

O-269-06

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2294251
STANDING IN THE NAME OF COURTESY SHOES LIMITED**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER NO. 82355
BY HALFORDS LIMITED**

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**IN THE MATTER OF a request for a declaration
of Invalidity thereto under no. 82355
by Halfords Limited**

BACKGROUND

1. On 1 March 2002, Courtesy Shoes Limited applied to register the following as a series of twelve trade marks: KIDDI-TRAKS, KIDDY-TRAX, KiddyTrax, KIDDI-TRAX, KiddiTrax, KIDDY-TRAK, KiddyTrak, KIDDI-TRAK, KiddiTrak, KIDDY-TRAKS, KiddyTraks and KiddiTraks. The registration procedure was completed on 20 September 2002.

2. The marks stand registered for the following goods and services:

Class 9: Telecommunication apparatus; radio communication apparatus; electronic transponding and responding apparatus; paging apparatus; sound recording and reproducing apparatus; position finding apparatus; protective clothing and footwear.

Class 18: Articles made from leather or from imitations of leather; articles made from plastics materials included in Class 18; bags, cases, holdalls, tote bags, rucksacks, handbags, backpacks, bags for sport and recreational purposes; shoe and boot bags; vanity cases; wallets, purses; belts and straps; harnesses; key cases; umbrellas; parasols.

Class 25: Articles of clothing, footwear, handwear and headgear.

Class 38: Telecommunications services; transmission and reception of data and messages by telecommunication; provision of services enabling one person to communicate with or positionally locate another person.

Class 45: Services for the location and retrieval of missing persons and property; services for the location and retrieval of missing persons and property using telecommunications or radio communication apparatus.

3. On 12 December 2005, Halfords Limited applied for a declaration of invalidity under Sections 47(1)/3(1)(b) and (c) and 47(2)(a) and (b)/5(2)(b), 5(3) and 5(4)(a) of the Act. They express their attack on the registration in the following terms:

“1. The applicants are well known retailers of, inter alia, cycles and equipment for cycles and cyclists.

2. The applicants are the proprietors of British Trade Mark Application No. 2108736 TRAX for protective helmets.....The applicants have been using the Trade Mark TRAX in the United Kingdom since at least 1993 on protective helmets both alone and in combination with other words. As a result they have a substantial reputation in the Trade Mark TRAX in respect of such helmets. Registration 2294251 consists of a series of Marks which are all phonetic equivalents of the words “kiddy” and either “track” or “tracks”. It is this phonetic equivalence which results in them being acceptable as a single series. Kiddy is a well known diminutive in the English language for a child and one of the meanings of the word “tracks” is to follow the progress or movement of. The mark is therefore inherently descriptive of any goods which are provided with, for example, a RFID tracking device or a GPS tracking device, which can thus enable a person to monitor the movement of the child user. It is also entirely descriptive of services which relate to the location or retrieval of missing persons and property or goods utilised in connection therewith.

Accordingly the registration was registered in breach of Section 3(1)(b) and 3(1)(c) and should be declared invalid for all the goods and services listed in the registration.

3. The registration should further be declared invalid because British Registration No. 2108736 is an earlier Trade Mark in relation to which the conditions set out in Section 5(2)(b), 5(3) and 5(4)(a) obtained or are satisfied at least in respect of protective clothing and footwear in class 9 and articles of clothing, footwear, handwear and headgear in class 25.”

4. On 25 January 2006 the Registered Proprietor filed a counter-statement in which the grounds of invalidation are effectively denied; in addition, the Applicant is asked to provide proof of use of the registration mentioned.

5. Only the Applicant filed evidence in these proceedings; both parties ask for an award of costs. Neither party requested to be heard but both filed written submissions. After a careful study of all the papers, I give this decision.

EVIDENCE

Applicant’s evidence

6. This consists of two witness statements. The first, dated 13 March 2006, comes from Philip Parker. Mr Parker explains that he is the Company Secretary of Halfords Limited, a position he has held for almost eighteen months. He confirms that he is familiar with his company’s products and is authorised to make his statement on their behalf, adding that the information in his statement comes from either his own knowledge or from company records.

7. Halfords is, says Mr Parker, the leading bicycle retailer in the United Kingdom with over 400 stores. It sells an extensive range of bicycles accessories many under its own brand. Exhibit PAP.1 consists of extracts from a Halfords Christmas Gift Guide. Whilst Mr Parker is not certain of the exact date of distribution of this Guide, he notes that the back page of the Guide contains the following wording: “Halfords a Burmah Group Company”. He explains that Burmah sold his company to Ward White Retail

UK Limited in approximately 1984 and concludes that the catalogue must predate that date. He notes that the Guide shows use of the TRAX mark in relation to trousers, jerseys, helmets and gloves.

8. Mr Parker comments that in 1993 his company began to source and have manufactured a range of cycle helmets branded with the TRAX mark. He says that while the TRAX mark is often used in combination with other names, the TRAX mark alone is also used on the helmets. Exhibit PAP.2 consists of examples of this type of use taken from his company's Bikes & Accessories catalogue of 2000, an image taken from his company's website on 17 January 2005, and extracts from his company Christmas catalogues of 1993 (possibly), 1994, 1995 and 1996.

9. Since 1993 sales of these helmets has, says Mr Parker, been extensive and would amount to tens of millions of pounds. However, as a result of changes to his company's computer software system, detailed figures for past years are unavailable. Sales between April 2004 and January 2005 amounted to 92,036 helmets at a value of £1,356,100; the corresponding figures for the previous year, for the equivalent period, amounted to 82,604 helmets at a value of £1,232,143.

10. Mr Parker explains that as a result of these sales combined with the length of time his company has been using the TRAX mark, it is recognised as one of the main brands of cycle helmets in the United Kingdom. To illustrate this point, he exhibits at PAP.3, an extract from Hansard regarding a debate which took place on 23 April 2004. The debate, which appears to relate to a Bill to make the wearing of helmets by cyclists compulsory, includes a quotation from an article which appeared in the Burnley Express. The passage, in so far as it is relevant to these proceedings, reads:

“Halfords who sell their own brand of helmets, Trax, and have a superstore based in Burnley said....”

11. In addition, Mr Parker states that his company's reputation is enhanced by the advertising that they undertake. He cites, as examples, the Christmas catalogues which he says were extensively distributed to households in the United Kingdom. He adds that his company routinely advertises in the press and on television and that from time to time products bearing the TRAX mark are included; in so far as the last two categories are concerned, I note that no examples are provided.

12. Mr Parker comments that exhibit PAP.1 to his statement illustrates the relationship between protective helmets and other clothing for cyclists. Cyclists' footwear is, he says, also often protective against accident and injury and is therefore particularly aligned with protective helmets. Exhibit PAP.4 consists of print-outs obtained on 14 June 2005 from a number of websites filed to support this contention.

13. The second witness statement, dated 14 March 2006, comes from Victor Caddy. Mr Caddy is a Trade Mark Attorney in the employ of Wynne-Jones, Laine & James who are the Applicant's professional representatives in these proceedings. Exhibit VIC.1 to his statement consists of extracts from Chambers 21st Century Dictionary in which the words “kiddie” and “tracks” are defined.

14. That concludes my review of the evidence filed in these proceedings.

The Opponent's written submissions

15. The Opponent's written submissions, contained in a letter dated 9 June 2006, makes the following points:

- that all of the marks in the series consist of the word KIDDI or a phonetic equivalent together with a misspelling or phonetic equivalent of the word TR(AC)KS. That as the marks are a series, the differences between the various marks are of such a nature as not to change the identity of the trade marks and the differences are of such a marginal nature that they will not be perceived by the average consumer as affecting the identity of the trade marks;
- that to be objectionable under Section 3(1)(c) of the Act it is sufficient that at least one of the possible meanings of the word identifies a feature of the goods or services concerned;
- that at least one possible meaning of the trade mark is that it is descriptive of apparatus which enables a person to monitor the movement of a child user. In addition, it is also entirely descriptive of services which relate to the location or retrieval of missing persons and property or goods utilised in connection therewith;
- that whilst the Registered Proprietor seeks to put the Applicant to proof of the descriptive nature of the marks, this is a matter which hangs on the ordinary meaning of the words and is not a matter for proof from the market place or elsewhere;
- that all of the goods are either capable of performing this function or being involved in this function, because for example, the Class 18 and 25 goods typically include RFID devices during sale as anti-theft features;
- that in relation to the objection based on Section 5(2)(b) of the Act, in Opposition No. B654246 between the same parties, the Opposition Division of OHIM found, in a Decision dated 23 May 2006, that the word TRAX was the dominant element of the mark KIDDI-TRAX, bearing in mind that the word KIDDI was a common misspelling of the non-distinctive word KIDDY and, that given the similarity of the marks and the identity or similarity between Classes 9 and 25, there was a likelihood of confusion;
- that the evidence of Mr Parker shows that cycle helmets are sold alongside other cycling clothing e.g. gloves and that footwear for cyclists is both ordinary and protective;
- that Mr Parker's evidence also shows that the Applicant's have a significant reputation in the TRAX mark which would allow them to bring an action for passing off under Section 5(4)(a) and that any use by the Registered Proprietor would be detrimental to this reputation and the distinctive character of their earlier mark under Section 5(3) .

The Applicant's written submissions

16. The Applicant's written submissions are contained in a letter also dated 9 June 2006 which makes the following points:

- the Applicant has not demonstrated that the registration should be declared invalid;
- regarding the Applicant's case under Sections 3(1)(b) and (c), we commend the Registrar's original decision to accept the trade mark in all its versions for registration;
- the witness statement of Mr Caddy consists of nothing more than quoting the dictionary meanings of the separate word elements of the trade mark;
- the Applicant has provided no evidence to the effect that the two word combination KIDDI-TRAX howsoever spelt is devoid of distinctive character, and we submit that on the prima facie case the words KIDDI-TRAX howsoever spelt possess distinctive character sufficient for a valid trade mark registration;
- the Applicant has provided no evidence to the effect that the words KIDDI-TRAX howsoever spelt serve or would be likely to serve to designate the kind or intended purpose of the goods covered by the registration. The fanciful argument presented in the second paragraph of the Applicant's statement of case is not supported by the evidence. There is no evidence that the words KIDDI-TRAX are descriptive now, or were so at the time of registration;
- in so far as the objections based on Sections 5(2)(b), 5(3) and 5(4)(a) are concerned, the Applicant has presented no evidence to the effect that the registration breaches these sections;
- there is no evidence of actual confusion in the market place and/or on the part of the public;
- there is no evidence of likelihood of confusion on the part of the public or evidence of a likelihood of association with the Applicant's trade mark;
- the Applicant has not made the case for the trade mark TRAX being considered as having a reputation within the meaning of Section 5(3) of the Act. Even if a reputation had been demonstrated then there is no evidence to the effect that the registration of the trade mark KIDDI-TRAX howsoever spelt would take unfair advantage of or be detrimental to the distinctive character of the trade mark TRAX;
- the Applicant has produced no evidence to the effect that cycle helmets should be regarded as similar goods to the goods and services covered by the registration.

DECISION

17. Section 47 of the Act reads as follows:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been

made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground -

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

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

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

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

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4)

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

18. I will deal first with the ground of invalidation based on Section 47(1) of the Act. This relates to objections under sub-paragraphs (b) and (c) of Section 3(1) of the Act. These read as follows:

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

(a).....

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d).....

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.”

Section 3(1)(c)

19. The Registered Proprietor has not filed any evidence in these proceedings. I have therefore only the inherent characteristics of their marks to consider.

20. There are a number of European Court of Justice judgments which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – (*Wm Wrigley Jr & Company v OHIM* – Case 191/01P (Doublemint) paragraph 30;
- thus Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;
- however such a combination may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements – *Koninklijke Nederland NV v Benelux Markenbureau*, paragraph 99.

21. The marks the subject of the registration consist of the words KIDDI, and KIDDY (in upper and title case) together with the words TRAKS, TRAX and TRAK (also in upper and title case). In some of the marks the elements are hyphenated as in, for example, KIDDI-TRAX and in others the elements are conjoined as in, for example, KiddiTrax.

22. It is well established that the distinctive character of a mark must be assessed in relation to the goods for which registration is sought. In the present case, that is for a range of goods and services in Classes 9, 18, 25, 38 and 45. The mark must also be assessed by how it is likely to be perceived by the average consumer which, in this case, I consider to be the general public.

23. In their statement of case and written submissions, the Applicants comment that in their view the marks would be seen as describing, for example, apparatus which enables a person to monitor the movement of a child, and goods and services relating to the location or retrieval of missing persons and property. Exhibit VIC.1 to the witness statement of Mr Caddy consists of an extract from Chambers 21st Century Dictionary which provides definitions for the words “kiddie” and “track”. I note that “kiddie” or “kiddy” is defined as “*colloq* a small child” and that there are a number of definitions of the word “track” including: “a line path or course of travel, passage or movement”.

24. It is clear from the principles mentioned above, that: (i) if a mark produced by a combination of elements is to be regarded as descriptive, it is not sufficient that each of its components may be descriptive the mark itself must also be descriptive, (ii) that merely bringing together descriptive elements without unusual variations cannot assist a mark in escaping objection, and (iii) such a combination may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the combination of elements.

25. The word “kiddy” has the meaning indicated above i.e. a small child. The word “track” or “tracks” has a range of meanings and I accept that one of these meaning is “to follow the progress or movement of”. As indicated above, all of the marks the subject of the registration contain either the word “kiddy” or “kiddi” (in upper or title case) as a separate identifiable prefix element, together with the words “trak”, “traks” or “trax” (also in upper or title case) and also as a separate identifiable suffix element. Do then the six marks consisting of the word “kiddy” together with phonetic equivalents of the word “track” or “tracks” fall foul of Section 3(1)(c) of the Act? If they do not, the Applicant is, in my view, in a weaker position in relation to the remaining six marks which consist of only phonetic equivalents of the word “kiddy” and “track” or “tracks”.

26. The Applicant’s objections relates to goods and services which allows one to monitor the movement of a child or to locate and retrieve missing persons and property; they say that all of the goods and services are capable of performing or being involved in this function. With the exception of “protective clothing and footwear”, I accept that the goods in Class 9 and all of services in Classes 38 and 45 may be used or are to be used to locate and retrieve missing person and property. However, I am far less convinced that the remaining goods in Class 9 and the goods in Classes 18 and 25 would be used for this purpose. Turning to the marks themselves, it is, in my view, extremely doubtful if even the words “kiddy” and “track” or “tracks” (in their ordinary spellings) and presented in the same manner as the marks the subject of the registration would attract objections under this head. I have therefore no hesitation in concluding that in the form in which they are registered, the marks the subject of the series

are sufficiently far removed from terms that may serve in trade to describe goods and services which are designed to track or to be used in association with the tracking of children, people or property, to render them all acceptable under Section 3(1)(c) of the Act. The objection based on Section 3(1)(c) of the Act is dismissed accordingly.

I now turn to the objection based on Section 3(1)(b) of the Act.

Section 3(1)(b)

27. I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- an objection under Section 3(1)(b) operates independently of objections under Section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- 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);
- a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Koninklijke KPN Nederland v Benelux Merkenbureau*, paragraph 86);
- a trade mark's distinctiveness is not to be considered in the abstract but rather by 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 Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- 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*).

28. It is clear from the authorities mentioned above, that (i) an objection based on Section 3(1)(b) of the Act operates independently of an objection under Section 3(1)(c) of the Act, (ii) that for a mark to possess a distinctive character it must identify the product for which registration is sought as originating from a particular undertaking and thus to distinguish that product from the products of other undertakings and (iii) that a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.

29. Earlier in this decision I found that the marks the subject of the registration do not fall foul of the provisions of Section 3(1)(c) of the Act. I see no reason having reached that view, and having applied the guidance indicated above, why the marks should be considered to be devoid of any distinctive character and the objection based on Section 3(1)(b) of the Act is also dismissed.

30. I now turn to the ground based on Section 47(2) of the Act in relation to objections based on Sections 5(2)(b), 5(3) and 5(4)(a) of the Act. I note that in Box 6 of Form TM8 (the Notice of defence and counterstatement), the Registered Proprietor puts the Applicant to proof of use of the single mark they rely on in relation to the grounds based on Section 5(2)(b) and 5(3) of the Act.

31. Registration No.2108736 for the mark TRAX was applied for on 29 August 1996 and is registered in respect of “Protective helmets” in Class 9. I note that the registration procedure was completed on 11 July 1997 and that the Application for Invalidity was filed on 12 December 2005. As such, the registration is clearly subject to the provisions of Section 47(2A)(c), (2B), (2C) and (2E) and the relevant period is: 13 December 2000-12 December 2005.

32. The guiding principles in relation to what constitutes genuine use can be found in the ECJ’s judgment in *Ansul BV and Ajax Brandbeveiliging BV (Minimax)* [2003] RPC 40. The relevant paragraphs are as follows:

“36 “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37 It follows that “genuine use” of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Art.10(3) of the Directive, by a third party with authority to use the mark.

38 Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.”

33. In his evidence, Mr Parker explains that the mark the subject of registration has been used since at least as early as 1984. In exhibit PAP.1, the TRAX mark can be seen on, inter alia, a cycling helmet; I note that it appears in a highly stylised format and is accompanied by the word “Pro”. In 1993 the

Applicant began to source and have manufactured a range of cycle helmets which were branded with the TRAX mark. He explains that while the TRAX mark often appears with other names, it is also used alone. Exhibit PAP.2 consists of a range of catalogues dating from 1993, 1994, 1995, 1996 and 2000 and a website extract from January 2005, in which the TRAX mark appears on cycling helmets. Only the Bikes & Accessories 2000 catalogue and the website extract fall within the relevant period. In the catalogue I note, for example, that whilst the helmets shown all contain what I take to include secondary branding i.e. TRAX GRANIT, TRAX OVERRIDE, TRAX AVIUS, TRAX REAVER and TRAX SEISMIC, all of the helmets bear the TRAX mark appearing alone (and, in my view, in a form which does not alter its distinctive character) on the front of the helmet. Sales are said to have amounted to “tens of millions of pounds” with sales in the period April 2004 to January 2005 amounting to 92,036 helmets at a value of £1,356, 100; the corresponding figure for the previous year, for the equivalent period, was 82,604 helmets at a value of £1,232,143. Finally, the Applicant states that the mark is promoted through advertising by means of the catalogues mentioned above and by way of press and television advertising, although no examples of press and television advertising are provided.

34. Whilst no documentation has been provided to corroborate the Applicant’s assertions as to sales of goods under the mark, I note that Mr Parker’s evidence has not been challenged by the Registered Proprietor. That being so, and having applied the guidance in *Ansul* to the circumstances of this case, I am satisfied that the Applicant has made genuine use of their TRAX mark, but not in relation to protective helmets at large. Class 9 includes a wide range of protective headwear. For example it includes, amongst others, protective helmets for industrial use, respiratory helmets, shotblasters’ helmets and welding helmets.

35. In my view, the evidence provided only shows use in relation to helmets for cyclists. As such, the provisions of Section 47(2E) apply, and I must consider the Application as if the TRAX mark is registered only in respect of a specification of goods for which the Registered Proprietor has proven use. The effect of Section 47(2E) is much the same as Section 46(5), where, in Revocation proceedings based on alleged non-use of a registered trade mark, the evidence shows use of the trade mark in respect of some, but not all of the goods for which a mark is registered. In such circumstances the specification is restricted, but not necessarily to an exact description of the goods or services for which use has been shown.

36. So, that brings me to what would constitute a fair specification of goods having regard to the use shown. In this regard, I look to the guidance contained in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 where Aldous L J said:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for “motor vehicles” only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is

envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

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

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

37. Having applied the guidance in *Thompson Holidays*, it appears to me that cycle helmets is a fair specification for the goods on which the TRAX mark has been used. In his evidence Mr Parker refers to the goods as cycle helmets and the goods are referred to as cycle helmets in a number of the documents in exhibit PAP.2. I am fortified in this view by the decision in *Reckitt Benckiser (España) SL v OHIM (Aladin) Case T-126/03* where the Court of First Instance had before it on appeal a case where the OHIM Opposition Decision had been of the view that the opponent had shown proof of use in relation to "a product for polishing metal consisting of cotton impregnated with a polishing agent (magic cotton)". That is to say, a sub-category of the specification for which the mark was registered, 'polish for metals'. In finding that the Opposition Division's (and Board of Appeal's) approach was overly restrictive the CFI held that:

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

It is on the basis of use on cycle helmets that I will now consider the grounds based on Section 47(2)/Sections 5(2)(b) and 5(3) of the Act.

38. Section 5(2)(b) reads as follows:

“5.-(2) A trade mark shall not be registered if because -

(a)

(b) it is similar to an earlier mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

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

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

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

The trade mark on which the Applicant relies is an earlier trade mark as defined by Section 6(1) of the Act.

39. In reaching a decision I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG* who is deemed to be reasonably well informed and circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse it's various details; *Sabel BV v. Puma AG*;

- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*.

Comparison of goods

40. The Registered Proprietor's mark is registered in Classes 9, 18, 25, 38 and 45; earlier in this decision I determined that the Applicant's mark has been used in respect of cycle helmets. In *Canon Kabushiki Kaisha and Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, the ECJ has given the following guidance when it comes to comparing goods (and services):

“23 In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

(see paragraph 56 of Case T-169/03 explaining the change from ‘end consumers’ to ‘intended purpose’. This appears to have resulted from a mis-translation of the original text.)

41. In determining whether the goods and services covered by the Registration are similar to the goods covered by the Applicant's mark, I also bear in mind the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 as set out below:

“[T]he following factors must be relevant in considering whether there is or is not similarity:

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

42. Whilst I accept that in view of the judgement of the ECJ in *Canon* the above case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions, which are those listed above, are still relevant in respect of the comparison.

43. Having applied the above guidance to the circumstances of these proceedings, it is, I think, self evident that the goods on which the Applicant has used their TRAX mark namely cycle helmets can not be considered similar to: “telecommunication apparatus; radio communication apparatus; electronic transponding and responding apparatus; paging apparatus; sound recording and reproducing apparatus; position finding apparatus” in Class 9 nor to any of the goods and services in Classes 18, 38 and 45. The nature, intended purpose and method of use of the respective goods and services are clearly different, they are neither in competition with each other nor are they complementary. Indeed it appears that the Applicant foresaw such an outcome when, in relation to the scope of the invalidity based on Section 5 of the Act they said, inter alia, in paragraph 3 of their statement of case:“.. should further be declared invalidat least in respect of protective clothing and footwear in class 9 and articles of clothing, footwear, handwear and headgear in class 25.” In *Alecansan, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-12/04, the CFI stated:

“35 However, a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services referred to in the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative (Canon, paragraph 22, concerning the provisions of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), and Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraph 51, concerning Article 8(1)(b) of Regulation No 40/94). Thus, even where the sign applied for is identical to a mark which is highly distinctive, it must be established that the goods or services covered by the opposing marks are similar (judgment of 1 March 2005 in Case T-169/03 *Sergio*

Rossi v OHIM- Sissi Rossi (SISSI ROSSI) [2005] ECR II-0000, paragraph 53; see also, by analogy, Canon, paragraph 22).”

Consequently, as there is no similarity of goods in respect of the goods identified earlier in Class 9, and the goods and services in Classes 18, 38 and 45, there can be no likelihood of confusion and the request for invalidation against these goods and services under Section 5(2)(b) of the Act is dismissed accordingly.

44. That said, I now have to consider whether cycle helmets in Class 9 are the same or similar goods to “protective clothing and footwear” in Class 9 and to “articles of clothing, footwear, handwear and headgear” in Class 25. In his evidence Mr Parker states that exhibit PAP.1 illustrates the relationship between protective helmets and other clothing for cyclists, whilst PAP.4 illustrates the relationship between protective helmets and footwear for cyclists which also have a protective function. In this regard, I note that in exhibit PAP.1 the Applicant’s TRAX mark is used on goods described as: “Trax Trousers”, “Trax Pro Jersey”, “Trax Sliders” and “Trax Pro Gloves”. Exhibit PAP.4 consists of printouts dated 14 June 2005 from a range of websites designed to show that footwear for cyclists has a protective element. The first reference is to a US based website called: Bicycle Buys.com and refers to the Cannondale range of, inter alia, cycling shoes; I note the highlighted reference to the Cannondale Carve Cycling Shoe namely: “...Injection moulded exterior heel and toe counters for superior support and protection...” The second, third and fourth references refer to a United Kingdom website called Wiggle.co.uk and refers to: the Gaerne Polar MTB Competition Shoe; I note the reference to: “The heel cup stabilizes the heel for extra control and prevents tendonitis”, the Shimano MT30 Shoe; I note the reference to: “toe reinforcement” and the Specialised Sawpit MTB Shoe; I note the references to: “First shoe to fully recognise the performance and protection requirements for the aggressive trail rider...”, “..& designed to reduce injuries” and “..moulded carbon impact protection panels”.

45. In so far as the “protective clothing and footwear” are concerned, in my view, the phrase protective clothing would include protective headwear and as such the goods are identical. In so far as footwear in Class 9 is concerned, this can only be footwear of a protective nature. However, it would not include, for example, footwear for use by cyclists whether of a protective nature or not; these goods would be proper to Class 25. The protective footwear in Class 9 is, for example, footwear for protection against fire or acid. That being the case, I do not think that the term footwear appearing in Class 9 of the registration is similar to the Applicant’s cycle helmets notwithstanding that they are both in the same Class.

46. Turning now to Class 25 of the registration, I note that the specification is unlimited. As such, all of the goods named could be specifically designed for or adapted for use by cyclists. I have already indicated above that cyclists’ footwear would be proper to this Class, and note that the same would be true of articles of clothing designed for or adapted for use by cyclists, for example, the trousers, jersey and gloves shown in exhibit PAP.1. Applying the *Canon* and *Treat* criteria to the relationship between the Applicant’s goods in Class 9 and the Registered Proprietor’s goods in Class 25, I have come to the conclusion that as the respective goods are likely to be sold to the same users i.e. cyclists, for the same purpose i.e. cycling, in either bespoke cycling retail outlets or in the same area of outlets retailing, inter alia, bicycles, and as the respective goods are clearly complementary, that the Registered Proprietor’s goods in Class 25 are similar to the Applicant’s goods in Class 9.

47. In summary, in relation to the similarity of goods, I have concluded that the goods on which the Applicant has used their TRAX mark are similar to protective clothing in Class 9 and to articles of clothing, footwear, handwear and headgear in Class 25. However, they are not similar to the remaining goods in Class 9 nor to the goods and services in Classes 18, 38 and 45.

Comparison of marks

48. I now go on to consider the respective marks, For the sake of convenience, the respective marks are reproduced below:

Applicant's trade mark:

TRAX

Registered Proprietor's trade marks:

KIDDI-TRAKS, KIDDY-TRAX,
KiddyTrax, KIDDI-TRAX, KiddiTrax,
KIDDY-TRAK, KiddyTrak, KIDDI-TRAK,
KiddiTrak, KIDDY-TRAKS, KiddyTraks
KiddiTraks

49. The reputation of a trade mark is an important consideration when making a determination under Section 5(2) of the Act, as it may enhance the distinctive character of the earlier trade mark and in so doing widen the penumbra of protection. The Applicant's mark consists of the word TRAX in upper case. In relation to the goods for which it is has been used, cycle helmets, it may be seen as the phonetic equivalent of the pluralized version of the dictionary word TRACK (meaning a course for running or racing) and as such may allude to cycle helmets designed or adapted for use on tracks, although I accept that this is doubtful. As an unused mark the word has, in my view, an above average degree of distinctive character. However, when one also factors in the use that the Applicant has made of the mark this, in my view, enhances the distinctive character of the mark appreciably.

50. With these observations on the distinctive character of the Applicant's mark in mind, I now go on to compare the respective trade marks from the visual, oral/aural and conceptual standpoints. Turning first to the visual comparison. As mentioned above, the Applicant's mark consists of the word TRAX presented in upper case. The Registered Proprietor's marks consist of the words KIDDI and KIDDY (in upper and title case), conjoined or hyphenated to the words TRAK, TRAKS, and TRAX also in upper and title case. Given the presentation of the Registered Proprietors marks, the word TRAX is presented as a separate identifiable suffix element in the following marks: KIDDY-TRAX, KiddyTrax, KIDDI-TRAX and KiddiTrax. So, in relation to these four marks, the Applicant's mark shares a reasonable degree of visual similarity. In so far as the remaining eight marks are concerned, the degree of visual similarity is reduced somewhat and relies on the similarity between the Applicant's mark and the separately identifiable TRAK and TRAKS elements present in the Registered Proprietor's marks.

51. In *React Music Limited v Update Clothing Limited* (BL O/258/98) the Hearing Officer said:

“There is no evidence to support Ms Clark's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a

significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go as far to say that aural means of identification are not relied upon”.

52. This view was supported on appeal to the Appointed Person (*REACT Trade Mark* [2000] 8 RPC 285 lines 22 to 26) and I believe it to be appropriate to the present case. I see no reason why the same considerations would not apply to cycle helmets and protective clothing in Class 9.

53. I now turn to the oral/aural comparison. The Applicant’s mark consist of a single syllable word, whereas all the Registered Proprietor’s marks consist of three syllables. Whilst all of the Registered Proprietor’s marks contain an element which is phonetically identical to the Applicant’s mark, this forms the second element of the respective marks and as such is likely to be given less significance in spoken use. Consequently, I conclude that the marks share only a modicum of oral/aural similarity.

54. Turning finally to the conceptual comparison, the Applicant’s evidence establishes that the word “kiddie” or “kiddy” means a small child, a point of which I would have been prepared to take judicial notice had evidence not been provided; in my view, the variant spelling i.e. “kiddi” is likely to be similarly viewed. In addition, the words Trax, Trak and Traks are likely, in my view, to be seen as phonetic equivalents of the word TRACK(S) and treated accordingly. Conceptually, the Applicant’s mark may be seen (by some) to hint at goods for use on tracks, whereas the Registered Proprietor’s marks may be seen as hinting at goods for children for use on tracks. Consequently, in my view, the respective marks share similar conceptual ideas.

Likelihood of confusion

55. In reaching a conclusion, I must apply the global approach advocated having assessed the degree of visual, oral/aural and conceptual similarity between the respective trade marks. I must keep in mind the degree of similarity between the specification of goods for which the Applicant have used their mark and the relevant goods in Classes 9 and Class 25 for which the Registered Proprietor’s mark is registered. I must also keep in mind the traits of the average consumer of the goods in question, who in my view, would be the general public. Given the nature of the goods now at issue in these proceedings i.e. protective helmets and protective clothing in Class 9 and clothing in Class 25 the average consumer is likely to pay a relatively high level of attention to their purchase.

56. Having considered all of these interdependent factors, I have concluded that: (i) there is a reasonable degree of visual similarity between the Applicant’s mark and the Registered Proprietor’s marks which have the word TRAX as a separate identifiable element, and a lesser degree of visual similarity with the eight remaining marks, (ii) that the marks share only a modicum of oral/aural similarity and (iii) that the respective marks share similar conceptual ideas. I must also bear in mind that the words “kiddy” and in my view “kiddi” as they appear in the Registered Proprietor’s marks are likely to be perceived by the average consumer as denoting goods suitable for children; while these elements will not be ignored or overlooked, it is, in my view, highly likely that the identifiable suffix element of the marks is likely to be given greater significance.

57. Taking all of the above into consideration, and bearing in mind the well established principle of imperfect recollection, I have to come to the clear conclusion that there would be a likelihood of confusion between the Applicant's mark and the twelve marks in the series in so far as protective clothing in Class 9 and articles of clothing, footwear, handwear and headgear in Class 25 are concerned and the Application based on Section 5(2)(b) succeeds to that extent. It fails in relation to the remaining goods in Class 9 and in respect of all of the goods and services in Classes 18, 38 and 45.

58. I now turn to the Objection based on 47(2)/Section 5(3) of the Act. As a result of regulation 7 of The Trade Marks (Proof of Use etc) Regulation 2004, Section 5(3) now reads:

“5.-(3) A trade mark which -

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

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

59. In their statement of case, the Applicant does not indicate the nature of their objection under this head. However, I do note that in their written submissions they say:

“Similarly under Section 5(3) any usage of the type suggested by the Applicant's application can only be detrimental to this reputation and the distinctive character of the earlier trade mark.”

The first requirement to be met under Section 5(3) is for the earlier trade mark to be identical or similar to the trade marks the subject of the registration. I have already determined that the Applicant's mark is similar to the Registered Proprietor's marks in relation to named goods in Class 9 and the totality of the specification in Class 25. However, I found that there was no similarity of goods and services with the remainder of the goods in Class 9 and all of the goods and services in Class 18, 38 and 45.

60. The next requirement is that the opponent's mark possesses a reputation in the UK to the extent set out by the ECJ in *General Motors Corporation v. Yplon SA* [1999] E.T.M.R. 122. The court concluded that the requirement implies a certain degree of knowledge amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

61. I have already reviewed the use that the Applicant has made of their mark earlier in this decision. In his evidence Mr Parker explains that the Applicant is the leading bicycle retailer in the UK with over 400 stores. Even if I assume that these stores are throughout the United Kingdom, and that the TRAX mark has been used since as early as 1984, and whilst I note Mr Parker's comments to the effect that “sales of

these helmets has been very extensive since 1993 and over the full period the sales would amount to tens of millions of pounds”, I have only been provided with sales figures for April 2003 to January 2004 and April 2004 to January 2005. Whilst these figures amount to sales in the amount of approximately £2.6m representing the sale of 174, 640 helmets, I am not provided with details of the size of the market for such goods, nor I am I told the Applicant’s market share. Similarly in relation to advertising, Mr Parker says: “This reputation is enhanced by my company’s advertising”. He mentions the Christmas catalogues which he says were extensively distributed to households in the United Kingdom, and that his company routinely advertises in the press and on television and that from time to time TRAX products are included. As I mentioned earlier in this decision, no examples of press or television advertising are provided nor is an indication of the amounts spent promoting the TRAX mark via these various methods.

62. Put simply I have not been provided with sufficient information to satisfy me that the Applicant’s TRAX mark has a reputation in the United Kingdom; the consequence of which, is that the ground of objection based on Section 47(2)/ 5(3) of the Act fails accordingly.

63. The final ground of objection is based on Section 47(2)/Section 5(4)(a) of the Act. That section 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.”

Mr Geoffrey Hobbs QC, sitting as the Appointed Person set out a summary of the elements of an action for passing off in his decision in the *Wild Child* Trade Mark case [1998] RPC 455. Mr Hobbs summarised the requirements as follows:

“(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

64. Given my findings above, I have no hesitation in finding that the Applicants have goodwill in their TRAX mark in relation to cycle helmets. I have also found that there is a likelihood of confusion between the Applicant's mark and the marks of the registration in so far as protective clothing in Class 9 and the Class 25 element of the registration are concerned. It follows, that for the purposes of Section 5(4)(a) of the Act, I would accept that there is a misrepresentation which would lead to damage to the Applicant; in that respect at least, the objection under Section 5(4)(a) is successful, but to no greater extent than the objection based on Section 5(2)(b) of the Act.

65. In exhibit PAP.1 the Applicant has provided examples of the word TRAX, (together on occasion with the word Pro) in use in relation to trousers, jerseys, sliders and gloves but no sales or promotional figures are provided in relation to these goods nor has any use of the word TRAX been provided in relation to any goods or services not within the scope of the original registration.

66. In *South Cone v Jack Bessant, Dominic Greensmith, Kenny Gary Stringer (a partnership)* [2002] RPC 19 Pumfrey J, in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a), said at paragraphs 27 and 28:

“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 and Co. Ltd's Application (OVAX)* [1946] 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 473). 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 to the relevant date.”

67. I do not consider that the applicant has discharged the onus of showing that they have a goodwill in any goods or services beyond cycle helmets, nor that the necessary misrepresentation required by the tort of passing off will occur in relation to the remaining goods in Class 9 nor any of the goods and services in Classes 18, 38 and 45; the opposition under Section 5(4)(a) in this regard fails accordingly.

Summary

68. In summary I have concluded that:

- the objections based on Sections 3(1)(b) and (c) of the Act fail:
- the objection based on Section 5(2)(b) of the Act succeeds in relation to “protective clothing” in Class 9, and “articles of clothing, footwear, handwear and headgear” in Class 25 and the registration will be declared invalid in respect of these named goods;

- the objection based on Section 5(2)(b) of the Act fails in relation to the remainder of the goods in Class 9 and all of the goods and services in Classes 18, 38 and 45;
- the objection based on Section 5(3) of the Act fails because the Applicant has failed to establish the necessary reputation;

and:

- the objection based on Section 5(4)(a) of the Act succeeds but to no greater extent than the objection based on Section 5(2)(b) of the Act.

COSTS

69. Although the Applicants indicated in their statement of case that invalidation under Sections 5(2)(b), 5(3) and 5(4)(a) was sought: “at least in respect of protective clothing and footwear in Class 9 and articles of clothing, footwear, handwear and headgear in Class 25”, it is clear that they attacked the registration (under both Sections 3 and 5 of the Act) in its entirety; they have of course only been partially successful. Similarly, the Registered Proprietor defended the registration in its entirety also with partial success. As each party has achieved a measure of success in these proceedings, I propose to make no order as to costs.

Dated this 21st day of September 2006

C J BOWEN
For the Registrar
the Comptroller-General