

**TRADE MARKS ACT 1938 (AS AMENDED)
TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 1585679
by Silverstone Tire & Rubber Co SDN BHD to
register a trade mark in Class 12**

**AND IN THE MATTER OF Opposition thereto
under No 47167 by British Racing Drivers Club**

Background

1. On 21 September 1994, Silverstone Tire & Rubber Co SDN BHD of Malaysia applied to register a series of marks in Class 12 for “vehicle tyres included in Class 12.”
2. The application was advertised for opposition purposes before acceptance under the provisions of Section 18(1) of the Trade Marks Act 1938 (as amended). The advertisement indicated that the Registrar was proposing to register the marks in Part B of the register maintained under the 1938 Act.
3. The series of two marks published consists of the word SILVERSTONE in block capital letters and in the form shown below.

SILVERSTONE

4. On 7 July 1997, the British Racing Drivers Club Limited filed Notice of Opposition to the proposed registration. The original grounds of opposition (insofar as they are now pursued) are under Sections 11 and 17 of the 1938 Act. The Section 11 ground is based upon the opponent’s claim that because of its use of the mark SILVERSTONE since 1949, the applicant’s use of the marks applied for result in deception and confusion. The Section 17 objection is pleaded in the following terms.

“In view of the opponent’s proprietorship of the trade mark Silverstone, application No B1585679 is made, and was made in bad faith. Accordingly the mark applied for should be refused in exercise of the Registrar’s discretion.”

5. The applicant filed a counterstatement denying the grounds of opposition.
6. Both sides seek an award of costs.
7. By the time this matter came to be decided the Trade Marks Act 1938 had been repealed in

accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. Nevertheless, these proceedings must continue to be dealt with under the old law in accordance with the transitional provisions set out in Schedule 3 of the 1994 Act. Accordingly, unless otherwise indicated, all references in the remainder of this decision to sections of the Act, are references to the provisions of the 1938 Act.

8. The matter came to be heard on 9 March 2001 when the applicant was represented by Mr H Carr QC instructed by Field Fisher Waterhouse, and the opponent was represented by Mr R Arnold QC instructed by A A Thornton & Co.

9. Although the application is to register a series of two trade marks, one of which is the word 'Silverstone' in a slightly stylised form, the essential feature of this mark is plainly the word 'Silverstone'. Accordingly, for the purposes of this decision I will not distinguish between the two marks. I will treat the application as though it were simply for the mark SILVERSTONE.

Application to Add Additional Ground of Opposition

10. Two days prior to the hearing, the opponent's solicitors wrote to the Registrar seeking leave to add a further ground of opposition under Section 10 of the Act. Mr Arnold's skeleton argument outlined the applicant's case like this:

"15. The Section 10 objection is one which was not originally pleaded, but the opponent should be given permission to plead it now because it arises out of the applicant's own evidence filed in this opposition, and in particular the first declaration of Janet Thelma Sawyer and the exhibits thereto cf. C Trade mark [1998] RPC 439.

16. Silverstone is a village in Northamptonshire. Accordingly the ordinary signification of the mark applied for is a geographical name. It was therefore unregistrable in Part A of the register save upon proof of distinctiveness: Section 9(1)(e). The applicant filed evidence of use which the Registry evidently regarded as insufficient to pass the threshold for registration in Part A, but sufficient to pass the threshold for registration in Part B. The application was then advertised before acceptance under the proviso to Section 18.

17. Normally evidence of use filed in such circumstances would not be open to public inspection and an opponent would be in no position to comment on it. In the present case, however, the applicant has exhibited the evidence in question to its evidence in the opposition. As a result, it can be seen from a comparison of the evidence filed at the ex parte stage with the other evidence filed by the applicant in the opposition that the evidence of use was at best significantly incorrect and inflated the scale of use claimed by the applicant."

11. The evidence of Mr Phang Wai Yeen, filed before publication of the application, provides approximate figures for the value and volume of sales for each of years from 1991/2 to 1994/5. Mr Yeen gives evidence that the mark SILVERSTONE was first used by the applicant in the UK in 1991 in relation to vehicle tyres. He further states that sales since that date in the UK have amounted to £8.18m. Mr Yeen's statutory declaration is dated

1 August 1996. At that date Mr Yeen was the Executive Director of the applicant company. He states that the information he gives comes from his own knowledge or has been extracted from his company's records.

12. In the opposition proceedings, the applicant filed two further statutory declarations by Ooi Kheng Lam, who is the applicant's Chief Accountant. Mr Lam states that between 1991 and 1994 the applicant sold its tyres in Europe through a company called Unitco B.V. He says the company's records only record sales to Unitco and do not provide exact figures for sales in the UK for this period. From 1995 the applicant started to establish its own distribution network in the UK. Mr Lam is therefore able to verify the sales figures in the UK for 1994/5 and three subsequent years.

13. Mr Arnold identified various inconsistencies in the evidence of Mr Yeen and Mr Lam. The principal criticisms seemed to me to be:-

- (a) whilst it is possible that the "approximate figures provided by Mr Yeen for the years 1991/2, 1992/3 and 1993/4 are based upon Mr Yeen's personal knowledge of the percentage of total European sales made in the UK (the figures provided by Mr Yeen being lower than the European sales figures provided by Mr Lam from the company's records for each of these years), it appears improbable that UK sales in 1992/3 and 1993/4 would have amounted to 96% and 97% of total European sales, when in 1991/92 the figure was only 20%.
- (b) The sales figure provided by Mr Yeen for 1994/5 (£4,630,000) is over three times higher than the figure provided by Mr Lam for the same period (£1,521,901).

14. The applicant's evidence also includes a statutory declaration dated 19 August 1998 by Kelvin Lau, who, by that date, had been the applicant's Regional Manager for the UK for four years. Mr Lau provides sales and volume figures under the mark SILVERSTONE for the years 1995/6 to 1997/8. Strictly speaking these are irrelevant to the matter as they cover a period after the relevant date in these proceedings. Mr Arnold relied upon them to highlight two points:

- a) By comparing the volume and value figures provided by Mr Lau for 1995/6 to those provided by Mr Ween for 1994/5, it appears that - if both sets of figures are accurate - the unit price of the applicant's tyres dropped from £73.12 in 1994/5 to £16.38 in 1995/6.
- b) None of the sales figures for the UK for the years 1995/6 to 1997/8 provided by Mr Lau, correspond to those subsequently by Mr Lam, the company's Chief Accountant.

15. On the basis of these inconsistencies Mr Arnold invited me to reject the applicant's evidence of use of its marks in the UK as unreliable.

16. Mr Carr resisted the addition of the further ground of opposition, primarily on the grounds of the lateness of the request, the probability of further delay, and the lack of merit in the opponent's criticisms of the applicant's evidence.

17. On the last point, Mr Carr pointed out that although Mr Ween had provided sales and volume figures for 1991/2 to 1994/5, he had not specifically claimed that all the sales in question were in the UK. In support of this argument, Mr Carr noted that Mr Ween had claimed only £8.18m worth of sales in the UK since 1991, whereas the sum of the annual figures provided was considerably higher. Mr Arnold pointed out that the sum of the yearly sales figures amounted to £18.18m. He suggested the lower global figure in Mr Ween's evidence was therefore probably just a typographical error.

18. Having listened to the arguments of the parties, I decided to allow the additional ground of opposition, which Mr Arnold clarified as being:-

“The mark applied for is in its ordinary signification a geographical name. Accordingly, the mark should be refused under Section 10 of the 1938 Act.”

19. My reasons for doing so are as follows:

- a) The application has not yet been accepted by the Registrar under Section 17(2) of the Act. The application was, as noted above, advertised for opposition purposes before acceptance under the proviso to Section 18(1) of the Act;
- b) The application was published for opposition because the Registrar's Examiner took the view that Mr Ween's evidence was sufficient to overcome a prima facie objection to registration under Section 10 of the Act on a similar ground to the 'new' ground of opposition.
- c) The inconsistencies in the applicant's evidence identified by the opponent were sufficient to place a serious question mark against the reliability and accuracy of Mr Ween's evidence.
- d) Given that the application has not yet been accepted by the Registrar, the doubts about the applicant's evidence could not be overlooked when the Registrar came to formally accept the application.
- e) If the Registrar would otherwise have to raise the matter herself, there was no substantial prejudice to the applicant in allowing the opponent to raise the matter even at such a late stage - provided that the applicant was given a proper opportunity to respond.

20. Mr Arnold submitted that, having relied upon evidence of fact and distinctiveness under Section 10(2)(b) of the Act at the examination stage, the opponent should not now be permitted to contend that its mark was inherently capable of distinguishing under Section 10(2)(a) of the Act.

21. Mr Carr asked for time for the applicant to submit further evidence about the matters raised by Mr Arnold in relation to the evidence already submitted. He further sought a postponement of the hearing until after such evidence had been filed.

22. I decided to proceed with the hearing on the basis that the Section 11 and 17 objections could be disposed of thus at least narrowing the grounds still in dispute. I rejected Mr Arnold's submission that the applicant could not ask me to reconsider the prima facie case for registration under Section 10. As the application has not yet been formally accepted (or refused) the Examiner's view of the application must be regarded as provisional. I am, therefore, no more prevented from deciding that the mark is registrable prima facie, than I am from deciding that it is not registrable on the basis of the evidence filed (as the opponent contends). My decision will therefore cover all aspects of the case for refusal under Section 10 of the Act.

23. I indicated at the hearing that if the Section 10 ground succeeded on a prima facie re-examination of the application, but the other grounds of opposition failed, I would allow the applicant a period of time to submit further evidence under Rule 13(11) of the Trade Mark Rules 2000 (which apply to these proceedings by virtue of Rule 74). I rejected Mr Arnold's submission that the applicant should not be given such an opportunity. The opponent was given Mr Lam's evidence in October 1999. The opponent filed further evidence in February 2000 but made no attack on the inconsistencies in the applicant's evidence of use of its mark until two days before the hearing. If the evidence in question is material to the outcome of the opposition, natural justice requires that the applicant be given a proper chance to provide an explanation for the inconsistencies (belatedly) identified by the opponent.

Section 10

24. Section 10 of the Act is as follows:

10.-(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts

thereof.

25. The following extract from the Registrar's Work Manual sets out the practice at the relevant date:

“9-85 GEOGRAPHICAL NAMES

The registration of major geographical place names as trade marks for goods (see Chapter 11 in relation to service marks) is barred absolutely - reference the Liverpool, Yorkshire and York decisions - and even in the case of less well known names the Courts and the Registry have been reluctant to encroach upon the freedom of traders (present and future) to use place names for their original purpose ie to indicate geographical origin. That said, however, registration of geographical names of lesser significance is not forbidden by the Act, particularly if evidence of factual distinctiveness is filed in support of the application. However, when considering evidence of factual distinctiveness, one must also consider whether the mark has any inherent distinctiveness and whether or not the location concerned has any reputation for the goods; whether such goods are likely to be produced there, either now or in the future, and whether such goods are likely to be traded in, in the United Kingdom. Obviously the possibility of registration increases if the geographical names are in respect of places outside the United Kingdom, and the more remote and unheard of the location the more likely is registration to be allowed.”

26. The York case referred to in the passage is set out in 1984 RPC 231. The House of Lords considered the registrability of geographical place names in Part B of the Register. Lord Wilberforce, who gave the leading speech, described as “an authoritative pronouncement”, the earlier judgement of the Fletcher Moulton L.J in the cases of Perfection and California Syrup of Figs (1909) RPC 837, 854. Referring to the judgement in those cases, Lord Wilberforce said:

“In an extended passage, the whole of which repays study, and which has been accepted as a classic statement of the law, he described the policy of the Act as substituting for an absolute exclusion, from the use as trade marks, of geographical names, a judicial examination on the merits of each individual case. This was followed in W & G de Cros Ltd (1913) 30 RPC 660, concerned with the use of initials in which Lord Parker said that the right to registration should:

“Largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper notice, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.”

27. In order to achieve a measure of consistency in examining applications to register the names of small geographical locations, the Registrar adopted the following practice in 1989.

“9-91 NAMES OF VERY SMALL GEOGRAPHICAL LOCATIONS

Under the *de minimis* principle, geographical names of places with populations lower than 2,000 in the United Kingdom and 50,000 overseas where the goods are not natural produce and the place has no reputation in the goods may be accepted for registration in Part B. In such cases it is thought that the likelihood of traders wishing to use such place names in relation to their goods is so remote that it can be ignored.”

28. According to the evidence of Mr Cunningham (exhibit DC 6 to his second declaration) the relevant District Council estimated the population of Silverstone in 1997 to be 1,989. This information appears to be “based upon” 1991 census figures. I imagine that the estimating arises from a judgement as to the movement in the population between 1991 and 1997. The relevant date for the purpose of this decision is 21 September 1994. I have no way of knowing whether the population of Silverstone was rising or falling between 1991 and 1997, so it is not possible for me to be sure whether the population was above or below the Registrar’s *de minimis* figure of 2,000 at the relevant date. Given the general rise in the population, it seems quite possible that the population of Silverstone was less than 1,989 in 1994.

29. However, given that the figures are borderline, and that the Registrar’s practice is only a guide, it would be wrong to pay too much attention to the precise population figures without considering other relevant factors.

30. The applicant seeks a registration in respect of ‘vehicle tyres’. These are not the sort of goods that are manufactured in small numbers from small industrial premises. Rather they tend to be manufactured in large numbers from substantial industrial establishments. I consider it very unlikely that a rural village like Silverstone would, either now or in the future, be the site of a tyre manufacturing facility. I cannot, of course, completely exclude the possibility. The situation is not so extreme as the often quoted example of NORTH POLE for bananas. These sorts of questions are rarely that simple in practice. Nevertheless, I believe the likelihood of tyres being manufactured in Silverstone is so low it can be regarded as *de minimis*.

31. The opponent points out that the SILVERSTONE race circuit is “a large sporting and industrial complex.” I am not sure what is meant by the latter. There is no claim that vehicle parts are manufactured at SILVERSTONE. In any event, the background to the SILVERSTONE race circuit and its location of Silverstone is explained by Mr Cunningham. He says that from 1939 until the end of the war, Silverstone was the location of an RAF Training Station. After the war the disused aerodrome was acquired by the opponent for the purposes of motor racing. This appears to be a most unlikely precedent for large scale industrial development around the tiny village of Silverstone.

32. Even if I were to accept the opponent’s classification of SILVERSTONE as an “industrial complex”, I believe it is irrelevant to the merit of the Section 10 objection. Any use of SILVERSTONE in this context would be by way of reference to the opponent’s business, for which it contends the name SILVERSTONE is a trade mark, rather than the use of Silverstone as a geographical indication.

33. It seems very unlikely that a rural village of less than 2,000 people would even have a specialist tyre retailer - there simply would not be enough customers. It is quite possible that Silverstone has a local garage that may sell tyres amongst other things. But even if that garage was named after the village, this would clearly not be use of the name 'Silverstone' in connection with its own goods: Autodrome 1969 RPC 564.

34. I conclude that here are no grounds for diverting from the Registrar's practice (since 1989) of accepting in Part B the names of geographical locations with a population of less than 2,000 on the *de minimis* principle. I do not know why the examiner originally took a different view, but it seems to me that he was wrong to do so.

35. In these circumstances I do not consider the doubts I have expressed about the accuracy of the applicant's evidence of use are a reason to refuse registration. If the application qualifies for registration under Section 10(2)(a) of the Act it cannot matter whether or not it also qualifies under Section 10(2)(b).

Section 11

36. Section 11 of the Act is as follows:-

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

37. There is no significant dispute between the parties as to the law. Both sides accept that the test is as set out in Smith Hayden's Application (1946) 63 RPC 97, 101 as modified by BALI Trade Mark [1969] RPC 472, 496. In the present case this may expressed as follows:

Having regard to the user of the (opponent's) SILVERSTONE mark, is the tribunal satisfied that (the applicant's) SILVERSTONE mark if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

38. Mr Arnold pointed out that in the BALI TM case, Lord Upjohn observed that:

"It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source."

39. In fact the observation in question (which originated from Romer J in Jellinek's TM (1946) 63 RPC 59 at 78) continues:

"It is enough if the ordinary person entertains a reasonable doubt, that the court has to be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is

put on the register.”

40. I believe that this is the law. I do not believe that anything that has said by the Privy Council in Sprints v Comptroller of Customs [2000] FSR 814 (to which Mr Arnold drew my attention) alters the law in any way that is relevant to the facts of this case.

41. The opponent’s evidence of use of the name SILVERSTONE is set out in two statutory declarations by David Cunningham, who has been the Director of Silverstone Circuits Ltd since July 1995. Mr Cunningham explains that SILVERSTONE is a trade mark used by the opponent primarily in respect of vehicle rallying and racing events, but also in respect of merchandise and driver training services. Not all of the latter are held at the race circuit in the village of Silverstone. Mr Cunningham says this is evidence that SILVERSTONE is used as a trade mark and not merely as the name of the location of the racing circuit.

42. There is evidence that thirty British Grand Prix races had been held at Silverstone by 1995 and that it was known as the “home” of British Grand Prix racing. There is no point in detailing the evidence of the well known reputation of Silverstone as a racing circuit further because the applicant concedes that it is a very well known race track. Mr Carr put the applicant’s case like this in his skeleton argument.

““Silverstone” is a very well known race track (in particular for Formula 1 Racing). This fact (which is self evident) is supported by BRCD’s evidence. However, BRCD’s evidence establishes nothing in relation to relevant trade mark use. In particular, a certain amount of evidence is given about merchandising (clothing, headgear, keyrings etc). See Cunningham (2) paragraph 5 and exhibits DC 9 and DC 10. This is not trade mark use at all, but typical evidence of sales of souvenirs/memorabilia. There is no evidence of any use of the trade mark SILVERSTONE in relation to any parts for motor vehicles - much less tyres. At exhibit DC 2, Mr Cunningham exhibits a Silverstone Formula 1 programme for 1995, and points for the advert on the back for Goodyear tyres. Not only is that after the application date, but it is irrelevant. Goodyear (and not SILVERSTONE) is used as a trade mark in relation to tyres.”

43. In support of this submission, Mr Carr referred me to an unreported decision of Pumfrey J dated 15 December 1999 in a case concerning an application to register a logo incorporating the word NASA as a trade mark for clothing. The application was opposed by the US Space Agency of that name. The opposition under Section 11 of the Act failed because there were insufficient customers in the UK who would be confused by the applicant’s use, notwithstanding some evidence of the opponent’s trade in souvenir clothing, probably (although it is not clear from the informal record I have been given) in the USA.

44. As a matter of law there is no requirement that confusion or deception in the goods or services arising from use of an earlier name other than as a trade mark, is insufficient to give rise to Section 11 objection. See Lord Diplocks’ remarks in G E Trade Mark 1973 RPC at 322, lines 9-24.

45. That is not to say that the nature of the earlier use is irrelevant. Clearly it is. It appears to me that the opponent has used the name SILVERSTONE to distinguish its racing and rallying

entertainment services from those of other traders. I am therefore prepared to accept that the name has been used as a trade mark for these services. I am also prepared to accept Mr Cunningham's evidence that SILVERSTONE has been used as a trade mark for driver training services since 1988 (see exhibit DC 11 to Mr Cunningham's second declaration), and as a mark for official merchandise (mainly items of clothing and badges) from around the same time (see exhibit DC 10). It appears that the opponent's merchandise was available through a mail order catalogue and at the Silverstone circuit. There is no more detailed evidence about the extent of any such sales or the extent of the distribution of the mail order catalogue.

46. Mr Carr also drew my attention to the case of Daimler Chrysler AG v Javid Alavi 26 January 2001. This has a passing-off case. The learned judge, Mr Justice Pumfrey, accepted that a) Mercedes was a well known mark for motor vehicles, b) that the public often referred to such a vehicle as a MERC, and c) the claimant had sold some clothing under the mark MERCEDES in the nature of merchandise sold as an adjunct to its trade in motor vehicles. The judge decided that the claimant had no separate goodwill in relation to clothing and the defendant's use of MERC for clothing was not likely to cause confusion or deception. The passing off case therefore failed.

47. On the one hand it can be said that this was a passing-off case and it is well established that it is more difficult to establish relevant deception or confusion for passing-off purposes than is the case in opposing registration under Section 11 of the Act. (Not least because the burden of proof is on the applicant under Section 11 whereas in a passing-off case it is on the claimant). On the other hand it may be noted that the claimant in that case was able to demonstrate some trade in the relevant field of activity. There is no suggestion that the opponent in this case has ever traded in vehicle tyres. Probably the most relevant point that comes out of the case is the need to bear in mind when assessing the likelihood of confusion and deception, not just the scale of any reputation under an opponent's mark, but also the nature of that reputation.

48. Mr Arnold submitted that it is self evident that normal and fair use of an identical mark upon vehicle tyres would have the result that a number of persons would be caused to wonder whether it might not be the case that those tyres came from the opponent or a licensee of the opponent.

49. It is not self evident to me why anyone would think that a business centred on the holding of racing and rallying events at a single location in the UK would be a plausible, let alone likely, source of vehicle tyres.

50. Mr Arnold pointed out that normal and fair use of the applicant's mark would include use in relation to high performance tyres for use in motor sports. I accept this, but whilst this may draw the respective fields of activity closer together, it does not, in my view, provide sufficient basis for supposing that any significant number of persons are going to believe the opponent has entered into the market of vehicle tyres. What reason would the public have for so believing? It seems very unlikely that a business such as the opponent's would become a manufacturer of tyres. It could badge other companies tyres with its SILVERSTONE mark, but this would not appear to be an obvious extension of its trade. People go to the opponent's venue for entertainment not to buy spare parts for their vehicles. I would have considered it

most unlikely that the owners of entertainment venue, such as a racing circuit, would bring out an 'own brand' tyre for motor sports.

51. Mr Cunningham gives evidence that the opponent has given agreement to an insurance company to use the mark SILVERSTONE in relation to motor insurance. A further agreement was given to a ferry company to use the mark SILVERSTONE in relation to a catering facility. However, no further details of those agreements are given in evidence and, in any event, they appear to date from 1999, some five years after the relevant date. There is, therefore, no evidence to support the contention that the public had been educated to expect licensed use of the SILVERSTONE mark in different fields of activity at the relevant date in these proceedings.

52. The high point of the opponent's case appears to me to be the evidence of Mr Cunningham (Exhibit DC 2 to his first declaration) which shows that it is common practice for tyre manufacturers such as MICHELIN, GOODYEAR, DUNLOP and FIRESTONE to advertise their products at motor racing events, including emblazoning their marks and logos on racing vehicles. This raises the prospect of SILVERSTONE tyres being advertised at motor racing events.

53. For the reasons given above, I do not believe that the close proximity of the parties SILVERSTONE marks is likely to lead to confusion as to the origin of the respective goods and services. I suppose it is possible that the promotion of the applicant's mark on, for example, a motor racing car without any reference to the goods being promoted, might be mistaken for promotion of the opponent's racing circuit. However, such use would not be such as to lead to any confusion between the applicant's goods and the opponent's services, or to falsely suggest that there is any economic connection between the two. I do not therefore believe that, even if it were to occur, it would be relevant for the purposes of the test set out at paragraphs 37-39 above. Whenever two parties adopt the same trade mark for different goods and services there is always the possibility that promotion of either trade mark in isolation from a statement as to the goods/services being offered under the mark, may be mistaken for a promotion by another user of the same mark, eg "Buy Burton's" on the side of a bus could be reference to the tailor or the biscuits. It is not such as to suggest any connection between them and is not therefore objectionable for the purposes of Section 11.

54. The opponent filed a statutory declaration by Roger Etccl, who is a Director of the opponent company. Mr Etccl gives evidence that both the applicant and the opponent were represented in January 2000 at a trade show called "Autosport International" held at the NEC in Birmingham. Mr Etccl suggests that the close proximity of the parties stands was such as to give rise to confusion, although he does not claim that any actual confusion came to the opponent's attention. I accept Mr Carr's submission that this evidence takes the opponent's case no further. It merely shows co-existence.

55. As noted above, the applicant has filed evidence of its use of the mark SILVERSTONE in the UK. The reliability of this evidence has been challenged and there is some doubt in my mind about the extent of the applicant's use, at least prior to the relevant date. Nevertheless, there is clear evidence that the applicant has used its mark in the UK. The result of such use - even if after the relevant date - is potentially capable of shedding light backwards on the

likelihood of confusion at the relevant date.

56. I should record at this point that the opponent submitted a statutory declaration by Rachel Sarah Harvard, who is a Trade Mark Assistant at A A Thornton & Co. Ms Harvard gives evidence of some results of an investigation that the opponent commissioned into the applicant's use of its mark in the UK. This consists mainly of extracts from conversations between the investigator and various retailers of tyres. The name of the investigator (as opposed to that of his or her firm) is not disclosed. In some cases the name of the person to whom the investigator spoke is not disclosed either. I cannot give this sort of evidence any weight. In any event, what is alleged to have been said does little to disturb my conclusion that there has been significant use of the applicant's mark after the relevant date.

57. The applicant filed five statutory declarations from persons involved in the tyre trade supporting the contention that the applicant's use had not resulted in any confusion. Two of these declaration are from distributors of the applicant's tyres. - Mr Stephen Belcher and Mr Lance O'Riordan. Not unexpectedly, they are both supportive of the applicant's case. The other three declarants appear more independent and it is worth recording what they have to say.

58. Mr David Wilson is the editor and publisher of an internet website called "Tyres-Online". He has been involved in the tyre industry for eleven years and was editor of Tyres and Accessories Magazine from 1987-93. The relevant part of his evidence is re-produced below.

"I am aware of the Silverstone Tire & Rubber Company through my involvement in the tyre trade. I know them to be a company based in Malaysia who manufacture car tyres. I believe them to be very involved in the motor sport industry in Malaysia, but in the UK they are involved only in the sale of car tyres for commercial use and, as far as I am aware, no other industry.

I am also aware of the Silverstone racing circuit. I know this to be the racing circuit where the British Grand Prix is held. I am not aware of the Silverstone racing circuit selling, licensing, sponsoring or being associated with tyres or any other form of car accessory.

I am well aware of both these companies and their activities through my long involvement in the tyre industry and have never thought that Silverstone tyres are produced by the owners of the racing circuit. I know that there is a racing school at Silverstone racing circuit and it is probably possible to buy private racing lessons there, but I have never come across any accessories, and certainly not tyres, sold by the racing circuit.

Silverstone tyres do not advertise on Tyres-Online and, possibly for this reason, I do occasionally get enquiries as to the nature of their products. When I am asked I say that they are a Malaysian tyre manufacturer. At no time when asked has anyone thought that the tyres were produced by, sponsored or associated with the racing circuit."

59. Mr Peter Rowland Taylor is the Director of the Imported Tyre Manufacturer's Association ("ITMA"). He has worked in the tyre industry for 30 years. He says:

"Silverstone Tire & Rubber Company SDN BHD ("Silverstone") is well known to me being a member of ITMA. I know Silverstone to be a well established Malaysian manufacturer of tyres with the Silverstone tyres sold across the world. Silverstone also has a significant UK market presence and are well known in the retail tyre trade.

I was asked if I had heard of the Silverstone Racing Circuit. I replied that I had and although I was not a motor racing enthusiast I did know the circuit was used to race cars. I do not know anything more about Silverstone Racing Circuit and I am certainly not aware of any other activities that they may be involved in. I know they do not manufacture tyres or licence the Silverstone name to be used in connection with tyres.

I certainly would not think of Silverstone and Silverstone Racing Circuit in the same context. The manufacture of tyres it is a capital intensive world-wide business activity and as such it is unlikely that members of the public will be confused in any way between the two. Also, in the context of my activities as Director of ITMA I often receive telephone calls from members of the public requesting reassurances about the quality and reputation of various tyres. In this context I have never received a telephone call which even suggested confusion between Silverstone and the Racing Circuit."

60. Mr Imitiaz Umaji is a director of General Traffic Ltd, which distributes car parts. Mr Umaji has worked in the car industry for nineteen years. He says:

"Through my involvement in the car trade, I have come across the Silverstone Tire & Rubber Co Sdn Bhd ("Silverstone Tires"). I know them to be a manufacture of car tyres. The tyres are manufactured in Malaysia and sold throughout the world.

I have heard of the Silverstone racing track, but only know it to be a track on which competitive races are held. It is where the Formula One races are carried out, with such drivers as Damon Hill.

I have never come across any products put on to the market by the owners of the racing circuit. Certainly, I have never seen or heard of the Racing Circuit selling or licensing any car accessories or tyres. I only know the racing trade to be a venue for racing.

When I first came across Silverstone Tires, I did not think that they were in any way connected to the racing circuit, but was fully aware that they were independent. In all my years working in the car industry, I have never had any customers who asked me if there was a connection between Silverstone Tires and the Silverstone racing circuit or come across anyone who has been confused that the two businesses are connected."

61. Messrs, Wilson, Taylor and Umaji are all engaged in the trade in vehicle parts. They are not therefore average consumers of the goods, and for that reason the fact that they were not

confused does not mean that the average consumer was not confused into believing there to be some sort of economic connection between the parties. It is perhaps more significant that despite their proximity to the trade in vehicle tyres, all three say they have never come across customers who expressed a belief that the SILVERSTONE race track was the source of, or connected with, SILVERSTONE tyres.

62. It would be wrong to place too much weight on this evidence and I do not do so. I regard it as merely confirming the correctness of the view that I have already come to - that there is no reason for members of the public to believe or even speculate about whether SILVERSTONE tyres are connected in trade with the opponent. There is no real tangible danger of confusion. The Section 11 objection therefore fails.

Section 17

63. Section 17 of the Act is as follows:

17. -(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.

(2) Subject to the provisions of this Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.

64. The opponent says that in view of its proprietorship of the mark SILVERSTONE, the application was made in bad faith, and should be refused in exercise of the Registrar's discretion under Section 17(2) of the Act.

65. The opponent is not registered as the proprietor of the trade mark in respect of vehicle tyres or goods of the same description. The "bad faith" allegation therefore arises from the applicant's choice of the mark SILVERSTONE for different goods. Mr Lau gives the following evidence on behalf of the applicant:

"The name "Silverstone" derives from the location of my company's factory, situated in Perak, which means "silver" in Malay. The word "stone" was added because there are a number of tyre manufacturers in the Far East who use the word as part of their company names or trade marks, and my company wanted to be named in a similar way. An example of such a name is Bridgestone, a well-known Japanese tyre manufacturer which also manufactures tyres under the mark Firestone. Other examples are companies called Roadstone and Eurostone."

66. There has been no request to cross examine Mr Lau on his evidence, which I accept. I do not accept that the application was filed in bad faith. I therefore decline to refuse the application in the exercise of the Registrar's discretion on the ground stated.

67. Mr Arnold did suggest in his skeleton argument that the application ought to be refused in

exercise of the Registrar's discretion on the alternative ground that the applicant had filed misleading evidence. This ground is not pleaded and I understood Mr Arnold to retreat from the allegation at the hearing, contenting himself with the allegation that the applicant's evidence was simply inaccurate and unreliable.

68. There is nothing to suggest that the applicant has deliberately sought to mislead the Registrar. The way in which the doubts about the accuracy of Mr Ween's evidence have come to light (through the re-filing of that evidence in the opposition and the filing of further evidence from the applicant's own accountant) suggests the opposite. Accordingly, even if this ground for refusal had been pleaded, I would not have exercised the Registrar's discretion in the way Mr Arnold requested.

Costs

69. The opposition having failed the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1,200. This to be paid within seven days of the end of the period allowed for appeal.

Dated this 18TH Day of June 2001

**Allan James
For the Registrar
The Comptroller General**