCKFORD design on many occasions and has known it for many years but cannot be more precise as to date.

29. Mr Turner is a Director of Ball Shoes Ltd, a position he has held since March 1995. He has been employed by the company since July 1993. He says he recalls the ROCKFORD logo being in use when he joined the company. He exhibits (DPT1) an example of such a label. He also refers to other ROCK prefixed marks in use in the footwear industry. He exhibits a photograph of a pair of ROCKWOOD shoes bought from a Barratts store in Preston (DPT2). He also exhibits (DPT3) a print out from a Rock Fall UK Ltd website and a photograph of a box used as packaging for ROCK FALL shoes.

30. The final witness statement is from Ms Arnott who is a registered trade mark attorney. She refers to Mr Turner's witness statement which she read in draft form and provides information from the UK and Community Trade Marks Registries' websites giving details of the ROCKWOOD and ROCK FALL marks referred to by Mr Turner along with certain other information in connection with these marks.

31. That completes my review of the evidence.

Preliminary point

32. On 27 August 2002 the applicants' attorneys wrote to the Registry with a request to file further evidence in the form of a witness statement by Ian Wilkes who had already given evidence in these proceedings. The registered proprietor objected to this further evidence by

letter dated 3 September 2002. As a result the matter was set down to be heard as a preliminary point at the main hearing.

33. The evidence in question is directed particularly towards the bad faith claim and consists of print-outs of what Mr Wilkes refers to as the well known TIMBERLAND and tree logo marks and a registration in the name of a company of which Mr Ball is a director of the mark TIMBERLAKE and tree logo.

34. Mr Edenborough submitted that this was important and relevant evidence; that it was of a factual nature and did not call for evidence in response; and that the information had come to light as a result of continuing investigations by his clients into Mr Ball's activities.

35. Mrs Arnott pointed out that the evidence resulted from enquiries conducted in mid-August 2002 but the information itself could have been filed earlier; that there was insufficient explanation for the delay; that the evidence was in any case after the material date in the proceedings; and it lacked relevance.

36. I indicated that I intended to admit this evidence.

37. My reasons for doing so can be summarised as follows:

- the circumstances in which the new material came to light could have been more fully explained but this and the lateness of the request should not in itself be determinative of the matter;
- the applicants' claim regarding the pattern of behaviour adopted by Mr Ball was already in issue in these proceedings;
- the full relevance/significance of the evidence could only be properly considered as part of the substantive issues. It was preferable that it should be available for this purpose;
- appeal tribunals have commented on the need for pleadings and evidence to be fully brought out before the Registrar to avoid the first instance tribunal being treated as a dry run to establish gaps in evidence;
- the existence of the TIMBERLAKE registration is a factual matter. There does not appear to be any significant prejudice to Mr Ball in having the evidence admitted;
- any slight prejudice to the registered proprietor can be corrected by (i) allowing an opportunity to reply and (ii) an award of costs.

38. In relation to (i) above I allowed 14 days from the date of the hearing for written submissions or evidence directed solely to the narrow issue raised by the applicants' further evidence. Mr Ball subsequently filed a witness statement which says that the mark TIMBERLAKE and tree device was adopted for its outdoor connotations and desirable image

in relation to leisure shoes. There was he says no intention to emulate the TIMBERLAND brand.

Section 47(2)(a)/Section 5(2)(b)

39. These Sections read as follows:

Section 47(2)

“(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

Section 5(2)

“(2) A trade mark shall not be registered if because -

- (a)
- (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.”

40. I take note of the guidance from the European Court of Justice in the cases of *Sabel BV v. Puma AG* [1998] RPC 199; *Lloyd Schuhfabrik Meyer & Co v. Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v. Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

41. It is common ground that I must consider the matter judged through the eyes of the average consumer of the goods or services in question who is deemed to be reasonably well informed and reasonably circumspect and observant. However, the average consumer rarely has the change to make direct comparisons between marks and must, instead, rely upon the imperfect picture of them he has in his mind.

42. Furthermore, I must bear in mind that the average consumer normally perceives trade marks as a whole and does not proceed to analyse their various details. I must, therefore, look at the visual, aural and conceptual similarities of the marks and assess the likelihood of confusion by reference to the overall impressions created by those marks, bearing in mind the

distinctive and dominant components. I must also bear in mind that mere association, in the sense that the later mark simply brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2)(b).

Similarity of goods

43. No issue arises here. The goods are identical. For the purposes of the invalidity action generally I take No. 1472734 (for the mark ROCKPORT) as a convenient starting point. It covers 'articles of clothing, footwear and headgear'. If the applicants do not succeed on the basis of this registration they will be no better placed from the point of view of their other earlier trade marks.

Distinctive character of the applicants' earlier trade mark

44. I am required to take account of both the inherent distinctive character of the applicants' ROCKPORT mark and the extent to which its intrinsic qualities have been enhanced through use.

45. It has not been suggested that ROCKPORT is in any way descriptive or non-distinctive in relation to the goods at issue. Mr Edenborough sought to make out a case for an enhanced degree of distinctive character. He relied for this purpose on Ms Telford's evidence described above. In particular he suggested that the turnover figures demonstrated significant sales. Whilst there was no breakdown between footwear and apparel, it was in his view reasonable to infer that the figures related principally to the former. The absence of contextual information such as market share was not, he submitted, critical as there may be many traders who could claim a reputation.

46. The relevant date at which the reputation of the applicants' earlier trade mark must be assessed is 23 July 1998. As Mrs Arnott pointed out, the earliest trading figures given in Ms Telford's witness statement are for 1995. A significant increase in turnover was achieved in 1997. The applicants have, it would seem, engaged in relatively high profile advertising in a variety of media but the difficulty is assessing its impact at the relevant date. Advertising and promotional expenditure is only given for years after the material date. Most of the exhibits relate to either 1999, 2000, are undated or dates are not discernible. Mr Edenborough sought to overcome this point by suggesting that the evidence from, or relating to, more recent years can reasonably be interpreted as being the continuation of an established pattern of activity. That may be so but, given particularly the significant increase in turnover in the year proceeding the filing date there are inherent difficulties in judging the impact on consumers in July 1998.

47. The nature of a claim that a mark has a particularly distinctive character was considered by Mr S Thorley QC, in DUONEBS [O/048/01]. He said, referring to the ECJ guidance in Sabel v Puma:

"In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be

enhanced. I do not believe that ECJ was seeing to introduce into every comparison required by section 5(2), a consideration of the reputation of a particular existing trade mark.”

48. Those comments suggest that the threshold test is a relatively high one. It is possible that the mark did enjoy a significant reputation at the relevant date but I am not persuaded that there is sufficient substantiating detail in the evidence provided to satisfy me that the mark had made the claimed impact on the public. Nevertheless I consider that the mark is an inherently distinctive one.

Similarity of marks

49. Mr Edenborough submitted that the marks were visually similar; that the graphical aspects of the registered proprietor’s mark would be less noticeable or lost if the mark was embossed on goods; that aurally the first syllables are more important (and endings may be slurred); and that conceptually both marks had associations with water.

50. Mrs Arnott submitted that the only similarity between the marks is the prefix ROCK -; that the suffixes consisted of known words ie. -PORT and -FORD; that whilst these words share the letters “OR” in the middle, they look and sound different and are conceptually different. Furthermore, the mark ROCKFORD is combined with a significant device element. In relation to the latter she referred me particularly to MEDISON Trade Mark, 0-574-01, and the significance attached to the device element in that application (paragraph 16 of Mr D Kitchen QC’s decision on appeal). She further supported her submissions in relation to the importance of visual considerations by reference to REACT Trade Mark [2000] RPC 285. The following passage from Mr S Thorley QC’s decision on appeal will suffice to illustrate the point being made:

“[Counsel]... drew my attention to the fact that in relation to clothing of the type for which the mark is to be registered, anybody using the mark aurally would be informed to some extent of the nature of the goods they were proposing to purchase; they will therefore know of a mark; and they will know what they want. I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

51. The ECJ guidance requires me to consider the visual, aural and conceptual similarities. It will be convenient to start with the conceptual aspect of the marks not least because it provides a key to how consumers are likely to approach them. Whilst it is necessary to be mindful of how marks are made up, consumers do not normally approach marks in a spirit of analysis or look for underlying meanings (Sabel v Puma, paragraph 23). Whatever similarities or dissimilarities can be drawn from the elements -PORT and -FORD seem to me to be outweighed by the fact that it is the totality of each of the marks that will impress itself on the mind of the consumer. In that respect ROCKPORT seems to me to suggest a place name and ROCKFORD either a place name or a surname. I have not been told whether they

are actual place names or surnames but I am of the view that the average consumer would, albeit subconsciously, equate them with such names and exercise the sort of care that is customarily used when faced with such names.

52. Visually there are the obvious and undeniable points of similarity between the marks but they are not such that in my judgment the average consumer would consider them to be similar. The common element (ROCK) is not so dominant or independently memorable that it is likely to outweigh the difference between the second syllables (both of which are after all common dictionary words). Mr Edenborough was right, in my view, to suggest that the shadowing of the letters in the proprietor's mark may not be apparent in a retail context. The device however, is unlikely to be ignored. It is one of the distinctive components of the mark and is placed in a prominent position. Even so, as has often been said, words talk in trade marks. It seems likely that consumers would place particular reliance on ROCKFORD as the principal identifier.

53. By the same token the word ROCKFORD is likely to be the key feature of the proprietor's mark in oral/aural use. As with visual aspects of the respective marks there are clear points of aural similarity but the elements which make up the marks are common dictionary words. Even allowing for the slurring of the endings of words I consider that the overall differences outweigh the points of similarity.

54. Conceptually I consider that it is the overall impression created by the words rather than the meaning of their component parts that will make an impact on the average consumer. To that extent both words might suggest place names but beneath that high level of generality I can see no obvious point of conceptual similarity.

Likelihood of confusion

55. In coming to a global appreciation of the matter I bear in mind the following comments of Mr G Hobbs QC in *Raleigh International Trade Mark*, [2001] RPC 202:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and 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.”

56. I also bear in mind that more often than not consumers do not encounter marks side by side but are exposed to them in a range of retail environments at different times. Imperfect recollection may, therefore, play a part. But, even if it can be said that the registered proprietor's mark might bring to mind the applicants' mark, that is insufficient unless it causes the average consumer to consider that the underlying goods came from the same or an economically linked undertaking (*Canon v MGM* paragraph 29). I have come to the view that there is no likelihood of confusion as to trade origin even allowing for the fact that the marks may be used on identical goods. The application for invalidity thus fails under Section 5(2)(b).

Section 47(2)/Section 5(4)(a)

57. The relevant part of Section 47(2) is set out above. Section 5(4)(a) reads:

“(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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

58. The conventional test for determining whether a party 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 invalidity proceedings, the three elements that must be present can be summarised as follows:

- (1) that the applicants for invalidity’s goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the registered proprietor (whether or not intentional) leading or likely to lead the public to believe that goods offered by the registered proprietor are goods of the applicants for invalidity;
- (3) that the applicants for invalidity have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the registered proprietor’s misrepresentation.

59. The very full guidance given in the *WILD CHILD* case by Mr Hobbs by reference also to Halsbury’s Laws of England can be found at pages 460 and 461 of that decision.

60. Mr Edenborough submitted that the applicants were claiming goodwill from 1992 and that the Section 5(4)(a) ground advanced their case beyond the position pertaining in relation to Section 5(2)(b) because there were other circumstances that increased the likelihood of consumer deception (misrepresentation). Specifically those circumstances are said to be

- the registered proprietor’s use of the names ‘Nebraska’, ‘Utah’ and ‘Baltimore’ in association with *ROCKFORD* which, it is said, mirrors the applicants’ practice of using US State names as sub-brands in association with its *ROCKPORT* mark;

- the use of ROCKFORD upon shoes that are almost identical in shape and styling to those produced by ROCKPORT.

61. Mr Edenborough submitted that the use of sub-brands and the whole get-up of a mark can be brought into the reckoning. That raises the question of whether the enquiry under Section 5(4)(a) must be based purely on the mark in the form it is registered (allowing for normal and fair use thereof) or whether surrounding circumstances should also be taken into account. The point has been considered in *MAGIGROW/MAGI-GROW Trade Marks*, a decision of Professor Annand, sitting as the Appointed Person in a decision dated 19 December 2001 O/583/01).

62. Having taken *WILD CHILD Trade Mark*, [1998] RPC 455, as her starting point she went on to conclude:

“61. In *WILD CHILD* there was no prior use on the part of the applicant for registration. By contrast the applicant has used the *MAGI-GROW* trade marks since 1995. The present case therefore raises the additional question of whether the actual presentation of the trade marks in suit should be taken into account.

62. As far as I am aware, no case has discussed that additional question for the purposes of section 5(4)(a) of the TMA. However, the point was decided by the Court of Appeal in relation to section 11 of the Trade Marks Act 1938 in *OPEN COUNTRY Trade Mark* [2000] RPC 477. An application to register *OPEN COUNTRY* for clothing was opposed by the proprietor of *OPENAIR* in respect of identical goods. Both marks were in use at the date of the application. The opponent sought to rely on the way the applicant’s mark had been used as an illustration of normal and fair use. On appeal from the registry, the judge rejected that approach:

It seems to me that in making the comparison, the section and authority of *Re BALI* and, in particular, the speech of Lord Upjohn, require a comparison between the opponent’s mark as used and the applicant’s mark in notional fair use. It does not seem to me that it is appropriate to compare the way in which the marks were actually presented, the actual contention being that what was in fact being done was an attempt to pass off the goods of the applicant as the goods of the respondent because the marks were similarly presented. It does not seem to me to be logical or right to use that argument as a reason to oppose registration.

On further appeal, Aldous L.J., at p. 482, disagreed:

The test laid down in *Smith Hayden*, adapted in accordance with the speech of Lord Upjohn in *BALI*, is the test applicable whether the applicant has or has not used his trade mark. However, no court would be astute to believe that the way that an applicant has used his trade

mark was not a normal and fair way to use it, unless the applicant submitted that it was not. It does not follow that the way that the applicant has used his trade mark is the only normal and fair manner. However in many cases actual use by an applicant can be used to make the comparison. I believe that this is such a case.

63. The differences between on the one hand, section 11 of the 1938 Act and on the other hand, section 5(4)(a) of the TMA are well known, in particular, that under section 11 it was unnecessary to prove passing off and it was for the applicant to show its mark was registrable. Nevertheless, it seems to me, that the ratio of Aldous L.J. above is equally applicable to the determination of normal and fair use under section 5(4)(a) of the TMA. Remarks by Pumfrey J. in *South Cone Inc. v. Bessant*, 25 July 2001 appear to support that view although the applicant's mark in that case had not been used at the application date."

63. The relevant use which the Court of Appeal brought into the comparison of marks as a result of the finding referred to above was use of the respective marks on labels of a particular colour and size. Whether the test can properly extend to the circumstances relied on by Mr Edenborough is not entirely clear from the above authority. For reasons which will become apparent I do not need to reach a concluded view on the matter and, in the circumstances, prefer not to do so.

64. The date for considering whether use of the registered proprietor's mark in the UK would be liable to be prevented by the law of passing off is the date of application for registration (Article 4.4(b) of the Directive). Where the proprietor's mark is already in use the question needs to be answered by reference also to an earlier date (*Cadbury Schweppes Pty. Ltd v Pub Squash Co Pty* [1981] 1 All ER 213 (PC)), that is to say the date of the act first complained of. That might in turn give rise to a need to consider whether the registered proprietor's use was passing off when it commenced and, if so, whether the registered proprietor had established an independent goodwill by July 1998 with the result that, even if his use was passing off at the earlier date, his own goodwill would have meant that his continued use would not be a misrepresentation.

65. Given the factual matrix that is said to underpin the applicant for invalidity's objection under this head and the registered proprietor's competing claim, the application of the underlying principles is not an easy matter. I also bear in mind the guidance in *South Cone Incorporated v Jack Bessant and others* [2002] RPC 19 on the standard of evidence in an action of this kind:

"The second question follows: how cogent must the evidence be upon which the Registrar should act in upholding an opposition on this ground?"

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."

66. The position on the applicants' evidence seems to me to be as follows:

- the applicants commenced use in 1992 in relation to footwear but no documentary evidence or trading information is supplied to substantiate that bare claim;
- an apparel range was introduced in 1995;
- turnover figures have been supplied from 1995 onward but are not broken down between footwear and clothing;
- there was a significant increase in turnover in the year 1997 and continuing into 1998 (the relevant date is 23 July 1998);
- there has been high profile advertising but expenditure figures on promotional activities are only given for periods after the material date;
- there are no exhibits that can confidently be placed within the relevant period;
- there is no invoice evidence to support the claims being made.

67. In relation to the other circumstances relied on by the applicants:

- there is evidence to support Rockport's claim that they use US State names as sub-brands. But the example given is from a 1999 catalogue. It is described as a 'Fall' catalogue and is likely, therefore, to have been directed at the US market. There is no specific evidence to support the claim that the practice has been adopted in the UK or, if it has, from what date or to what extent;
- the claim that the ROCKPORT style of shoes has been imitated is based upon hearsay evidence of a statement made by a Mrs McDonald, an employee at one of the proprietor's outlets, (3.10 of Mr Lane's 17 October 2000 report) and a statement by Mr Lane as a result of his further investigations (4.4 of his 25 April 2001 report);

- the shoes themselves have not been exhibited so it is not possible to assess the underlying claim.

68. The registered proprietor has responded to the first of these supplementary claims by explaining how the use of US State names came about as a result of adoption by his suppliers to indicate different styles of shoes. He has not supplied any documentary evidence to this effect.

69. Various dates were put forward at the hearing as being relevant depending on what view is to be taken of the evidence. Mrs Arnott in her skeleton argument suggested that the relevant date for assessing whether the applicants have passing off rights "is at least 1995 and arguably as early as 1992". These dates reflect, as I understand it, Mr Ball's claimed use of his mark from 1992 in relation to unbranded or debranded footwear or from 1995 in relation to footwear in general. Mr Edenborough contended that the applicants could claim goodwill from 1992.

70. On the bare facts outlined above there are difficulties for the applicants in substantiating either the 1992 or 1995 date in relation to ROCKPORT. It is likely that they have a legitimate claim as at the filing date of the registration under attack but even that much can scarcely be supported from the material exhibited to the evidence. The exhibits are rather more convincing in terms of substantiating the nature and scale of the applicants' business from 1999 onwards and there may be some force to Mr Edenborough's submission that the position in 1999/2000 can be taken to be the continuation of a by then established business.

71. However, it seems to me that the applicants' position under Section 5(4)(a) is heavily dependent upon the additional factors referred to above being an operative part of their claim. That must be so because, having found against the applicants on a comparison of the marks ROCKPORT and ROCKFORD under Section 5(2)(b), they could not in normal circumstances expect to succeed under Section 5(4)(a) if the only point in issue were use solely of those same marks. The applicants therefore needed to establish their case in relation to the surrounding circumstances with great care.

72. A party's motives in adopting a particular mark or sign are relevant to the inquiry. It was said in *United Biscuits (UK) Limited v Asda Stores Limited*, [1997] RPC 513 that:

"But it seems to me likely that Mr. McLeod, Mr Blundell [senior employees of the defendants] and their subordinates and independent designers were, under advice, seeking to make only such changes as were needed in order to avoid what they judged to be an unacceptable risk of being attacked for copying, while maintaining Puffin's position as an obvious competitor and parody, and (they hoped) a "brand beater". I cannot escape the conclusion that, while aiming to avoid what the law would characterise as deception, they were taking a conscious decision to live dangerously. That is not in my judgment something that the court is bound to disregard."

73. Similarly in *Harrods Ltd v Harrodian School Ltd*, [1996] RPC 697 it was said:

“Deception is the gist of the tort of passing off, but it is not necessary for a plaintiff to establish that the defendant consciously intended to deceive the public if that is the probable result of his conduct. Nevertheless, the question why the defendant chose to adopt a particular name or get up is always highly relevant. It is “a question which falls to be asked and answered”: see *Sodastream Ltd. v. Thorn Cascade Co. Ltd.* [1982] RPC 459 at page 466 per Kerr L.J. If it is shown that the defendant deliberately sought to take the benefit of the plaintiff’s goodwill for himself, the court will not “be astute to say that he cannot succeed in doing that which he is straining every nerve to do”: see *Slazenger & Sons v. Feltham & Co.* (1889) 6 RPC 531 at page 538 per Lindley L.J.”

74. The inference to be drawn from the applicants’ objection is that the registered proprietor in this case is living dangerously and that I should take that into account. I do not find the registered proprietor’s explanations of what has occurred to be wholly convincing but equally the applicants’ evidence falls some way short of providing a sufficient basis for finding against him. Thus I find that, even if the applicants can be said to have substantiated their claim to goodwill (and even if that were the position in 1992 or 1995) it is only likely to have been in the mark/sign, ROCKPORT. In which case no misrepresentation will arise. The other circumstances relied on have not been clearly enough established on the evidence to provide a basis for a claim to a subjective intention to deceive. On that basis the Section 5(4)(a) case is bound to fail and I do not need to go on and consider the registered proprietor’s use beyond what is dealt with above. Had it been necessary to do so I would have needed to consider Mr Edenborough’s submission that the registered proprietor would have been unable to benefit from any of the equitable defences, by which I understand him to mean laches (delay), estoppel or acquiescence. Given that both parties claim to have commenced use in 1992 it might also have been necessary to consider the effect of antecedent or concurrent use though I have to say that the registered proprietor’s case also suffers in this respect from lack of detailed substantiation. As matters stand the application for invalidity fails under Section 47(2)(b)/Section 5(4)(a).

Section 3(6)

75. The Section reads:

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

76. Mr Edenborough referred me to two cases which are often quoted by Hearing Officers when dealing with the issue of bad faith. The first is *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 where Lindsay J said:

“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.”

77. The second is *Eicher Ltd Royal Enfield Motor Units v Matthew Scott Holder* where Mr S Thorley QC said:

“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.”

78. In relation to the latter case Mr Edenborough suggested that it was wrong to characterise all allegations of bad faith as being equivalent to commercial fraud. In his view the concept of bad faith is much broader than the concept of commercial fraud even though it would naturally include such activities.

79. Mrs Arnott was content to accept that bad faith could extend to matters other than commercial fraud but submitted that Mr Thorley’s comments should be read as indicating the seriousness of the allegation and the standard of proof required of a party making such an allegation. In this respect I see no inconsistency between Mr Thorley’s above comments and the following remarks of Lord Denning in *Hornal v Neuberger Products Ltd* [1957] QB 247 and 258 which were referred to by Mr Edenborough:

“The more serious the allegation the higher the degree of probability that is required; but it need not, in a civil case, reach the very high standard required by the criminal law.”

80. The relevant date is the filing date of the registration under attack. Mr Edenborough submitted that events after the date could be taken into account to the extent that they shed light retrospectively on someone’s behaviour in applying for a mark. I would hesitate to disagree with that general proposition though the application of the principle involved requires careful consideration in each case.

81. The applicants’ case, as it emerges from the evidence, skeleton arguments and submissions, is based on a number of factors:

- the abandoned attempt by the proprietor to register ROCKFORT;
- the registration of ROCKFORD;
- the use of sub-brands in imitation of the applicants' practice;
- the selling of shoes which are said to be a copy of the applicants' own goods and the display of ROCKFORD shoes alongside the ROCKPORT shoes;
- the systematic imitation of both ROCKPORT's marks and those of other well known brand owners. In this latter category is said to be the TIMBERLAKE registration which is the subject of the evidence admitted at the hearing and a further mark, LICKERS (a lapsed/refused application).

82. Mr Edenborough fairly conceded that taken individually these circumstances would not be sufficient for a finding of bad faith: but taken collectively he submitted that they produced a body of evidence that pointed to a pattern of behaviour on the part of the registered proprietor which did permit such a finding.

83. Insofar as the mark ROCKFORD is concerned I have found that there is no likelihood of confusion with the applicants' mark ROCKPORT. I am aware of two cases where Registry Hearing Officers have dealt with objections under Section 3(6) having previously considered objections under Section 5(2). In MAGIGROW/MAGI-GROW Trade Marks, O-240-01, the Hearing Officer dealt with a claim contained in a magazine article that the applicant, when searching for a name for its soluble plant feed, looked to identify names like or similar to MIRACLE-GRO (said to be a market leader in relation to such goods). An objection under Section 5(2)(b) failed. The Hearing Officer went on to deal with Section 3(6) as follows:

“While it is well established that a tribunal should not be astute to find that there is no dishonesty where there is evidence that the applicant set out to deceive, it does not follow that the adoption of a mark with some similarity to a market leader is prima facie evidence of intention to deceive and association, in the strict sense, can be used as a means of denoting a products suitability as an alternative to the market leader's product. The question in each case is whether there is a likelihood of confusion and if there is not, the use is not objectionable and there is no bad faith. The objection under Section 3(6) fails.”

84. That case was appealed to an Appointed Person and the Hearing Officer's decision was upheld, O-583-01.

85. The second case is TIMBERWEAR Trade Mark, O-042-01, where the Hearing Officer expressed the following view:

“The invalidation case was always likely to turn on the outcome of the Section 5(2) ground of attack. This requires an objective comparison of the similarity between the respective marks and goods and the resulting likelihood of confusion. A separate attack under Section 3(6) is unlikely to succeed on the basis that the registered

proprietor tried, but failed, to adopt a mark that was confusingly similar to the mark of the applicant.”

86. The Hearing Officer was, it seems to me, expressing a view on the degree of difficulty likely to be encountered in relation to a bad faith claim when no likelihood of confusion has been found having regard to the marks themselves, rather than excluding completely the possibility of success under Section 3(6).

87. In this particular case there is more than simply the marks themselves. There are the additional factors outlined above. This in turn raises questions as to the scope of Section 3(6) and the extent to which it is permissible to bring such factors into the reckoning in determining whether the application is made in bad faith.

88. There is to date little established case law dealing with this question. The underlying difficulties were acknowledged in *DEMON ALE* Trade Mark [2000] RPC 345 where Mr Hobbs QC referred to Lindsay J’s remarks in *GROMAX* (quoted above) and said:

“These observations recognise that the expression “bad faith” has moral overtones which appear to make it possible for an application for registration to be rendered invalid under section 3(6) by behaviour which otherwise involves no breach of any duty, obligation, prohibition or requirement that is legally binding upon the applicant. Quite how far the concept of “bad faith” can or should be taken consistently with its Community origins in Article 3(2)(d) of the Directive is a matter upon which the guidance of the European Court of Justice seems likely to be required: *Road Tech Computer Systems Ltd v. Unison Software (U.K.) Ltd* [1996] F.S.R. 805 at pages 817, 818 *per* Robert Walker J.”

89. He also observed that “I do not think that Section 3(6) requires applicants to submit to an open-ended assessment of their commercial morality”.

90. In *IVANA* Trade Mark, 0-393-00, the Hearing Officer took account of ‘similar fact’ evidence that, by its very nature, involved consideration of circumstances beyond the scope of the registration before him. This was an application for invalidity filed against the mark *IVANA* by House of Ivana Inc (Ivana Trump). The Hearing Office had before him evidence that, on the same day that the *IVANA* application had been filed, a separate application had been made for the mark *IVANA TRUMP* (that application was subsequently allowed to lapse). There was, additionally, evidence of other attempts by the registered proprietor to register the names and/or drawings of Disney characters. Many had been withdrawn but others had resulted in opposition proceedings being concluded with findings against the applicant under Section 3(6). The Hearing Officer accepted that the combined effect of the evidence before him, including the similar fact evidence, was sufficient to make out a *prima facie* case of bad faith against the proprietor of the *IVANA* mark.

91. I am not aware that that decision has been appealed. Nevertheless the circumstances I am being asked to consider here go well beyond those of the *IVANA* case. I propose, therefore, to consider the applicants’ claims on their merits but to do so with some caution bearing in mind that it is not an area of settled law.

92. Reaching a view on the collective force of the applicants' claims cannot be achieved without also considering the merits of the individual points. The first of the claims is that an attempt was made to register the mark ROCKFORT (with fortress device), a mark that is rather closer to the applicants' main mark than ROCKFORD. Mr Ball acknowledges in his witness statement that this was a mistake. I infer that he recognised, when threatened with opposition, that he may have trespassed too close to the applicants' ROCKPORT mark. The ROCKFORT mark was never used - a point that is confirmed by Mr Lane.

93. I have already dealt with the marks ROCKPORT and ROCKFORD and found that there is no likelihood of confusion. I have also commented on what I consider to be the weakness of the applicants' claim in relation to the use of sub-brands (see the paragraphs dealing with Section 5(4)(a)). Similarly the claim based on the copying of styles of shoes lacks evidential support. It is in any case a difficult point. There are a finite number of types of shoes (trainers, casual shoes, sandals, boots etc). A cursory glance at displays of any particular type is likely to reveal a number of different manufacturers producing goods which to all but the most discerning eye contain similar features of styling. What is or is not similar is in any case a subjective matter. There is no, or insufficient, evidence before me for the point to have substance.

94. The investigator's report also suggested that ROCKFORD and ROCKPORT goods were being sold in physical proximity to one another. That is not altogether surprising if they were the same type of footwear. These are also circumstances where instances of confusion might be expected to occur if it was going to happen though I acknowledge that the absence of confusion may simply be attributable to the fact that any complaints might be lodged with the retailer rather than the supplier.

95. The final point is the claimed systematic adoption of marks that approximate to those of leading suppliers (in addition to the applicants). There is no suggestion that Mr Ball or his companies have taken the third party brands themselves. It was said in *The European Limited v The Economist Newspaper Limited*, [1998] FSR 283:

“Similarity is a matter of degree; and except in the case where there is absolutely no similarity at all between sign and mark (which is not this case) the question is whether the similarity is such as to be likely to cause confusion in the mind of the public. A degree of similarity is tolerable; the question is whether there is a confusing similarity.”

96. Imitating the marks of market leaders, if that is what is happening, is not in itself conduct that falls foul of the provisions of the Act though doubtless someone who regularly adopts this practice might be said to be living dangerously as it was put in the *United Biscuits v Asda Stores* case. Whether in adopting the LICKERS (and device) and TIMBERLAKE (and device) marks Mr Ball has come too close to well known brands is not a matter on which I am called upon to express a view. It would effectively be inviting me to draw conclusions about, inter alia, the reputation of the third party brands and the issue of similarity/confusion. That is beyond the scope of the present action. I note, but draw no particular conclusions from, Mr Ball's own comments on the choice of the TIMBERLAKE mark.

97. To return to my starting point, Mr Edenborough's submission is that it is the collective force of these points that should influence any decision. In my judgment the applicants' claims taken individually have insufficient weight; are not adequately substantiated; and/or are inconclusive. Taken together they suggest that the registered proprietor or his companies may be following a practice of adopting marks that are based on those of other traders. If that is so Mr Ball may indeed be living dangerously. However I am not persuaded that the choice of the mark ROCKFORD (and device) and the additional factors relied on in this case combine to enable me to reach a finding of bad faith. As Mr Thorley has said in the Royal Enfield case an allegation of bad faith "should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference". I am left feeling uneasy about the registered proprietor's behaviour and his explanations for that behaviour but that is not enough for a finding of bad faith. The Section 3(6) objection also fails.

98. The registered proprietor has succeeded and is entitled to a contribution towards his costs. Some slight adjustment of the normal scale award is appropriate to compensate for the effects of the late evidence. I order the applicants to pay the registered proprietor the sum of £2200. 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 14th day of October 2002

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

Brief details of the applicants' registrations

No.	Mark	Class
1496995	ROCKPORT	03
2153262	ROCKPORT	16, 24
1058957		18



1472734	ROCKPORT	18, 25
1058958		25



