

O-165-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2439103  
BY RUPERT JAMES PHEASANT TO REGISTER A  
TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 96089 BY DUNCAN FORBES, STAUNCH INDUSTRIES**

## BACKGROUND

1) On 21 November 2006 Rupert James Pheasant filed an application to register the word STAUNCH as a trade mark. Following examination, the trade mark was accepted and published for opposition purposes on 7 December 2007 in Trade Marks Journal No.6713 for the following goods in class 25:

Clothing; footwear; headgear.

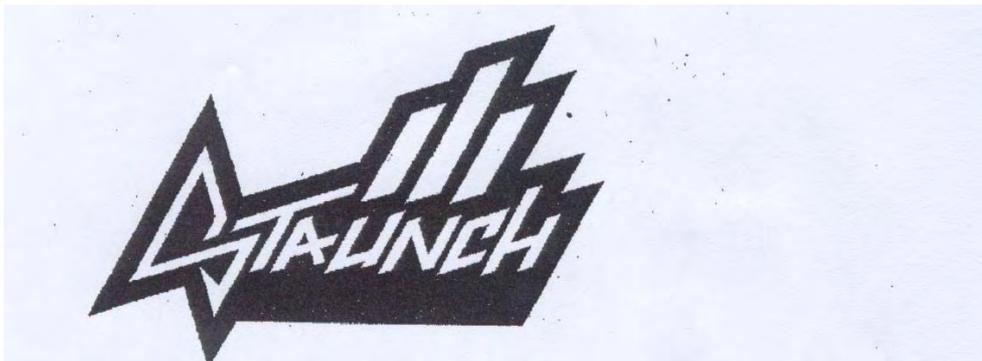
2) On 4 February 2008 a notice of opposition was filed. In response to the following question on the Form TM7:

“Full name and address (including postcode) of the opponent”,

I note the following has been entered:

“Duncan Forbes  
Staunch Industries  
2313 Restalrig Road  
Leith  
EH6 8BB”.

3) I propose to refer to this party as the opponent in these proceedings, I will (if necessary) return to the identity of the opponent later in this decision. The opposition consists of a single ground based upon section 5(4)(a) of the Trade Marks Act 1994 (as amended) (the Act). Having identified that the unregistered trade mark on which the opponent relies is as follows:



4) In their Notice of opposition the opponent states:

“Staunch Industries design and manufacture own brand, limited edition surfware. All our garments feature the words Staunch industries and our three bar logo. The name and logo also feature on our websites [www. Staunchclothing.co.uk](http://www.Staunchclothing.co.uk), [www. Staunchindustries.co.uk](http://www. Staunchindustries.co.uk).”

5) The opponent goes on to say that the earlier trade mark has been used since December 2005, and in response to the following question on the Form TM7:

“State which goods or services in the application you object to”,

The opponent states:

“As we design and manufacture all our clothing we object to clothing.”

6) On 22 February 2008 Birketts LLP (on the applicant’s behalf) filed a counterstatement which consists of a denial of the ground on which the opposition is based. I also note that they ask the opponent to prove their various claims.

7) Both parties filed evidence in these proceedings. Neither party requested to be heard. The applicant filed written submissions in lieu of a hearing which I shall refer to as and when necessary.

### **OPPONENT’S EVIDENCE**

8) This consists of three witness statements. The first, dated, 16 July 2008, is from Duncan Forbes who explains that he is the part owner and Director of SI a position he has held since February 2006. He confirms that the information in his statement comes from his personal knowledge and from company records. He states:

“We had been using the name Staunch Industries prior to 2006, however it was formally used on garment designs, a grant application and the opening of a bank account in February 2006.”

9) He goes on to say that since that time the Staunch trade mark has been incorporated into their clothing designs, adding that the garments that they have manufactured printed and embroidered with the Staunch trade mark include: T-shirts, hoodies, socks and hats. The six exhibits attached to Mr Forbes’ statement are as follows:

- DF1 – consists of a business gateway Start-up grant application dated 14 February 2006 in which the word STAUNCH is mentioned. I note that in response to the question: “When do you plan to start in business?” that December 2005 has been struck out and 13 February 2006 has been entered;
- DF2 – consists of a “Confirmation of Registration” letter from nominet to Mr Forbes at Staunch Industries dated 2 September 2006, which confirms that the domain name [staunchindustries.co.uk](http://staunchindustries.co.uk) has been registered for two years from 23 June 2006;
- DF3 – is said to consist of “a page highlighting the sales activity through our online shop”. I note that the page contains fifteen entries; twelve are described as “Payment”, one is described as “Refund”, one as “Transfer” and one as “Update”. While the “Gross” value of the invoice (discounting the entries relating to the Refund and Transfer) amounts

to £434.75, I note that none of the entries are dated, nor do they indicate the goods to which they relate or any trade mark;

- DF4 – consists of a copy of a bank statement dated 10 August 2006 from the Bank of Scotland in respect of the account name: “Duncan Forbes T/A Staunch Industries”.
- DF5 – is said to consist of “A screen grab from our Google ad words account.” The page which appears to be undated save for the Google copyright date of 2008, shows against the word Staunch, 7,520 clicks at a cost of £517.96.
- DF6 – is said to consist of examples of Staunch garments. The two pages provided (which are again undated) show twelve items of clothing; nine T-shirts and three hoodies. The word STAUNCH can be made out in four of the garments.

10) Mr Forbes states that Staunch Industries advertise through Google ad words (exhibit DF5 refers) adding that they conduct regular PR campaigns using Amethyst media and Stripe Communications. Mr Forbes explains that Staunch Industries have a number of stockists in Scotland and states that goods bought through their online store have been dispatched throughout England, Scotland and Wales.

11) Mr Forbes concludes his statement in the following terms:

“Staunch Industries design print and manufacture unique clothing. We have built up a reputation as an innovative UK surf brand using the name Staunch Industries. Our garments and designs feature the Staunch mark, it is therefore integral to our brand and essential that we maintain the reputation we have developed.”

12) The second statement, also dated 16 July 2008, is by Janeanne Gilchrist who is the owner and Director of Unit Photographic, a position she has held since 1998. She confirms that the information in her statement comes from her own knowledge, adding that she has worked with Staunch Industries on a number of campaigns.

13) Ms Gilchrist states that the mark Staunch Industries was first used in early 2006 and that she was the main photographer during the summer campaign photo shoot. The Staunch Industries trade mark has, she says, been printed on T-shirts, sweatshirts and hoodies since May 2006.

14) The three exhibits attached to Ms Gilchrist’s statement are as follows:

- SII – is said to consist of “Images and visuals of the designs and garments featuring the Staunch mark”. The exhibit consists of four pages, the first two of which are identical to those contained in exhibit DF6 to Mr Forbes’ statement. The remaining two pages consist of five photographs (taken at a seaside location) featuring models wearing a range of T-shirts and hoodies. While the hoodies photographed bear the word STAUNCH, the T-shirts featured do not; none of the pages are dated.

- SI2 – is said to consist of “Article featuring Staunch in the News and surf publications illustrating how the mark is used to promote the brand and the garments we sell”. This exhibit consists of six pages. The first page consists of an article entitled: “Stylish Surfers wave bye-bye Bondi...and hello Pease Bay.” The article, written by Adrian Mather and which I think appeared in the Edinburgh Evening News, appears to be undated but can I think (given the information provided in Mr Forbes’ statement and the reference in the fourth paragraph of the article to: “After setting up less than a year ago...”) be dated as appearing sometime between late 2006 and early 2007. I note that the article refers to Staunch Industries in the context of a trade in T-shirts, and also suggests it is run by Mr Forbes and also Mr Will Beeslar.

The second page of exhibit SI2 consists of an undated article by Claire Sawers under the heading of “Brand of the Month”; the publication in which the article appeared is not provided. The article which refers to the Staunch brand and also to [www.staunchclothing.co.uk](http://www.staunchclothing.co.uk) includes, inter alia, the following text:

“...the limited edition t-shirts...in fact the boys have plans to expand the range and design hoodies, girls t-shirts, surfboards and technical clothing too.”

The third page consists of an article from the website [www.surferspath.com](http://www.surferspath.com). The article which is entitled “Edinburgh Surfers Launch Home-Grown Surf Brand” and which is described as being posted on July 8 2007 discusses the Staunch brand in the context of a range of T-shirts and includes, inter alia, the following text:

“..They are currently in discussions with local manufacturers to develop more technical clothing and other surf inspired products..”

The fourth page consists of an undated article from [www.5ones.com](http://www.5ones.com) entitled “Staunch: Scotland’s First Surf Clothing Brand.” The article includes the following text:

“Right now Staunch is limited to just t-shirts. However, they are in talks to develop more technical surf gear.”

The fifth page consists of an article entitled “Scottish Surfers launch clothing brand” dated Monday 9 July (which I take to be a reference to 2007) from [www.bigwednesdaysurf.com](http://www.bigwednesdaysurf.com). I note the article mentions “limited to clothing”.

The final page consists of an undated photograph of a male model wearing, inter alia, a T-shirt on which the word STAUNCH can be seen.

- SI3 – consists of a number of images of what Ms Gilchrist describes as celebrities endorsing the Staunch label and mark and which she explains formed part of a marketing campaign during the Summer festivals season in 2007. The photographs show members of Snow Patrol and Franz Ferdinand wearing T-shirts in which the word STAUNCH can be seen.

15) Ms Gilchrist concludes her statement in the following terms:

“....In my opinion Staunch Industries using the Staunch mark have built up a strong reputation for energetic, innovative design within the UK surf scene.”

16) The final statement, dated 18 July 2008, comes from James Simpson who is a Business Advisor at Hardengreen Business Centre in Eskbank a position he has held since 2005. He confirms that the information in his statement comes from his own knowledge of Staunch Industries grant application and from discussions with his colleague Weir Brown.

17) Mr Simpson explains that discussions with Staunch Industries commenced in February 2006 and adds that Weir Brown was the main business advisor. He adds that as far as he is aware, the company have been designing and printing T-shirts, sweatshirts and hoodies since the summer of 2006.

18) Attached to Mr Simpson's statement are 4 exhibits. Exhibit JS1 consists of a "To whom it may concern" letter dated 8 January 2008 from Weir Brown of the Midlothian business gateway in which he explains that discussions with Mr Forbes commenced in February 2006 "regarding the launch of his designer clothing business Staunch." He goes on to say that at least two meetings were held with Mr Forbes and that they assisted him with both his business plan and financial forecasts from 1 February 2006, and his application for a £1000 start-up grant which was verified in March 2006. Exhibits JS2 to JS4 consist of copies of documents already provided as evidence by Mr Forbes.

## **APPLICANT'S EVIDENCE**

19) This consists of a witness statement, dated 29 October 2008, from the applicant for registration Mr Pheasant who confirms that the information in his statement comes from either his own knowledge or his records.

20) Mr Pheasant explains that in early 2004 he wanted to launch a clothing brand (principally for skateboarders) under the STAUNCH trade mark and that on 18 February 2004 he incorporated STAUNCH TRADING COMPANY LIMITED – exhibit RJP1 refers. He goes on to say that due to work commitments he did not start producing T-shirts under the STAUNCH trade mark until 2006. Exhibit RJP2 consists of three photographs of what I take to be two different T-shirts. The first T-shirt has, inter alia, the word STAUNCH on the front and is said to date from February 2006. The second T-shirt also said to date from February 2006 has, inter alia, the word STAUNCH on the rear.

21) Exhibit RJP3 consists of three pages. The first page contains six representations which consist either exclusively of or contain the word STAUNCH. At the top of the page appears the following text: "Start of Staunch Designs in 2004, when we started the ltd company, Started printing in Jan 2006 due to other business." The second page headed: "Staunch Design Jan 2006, first Staunch t-shirt design" contains a representation in which the word Staunch appears. The final page is split into two parts. At the top of the page headed: Staunch Designs for 2006, 2007, 2008 on Hoodys and T-shirts" are eight representations, six of which contain, inter alia, the word

STAUNCH. At the bottom of the page under the heading: “Samples Designs done in 2006, 2007” are a range of representations, seven of which contain, inter alia, the word STAUNCH.

22) Mr Pheasant says that exhibit RJP4 consists of a copy of the opponent’s homepage which he says confirms that the site went live in March 2007. I note that the page provided which is dated 23 March 2007 contains the following text:

“Brilliant, the sweet smell of spring. Welcome to Staunch. Yep, its been a long time but we are officially alive alive O. We have hooked up with those cleaver guys at Big Cartel to offer the smoothest shopping experience that Staunch can afford.”

23) Mr Pheasant states that in February 2007 he opened his first shop. Exhibit RJP5 consists of two photographs showing the interior and exterior of the shop. In the exterior photograph www.staunch-xtreme.com can be seen on the front signage. The photographs are accompanied by, inter alia, the following text: “Staunch-xtreme. First shop in Eagle Street, Ipswich. From Feb 2007 to Feb 2008...”. He goes on to say that in February 2008 he moved to bigger premises. Exhibit RJP6 consists once again of two photographs showing the interior and exterior of the store. In the photograph of the exterior the words THE STAUNCH BUILDING can be seen on the front signage.

24) Mr Pheasant adds that in addition to the shop, he has had stands at a number of festivals and events including USC 2007, SantaPod 2007 and Bug Jam 2008, at which he has sold and promoted his STAUNCH clothing. In addition, he explains that he has sponsored events such as the opening of the plaza at Skegness (April 2008) and hosting the DVS Photographers Series Exhibition (date unknown). Exhibit RJP7 consists of promotional posters for these events in which the STAUNCH trade mark is featured. His final exhibit RJP8 consists of three photographs showing: (i) an individual wearing a STAUNCH T-shirt (February 2007), (ii) two children wearing what appear to be hoodies featuring the STAUNCH trade mark (date unknown), and (iii) STAUNCH clothing (hoodies) appearing on a rack in the Ipswich shop (date unknown).

#### **OPPONENT’S EVIDENCE IN REPLY**

25) This consists of a witness statement, dated 15 February 2009, from Fiona McIntosh who has been the owner of Tessuti since 1985. Ms McIntosh confirms that her information comes from her own knowledge and her trading relationship with Staunch Industries.

26) Ms McIntosh explains that she started working with Staunch Industries in February 2006, constructing printing screens based on Staunch Industry’s designs. She adds that Staunch Industry have been designing, printing and selling garments since June 2006.

27) The three exhibits attached to Ms McIntosh’s statement are as follows:

- FM1 – consists of an invoice from Tessuti to “Will/Duncan, Staunch” bearing an order date of 19 June 2006, a delivery date of 26 June 2006 and a total price of £349. Ms

McIntosh explains that the invoice is for the printing of 156 garments and the production of six screens based on four designs provided by SI;

- FM2 – consists of a copy of an invoice dated 31 May 2006 for: “the garments provided to me by Staunch Industries..”. The invoice which relates to a: “Men’s Classic Jersey T-shirt (in a range of colours) is for 170 T-shirts valued at £521.71. I note the invoice is marked “PAID 31 May 2006”.
- FM3 – consists of six undated photographs of T-shirts one of which bears the word STAUNCH and described by Ms McIntosh as “printed by Tessuti during this and subsequent print runs.”

28) That concludes my summary of the evidence filed in these proceedings to the extent that I consider it necessary.

## **DECISION**

29) The opposition is based solely upon section 5(4)(a) of the Act which 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.”

30) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Wild Child Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

31) To the above I add the comments of Pumfrey J in *South Cone Incorporated v JackBessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he 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.”

32) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

“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.”

33) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429.

34) In the counterstatement the applicant claims to have first used its *Staunch* mark on T-shirts in February 2006. However, the applicant has not provided any corroborating evidence such as invoices, catalogues or third party witnesses. The company was incorporated in February 2004 and some preparation work was done during 2005 and early 2006, but it is difficult to state when the applicant first used the mark in suit on goods within the specification. I must also consider the fact that the opponent has not challenged the applicant’s statements. The opponent’s

strongest case is served by taking the later application date of 21 November 2006. If it cannot succeed at this date then it would be bound to fail at any earlier date.

35) The first issue is to determine who the opponent is. The notice of opposition simply stated the opponent as being Duncan Forbes, Staunch Industries. In his witness statement Mr Forbes states that he is “the part owner and Director of Staunch Industries”. However, the bank statement provided at exhibit DF4 shows the account in the name of “Duncan Forbes T/A Staunch Industries”. Whilst from the evidence at exhibit S12 it would appear that the firm is run by Mr Forbes and Mr Will Beeslar, the best I can make of this is to regard Staunch Industries as a partnership owned and run by Mr Forbes and Mr Beeslar, with either partner being able to contractually commit the partnership. In regarding the issue in this manner the opposition can be considered, rather than rejected as not coreectly identifying the opponent.

36) In the statement of grounds the opponent identified the unregistered trade mark that it was relying upon in this action. It was stated that this is used on all the opponent’s garments. It was also claimed that al garments carried the mark “Staunch Indurtries”. . However, in the evidence no use of the mark identified or “Staunch Industries” can be found. Moreover, the evidence shows that not all the garments carry even the word “Staunch” upon them. The opponent has therefore not shown that it has any goodwill in the mark identified in its statement of grounds. The opposition under Section 5(4)(a) must therefore fail.

37) In case I am wrong on this, I will go on to consider the position with regard to the use of the word “Staunch” *solus*. The evidence provided by the opponent shows use of the word “staunch” on T-shirts, sweatshirts and hoodies. Quite when this use began is less than clear as there appear to be a number of dates provided as “start dates”. The evidence of sales is problematic as the entries in DF3 are not dated and could relate to items with the other brands and designs upon them not the word “staunch”. There are two invoices relating to the provision of garments amounting to £870 dated May 2006 and June 2006, exhibits FM2 and FM1 respectively. However, these invoices lack any detail as to what trade mark, if any, these garments carried. The opponent provides evidence of promotional activity at exhibit DF5 but this is undated save for a copyright date of 2008. Even if I consider the opposition to be based upon the word “staunch” alone then the opponent has failed to show that at the relevant date it had any goodwill in the word “staunch” and so the opposition under Section 5(4)(a) fails.

38) I order the opponent to pay the applicant the sum of £750. 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 18<sup>th</sup> day of June 2009**

**G W SALTHOUSE  
For the Registrar  
The Comptroller-General**