

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Trade Mark Registration  
No: 2011477 in the name of Armando Pollini**

**and**

**An Application under No: 9349 for a declaration  
of invalidity by Calzaturificio Pollini SpA.**

### **BACKGROUND**

1. The following mark was applied for on 17<sup>th</sup> February 1995:

**ARMANDO POLLINI**



It is registered specifying these goods:

Class 18: 'Handbags, luggage, shoulder bags, beach bags, clutch bags, all purpose sports bags, attache cases, school bags, tote bags, travelling bags, credit card cases, document cases, passport cases, cosmetic cases sold empty, keycases, knapsacks, rucksacks, briefcases, purses, wallets, travelling trunks, suitcases, umbrellas, parasols, walking sticks'.

Class 25: 'Underwear, brassieres, corsets, hosiery, petticoats, nightgowns, pyjamas, pullovers, dressing gowns, bath robes, gloves, cardigans, hats, jerseys, ties, foulards, scarves, sweaters, socks, stockings, trousers, leggings, skirts, jackets, jerkins, shirts, vests, jumpers, track suits, blouses, jeans, pants, bermuda shorts, T-shirts, caps, panties, sweat-shirts, suits and dresses, overcoats, coats, anoraks, raincoats, bathing suits, belts, shoes, boots, slippers'.

2. The mark is registered in the name of Armando Pollini Design SpA, Via Gambolina 48, Vigevano (Pavia), Italy, which I, for the purposes of this decision, will call AP.
3. On 13<sup>th</sup> December 1996, Calzaturificio Pollini SpA (CP) filed their application for a declaration of invalidity. The grounds, under s. 47 of the Act, are two-fold: s. 3(6) in that the mark was filed in bad faith because the RP knew or ought to have known that the POLLINI portion of the trade mark was in the ownership of the applicant at the date of the application; and under s. 5(4)(a) because use of the mark is liable to be prevented by virtue of the law of passing off protecting the unregistered trade mark POLLINI, used in the course of trade by the applicant.
4. AP denies the grounds, and both sides ask for costs.

5. The matter came to be heard on 6<sup>th</sup> April 2001, when the applicants were represented by Mr Hacon of Counsel, instructed by Lewis & Taylor. The RPs were represented by Mr Edenborough of Counsel, instructed by Mewburn Ellis.

6. The request for the declaration of invalidity is made under ss 47(1) and 47(2)(b) of the Act. These state:

‘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).

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

(a) .. ,

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

7. This case turns on two matters: bad faith under s. 3(6) and passing off under s. 5(4)(a). The latter turns on the evidence of use by the parties, and I will examine this in a moment. But I wish to deal with the former ground first. S. 3(6) states:

‘A trade mark shall not be registered if or to the extent that the application is made in bad faith’.

The applicants base this ground on a legal agreement made in Italy in 1976 (the ‘Settlement’). A translation was provided by AP, and it states, as follows:

#### ‘DEED OF OUT OF COURT SETTLEMENT

between

Mr Armando Pollini, Cso Milano 6, Vigevano, and Snc CALZATURIFICIO POLLINI DI VITTORIO POLLINI eC.

#### WHEREAS

- C with deed of summons served on December 29, 1976 Snc Calzaturificio Pollini brought before the Court of Ravenna - among others - Mr. Armando Pollini;
- C through his appearance on April 2, 1977 Mr Armando Pollini, in person and as owner of the individual company of the same name, appeared before the Court;
- C the parties - with the assistance of their respective lawyers - decided to resolve the controversy out of Court.

That having been stated:

(1) Mr. Armando Pollini, in implied and complete satisfaction of the claims put forward by Calzaturificio Pollini, undertakes, with regard to footwear of any kind:

- C not to use, in order to identify, mark and/or sign his own products/creations, the same typographical characters used by Calzaturificio Pollini;
- C not to use his surname alone, but only together with his Christian name;
- C always to use his own name and surname preceded or followed by the words “designed by”, “designer” or “stylist” or other equivalent.

With the exception of the aforementioned, Armando Pollini has the right to use his own characteristic signature, as per the example signed this day by the parties.

In any event with regard to articles other than footwear - where applied to footwear, and always excluding the use by Armando Pollini, of the surname Pollini alone -

- C Armando Pollini may use both his own signature, in the aforementioned characters, and his own name and surname, provided accompanied by another creative word, consisting of at least three letters.

(2) On its part, Calzaturificio Pollini may not use, for its own distinctive signs, the same graphic signs that distinguish the A Pollini creations.

In the case of signature or initials as designer of the products, the name of the designer having the surname Pollini must be well specified.

(3) Mr Armando Pollini and Snc Calzaturificio Pollini decided to abandon, according to art. 309 of the Civil Procedure Code., the civil lawsuit pending before the Court of Ravenna, G.R. No. 22/77. Investigating Judge Dr. Raspini, costs and fees thereof to be entirely covered by the parties’.

8. This can be found in Exhibit DAT2 to Mr David Alan Taylor’s declaration, who is a Registered Trade Mark Agent, employed by AP’s agents. Mr Taylor also refers to the following legal actions that occurred in Italy:
  - C Law suit No. 22/77 before the Court of Ravenna (Italy) (which resulted in the out of court settlement).
  - C Action N° 6851/85 before the court of Milan (Italy).
  - C Decision No. 11430/1997, which arose from Action N° 6851/85.
  - C An Appeal by AP against Decision No. 11430/1997, dated 19<sup>th</sup> June 1998.
  
9. This represents a long history of legal disputes, described mor fully in Exhibit DAT-1, pages 2 to 5. ‘Pollini’ is, apparently, a common surname in Italy and it appears to have been an unfortunate, but not wholly improbable coincidence, that two talented designers of shoes and handbags would share the same name. Mr Hacon pointed out, however, that all the legal actions cited had found in favour of the applicant in this case - including the appeal mentioned above, the result of which was announced at the hearing (with no objection from Mr Edenborough). It was against this background that Mr Hacon placed the AP’s successful application in the UK for the mark Amando Pollini in 1995. He was of the view that AP had no trade mark rights to the name Pollini in Italy. The only use of the name allowed there by AP - as indicated by the Settlement - was descriptive (see, for example, the third part of point

(1) in the Settlement: ‘always to use his own name and surname preceded or followed by the words “designed by”, “designer”..’ etc.). And it was this document that forms the basis of the applicants ground that the mark in suite was applied for in bad faith. Mr Hacon referred me to the familiar text of *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, where Lindsay J stated at page 379:

‘I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.’

10. Mr Hacon then stated:

‘What about this case? What we have here is a case where Armando Pollini, through his company, APD, having agreed, in order to settle litigation in Italy, essentially that he would not use POLLINI as a trade mark - he would only use it in a descriptive way that I was referring to earlier - applies for ARMANDO POLLINI simpliciter in this country. .... There can only have been two motives there. First, he wants to use ARMANDO POLLINI on shoes which were apparently made in Italy and exported to this country, so he is using the mark in a way he has agreed not to in order to avoid the consequences of earlier litigation. Secondly, because he is applying for a trade mark, he wants to stop CP from using POLLINI as a trade mark even though, effectively, he ceded the right to CP to use POLLINI when he settled litigation in April 1977.

In other words, what he wants to do is ... reverse the effect of this agreement he entered into in order to settle litigation by the backdoor, at least so far as the UK is concerned. I would suggest that falls well short of standards of acceptable commercial behaviour observed by reasonable and experienced men. If you enter into litigation with somebody, and if you settle it, by an agreed arrangement, for the use of the word POLLINI, ceding trade mark use to CP but retaining the right to say, “It was designed by me, Armando Pollini”, it is not acceptable commercial behaviour to try and get round that in jurisdictions around the world. That, in my submission, is bad faith. He is in breach of contract. Even if he were not, this was the arrangement he had reached, the commercial arrangement that he had reached to avoid litigation in Italy, and he should not and reverse it by the back door’.

11. There are a number of points here. In terms of the various legal actions between the parties in Italy, it is the usually the case that what occurs in the courts of other jurisdictions is seldom decisive when considering the effect of the law here, and the findings of the Italian courts I have largely ignored. I am not privy to either the facts presented to the Italian courts, nor to the application of Italian trade mark law. However, CP appears to have won their case on the basis of, *inter alia*, first registration of POLLINI in Italy in 1966, and AP could prove no prior right in that country sufficient to overthrow that registration. I note the response by Mr Edenborough to Mr Hacon’s submission:

‘..this is not a back door route to get round the ’77 agreement because the ’77 agreement is territorially limited. There are many disputes between many organisations that cover a large number of jurisdictions, and the various parties have different rights and different jurisdictions. As it turned out, within Italy, CP seemed to have the senior rights, but within the United Kingdom, that is not clear. ... it seems to be entirely reasonable for Armando Pollini to decide to operate within the United Kingdom, which he seems to be doing for at least ten years prior to the application. One asks rhetorically, if CP was so fussed about the breach of the settlement agreement, why did they not sue? They have had the best part of fifteen years to sue upon a breach of contract, but they have not yet done that.

So bearing in mind that Armando Pollini, firstly, is his name and, secondly, he has been using his name in relation to these goods for a very long time in Italy, I would say that using his name on those goods in a completely different jurisdiction to the one in which he was in dispute with CP is not bad faith and never could be. You need an awful lot more. So I would say that CP has not discharged the onus of proof with respect to bad faith’.

12. This is the view I incline towards. I asked at the hearing about territorial limitation of the Settlement, and Mr Hacon responded:

‘.. the agreement itself is in no sense territorially limited. It does not say anywhere in the agreement, “This, of course, only applies to Italy, but what I, Armando Pollini, reserve the right to do is sneakily go and do something else elsewhere”. It is hardly surprising. At that time, the parties, so far as one can tell - we are talking about 1977 - on the evidence were only trading in Italy, so their minds were only concerned with Italy. I do not suppose they thought about it. But if we can use the officious bystander, an animal you may have heard of, who pops up in other contexts, and if you had asked him, “Does that mean they are free to do whatever they like in England?”, would have said, “No, of course not, this is a deal about the use of the POLLINI mark”. This is the arrangement the parties have reached..’

13. The ‘officious bystander’ test is a means used by the courts to imply into contracts terms that are the unexpressed will of the parties; it is a device which fills gaps that they have left. The test works in the following way, as described by MacKinnon LJ in *Shirlaw v Southern Foundries Ltd* [1939] 2 KB 206:

“*Prima facie* that which in any contract is left to be implied and need not be expressed is something so obvious that it goes without saying; so that if, while the parties were making their bargain, an officious bystander were to suggest some express provision for it in their agreement, they would testily suppress him with a common “Oh, of course”.’

14. As Mr Hacon stated, the parties were concerned only with Italy - the Settlement had emerged from a dispute as to localised legal rights to a trade name in that country - and I doubt the effect of the contract in other legal jurisdictions was ever considered to be an obvious part of the agreement. I cannot see that the officious bystander test would work in the favour of the applicants here, and I am not prepared to imply a provision into the contract using it.
15. In short, I do not believe there is enough here to discharge the onus on the applicant in respect of bad faith. This ground fails.

16. Turning, now, to the next ground, based on the law of passing off under s. 5(4)(a), this states:

‘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...’

17. Following from *Wild Child* [1998] RPC 455, at page 460ff, Geoffrey Hobbs QC, acting as the ‘Appointed Person’ stated:

‘A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (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.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of ‘passing off’, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House’.

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.” ’

18. The applicants' evidence is found in two Statutory Declaration's by Mr Vittorio Pollini, CP's president since 1981. In the first of these, he states that his company manufactures footwear and bags and has sold its goods in the UK under the POLLINI mark since 1987. The value of the goods sold (I have included only that before the relevant date) is:

Year	£
1987	73,910
1988	132,789
1989	115,104
1990	180,025
1991	36,684
1992	106,152
1993	94,310
1994	81,932

Before 1995 there is no separation of the data between that spent on bags and that on footwear.

19. Mr V Pollini appends in Exhibit VP1 twelve invoices dated from October 1981 to December 1986. I discuss this material further below.
20. This is the sum total of the applicants' evidence before the relevant date. On 13 July 1995, CP arranged for the incorporation in the United Kingdom of the company Pollini UK Limited, which was registered for VAT in December 1995. In March 1996 (through Pollini UK Limited) CP opened its own retail outlet at 47 Sloane Street, London SW1, selling primarily footwear and bags.
21. AP also provide evidence of use before the relevant date. Exhibited to Mr Amando Pollini's Statutory Declaration is a large amount of material which, unfortunately, is mostly irrelevant, being well after the 17<sup>th</sup> February 1995. There is one reference to trade before this, and this appears in article in 'Shoe and Leather News', dated October 1995, providing a profile of Mr A Pollini. This describes the choice of location of his shop, and says: 'Pollini is fairly new to the UK market. He has been wholesaling here via agent Charles Nicole through outlets such as Kurt Geiger, Way In and Harrods....' I have read through the other material - large in extent, but small in evidential value - all after the relevant date, and mainly concerned with the opening of AP's new shop in London in late summer 1995 (see the article from 'Weekend Independent' dated 26<sup>th</sup> August 1995 headlined with: Armando Pollini's minimalist footwear will soon be on sale at his new London store', and 'Weekend Today' dated 26<sup>th</sup> September 1995 says the new shop opened in that month. This is confirmed in an extract from the Daily Mail dated 15<sup>th</sup> September 1995. Other documents suggest a 'launch' for his shop and their products around the end of the summer in 1995). All of this material features shoes alone, but for two examples where bags are exhibited - an extract from 'You' dated December 1995 and one from the Daily Mail date September 1996, both after the relevant date. (There is another, but it is unnamed and undated). Finally, there is a mention of handbags in article from 'Marie Clare' dated May 1997.
22. In passing I note, from the article in 'Shoe and Leather News', that Mr A Pollini worked in London in the 1960's. However, this appears to have been as an employee, and there is nothing to suggest - nor is any claim made - that he was trading under his own name at that time.
23. In his Declaration, Mr A Pollini states that the mark has been in the United Kingdom since 1986 and provides the following the wholesale sales figures:

Year	£
1986	3465
1987	48250
1988	79553
1989	44919
1990	23594
1991	26526
1992	51204
1993	83934
1994	107504

He also refers to advertising costs of some £734 in 1994.

24. As far as turnover data is concerned, there appears to be something of a 'score-draw' between the parties; if anything, AP began trading in the UK before CP, with the latter achieving, in general, greater sales over the same period. Neither party has questioned the extent of the sales claimed, and it seems to me that they could argue a concurrent goodwill under their respective trading names (I discuss this below).
25. But there is the invoice evidence from CP. I have represented this trade as follows:

Year	Items	Lira (000)
1981	180	5224.16
1982	113	88366.506
1983	864	21196
1984	374	29098.5
1985	2	214
1986	84	7782

26. This is 1617 items sold over 5 years, at a cost of 151881166 lira, or approximately £72324.37 worth of business, which is at wholesale prices. Of itself this would be enough to have established a good will in the name Pollini by 1985. However, though the mark POLLINI is clearly visible at the top of these documents, this evidence suffers from the following serious flaws:

(1) None of the invoices are translated. It is not my brief to translate these documents - I am not an Italian speaker and I could easily make mistakes - however, I note there are references to colours in the 'descrizione' section, as well as to 'vernice' - which could be 'patent leather' - and to 'vitello' (calf?), and 'seta' silk. But are the products footwear or, bags? Mr V Pollini does not explain - he mentions 'goods'. There is a reference on the invoice dated 26<sup>th</sup> October 1981 to 'Stivali da donna in pelle & cuoio' which I take to be 'boots for women in skin and leather'. Of course, Mr V Pollini has stated that his 'goods' are footwear and bags, and I think I can safely assume that the invoices apply to these.

(2) All the products were delivered to one trader only, that is, Kurt Geiger Limited, 95 New Bond Street, London. The latter may well have had a concession to sell products within other stores such as Harrods (see declaration dated January 1999 paragraph (b)), Selfridges Limited, Oxford Street (invoice dated 22<sup>nd</sup> December 1986) and Dickens and Jones Limited, Regent Street (invoice dated 22<sup>nd</sup> December 1986).

(3) No examples of the goods are enclosed; as a result I cannot be certain that they were sold under the Pollini mark.

27. Despite Mr V Pollini's statement that outlets such as Harrods '..attract many visitors and custom from throughout the United Kingdom..' the second of these points tends to devalue this evidence. And I think the first is fatal to it. These invoices are the only material supplying

CP with a prior right and I have no idea of the nature of that right in terms of the market established, i.e. whether it applies to footwear or bags. This is somewhat critical if I am to identify the character of the protectable goodwill. Of course, on the second point above, one might argue it unlikely that such designer goods did not carry the POLLINI name, but I cannot be certain of this. The goods could have been marketed by Kurt Geiger as 'Italian' shoes, *sans* the designer's name.

28. Really, I am being asked, with this evidence, to give the applicant the benefit of the doubt twice, and I think AP would have a justifiable right to cry 'foul' if I did that. Really, it is not up to me to make up for deficiencies in the applicants' evidence, particularly as the burden of proof lies with them (see s. 72).

29. On this basis, I think I must ignore the evidence in the invoices. And if I do, it appears to me that the parties, in the UK, have acquired concurrent rights which result in the use of confusingly similar marks without misrepresentation by either party. As Oliver LJ said in *Habib Bank Ltd v Habib Bank AG Zurich* [1982] RPC at 24:

'Where you find that two traders have been concurrently using in the United Kingdom the same or similar names for their goods or businesses, you may well find a factual situation in which neither of them can be said to be guilty of any misrepresentation. Each represents nothing but the truth, that a particular name or mark is associated with his goods or business.'

30. Even if I am wrong about the invoice evidence, I think there is another reason why I do not think it will assist CP in succeeding in a passing off case within the terms of s. 5(4)(a). It is now well established that the question of whether the defendant's use could have been prevented by the earlier right must be determined at the relevant date, that is, the date of application of AP's mark (17<sup>th</sup> February 1995). Again, the onus is on the applicants to establish that, on the balance of probabilities, they would have succeeded in a passing off action brought at that date. This is approximately 14 years after CP claim to a prior right (via the invoices) begins, and some nine years after AP began trading in the UK (according to their unchallenged evidence). The following passage is from *The Law of Passing Off* by Wadlow, (Sweet and Maxwell Second Edition 1995) paragraph 7.22:

'It is doubtful if delay on its own is ever sufficient to extinguish the right to an injunction. However, delay is relevant in a number of ways in passing-off. At its most serious, delay in suing infringers may contribute to a mark losing its distinctiveness. In that case the plaintiff's right to restrain the use of that mark is wholly destroyed and all that remains is the right to past damages up to the date when the mark ceased to be distinctive. It does not matter that the defendant may be relying on his own wrongful conduct to defeat the plaintiff's case. However, it is not delay as such that causes the loss of distinctiveness, and the plaintiff's cause of action remains if the mark is still distinctive of him despite the presence of infringers'.

31. In my view CP have not established that POLLINI remained distinctive of them at the time of AP's application for their trade mark. *Wadlow* also goes on to say that the presence of '...delay affects the evidential burden on the plaintiff, in that if the conduct of the defendant has been going on for some time adverse conclusions may be drawn if the plaintiff fails to provide evidence of actual deception and damage.' (see *Bulmer (HP) Ltd v J Bollinger SA* [1978] RPC 79; *Habib supra*). None of this has been forthcoming.

32. This issue of lack a of evidence of confusion - in the face of some nine years of concurrent trading - was raised by Mr Edenborough. Mr Hacon stated:

‘So why was there not any confusion? It is not difficult to see why not. One could just imagine somebody who is familiar with CP’s POLLINI range. It had been advertised, £35,000 a year’s worth of advertising, and maybe he bought some. He sees ARMANDO POLLINI shoes. First of all, what will he think? He will think it is a member of the same family, a member of the same outfit. They are connected in the course of trade. What is he or she going to do about it? Write to anybody? No. Suppose they like the shoes? They might buy them instead of CP’s POLLINI shoes. Will anyone ever find out that he or she was confused? Of course not. Suppose the purchaser, or potential purchaser, does not like ARMANDO POLLINI’s shoes. What will happen? What will happen is that he or she will say, “Well, these POLLINI shoes are not near as good as they look in the magazines. I will not buy those I thought they were a good brand, but I do not think so any more”. ... Again, no one will complain about anything. Why should they? The confusion will happen, and nobody will ever register it on any kind of register’.

33. I think Mr Hacon is struggling to deal with the implication that the concurrent use of the parties has for confusion under passing off. I note that the CP products have been sold to Kurt Geiger (see the invoices). This is also the case with the AP products (see the article in ‘Shoe and Leather News’, dated October 1995). Yet the applicants are unable to cite even one instance of confusion, or produce evidence from purchasers indicating they would have been confused. I think I incline to the statement made in paragraph 9 of Mr A Pollini’s declaration:

‘It is clear ... that the trade marks in question have .. co-existed for more than 10 years in the market place in the United Kingdom. Despite such co-existence the applicants for a declaration of invalidity have been unable to produce a single instance of confusion at any time during that co-existence up to the present day and especially no evidence of confusion prior to February 1995’.

The latter point is not decisive, but it is telling. It is clear from the AP’s evidence that, following the opening of their shop in Brook Street, publicity has been intense, yet the applicants have not shown any evidence of confusion in the intervening period. This may be due to the observation by Mr Edenborough that these are expensive items, and purchasers are likely to take their time when buying. There is also some evidence to suggest that the products are directed to different shoes-buying customers (see pages 1 and 2 of the translation of the Italian Appeal in Exhibit DAT-1 to Mr Taylor’s declaration).

34. For the reasons given above, I do not believe that the applicants could have succeeded in a passing off action as of February 1995. This ground fails, and the application does too.
35. AP are entitled to an award of costs. I order CP to pay them the sum of £1000. This sum is to be paid within seven days the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 6<sup>TH</sup> Day of July 2001.**

**Dr W J Trott  
Principal Hearing Officer  
For the Registrar, the Comptroller General.**