

O-011-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2491986
BY SHEHRAZ FAZAL TO REGISTER A
TRADE MARK IN CLASSES 3, 14 & 18**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 99299 BY SUKHDEV SINGH**

BACKGROUND

1. On 9 July 2008, Shehraz Fazal applied to register **ROC-A-FELLA** as a trade mark. Following examination, the application was accepted and published for opposition purposes on 17 April 2009 in Trade Marks Journal No.6781 for a range of goods in classes 3, 14 and 18. However, I note that on 25 January 2010 Mr Fazal filed a Form TM21 in which he asked for the goods in class 3 to be deleted from the application. The goods which remain are as follows:

14 - Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

18 - Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.

2. On 14 July 2009, Sukhdev Singh filed a notice of opposition. Following amendment, this now consists of grounds based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (as amended) (the Act). In his Statement of Grounds Mr Singh indicated that the opposition under section 5(2)(b) of the Act (which is based upon the trade mark below) was directed against the following goods which remain in the application for registration:

14 - Jewellery, costume jewellery, watches.

18 - Leather and imitations of leather; travelling bags; handbags, purses.

I note that in relation to class 18 Mr Singh also mentions wallets. However, this item was never specifically mentioned in Mr Fazal's application for registration.

Trade Mark	No.	Application date	Registration date	Goods
ROCKAFELLA	2029800	8/8/95	29/3/96	Jackets, trousers, shirts, waistcoats, suits, coats, scarves, shoes, vests, jumpers, boxer shorts, knitted articles of clothing, articles of clothing made from knitted materials; belts, ties, socks, gloves; T-shirts; jeans, hats, all being articles of clothing; all for men and boys.

3. Insofar as the objection based on section 5(3) of the Act is concerned, Mr Singh relies on the trade mark shown in paragraph 2 and objects to the same goods shown above (again mentioning wallets). However, the objection is also said to relate to "clothing for animals". Mr Singh says:

“The unfair advantage that would be taken by the use of the word ROC-A-FELLA by the applicant is likely to take the form of an undeserved respect afforded to the products of the applicant in view of the reputation of the opponent. The public will associate such goods (jewellery, costume jewellery, watches, leather and imitations of leather products i.e. belts, bags, handbags, clothing for animals i.e. dogs) and services with the opponent and assume that they come from that, or a related undertaking. The result of this would also be detrimental to the repute of the opponent’s trade mark, as they would have no means of quality control over the products and services produced by the applicant under the mark. Accordingly, the public could form a negative impression of the opponent’s goods and services due to their experience of the goods and services of the applicant.

The use of ROC-A-FELLA by the applicant in the UK would also be detrimental to the distinctive character of the opponent’s trade mark due to the proliferation of trade marks incorporating the word ROCKAFELLA in respect of the goods and services reducing the ability of the opponent’s own trade mark to distinguish the goods and services of the opponent from those other parties, in the eyes of the public.”

4. In relation to the ground based upon section 5(4)(a) of the Act, Mr Singh said:

“ROCKAFELLA has sold leather and imitations of leather in London Bethnal Green since 1995. Imitations of leather jackets since 1995, imitation of leather bags and leather belts since 2002.

ROCKAFELLA sold branded jewellery in London, Bethnal Green since 2004. This included neck chains, key rings on long chains which hang from jeans, bracelets.

ROCKAFELLA sold men’s aftershaves in London, Bethnal Green since 2008.”

5. The objection under section 5(4)(a) is said to relate to:

14 - jewellery

18 - Leather imitations of leather, travelling bags, handbags.

Mr Singh specifically mentions “neck chains”, “bracelets” and “key rings” which I have taken to be a sub-set of the word “jewellery”. Finally, I note that in paragraph 9(a) of his Statement of Grounds Mr Singh asked for Mr Fazal’s application for registration to “be refused in its entirety.”

6. On 21 December 2009, Mr Fazal filed a counterstatement in which he said:

“When I registered my application, I was careful not to register my mark under classifications that were already registered. I feel the opponent has no reason to oppose my application. If he or they felt so passionate about their mark or were using it for the classes I have applied for, then why did they not register their mark under those classifications??? I strongly feel there is no reason for my mark to be refused.”

7. I note that in his counterstatement Mr Fazal indicates that he requires Mr Singh to provide proof of the use that he has made of his trade mark in relation to all of the goods on which Mr Singh relies.

8. Only Mr Singh filed evidence; neither party asked to be heard or filed written submissions. After a careful consideration of all the material before me, I give this decision.

9. Before turning to the evidence filed, I note that on 26 October 2010, the Case Work Examiner (“CWE”) dealing with these proceedings wrote to Mr Singh to seek clarification on a number of apparent inconsistencies in his pleadings. This included, inter alia, the tension between the request for the application to be refused both partially and in its entirety. Mr Singh responded to this request on 2 November. In paragraph 9(a) of his amended Statement of Grounds he said:

“9. The Opponent request that

[Mr Fazal’s application] be refused in respect of the goods being opposed including for the use on leather and imitations of leather, animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols, walking sticks. Fashion jewellery, costume jewellery...and watches all of which can be worn or used by people or worn and used as fashion accessories by people.”

10. On 10 November the CWE wrote to the parties. He said, inter alia:

“I confirm that the Registry is satisfied that the amended pages now submitted clarify the position and so it is the Registrar’s view that these should be entered into the proceedings.”

11. In his letter the CWE allowed Mr Fazal until 17 November to comment otherwise: “the preliminary view will be confirmed”. At the time of writing this decision no response to the CWE’s letter had been received.

12. On the basis of the now amended pleadings, it appears to me that Mr Singh's opposition is directed (under one or more of the grounds mentioned above) at the following goods contained in Mr Fazal's application:

14 - Jewellery, costume jewellery, watches.

18 - Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; clothing for animals.

13. Insofar as the class 14 element of Mr Fazal's application is concerned, the attack is no broader than the original request under section 5(2)(b) of the Act. However, in relation to the class 18 element Mr Singh has broadened his attack to include: animal skins, hides, trunks, rucksacks, umbrellas, parasols and walking sticks; he has not however indicated under which pleaded ground the attack on these additional goods is based. Given that the parties to these proceedings are litigants in person (and in the absence of any comments from Mr Fazal) I see no real benefit in seeking further clarification on this point at this stage of the proceedings. I shall consider the request to oppose these additional goods under each of the grounds pleaded.

Mr Singh's evidence

14. This consists of a witness statement, dated 20 March 2010, from Manjinder Singh. Mr Singh explains that he is the Manager of ROCKAFELLA, a position he has held since 1990. Mr Singh confirms that the information in his statement comes from his own knowledge or from company records.

15. Mr Singh explains that the ROCKAFELLA trade mark was first used in the United Kingdom in 1995 adding that the goods on which the trade mark has been used are as follows:

1996 – clothing and clothing accessories for men;

Not later than 2000 – belts, shoes, bags in leather and imitations of leather;

Not later than 2005 – costume jewellery.

16. Attached to Mr Singh's statement are a range of exhibits which he categorises as follows:

Exhibits A1 – A37 consists of invoices from 2006 to 2008 on which products made of leather or imitations of leather have been highlighted. Of these products Mr Singh says:

“...all products were either bought with the ROCKAFELLA branding on them or later customised and branded with ROCKAFELLA.”

Exhibits A36-A41 consists of invoices in relation to, inter alia, accessories, jewellery and costume jewellery which Mr Singh explains were sold with the ROCKAFELLA branding.

Exhibits A42-A50 consists of invoices for fashion shows and exhibitions attended in the period 2006-2009 at which the ROCKAFELLA brand was promoted.

Exhibits B1-B31 consists of photographs of, inter alia, a range of goods which Mr Singh says bear the ROCKAFELLA trade mark together with examples of labels, tickets and packaging.

17. Sales of goods made of leather or imitations of leather in the period 2004-2008 were as follows:

Year	Sales (000)
2004	£15
2005	£15
2006	£26
2007	£37
2008	£46

18. Sales of jewellery in the period 2006-2008 were as follows:

Year	Sales
2006	No less than £1,000
2007	No less than £1,000
2008	No less than £6,000

19. Mr Singh explains that amounts spent on “promoting the goods/services through fashion shows, flag ship store promotion events and sponsorships” in the period 2004-2008 amounted to:

Year	Amount spent (000)
2004	No less than £20
2005	No less than £20
2006	No less than £35
2007	No less than £35
2008	No less than £35

20. Mr Singh adds:

“The bulk of the marketing promotion and sales up to 2008 have been in the south east of the UK i.e. London and surrounding counties and the midlands i.e. Birmingham and surrounding cities. Since 2008 we have launched on the internet and this has enabled us to promote to the whole of the UK and has seen dramatic sales increase in Scotland and Wales.”

21. While that concludes my summary of the evidence filed by Mr Singh to the extent that I consider it necessary, I will return to how this evidence should be interpreted later in this decision.

DECISION

22. The first ground of opposition is based on section 5(2)(b) of the Act which reads as follows:

“5. - (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, or

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

23. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

24. In these proceedings Mr Singh is relying on the registered trade mark shown in paragraph 2 above which has an application date of 8 August 1995. This is prior to that of Mr Fazal’s application for registration which was filed on 9 July 2008; as such, it qualifies as an earlier trade mark under the above provisions. Mr Fazal’s application for registration was published for opposition purposes on 17 April 2009 and Mr Singh’s earlier trade mark was registered on 29 March 1996. As a result, Mr Singh’s earlier trade mark is subject to The Trade Marks (Proof of Use, etc) Regulations 2004. As I mentioned above, in his counterstatement Mr Fazal asked Mr Singh to provide proof of the use he had made of his trade mark. The relevant sections of the Proof of Use Regulations read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Proof of use

25. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of Mr Fazal’s application for registration i.e. 18 April 2004 to 17 April 2009. The leading authorities on the principles to be applied when determining whether there has been genuine use of a trade mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);

- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);

- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);

- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);

- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);

- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

26. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a

person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

27. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

28. Finally, the comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the

opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories."

29. In his Notice of Opposition Mr Singh says that his ROCKAFELLA trade mark has been used on all the goods the subject of his registration. Of the goods listed by Mr Singh (see paragraph 15 above) it is likely that only clothing and clothing accessories and belts and shoes (whether made of leather or not) fall within class 25 and can be taken into account for the purposes of the objections based on section 5(2)(b) and 5(3) of the Act; the bag, for example, at exhibit B15 would be proper to class 18.

30. Whilst I have been provided with sales figures for goods made of leather or imitation of leather, these figures have not been broken down to show sales of goods which are proper to class 25 as opposed to those proper to class 18. However, having reviewed the evidence provided, it appears to me that the vast majority of the invoices/photographs are (insofar as class 25 is concerned) in relation to jackets, shoes and belts for men, made of leather or imitations of leather. As to the trade mark used, I note that Mr Singh has used his ROCKAFELLA trade mark in a range of formats e.g. slightly stylised in lower case and where the letters R and F are both capitalised and stylised. Turnover between 2004 and 2008 was in the order of £140,000 with some £145,000 spent during the same period promoting the trade mark at exhibitions such as the Clothes Show Live in 2006, 2007 and 2008.

31. As is often the way in cases such as this Mr Singh's evidence is far from perfect. Whilst the value of goods sold under the trade mark in class 25 are likely to be somewhat less than the £140,000 mentioned above, having applied the principles outlined in paragraph 25 above, and in the absence of any challenge to Mr Singh's evidence by Mr Fazal, there is nothing in Mr Singh's evidence which suggests to me that the use of the ROCKAFELLA trade mark has been anything other than genuine. Having reached that conclusion I must now go and determine what constitutes a fair specification.

32. Mr Singh's ROCKAFELLA trade mark stands registered for:

Jackets, trousers, shirts, waistcoats, suits, coats, scarves, shoes, vests, jumpers, boxer shorts, knitted articles of clothing, articles of clothing made from knitted materials; belts, ties, socks, gloves; T-shirts; jeans, hats, all being articles of clothing; all for men and boys.

33. In reaching a conclusion on this point I must begin by determining what actual use Mr Singh has made of his ROCKAFELLA trade mark. As I mentioned above, Mr Singh has, in my view, used his trade mark in relation to:

Jackets, shoes and belts for men, made from leather or imitations of leather.

34. Having reached that conclusion, I must now decide how the average consumer would describe these goods. The goods on which Mr Singh has used his trade mark are everyday consumer items that can be found on any high street; they are goods with which the average consumer is very familiar. Whilst the average consumer might (if the items were considered in isolation) refer to them as perhaps outerwear, or accessories or footwear, having applied the guidance provided in paragraph 27 above to this question, it appears to me that when viewed collectively the average consumer would see them all as items to be worn and would as a result describe them as clothing. That being the case, and given that the difference between men and boys is essentially one of size, I intend to proceed on the basis that the use Mr Singh has made of his ROCKAFELLA trade mark is sufficient to justify me conducting any further analysis on the basis of his specification of goods as registered.

Section 5(2)(b) – case law

35. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and circumspect and observant – but who 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas (C-334/05)*, paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (h) 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*, paragraph 24;
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (j) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;
- (k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing decision

36. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The goods at issue in these proceedings are items of clothing, jewellery, watches, leather and imitations of leather, animal skins, hides; trunks, travelling bags, handbags, rucksacks, purses, umbrellas, parasols and walking sticks.

These are the sort of goods which will be bought by the general public; they then are the average consumer for such goods.

37. The selection of the goods by the average consumer is most likely to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (see the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285).

38. Insofar as Mr Singh's goods are concerned, I note that in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the General Court (GC) considered the level of attention taken when purchasing goods in the clothing sector. They said:

“43 It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

39. It appears to me that the logic applied by the GC to the level of attention paid by the average consumer to the selection of clothing applies with equal force to the opposed goods in classes 14 and 18. By that I mean that while one might assume that the average consumer will be more attentive when purchasing, for example, a particularly expensive watch or handbag, given that the cost of the opposed goods can also vary widely, one cannot simply assume that the same level of attention will be paid to the selection of all goods which fall within the general definition.

Comparison of goods

40. For the sake of convenience the goods at issue are as follows:

Mr Singh's goods	Mr Fazal's goods
Jackets, trousers, shirts, waistcoats, suits, coats, scarves, shoes, vests, jumpers, boxer shorts, knitted articles of clothing, articles of clothing made from knitted materials; belts, ties, socks, gloves; T-shirts; jeans, hats, all being articles of clothing; all for men and boys	14 - Jewellery, costume jewellery, watches. 18 - Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks.

41. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

42. I note that in *El Corte Inglés SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-443/05) the Court of First Instance (now the General Court) considered the clash between goods in classes 18 and 25. The GC said:

“42. First, the goods in class 25 and those in class 18 are often made of the same raw material, namely leather or imitation leather. That fact may be taken into account when assessing the similarity between the goods. However, given the wide variety of goods which can be made of leather or imitation leather, that factor alone is not sufficient to establish that the goods are similar (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 55).

43. Second, it is apparent that the distribution channels of some of the goods at issue are identical. However, a distinction must be made according to whether the goods in class 25 are compared to one or other of the groups of goods in class 18 identified by OHIM.

44. On the one hand, as regards the second group of goods in class 18 (leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery), the Board of Appeal rightly held that the distribution channels were different from those used for the distribution of goods in class 25. The fact that those two categories of goods may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (see, to that effect, Case T-8/03 *El Corte Inglés v OHIM – Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 43).

45. On the other hand, as regards the first group of goods in class 18, namely leather and imitation leather goods not included in other classes such as, for example, handbags, purses or wallets, it should be noted that those goods are often sold with goods in class 25 at points of sale in both major retail establishments and more specialised shops. That is a factor which must be taken into account in assessing the similarity of those goods.

46. It must be recalled that the Court has also confirmed the existence of a slight similarity between 'ladies' bags' and 'ladies' shoes' (*SISSI ROSSI*, paragraph 42 above, paragraph 68). That finding must be extended to the relationships between all the goods in class 25 designated by the mark applied for and the leather and imitation leather goods not included in other classes, in class 18, designated by the earlier mark.

47. In light of the foregoing, it must be held that there is a slight similarity between the goods in class 25 and the first group of goods in class 18. Consequently, the Board of Appeal could not conclude that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned.

48. As to whether clothing, footwear and headgear in class 25 are complementary to 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18, it must be recalled that, according to the case-law, goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking (*SISSI ROSSI*, paragraph 42 above, paragraph 60).

49. Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

50. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

51. It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which cannot be classified as slight."

Class 14

43. The clash between clothing and jewellery and watches was considered by the Hearing Officer in BL-O-280-09. She said:

"21. Jewellery is for personal adornment; watches are functional but may also be for personal adornment. Their nature, method of use and purpose (other than the fact, at a high level of generality, that they are worn) differ from clothing. Users for both are the general public. The channels of trade may differ or converge; there are specialist outlets for class 14 goods, but equally many clothes shops also sell costume or fashion jewellery side by side. They are not in competition; one would not substitute one for the other. This leaves a question as to whether jewellery and watches are complementary to clothing..."

And:

"Ltd submits that its registrations cover 'fashion items' which are identical or similar to the goods of the IR. Although the point is unexpanded, Ltd submits that there is a similarity in nature and purpose between 'fashion items', which would include goods in class 14 and classes 3 and 25."

44. This appears to me to be a very similar argument to that put forward by Mr Singh (see paragraph 9 above). I note that in *Oakley, Inc., v Office for Harmonisation in the*

Internal Market (Trade Marks and Designs) (OHIM) (Case T-116/06) the GC commented on the clash between the retailing of jewellery and watches and a trade in articles of clothing. The GC said:

“52. Regarding, third, the complementary nature of the services and goods in question, found to exist by the Board of Appeal in paragraph 23 of the contested decision, it should be pointed out that, according to settled case-law, complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (see, to that effect, *SISSI ROSSI*, paragraph 49 above, paragraph 60; *PAM PLUVIAL*, paragraph 49 above, paragraph 94; and *PiraÑAM diseño original Juan Bolaños*, paragraph 49 above, paragraph 48). “

And:

“85 Notwithstanding the fact that, as held in paragraphs 63 to 70 above, the signs are very similar, there is no similarity whatsoever between, in particular, retail services concerning eyewear, on the one hand, and items of clothing and leather goods, on the other hand. The earlier trade mark does not cover, directly or indirectly, goods similar to ‘eyewear, sunglasses, optical goods and accessories, watches, timepieces, jewellery, decals, and posters.

86. The intervener’s argument that eyewear, jewellery and watches could be similar or complementary to items of clothing cannot succeed, since, as correctly pointed out by OHIM, the relationship between those goods is too indirect to be regarded as conclusive. It must be borne in mind that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar (*SISSI ROSSI*, paragraph 49 above, paragraph 62).”

45. Having considered the comments of the GC, I have come to the same conclusion as the Hearing Officer in the case mentioned above i.e. there is no similarity between Mr Fazal’s goods in class 14 and the clothing in Mr Singh’s registration.

Class 18

46. Applying the decision of the CFI in *El Corte Inglés* to the current proceedings, it is clear that while there is a degree of similarity between the handbags and purses appearing in Mr Fazal’s application and the clothing appearing in Mr Singh’s registration, there is no similarity between Mr Singh’s goods and the leather and imitations of leather, animal skins, hides; trunks and travelling bags, rucksacks, umbrellas, parasols and walking sticks appearing in Mr Fazal’s application.

Conclusion on the similarity of goods

47. I have found that that the handbags and purses in Mr Fazal's application share a degree of similarity with the goods in Mr Singh's registration, but that there is no similarity in respect of the remaining goods in Mr Fazal's application i.e. jewellery, costume jewellery, watches, leather and imitations of leather, animal skins, hides, trunks and travelling bags, rucksacks, umbrellas, parasols and walking sticks. As there must be at least some degree of similarity between the competing goods to engage the test for likelihood of confusion, it will not be necessary for me to comment any further on the goods I have found not be similar. **Consequently, Mr Singh's opposition based on section 5(2)(b) of the Act fails in respect of:**

Jewellery, costume jewellery, watches, leather and imitations of leather, animal skins, hides, trunks and travelling bags, rucksacks, umbrellas, parasols and walking sticks.

Comparison of trade marks

48. For the sake of convenience, the trade marks to be compared are as follows:

Mr Singh's trade mark	Mr Fazal's trade mark
ROCKAFELLA	ROC-A-FELLA

49. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

50. The trade marks consist of ten and nine letters respectively, differing in respect of the letter K which appears as the fourth letter in Mr Singh's trade mark and which is not present in the trade mark of Mr Fazal. Presented as a single word in upper case Mr Singh's trade mark does not have a distinctive and dominant element; its distinctiveness lies in its totality. Although presented as three hyphenated elements, none of these elements can, in my view, be said to dominate Mr Fazal's trade mark; once again the trade mark's distinctiveness lies in its totality.

Visual/aural similarity

51. I have described the competing trade marks above. They are visually highly similar and, in my view, aurally identical.

Conceptual similarity

52. In my view the word ROCKEFELLER will be well known to the average consumer in this country as a surname; I am however less certain that the average consumer would know it was the surname of a wealthy American family or indeed how that family's surname was spelt. Although spelt differently, and despite the hyphenation, both trade marks in these proceedings are likely, in my view, to conjure up this surnominal significance in the mind of the average consumer; the respective trade marks are conceptually identical.

Distinctive character of Mr Singh's earlier trade mark

53. As the case law dictates, I must also assess the distinctive character of Mr Singh's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As I mentioned above, Mr Singh's trade mark is likely to be seen as a surname. Surnames are a common form of trade mark and are readily accepted as such by the average consumer. In my view, Mr Singh's trade mark is possessed of a reasonable level of inherent distinctive character, a level which has not, in my view, been improved upon to any appreciable extent by the modest use he has made of it.

Likelihood of confusion

54. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to consider the distinctive character of Mr Singh's trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

55. I have found that (i) the respective trade marks are visually highly similar and aurally and conceptually identical, (ii) there is a degree of similarity between the handbags and purses in Mr Fazal's application and the clothing in Mr Singh's registration, and (iii) Mr Singh's trade mark is possessed of a reasonable level of distinctive character. Applying

the interdependency principle to these conclusions, I am satisfied that the high level of overall similarity in the competing trade marks is sufficient to offset the limited degree of similarity in the goods, resulting in a likelihood of direct confusion i.e. the respective trade marks will be mistaken for one another.

Overall conclusion under section 5(2)(b)

56. Mr Singh's opposition succeeds in respect of:

Handbags and purses.

But fails in respect of:

Jewellery, costume jewellery, watches.

Leather and imitations of leather, animal skins, hides, trunks and travelling bags, rucksacks, umbrellas, parasols and walking sticks.

The objection based on section 5(3) of the Act

57. Section 5(3) of the Act reads as follows:

"5-(3) A trade mark which-

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

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 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."

58. The scope of Section 5(3) has been considered in a number of cases most notably: *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, C.A. *Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Davidoff & Cie SA v Gofkid Ltd (Davidoff)* [2003] ETMR 42, *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd (Adidas-Salomon)* (C-408/01) & in *Intel Corporation Inc v CPM (UK) Ltd ("Intel")* (C-252-07).

Proof of use regulations

59. Like section 5(2)(b), under section 5(3) of the Act an earlier trade mark for which the registration procedure was completed before the end of the five year period ending with

the date of publication of the applied for trade mark, may only be relied upon to the extent that it has been used (or that there are proper reasons for non-use). My conclusions in respect of the use made by Mr Singh of his ROCKAFELLA trade mark can be found in paragraphs 33 and 34 above and apply equally to this ground of opposition.

Reputation

60. In order to get an objection based upon section 5(3) of the Act off the ground, it is necessary for Mr Singh to prove that his ROCKAFELLA trade mark has a reputation. In *Chevy* the ECJ said:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

61. Although it is clear that Mr Singh has used his ROCKAFELLA trade mark, when one considers the extent of that use i.e. goods sold under the trade mark in the period 2004-2008 amounted to some £147,000 with promotional spend in the same period of £145,000, combined with the limited areas in which his trade mark has been used, it is, in my view, most unlikely that Mr Singh’s trade mark will, in the words of the ECJ, be “known by a significant part of the public concerned...” Without reputation the objection based on section 5(3) of the Act must fail and is dismissed accordingly.

The objection based on section 5(4)(a) of the Act

62. This section of the Act reads as follows:

“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.”

63. In reaching a conclusion on this ground of opposition, I note the comments of the Appointed Person, Mr Geoffrey Hobbs QC, in *Wild Child Trade Mark* [1998] RPC 455. In that decision Mr Hobbs said:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section

1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's 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 defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The material date

64. First I must determine the date at which Mr Singh's claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant

date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

65. The date of filing of Mr Fazal’s application is, therefore, the material date. However, if Mr Fazal has used his trade mark prior to this then this use must also be taken into account. It could, for example, establish that he is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that Mr Fazal’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer. Mr Fazal has not filed any evidence. The material date for the assessment is therefore the date of his application for registration i.e. 9 July 2008. In the absence of any evidence from Mr Fazal, I must make my assessment on what is known as a *quia timet* basis i.e. I must assess what would happen if Mr Fazal’s ROC-A-FELLA trade mark were to be used.

Goodwill

66. In order to succeed in an action for passing off, Mr Singh has to establish that at the material date there was goodwill in a business in which the ROCKAFELLA trade mark had been used. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first.”

67. The goodwill must be of more than a trivial nature. In *Hart v Relentless Records* [2002] EWHC 1984 Jacob J stated:

62 In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994 . The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see *per* Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472 . The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any

significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.

68. However, one does not need to be a large player to be protected under the law of passing-off. In *Stacey v. 2020 Communications Plc* [1991] F.S.R. 49 Mr. Justice Millett said:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

69. I also note that in *Stannard v Reay* [1967] FSR 140 it was held that:

“...even though the plaintiffs had only been trading for about three weeks, there was evidence of substantial takings by the business which fell when the defendants commenced trading. It was not impossible for goodwill in a new kind of business to be built up in a short period of time...”

(I note that the decisions in both *Stacey* and *Stannard* were made in the context of injunctive relief before full trial).

70. Finally, the following comment of Slade LJ in *Chelsea Man Menswear Limited v Chelsea Girl Limited and Another* [1987] RPC 189 is also relevant:

“However, the authorities show quite clearly that a plaintiff who has established a cause of action in passing off can obtain relief by way of injunction extending beyond the boundaries of the particular areas in which he has proved the existence of his reputation and goodwill.”

71. In order to make an assessment of whether or not Mr Singh has goodwill in a business conducted under the ROCKAFELLA trade mark, I must be possessed of sufficient information to reach an informed conclusion. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 Pumfrey J said:

“27. 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 Section 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.

28. 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 at 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 possibilities that passing off will occur.”

72. In *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J commented directly upon *South Cone* in the following terms:

“8 Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

73. Whilst there is a tension between the dates and locations on which Mr Singh says his ROCKAFELLA trade mark has been used, having reviewed his evidence earlier in this decision I concluded that (insofar as the objections based on sections 5(2)(b) and 5(3) of the Act were concerned), the ROCKAFELLA trade mark had been used in relation to “jackets, shoes and belts for men, made from leather or imitations of leather”. The totality of his evidence is, in my view, sufficient for me also to conclude that there is goodwill in the business which has conducted the trade in these goods under the ROCKAFELLA trade mark.

74. Mr Singh's evidence also indicates that the ROCKAFELLA trade mark has been used since no later than either 2000 or 2002 in relation to bags of leather and imitations of leather and from no later than 2005 in relation to costume jewellery. I am given no indication of what percentage of the sales figures provided in relation to sales of goods made from leather or imitations of leather is attributable to these non-clothing related items.

75. However, from the evidence provided (i.e. the invoices at exhibits A12, A23, A37 and the photographs at exhibits B14 and B15) I have been able to ascertain that some £2,300 has been spent purchasing items from JG Belts Ltd which are described as “side bag”, “double zip leather man bag” and “popper wallet”; I am also told that these items were sold under the ROCKAFELLA trade mark. It is, in my view, highly likely that when these goods were sold to the public a “mark up” would have been applied.

76. Insofar as the jewellery is concerned, I am told that between 2006 and 2008 sales of these goods amounted to no less than £8,000. Once again, a review of the evidence provided (the invoices at exhibits A36-A41 and the photographs at exhibits B8-B13) indicates that monies have been spent purchasing items described as, inter alia “skull key chain”, “skull wrist chain”, “waist chain”, “resin deco necklace”, “resin deco bracelet”, “rectangle stripe pendant on wire”, “rectangle stripe earrings on creoles” and “pewter star flower large pendant”.

77. Taking the most realistic view I can of the evidence provided (which as I mentioned above has not been challenged) and whilst keeping in mind the guidance provided in the cases mentioned above, I have come to the conclusion that the business which has used the ROCKAFELLA trade mark is also likely to enjoy a goodwill in relation to costume jewellery and bags and purses for men.

Misrepresentation/Damage

78. Earlier in this decision I commented on the high degree of similarity between the competing trade marks.. I have also concluded that that the business using the ROCKAFELLA trade mark has a protectable goodwill in relation to jackets, shoes and belts for men, made from leather or imitations of leather, costume jewellery, bags and purses for men.

79. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341 Lord Oliver said:

“Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff”

80. In *Harrods Limited v Harrodian School Limited* [1996] R.P.C. 697 Millet LJ said:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business...”

What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

“...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field

of activities of the defendant”; [Annabel's \(Berkeley Square\) Ltd. v. G. Schock \(trading as Annabel's Escort Agency\) \[1972\] R.P.C. 838 at page 844 per Russell L.J.](#)

81. In reaching a conclusion, I must keep in mind the nature and extent of the reputation enjoyed by Mr Singh’s business in the goods mentioned above, the class of persons targeted i.e. the public at large, the high degree of similarity between the competing trade marks and what is likely to be the relative closeness of the fields of activity in which Mr Fazal and Mr Singh operate. Having done so, it is, in my view, highly likely (given the manner in which a trade in these sort of goods is routinely conducted), that were Mr Fazal to put his ROC-A-FELLA trade mark into use in relation to jewellery, costume jewellery, watches, trunks and travelling bags, handbags, rucksacks, purses, umbrellas, parasols and walking sticks, the public would assume that they were goods emanating from Mr Singh’s business and that as a result Mr Singh’s business would suffer damage. While, in its simplest form, this damage is likely to take the form of a direct loss of sales, it could also take the form of either injurious association or damage caused by inferior goods. Insofar as the former is concerned in *Ewing v Buttercup Margarine Company, Limited* 34 RPC 232 Warrington LJ said:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

82. And in relation to the latter in *Rolls-Royce Motors Ltd. and Another v Zanelli and Others* [1979] RPC 148 Mr Justice Browne-Wilkinson said:

“When I come to consider the balance of convenience I am satisfied that the damage which may be done to the plaintiffs, if inferior work is put out as being the work of Rolls-Royce, is quite incalculable and of very great financial harm to Rolls-Royce. On this aspect of the case they are certainly in a very unusual position, in that a large part of the goodwill of Rolls-Royce does depend on their reputation for immaculate finish and engineering. Anything which might impinge on that reputation could do incalculable harm.”

83. However, notwithstanding the conclusion in paragraph 81, I do not think that the type of goods for which Mr Singh’s business enjoys a goodwill or the manner in which a trade is routinely conducted in those goods is sufficiently similar for Mr Singh to prevent the use by Mr Fazal of his ROC-A-FELLA trade mark in relation to leather and imitations of leather, animal skins, hides and clothing for animals.

Conclusion under section 5(4)(a)

84. Mr Singh’s opposition succeeds in relation to:

Jewellery, costume jewellery, watches trunks and travelling bags, handbags, rucksacks, purses, umbrellas, parasols and walking sticks.

but fails in relation to:

Leather and imitations of leather, animal skins, hides, clothing for animals.

Summary of conclusions

85. The following goods in Mr Fazal's application were not opposed:

14 - Precious metals and their alloys, precious stones; horological and chronometric instruments, clocks.

18 - Whips, harness and saddlery.

86. Under section 5(2)(b) of the Act, Mr Singh's opposition has succeeded in relation to:

Handbags and purses

but has failed in respect of the other goods opposed.

87. Mr Singh's opposition based upon section 5(3) has failed in its entirety.

88. Under section 5(4)(a) of the Act Mr Singh's opposition has succeeded in relation to:

Jewellery, costume jewellery, watches trunks and travelling bags, handbags, rucksacks, purses, umbrellas, parasols and walking sticks.

but has failed in relation to:

Leather and imitations of leather, animal skins, hides, clothing for animals.

89. In summary Mr Fazal's application may proceed to registration in respect of:

14 - Precious metals and their alloys; precious stones; horological and chronometric instruments, clocks.

18 - Leather and imitations of leather; animal skins, hides; whips, harness and saddlery; clothing for animals.

Costs

90. As both parties have achieved a measure of success in these proceedings I do not intend to favour either with an award of costs.

Dated this 18 day of January 2011

**C J BOWEN
For the Registrar
The Comptroller-General**