

O-010-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2189121B
BY THE SECRETARY OF STATE FOR DEFENCE IN
HER BRITANNIC MAJESTY'S GOVERNMENT OF THE
UNITED KINGDOM OF GREAT BRITAIN & NORTHERN IRELAND
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERTO UNDER
No. 90484 BY ARCADIA GROUP BRANDS LTD**

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by the Secretary of State for Defence in Her Britannic
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**IN THE MATTER OF Opposition thereto under
No. 90484 by Arcadia Group Brands Ltd**

BACKGROUND

1. On 17 February 1999, the Secretary of State for Defence in Her Britannic Majesty's Government of the United Kingdom of Great Britain & Northern Ireland, applied to register the following trade mark in relation to "Articles of outer clothing; shirts, coats, jackets, trousers, sweatshirts; Jeans; T-shirts, vests, shorts; underwear; night-wear; skirts, blouses; overcoats, rainwear, waterproof clothing; sweaters, pullovers, cardigans; ties, belts, scarves; sports clothing; footwear; shoes; boots; boots for sports; caps, hats, headgear including base-ball caps; body suits; socks; gloves; parts and fittings for all the aforesaid goods; all relating to the Royal Air Force":



Mark claim/limit:

The applicant claims the colours red, white and blue as an element of the mark.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 16 April 2002, Arcadia Group Brands Ltd filed a Notice of Opposition. In summary the Notice set out the following grounds:

(a) Under Section 3(1)(b) as the target device is not distinctive of such goods emanating from the applicant.

(b) Under Section 3(1)(d) as the target device consists exclusively of signs or indications which have become customary in the bona fide and established practices of the trade.

(c) Under Section 3(6) as at the date of the filing of the Application, the applicant has no bona fide intention to use the target device as a trade mark in relation to the goods for which registration is sought.

(d) Under Section 5(2)(b) on the basis of an earlier Community Trade Mark – No. 860130, which is registered in respect of “clothing, footwear, headgear” in Class 25 and is shown below:

Description of colours claimed:

Rouge: dans le centre de la cible, blanc: l’anneau suivant, bleu: l’anneau extérieur, noir: la légende “Tim Carter”.



On this basis a likelihood of confusion, including a likelihood of association will be created.

(e) Under Section 4(1)(d) as the target device is a device likely to lead persons to think that the applicant either has or has recently had Royal patronage or Royal authorisation.

4. The applicant filed a counterstatement in which the grounds of opposition are denied. The applicant also adds that the only valid grounds are section 3(1)(b) and (d)

and 3(6). Section 5(2)(b) cannot be a valid ground as the opponent does not own any earlier right upon which this ground can be based.

5. Both sides filed evidence in these proceedings and asked for an award of costs to be made in their favour. The matter came to be heard on 11th November 2003 when the applicant for registration was represented by Ms Heal of counsel instructed by the Directorate of Intellectual Property Rights, Ministry of Defence and the opponent by Mr Lynd of Edward Evans Barker Trade Mark Attorneys.

Opponent's Evidence

6. This consists of four statutory declarations. The first, dated 26 November 2002 is from Mr Michael Lynd. Mr Lynd explains that he is a Trade Mark Attorney and partner in the firm of Edward Evans Barker, the representatives of the opponent in this matter. Mr Lynd confirms that he has read the counterstatement of the applicant. In response to the applicant's assertion that the opponent is not entitled to plead Section 5(2)(b) as a ground of opposition as they are not the proprietor of the earlier right mentioned, Mr Lynd argues that Section 38 of the Trade Marks Act 1994 states that "any person" may oppose and that it is well established that the opponent does not need to own the earlier right upon which they seek to rely.

7. In seeking to establish that "Mod" culture is still prominent in fashion in the UK, Mr Lynd refers to the following exhibits to his declaration:

- Exhibit MAL1 comprising pages taken recently of Lambretta Fashion Clothing and Accessories, which show items of clothing bearing "target devices" on them;
- Exhibit MAL2, a page taken from a website of a Swedish company called Rudetrade, which shows a T-shirt on sale bearing a "target device" identical to the trade mark of the Application in suit;
- Exhibit MAL3 shows a page taken from the website of Sherry's clothes shop. Sherry's sells a wide range of clothing items and uses a "target device" on its website. MAL4 shows further pages taken from this website;
- Exhibit MAL5 shows pages from a "Mod" website, which runs discussions on anything "Mod". The website states that there are many present day mods, including a variety of modern bands such as Oasis, The Jam and Ocean Colour Scene;
- Exhibit MAL8 shows web page entitled "On Target" which sells "target" merchandise;
- MAL11 shows pages taken from the website of lets Goretro.com. There are frequent appearances of the "target device";
- MAL12 shows a parka for sale, from lets Goretro.com. MAL13 shows further pages from this site with other items of clothing for sale;

- MAL14 shows “target” t-shirts for sale;
- MAL15 shows web pages which identify the “target device” as the “Mod Target”. The exhibit also shows clothing carrying the target device image;
- MAL16 shows a press release dated 29 June 1996 issued by Reuters. The release is in relation to the rock band The Who and mentions that the singer, Roger Daltrey, sported an eye patch with the “target device” following an accident at rehearsals;
- MAL19 shows a web page where it can be seen that the entire background for the website consists of “target devices”;
- MAL22 are pages taken from the website of “Positively 13 O’clock” an original vintage clothing company based in Leeds, which has been operating for 10 years and makes repeated use of the “target device”;
- MAL23 shows a web page entitled “We are the Mods”- this site features repeated uses of the “target device”;
- Exhibits MAL27-30 show a variety of websites featuring clothing bearing the “target device”;
- MAL31 shows a web page entitled “Mod Culture” and features the target device as well as showing the band The Who, one of the band members bearing a “target device”.

8. Mr Lynd argues that the above exhibits show that the “target device” has been used by various third parties not associated with the applicant and as such shows that the application in suit lacks distinctive character for the specification filed.

9. Mr Lynd explains that exhibits MAL38- MAL51 show a variety of photograph prints which he took around the Covent Garden and Carnaby Street areas of London. Mr Lynd argues that the photographs establish that there is widespread usage by third parties of the “target device” in relation to clothing and that the applicant should not be granted a monopoly in the “target device” in relation to clothing.

10. In relation to all the exhibits referred to, Mr Lynd asserts that there are a number of inferences that can be drawn. That a significant section of the public is aware of Mod culture; that the evidence shows that the “target device” does, in relation to clothing, have a primary meaning of “pertaining to the Mods” and finally, that the evidence shows regular and widespread use of the “target device” by third parties unconnected with the applicant in relation to clothing. The bulk of exhibits filed with Mr Lynd’s declaration relate to the position after the relevant date for these proceedings.

11. The second statutory declaration, dated 28 January 2003, is from Mr Miles Gray. Mr Gray explains that he is the Chief Executive of Ben Sherman Group Limited and Sherman Cooper Marketing Limited. After explaining the history of the Ben Sherman brand, Mr Gray estimates that Ben Sherman Group Limited has been using a

red, white and blue “target device” trade mark in respect of clothing and accessories since the mid-1990s and that Sherman Cooper Marketing Limited has been using the same device in relation to footwear for at least four years. The “target device” has been used as sewn-in neck labels on the inside of garments; as side labels for knitwear, as part of the design of embroidered sweatshirts and on graphic and printed t-shirts; on the label of casual jackets and as part of the back-pocket tab label of jeans.

12. Exhibits MG1- MG6 show examples of how the “target device” has been used on various items of clothing, footwear and related accessories. MG7 shows photographs of Ben Sherman Group Limited’s headquarters, which show that the premises are adorned with huge e.g. white and blue “target device” motifs. MG8 shows a screen capture of the Company’s website, again with the pop-up screen prominently displaying the target device.

13. Exhibits MG9 to MG11 show various items of clothing with the “target device” appearing in the back neck labels or as an embroidered label on the front of the garment.

14. Mr Gray estimates that around 12-15% of overall sales of clothing made by Ben Sherman bears the “target device” image.

15. The third statutory declaration is dated 24 January 2003 and from Mr Robert Cohen. Mr Cohen states that he is the Director of Lambretta Clothing Company Ltd. Mr Cohen explains that his company was incorporated in February 1997, selling “Mod” clothing for men and women and has also more recently begun to sell clothing accessories. Lambretta have three shops in the UK, two in London and one in Leeds, but exhibit RC1 shows a current list of the retail outlets around the UK which sell Lambretta products. Lambretta also supplies the leading mail order houses in the UK, including GUS, Littlewoods, Freemans and Grattan.

16. The turnover of Lambretta has grown steadily, with turnover for the year ending 31 March 2002 (after the relevant date for these proceedings) being in the region of £10 million, £2 million of which is estimated to have sales purely from clothing bearing the “target device”. The anticipated figure for the financial year ending 2003 is £13-£14 million.

17. Mr Cohen states that the target device has been used by Lambretta since the company began. Exhibit RC2 shows a copy of an invoice dated 18 January 1998, Lambretta’s first order for t-shirts bearing the “target device”. He states that half the items on the invoice (1,002) bore the “target device”.

18. Exhibit RC3 shows the different ways in which the “target device” is used on Lambretta clothing. These include cardboard labels for jeans; swing tickets; woven patches and labels. Exhibits RC4-RC11 show a variety of items of clothing with the “target device” used on them.

19. Lambretta currently spend around £30,000 on advertising per season (there being 2 seasons per year). Exhibits RC12- RC16 show copies of magazine front pages together with the specific pages that mention Lambretta together with the “target

device”. The magazine titles include Express Magazine; Schuh and Envy. I note that all the magazines are dated after the relevant date in these proceedings.

20. Exhibit RC17 shows pages taken from a Great Universal Mail Order Catalogue for autumn-winter 2001 (after the relevant date), again showing items of clothing bearing the “target device”.

21. Exhibit RC18 shows a copy of Lambretta’s own promotional periodical publications. “Target devices” appear on almost every page of the periodical and also feature the device on items of clothing.

22. Exhibit RC19 shows pages from Lambretta’s own website again showing items of clothing bearing the “target device”. RC20 shows another website owned by a different company selling Lambretta products , again bearing the target device.

23. Exhibit RC21 shows illustrations of some of the products Lambretta have produced which incorporate target devices. Mr Cohen ends by stating from his own knowledge he is aware that red, white and blue “target devices” have been extensively used in relation to clothing by very many clothing companies, throughout the UK for very many years. As the red, white and blue target devices are widely associated with the Mod revivals, the device should be free for use in the UK in relation to clothing by all parties. Mr Cohen emphasises his fear that if the application in suit proceeds to registration, then the applicant will be able to prevent Lambretta from using this device or demand licence fees or royalty payments from them. The bulk of exhibits filed with Mr Cohen’s declaration relate to the position after the relevant date for these proceedings.

24. The fourth statutory declaration is dated 27 January 2003 and is from Mr Javid Alavi. Mr Alavi explains that he is the Chairman of the Merc Group of Companies. Mr Alavi advises that he started trading under the name MERC in 1967 and the clothing sold has always reflected Mod fashion. The red, white and blue “target device” became associated with Mod fashion in the 1960’s; MERC began to sell clothing bearing this device in 1975 and has continued to do so to the present day. Exhibit JA1 shows an example of the clothing produced by the MERC company which is claimed to be by Mr Alavi as typical of the ways in which Merc clothing has used the “target device” in relation to clothing since 1975.

25. Exhibits JA2- JA4 show a number of ways in which the “target device” is used by Merc, including on display cards and on bags and purses. Merc also sell clothing through mail order; other retail outlets and on the internet. The business has approximately 70,000 mail order customers and since the 1980s, the turnover of the Merc business in clothing bearing the “target device” has been at least £100,000 per annum.

26. Exhibits JA5 and JA6 show copies of invoices for the Merc business dated 30 May 2001 and 29 September 1999 respectively, both being outside the relevant date in these proceedings.

27. Exhibit JA7 shows the current catalogue of the Merc business. Around 12,000 copies have been distributed in the UK. The “target device” is clearly seen on the covers of the catalogue and on items contained within the catalogue.

28. Mr Alavi feels that it would be wrong to permit the RAF to obtain a registration of the “target device” in relation to clothing and thus give them the power to prevent him from using the device that he has been using in the UK in relation to clothing for more than 25 years.

Applicant’s Evidence

29. This consists of a witness statement, dated 1 April 2003, by Mr Moolamkuzhiel Raghavan Viswanathan Nair. Mr Nair explains that he works for the Ministry of Defence’s Intellectual Property Rights Group, which is responsible for the protection and licensing of RAF insignia.

30. Mr Nair refers to the “target device” as the “roundel” and says that this was first used during the First World War as an identification mark for British military aircraft. The red, white and blue “roundel” is reserved for non-combat aircraft such as trainers and search and rescue aircraft and is the corporate logo of the RAF (as shown by Exhibit MRVN 15).

31. Exhibit MRVN1 comprises an advertisement taken from the April 1998 edition of Royal Air Force News, showing neck ties depicting the “roundel”.

32. Exhibits MRVN2 and MRVN3 show advertisements for air shows and it is stated that the advertisement’s use of the “roundel” links the air shows with the RAF.

33. Exhibit MRVN4 shows an article taken from the Royal Air Force News of November 1998, concerning the new logo of the Royal Air Force Benevolent Fund, a charity closely associated with the RAF. It is stated that the use of the “roundel” on the logo again links the Fund to the RAF.

34. Exhibit MRVN5 shows a picture of a banner taken from RAF News of April 1998. Again the “roundel” is shown on the banner.

35. Exhibit MRVN6 shows an article in RAF News dated 3 April 1998, showing use of the “roundel” on the RAF Team Bobsleigh. MRVN7 shows the same.

36. Exhibit MRVN8 shows an article in MOD Focus dated October 1998, showing the use of the “roundel” within the Ministry of Defence as part of the logo of the RAF’s Support Chain Management Group.

37. Exhibit MRVN10 shows a brochure dated 1998, advertising the RAF Parachute Display Team, the “Falcons”. The roundel is used.

38. Exhibit MRVN11 shows a series of letters dating to 1998 licensing the use of the RAF “roundel” by Eastbourne Borough Council. It is stated that this series of letters demonstrates the Ministry of Defence, that it alone, is entitled to reproduce the “roundel” in connection with events relating to air shows.

39. Exhibit MRVN12 shows a series of letters dated to 1998 concerning the use of the “roundel” in relation to computer software.

40. Exhibit MRVN13 is a copy of a news item taken from the BBC website illustrating T-shirts bearing the RAF “roundel”.

41. Exhibit MRVN14, shows a recruitment advertisement, which it is stated shows the “roundel” being used as a corporate logo of the RAF. The “roundel” is also reproduced on the fascias of high street Armed Forces Careers offices, of which there are 52 such offices in the UK.

Opponent’s Evidence in Reply

42. This consists of a statutory declaration, dated 26 July 2003 from the same Michael Lynd who previously filed a declaration, dated 26 November 2002 in these proceedings. Mr Lynd confirms that he has read the statutory declarations of Miles Gray, Robert Cohen and Javid Alavi for the opponent and the witness statement of Moolamkuzhiel Raghavan Viswanathan Nair for the applicant. In relation to Mr Nair’s witness statement, Mr Lynd makes several criticisms:

- In relation to advertisements etc shown in the RAF News, no information is provided as to whether it was published in the UK or how many copies were produced;
- In relation to an article taken from RAF News for November 1998, Mr Nair has not provided any publication details; it is unclear as to whether the publication is available in the UK or in what numbers. Mr Nair provides no evidence that the RAF Benevolent Fund was authorised or licensed by the RAF to make use of a “target device” in November 1998;
- In relation to Exhibits MRVN5 and 6, Mr Lynd argues that there is no evidence that this publication was available in the UK or in what numbers. Mr Nair further provides no evidence that the use in April 1998 by the RAF Amateur Radio Society was with the licence or authority of the RAF;
- Exhibit MRVN8 is said to be an article for “MOD Focus”. It is unclear what this publication is and whether it has any circulation in the UK;
- Exhibit MRVN10 is a brochure dated 1998. Again it is unclear whether it was available in the UK, or any numbers of copies of the brochure that may have been available;
- In relation to the letters between the Ministry of Defence and Eastbourne Borough Council, Mr Lynd argues that the attitude of the Ministry of Defence in enforcing what they see as their rights in the “target device” is exactly what the opponent and their declarants fear will happen if the application is permitted to proceed to registration. Mr Lynd further

refers to a specific passage of a letter shown at Exhibit MRVN12, which he argues adds force to the opponent's fears as it suggests that the RAF is claiming proprietary rights in all devices of three concentric circles, not merely those coloured red, white and blue;

- Exhibit 2MAL7 shows devices used by many air forces of many countries of the world to designate their aircraft. All of these consist of devices of three concentric circles, frequently in red, white or blue, or combinations thereof;
- Exhibit 2MAL9 shows results of a trade mark search carried out by Mr Lynd on 11 July 2003 which shows that there are several UK and Community Trade Mark registrations for red, white and blue "target devices" including one for clothing in class 25 under number 1078419 in Exhibit 2MAL10;
- In relation to Exhibit MRVN13, which is a copy of a news item taken from the BBC website, Mr Lynd refers to Exhibit 2MAL11 which shows that this is dated 1 October 2002 and is therefore outside the relevant date;
- In relation to Exhibit MRVN14, Mr Lynd notes that the recruitment advertisement is dated 23 October 2001, which again is outside of the relevant date in these proceedings.

43. This completes my summary of the evidence.

PRELIMINARY ISSUES

44. In his skeleton argument forwarded on behalf of the opponent, Mr Lynd (on the day prior to the hearing) made mention of a new Section 5(1) ground of opposition based upon prior registration 1078419, a "target device" registered in Class 25 for "Articles of sports clothing". However, the existence this registered trade mark was not apparent until the opponent's evidence in reply, dated 26 July 2003, was filed and in the context of this evidence the existence of this registration can be seen as relating to "state of the register" information.

45. Prior to the hearing I reminded Mr Lynd that there was no mention of a Section 5(1) ground, or indeed registration number 1078419, in the Statement of Grounds of Opposition and pointed out that it could not have been reasonably been inferred that the opponent was raising a Section 5(1) ground prior to the receipt of the skeleton argument. These points were accepted by Mr Lynd who nevertheless formally requested that the Statement of Grounds be amended to allow the Section 5(1) ground.

46. Mr Lynd confirmed that the opponent was aware of registration number 1078419 prior to the filing of its Evidence in Reply and he stated that the failure to raise the Section 5(1) ground of opposition prior to the hearing was "an oversight".

47. On behalf of the applicant, Ms Heal strongly resisted the proposed amendment to the Statement of Grounds, pointing out the late nature of the request and that the

opponent had long known of the existence of registration number 1078419 prior to making the request.

48. I drew the parties attention to a Registry Tribunal Practice Notice (TPN 4/2000), in particular paragraph 22 thereof, which reads as follows:

TPN 4/2000 – Paragraph 22:

“Amendment to statements of case and counter-statements

As parties will be expected to file focused statements of case and counter-statements, the Trade Marks Registry will consider requests to amend these documents later in the proceedings. Amendments may include adding or removing grounds of opposition/revocation or invalidity or correcting information contained therein. If an amendment becomes necessary parties should seek leave to make the amendment at the earliest opportunity. When seeking leave to amend full details of the amendment together with the reasons for the amendment should be submitted. Whilst each request to amend will be considered on its merits the Registry will aim to give favorable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties quickly and at less cost. If the amendment requires the other party to file an amended counter-statement or additional evidence, an award of costs to cover this may be made.”

49. TPN 4/2000 makes it clear that requested amendment to the pleaded grounds will be looked upon positively if possible, but it is not the intention of this approach to encourage piecemeal pleadings, as and when they occur to a party. The approach is also conditional in that the application to amend should be made at the earliest opportunity, with details of the requested amendment and reasons for the amendment. Furthermore, the following comments by Geoffrey Hobbs QC, sitting as the Appointed Person in the *Demon Ale Trade Mark* [2000] RPC 345, make it apparent that there is an onus on the opponent to clearly focus its Statement of Grounds:

“Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focused statement of the grounds upon which they intend to maintain that the tribunal should or should not do what it has been asked to do. The statement should not be prolix. It should, however, be full in the sense indicated by Mr Simon Thorley QC in *COFFEEMIX Trade Mark* [1998] RPC 717 at 722:

“It must be full in the sense that it must outline each of the grounds relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible, but it must be complete”.

50. In not allowing the amendment to the Statement of Grounds I took into account the late nature of the request, the fact that the information upon which the amendment was requested was known to the opponent for over three months (at least) prior to the

request, that the objection had not been foreshadowed prior in the run up to the hearing and that the applicant would have been unduly prejudiced.

51. Ms Heal raised a preliminary point relating to the opponent's evidence, much of which, she submitted, comprised submissions and also evidence which related to matters after the relevant date for the proceedings ie 17 February 1999. She requested that such "evidence" be struck-out.

52. While I understand Ms Heal's concerns, it is unfortunately not unusual for such "evidence" to be filed in opposition proceedings before the Registrar and Ms Heal accepted that in the present case, I would deal with such "evidence" on a pragmatic basis in that I would consider submissions presented as evidence merely as submissions to which I would give appropriate weight (if any) and that evidence which should not be given weight would not be taken into account in the reaching of my decision.

53. At the request of Ms Heal I also sought clarification on whether the opponent was pursuing a Section 3(3)(a) ground of opposition. Mr Lynd confirmed that no such ground had been raised or was being pursued.

54. Prior to the hearing Mr Lynd withdrew the grounds of opposition based upon Section 3(6) and Section 4(1) of the Act. Accordingly, only the Section 3(1)(b), Section 3(1)(d) and Section 5(2)(b) grounds remain.

DECISION

55. Firstly, I go to the Section 3(1) ground and the relevant parts of Section 3(1) of the Act read as follows:

"3.-(1) The following shall not be registered -

- (a)
- (b) trade marks which are devoid of any distinctive character,
- (c)
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

56. In the present case I must consider, on a prima facie basis, whether the mark in suit meets the requirements of Section 3(1)(b) and (d) of the Act. The applicant has not submitted evidence that its mark has acquired a distinctive character as a result of the use made of it in relation to the goods of the application.

57. Section 3(1)(b) of the Act provides for refusal of a trade mark on the ground that the mark in question is devoid of any distinctive character. In the application of Section 3(1)(b) I am assisted by the principles set out in the following decisions – *Cycling IS*..... [2002] RPC 37, *Libertel Group BV v Benelux Markenbureau*, Case C-104/01 and *Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01; which can be summarised as follows:

- (a) the exclusions from registrability contained in Section 3/Article 3 are there to ensure that trade marks whose use could successfully be challenged before the Courts are not registered. The defense available to other traders by virtue of an objection under Sections 3(1)(b) operates independently of objections under Section 3(1)(c) (*Cycling IS*paragraph 43-45 and *Linde* paragraphs 67-68);
- (b) for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- (c) it is legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them come from the same undertaking or economically-linked undertakings (*Cycling IS*.... paragraph 53);
- (d) a trade mark's distinctiveness is not to be considered in the abstract but rather be reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel* paragraphs 72-77 and *Cycling IS*paragraphs 54-61);
- (e) the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

58. While I take judicial notice of the fact that the RAF roundel is associated with the Royal Air Force in relation to the defence of the realm, the applicant's evidence does not substantiate a claim that, in fact, the mark in suit indicates the RAF as the trade origin of the goods specified in the application, although it does show some relevant use of the roundel in relation to clothing eg the neck ties offered for sale by the Royal Air Force Association in 1998 (Exhibit MRVN1). However, as pointed out by Ms Heal, the burden is not on the applicant to prove the distinctiveness of its mark, it is for the opponent to show that the mark should not be registered.

59. The opponent contends that the mark in suit, which it describes as the “target device”, has been used by numerous third parties in relation to clothing since the 1960s and in particular, has been closely associated with the style of dress worn by Mods, a group of individuals who from the 1960s became identified by their clothes consciousness, their fondness for motorised scooters and opposition to certain other groups.

60. Although the opponent’s evidence can be criticised (paragraphs 51 and 52 of this decision refer), in particular because it shows the availability of clothing bearing the “target device” after the relevant date for these proceedings, Mr Lynd, at the hearing, submitted that much of the evidence was relevant in that:

- (i) use after the relevant date can infer use before that date;
- (ii) the evidence contained in a number of exhibits contains historical information relating to the use of the “target device”;
- (iii) the evidence contained in a number of exhibits shows that use of the “target device”, while subject to changes in fashion trends, did not die in the 1960s and continues; and
- (iv) there is specific evidence from clothing businesses to say that they were using the “target device” on clothing prior to the relevant date.

61. While a good deal of the evidence relates to use of the “target device” after the relevant date, Mr Lynd drew specific attention to the following exhibits which were attached to his declaration of 26 November 2002 –

- (i) Exhibit MAL 1 – a 2002 extract from the LAMBRETТА internet site which states at paragraph 4:

“Whilst Ben Sherman and Fred Perry were perhaps the clothing brand of choice for many 60s Mods, Lambretta recognised this style revival years ago. The development of their superb clothing and accessories range is easily recognised today through the Target, Union Jack and St George motifs.”

- (ii) Exhibit MAL 15 – an extract taken from a MODREVIVAL website on 18 October 2002 which includes the following comments adjacent to a representation of the “target device”.

“A mod icon, unfortunately far too commercialised now, but I absolutely love the moment, while wearing a target top, when I’m asked “are you a mod then?”

- (iii) Exhibit MAL 17 – an article from a Mods website accessed on 18 October 2002, which includes the following statement:

“In fact, “the target shirt” was made famous by The Who and represents Mods even to this day”

62. Mr Lynd went on to comment on the evidence filed on behalf of the opponent by Mr Alavi, Mr Cohen and Mr Gray (paragraphs 11 to 28 of this decision refer).

63. In relation to Mr Alavi's evidence, Mr Lynd pointed out Mr Alavi clearly had unambiguously sworn that his business has sold clothing bearing a red, white and blue target device from 1975 to the present day and that Exhibit JA 1 to Mr Alavi's declaration contains an example of a t-shirt bearing the "target device" which Mr Alavi says is typical of the way his Merc clothing business has used the "target device" in relation to clothing. Mr Lynd also drew attention to Mr Alavi's statement that since the 1980s, the turnover of his business in clothing bearing the "target device" has been at least £100,000 per annum.

64. Turning to Mr Cohen's evidence, Mr Lynd drew attention to the statement in the declaration that Mr Cohen's company has "used a red, white and blue target device in relation to its clothing almost from the very inception of the company" – its inception being 11 February 1997. Mr Lynd also pointed out that Exhibit RC 2 to Mr Cohen's statement is a copy of an invoice dated 18 January 1998 from a Hong Kong clothing manufacturer for his company's very first order and that Mr Cohen declared that 1,002 of the t-shirts bore the "target device".

65. In relation to Mr Gray's statutory declaration, Mr Lynd drew attention to Mr Gray's statement that Ben Sherman Group Limited have been using a red, white and blue "target device" in respect of clothing since the mid 1990s, his comments about the various garments on which the "target device" had been used and the sales estimates.

66. While I accept Ms Heal's criticisms of much of the opponent's evidence, I take the view that the specific evidence mentioned above goes to demonstrate that prior to the relevant date for these proceedings, the mark, which is the subject of the application in suit, has been in use to a significant degree as a decorative motif or emblem, in particular by those persons who associate themselves with the grouping known as the Mods. The evidence provides historical information to this effect and the declarations of the opponent's witnesses are clear in relation to their business activities in selling goods bearing the "target device". I have no reasons for doubting the accuracy of their statements in this matter. Furthermore, in the circumstances of the present case, I tend to agree with Mr Lynd that the availability of clothing in the UK bearing the "target device" after the relevant date is indicative of the availability of such clothing prior to the relevant date.

67. At the hearing Ms Heal criticised the opponent's approach in, as she put it, attempting to show that the mark was distinctive of the Mods and therefore incapable of becoming distinctive of the RAF. However, it seems to me that the heart of the issue under Section 3(1)(b) is whether the mark, in the ordinary course and circumstances of trade, would identify the products in respect of which registration is applied for, as originating from a particular undertaking, thereby distinguishing the product from those sold by other undertakings. In my view the Mods as such could not be regarded as a source of trade origin in relation to the goods. However, the fact that clothing bearing the "roundel" or "target device" was commonly identified with

and worn by Mods indicates that the “roundel” or “target device” was acting as a decorative motif or emblem as opposed to being a sign demonstrating trade origin.

68. In the present case the evidence shows that clothing bearing the “roundel” or “target device” is available from different sources and it seems to me that it can be readily inferred, that the “target device” on clothing is perceived as a decorative motif or emblem, which many would associate with the Mods grouping. In my view the relevant public ie those persons who purchase clothing articles – the public at large, who are to be regarded as reasonably well-informed and reasonably observant and circumspect (*Libertel*, paragraph 46), are not likely to see the mark in suit as an indicator of trade origin, but rather as a decorative motif, which they could associate with the Mods, the Royal Air Force or a variety of suppliers, but not in the context of any being the undertaking whose goods are solely identified by the mark.

69. At the hearing Ms Heal submitted that the limitation contained in the applicant’s specification of goods ie “all relating to the Royal Air Force” would mean that the goods sold under the mark in suit would only be associated with the RAF in the context of their trade origin. In answer to my queries, Ms Heal stated that in use of the mark, the applicant would have to demonstrate to the civil standard of proof that the use was indicative to the purchaser that the goods in question were clothing articles emanating from the RAF or its licensees and that this was a matter the RAF would have to be conscious of.

70. While I have given Ms Heal’s submissions consideration I fail to see how the limitation to the specification assists in relation to Section 3(1) of the Act as the limitation does not affect the way in which the mark, in itself, would be perceived by the public in the ordinary course and circumstances of trade. A mark or sign which, in itself, does not indicate trade origin cannot meet the requirements of Section 3(1) if, in order for it to distinguish its goods, other material eg a house mark or other indicators of origin, must be added. Such a sign mark would not function as a trade mark and should not, of itself, be the subject of a monopoly.

71. To conclude, in relation to the Section 3(1)(b) ground I find that the device comprising the mark in suit has been used since the 1960s to a significant degree as a decorative motif or emblem on articles of clothing and prior to the relevant date has been used by a number of different traders. It has, in particular, been associated with a group of persons known as Mods and while its popularity has ebbed and flowed with fashion, clothing bearing the “roundel” or “target device” has remained available to the public. I have reached the view that, in the ordinary course and circumstances of trade, the mark in suit would not denote the trade origin of the goods in relation to any particular undertaking. In my view the relevant public are likely to perceive the mark, when used in relation to clothing, as a decorative motif or emblem on goods which could originate from a number of different sources or business undertakings.

72. In the light of the above, the mark applied for is devoid of any distinctive character and the opposition succeeds under Section 3(1)(b).

73. Turning to the Section 3(1)(d) ground I note that Jacobs AG in his opinion in *Proctor & Gamble v Office for Harmonisation In the Internal Market* [2001] ETMR 75 stated:

“As the Court of First Instance rightly noted, it is sufficient for one of the absolute grounds for refusal to apply for a sign to be ineligible for registration as a trade mark. Moreover, I cannot envisage any circumstances in which, in practice, it might be important to determine whether more than one absolute ground might apply.”

74. As the application is to be refused under Section 3(1)(b) of the Act I see no need to consider the objection under Section 3(1)(d) of the Act. Furthermore, in light of my decision under Section 3(1)(b), I have no need to consider the Section 5(2) ground.

COSTS

75. The opponent is entitled to a contribution towards costs. At the hearing, Ms Heal submitted that, on costs, I should bear in mind that two grounds of opposition were withdrawn at the start of the hearing and that there was a good deal of irrelevant material contained within the opponent’s evidence.

76. I have some sympathy with the opponent’s view on this issue. However, the Section 3(6) and Section 4(1) grounds were not supported by the evidence filed and the superfluous evidence filed in relation to the other grounds was not of a complex nature. I do not consider that these issues would have added significantly to the applicant’s costs but the costs award, stated below, reflects a £100 reduction in respect of these factors.

77. I order the applicant to pay the opponent the sum of £1,900. 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 13th day of January 2004

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General