

SUPPLEMENTARY DECISION

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 2621301A
BY THE JOCKEY CLUB
TO REGISTER THE TRADE MARK
THE JOCKEY CLUB
IN CLASSES 18 & 25
AND IN THE MATTER OF APPLICATION No. 2621303
BY THE JOCKEY CLUB
TO REGISTER THE SERIES OF TWO TRADE MARKS**



**IN CLASSES 18 & 25
AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER No. 104177A AND 400841 BY
JOCKEY INTERNATIONAL INC.**

- 1) On 22 December 2014 I issued decision O-553-14 in which I found in favour of the applicant. At the hearing it was agreed that the decision would be issued and that both parties would then have the opportunity to provide written submissions on costs.
- 2) Both sides have provided comments which I shall refer to as and when necessary.
- 3) Before moving onto the issue of costs there is an error in my earlier decision which requires amendment. In paragraph 80 I stated that the table provided by the opponent referring to use and reputation “did not list what mark each exhibit was being used to defend”. This was incorrect. The list did list the mark, the problem was that, for the most part the opponent was relying upon marks which were variations rather than the mark as registered; something which did not feature in its pleadings.
- 4) The opposition failed in its entirety.
- 5) The opponent has requested that it be awarded costs as it was put to unnecessary expense in proving its reputation in JOCKEY for underwear. The opponent also defended its decision to file the volume of evidence provided:

“In the interim decision the Hearing Officer has suggested the opponent used a swamping ploy of filing thousands of pages of exhibits without any explanation as to what they were being relied upon to show, and that after the Case Management

Conference the opponent did not list which exhibits were being relied upon for which part of each specification. To address these two points directly, the exhibits were intended to show a pattern of trading of significant duration and extent. They were logically structured and it was hoped and expected that the Tribunal would be adequately assisted as to what each exhibit showed by explanations in the accompanying witness statement, index of exhibits and letter. There was no intention to swamp.”

6) The opponent also contends that the applicant put it to unnecessary costs by refusing to accept that it had a reputation for men’s underwear, stating:

“The applicant has put the opponent to the expense of seeking to prove enhanced distinctiveness and a reputation for goods including men’s underwear, and further explanations regarding the pages of each exhibit relied upon to prove this reputation, when it must have been obvious to them that this was a needless exercise.”

7) The opponent also referred me to a number of previous Registry decisions and Tribunal Notices regarding costs, all of which I take into account in my decision. The opponent also filed a witness statement, dated 13 January 2015, by Alison Hague their Trade Mark Attorney. She described the behaviour of the opponent thus:

“4. Jockey has carefully focused the scope of its oppositions and the grounds relied upon from the outset. In the Notices of Opposition, Jockey only relied on its prior registered marks to the extent that it was confident it could prove use or to the extent that proof of use was not required. Although protected under several registration numbers, only three actual registered marks were relied upon - the word JOCKEY and the word JOCKEY together with a swirl device in two different positions. Jockey's grounds of opposition based on passing off were also narrowly framed. Jockey relied on goodwill only for limited goods ("underwear, underwear tops, underwear bottoms, T-shirts"). Goodwill was relied on for three marks which shared the common element JOCKEY. For JOCKEY & globe device Jockey clearly stated that it relied only on goodwill generated through use since approximately March 2012.

5. Jockey voluntarily partially surrendered four of its earlier UK trade marks in February 2013 and two earlier Community trade marks at about the same time. Following these partial surrenders, Jockey further narrowed its grounds of opposition against Application No.2621301A as notified by Jockey to TJC and the IPO in Dehns' letter of 20 June 2013.

6. On 6 August 2014 Jockey further narrowed its oppositions by withdrawing opposition to class 18.”

8) On the sheer amount of evidence provided she comments:

“8. It has been suggested that Jockey's main evidence filed on 20 June 2013 was voluminous. The exhibits may have included a lot of pages, but the evidence was structured in a logical way and the content and relevance of the exhibits was explained in the accompanying witness statement of Mr Harings and in the letter from Dehns to the IPO dated 20 June 2013. That letter included an index of the exhibits. The evidence was intended to establish that JOCKEY has a reputation and goodwill, as well as establishing use. It was considered that to establish reputation and goodwill, it would be desirable to demonstrate how Jockey's business had developed over a period of several years and how the product range had naturally expanded. It was desired to demonstrate a pattern of trading of significant duration and extent. The greatest number of pages in the exhibits comprised a selection of "Never Out of Stock" and seasonal brochures from the period 2006 to 2012 in Exhibits TJH4 and TJH5. These brochures were, by nature, structured to help the reader to identify specific types of products. All of the brochures in the exhibits were presented in a logical chronological order. Examples of key products featured in each brochure were given by Mr Harings at pages 5 to 8 of his witness statement. Although multiple examples of many goods were readily identifiable in the evidence, page references were provided in Dehns' letter of 20 June 2013 for goods which appeared less frequently. The remaining exhibits and their contents were also presented in a structured and logical order. For example invoices and marketing materials were arranged chronologically by country.”

AND:

“9....According to my attendance note, at the Case Management Conference [CMC] I argued that it would be unduly burdensome to the opponent to be required to produce a long list of page numbers on which there could be found examples of goods which are clearly numerous in the exhibits and that this would not be helpful. My recollection is that in setting an 8 week deadline for filing a table of page numbers, the Hearing Officer recognised that such a list would be time consuming to prepare.”

9) Ms Hague is correct in thinking that I regarded the table requested as being time consuming to prepare. However, she ignores my comments made at the CMC that I regarded the evidence as being out of proportion with what was required. The brochures were not filed as complete booklets i.e. stapled together. Instead the exhibit was some 3000 loose pages. This meant that the reader was required to view each and every page to know where each brochure started and ended. Given the claim of the opponent to use of a number of variations of mark, one had to then try to find each mark and the garments upon which it was used. The contention that all the marks were effectively use of the word JOCKEY, and so use of this single word was relied upon as evidence of use of all the marks relied upon in its opposition was not made until the hearing when I questioned the opponent's representative, having considered the evidence and the requirements regarding proof of use. The whole exercise was made even more onerous by the strange definitions applied to some of the goods. For instance despite “nightwear” being included within the opponent's specification the use

of the various marks upon pyjamas and long legged underwear or long johns was relied upon on to support its registration for trousers on the basis that a dictionary definition of trousers describes them as being long legged clothing. Elsewhere use of a mock car number plate “JKY1876” upon two bags is said to be proof of use of the word JOCKEY upon “bags”; “carrying cases”; “cases for sporting articles”; “holdalls”; “shoulder bags” and “travelling bags”. Numerous other examples of such overstatement can be seen in my original decision.

10) To my mind the opponent could, and should have selected certain pages from various brochures and put together a brief pack which would have, in conjunction with the witness statements and invoices, made a clear concise case for each of its marks upon the goods for which they were registered and on which the opponent was relying. Instead of which it decided to simply obtain as much evidence as possible and simply filed it with an effective invitation to pick out the bones or as it was put “here is a haystack find the needle”.

11) Whilst I accept and recognised in my first decision that the applicant could, and should, have accepted that the opponent had reputation in the word JOCKEY in respect of men’s underwear, this does not excuse the behaviour of the opponent. The need to show use on underwear could have been easily done with a few well chosen exhibits backing up its comments and sales figures included in its witness statements. Its response to the request was disproportionate and put the applicant to unnecessary expense, not least because the brochures were filed in a loose leaf manner which made them far more difficult to consider. The applicant has sought normal scale costs in regard to most aspects of the case. They only seek additional costs caused by the additional work the opponent’s behaviour put them to. Whilst I accept the premise, I do not accept that all of the costs listed were necessary and have also reduced the costs somewhat to reflect the applicant’s intransigence in not accepting the opponent’s reputation in men’s underwear at the start of the proceedings.

COSTS

Preparing statements and considering the other side’s statements x2	£1,000
Preparing evidence and considering the evidence of the other side	£12,000
Preparing for and attending the final hearing	£4,500
TOTAL	£17,500

12) I order Jockey International Incorporated to pay The Jockey Club the sum of £17,500. This sum 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 16th day of February 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**