

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2204310
BY BASSI FASHIONS LTD TO REGISTER
THE TRADE MARK ROCKFORD IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 51987
BY ROCKPORT (EUROPE) BV**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2204310
by Bassi Fashions Ltd to register the Trade Mark
ROCKFORD in Class 25**

and

**IN THE MATTER OF Opposition thereto under No 51987
by Rockport (Europe) BV**

DECISION

1. On 28 July 1999 Bassi Fashions Ltd of Nottingham applied to register the mark ROCKFORD for a specification of goods in Class 25 that reads "Denim jeans; denim shirts; denim jackets; sweatshirts; t-shirts; shirts". The application is numbered 2204310. I note that it was published for opposition purposes in the Trade Marks Journal on the basis that it was "Proceeding because of distinctiveness acquired through use" and by honest concurrent use with a third party registration.
2. On 10 January 2001 Rockport (Europe) B.V. filed notice of opposition to this application.
3. They are the proprietors of the following UK and CTM registrations

No	Mark	Class	Specification
1472734	ROCKPORT	18	Articles made of leather or imitations of leather; trunks and travelling bags; packs, cases, billfolds, wallets, key fobs and key cases; umbrellas, parasols and walking sticks; all included in Class 18.
		25	Articles of clothing; footwear; headgear; all included in Class 25.
1058958		25	Articles of clothing made wholly or predominately of leather or of imitation leather; boots, shoes and slippers.



CTM 414	ROCKPORT	18	All types of bags, leather and imitation leather goods, umbrellas.
		25	Clothing, footwear, headgear.

4. Objection is said to arise under Section 5(2)(b) on the basis of the above registrations.
5. The opponents also claim to have used the trade mark ROCKPORT and to be the owner of rights at common law. Specifically use is claimed in respect of footwear and footwear accessories (e.g. shoe care products) since at least 1992 and apparel since 1996. On this basis objection is said to arise under Section 5(4)(a).
6. Finally the opponents say:

"The opponent has reason to believe that the trademark ROCKFORD of Bassi Fashions Limited has been used in conjunction with another mark which is owned by the opponent ("XCS") and in the premise thereof, the opponent contends that application no: 2204310 has been filed in bad faith and the opponent accordingly contends that application no: 2204310 ought to be refused having regard to paragraph 3(6) of the Act.

In the premise of the aforesaid, the opponent contends that insofar as application no: 2204310 has been accepted by the Trade Marks Office under the provisions of Section 7(1)(a) of the Act, use of the trade mark ROCKFORD by the applicant has not been "honest" and application no: 2204310 ought, therefore, to be refused."

7. The applicants filed a counterstatement denying the grounds of opposition and commenting as follows:

"The Applicant admits that 50 samples of a single garment design, bearing the mark ROCKFORD and the letters XCS in the design on the front in a decorative manner (as illustrated in their 1998 catalogue previously submitted in evidence) were produced. However the product was not successful and was not put into commercial production. The design was created by the manufacturer. The Applicant had no knowledge until the (Amended) Statement of Grounds were filed in these proceedings that the mark XCS was registered by the Opponent. Hence, the Applicant denies that the present Application was filed in bad faith as alleged in paragraph 7 of the (Amended) Statement of Grounds."

8. Both sides ask for an award of costs in their favour.
9. Both sides filed evidence. The matter came to be heard on 11 September 2002 when the applicants were represented by Mr T Mitcheson of Counsel instructed by Forrester Ketley & Co and the opponents by Mr M Edenborough of Counsel instructed by RGC Jenkins & Co.

Opponents' evidence

10. The opponents filed three witness statements as follows:

Ian Wilkes	-	25 June 2001
Jane Telford	-	13 June 2001
John W Banse	-	31 July 2001

11. Mr Wilkes is a trade mark attorney with RGC Jenkins & Co, the opponents' professional representatives in this matter. He conducted a search to find registered/lapsed/abandoned or refused applications in the name of entities which have Bassi as the distinctive part of their name. As the results of this search were not relied on at the hearing I do not propose to record the details.

12. Ms Telford is the Operations Manager of The Rockport Company (UK). She exhibits and adopts into these proceedings evidence she gave in a separate opposition action (No. 51495). In this earlier evidence Ms Telford indicates that ROCKPORT has been used in the UK since 1992 in relation to footwear and from 1995 in relation to apparel. A retail catalogue (for Spring-Summer 1999) is exhibited at JT1. The mark is said to feature prominently on the goods as well as appearing on point of sale materials (JT2). UK sales have been as follows:

Year	Net Value (£)
1995	5,512,742
1996	9,227,000
1997	16,269,000
1998	22,174,000
1999	22,067,000

13. The goods are promoted by means of:

- advertisements in fashion and lifestyle magazines;
- strategically placed hoardings in major towns and cities;
- television advertisements;
- cinema advertisements;

Examples of the above are exhibited at JT3 to 5.

14. Ms Telford goes on to elaborate on her company's promotional and advertising activities. Magazine advertisements have appeared in Esquire, Focus, GC, Mens Health, New Scientist,

FHM and various sports based publications. Advertisements have also appeared in national and local newspapers. The ROCKPORT mark has appeared on hoardings, bus stops, bus sides, tubes, tube stations and such like in Edinburgh, Manchester, Glasgow, Doncaster, Liverpool, Blackpool and London. Television advertising has taken place on Discovery, Granada Plus, History, National Geographic, Paramount, Sky One, Sky Cinema, Sky News, Sky Premier, Sky Sports, Sky Sports 2, Sky Sports 3, TNT, UK Gold, UK Horizons, VH-1, Boomerang, MTV, MTV Base, MTV Extra, Total Cartoon Network, Total Fox Kids, Total Nickelodeon and Trouble. Cinema advertisements have appeared in locations throughout the UK. Total advertising spend for 1999 is said to have been £2.4 million but is not broken down between the periods before and after the material date.

15. The third witness statement is by John W Banse who is The Rockport Company's Corporate Counsel. He exhibits (JB1) a letter and attachments from the applicants' trade mark attorneys written in response to the lodging of this opposition. The letter enclosed samples of the material relied on by the applicants in establishing use of their mark since 1990 in response to a citation of a third party mark.

16. Mr Banse notes that one of the examples shows use of the ROCKFORD mark alongside the sub-brand XCS (JB2). XCS is, he says, a registered mark of The Rockport Company (details are exhibited at JB3). The trade mark XCS has been used by the Rockport corporate organisation in respect of footwear and various apparel products (Exhibit JB5 refers) since 1992.

Applicants' evidence

17. The applicants filed a statutory declaration by Avinash Bassi and a witness statement by Diana Mary Wardley.

18. Mr Bassi is the Managing Director of Bassi Fashions Ltd, a position he has held since 1991. The purpose of his declaration is to deal with those parts of the opponents' evidence that deal with his company's choice of marks.

19. In so far as is relevant Mr Bassi says:

"The use of the combination of our mark ROCKFORD and the letters XCS was very limited and came about in the following way. Some of our products were formerly made for us by R.S. Leisurewear in Leicester, as we did not then have a design team. In 1995 that company created a number of designs for us, including the sweatshirt bearing the combination of the mark ROCKFORD the letters XCS and the words "extreme clothing system", of which 50 samples were manufactured for us to take to an exhibition. However, that product was not successful, failing to obtain orders at the exhibition or elsewhere, and was never manufactured in bulk or sold on a commercial basis. The company which created the design was not instructed to use the letters XCS or indeed the description of "extreme clothing system"; they created the design themselves. Prior to reading Mr Banse's Witness Statement I had no knowledge that ROCKPORT used the mark XCS or had registrations for it. I therefore deny that this use of the mark ROCKFORD and/or the letters XCS by my company has been in bad faith."

20. Ms Wardley is a partner in the firm of Forrester Ketley, the applicants' trade mark attorneys. She exhibits at DMW1 a copy of the statutory declaration and exhibits filed in support of the applicants' claim to honest concurrent use in the face of a third party registration. This evidence consists of a statutory declaration by Avinash Bassi who claims use of the mark ROCKFORD in respect of articles of outerwear since at least 1990. He lists towns and cities throughout the UK where goods have been sold. Mr Bassi exhibits at AB1 specimen invoices dated from June 1993 to September 1999. The goods are purchased from manufacturers in Hong Kong and Macau. Examples of invoices and bills of lading from May 1993 to July 1999 are exhibited at AB2. Turnover is said to have been as follows (at wholesale prices):

<u>YEAR</u>	<u>VALUE</u>	<u>QUANTITY</u>
1990	£230,000	40,000 Units
1992	£310,000	50,000 Units
1994	£560,000	80,000 Units
1996	£440,000	70,000 Units
1999	£800,000	125,000 Units

21. Advertising expenditure has been as follows:

-	the press	-	£5000
-	literature and display materials	-	£2000
-	exhibitions	-	£30,000
-	labels	-	£10,000

22. The goods have been advertised particularly in 'Menswear' and 'Menswear Buyer'. Specimen advertisements are contained in Exhibit AB3. Also exhibited are examples of trade literature (AB4a) and a poster bearing the mark (AB4b). Specimen labels are exhibited at AB5a. Photographs of shirts and jeans bearing labels on which the mark is displayed are exhibited at AB5b. Exhibit AB6a contains copies of guides for exhibitions attended by the applicants in 1997 and 1998, these being 'Northern Exposure', 'Premier Menswear' and 'MXL'. A photograph of the applicants' stand at an NEC Exhibition in August 1995 is exhibited at AB6b. The final exhibit, AB7, shows the mark in use on articles of clothing.

23. That completes my review of the evidence.

Section 5(2)(b)

24. The relevant part of the statute reads:

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

- (a)
- (b) it is similar to an earlier trade 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.”

25. I take note of the guidance from the European Court of Justice in the cases of *Sabel BV v. Puma AG* [1998] 199; *Lloyd Schuhfabrik Meyer & Co v. Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v. Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

26. It is common ground that I must consider the matter judged through the eyes of the average consumer of the goods or services in question who is deemed to be reasonably well informed and reasonably circumspect and observant. However, the average consumer rarely has the change to make direct comparisons between marks and must, instead, rely upon the imperfect picture of them he has in his mind.

27. Furthermore, I must bear in mind that the average consumer normally perceives trade marks as a whole and does not proceed to analyse their various details. I must, therefore, look at the visual, aural and conceptual similarities of the marks and assess the likelihood of confusion by reference to the overall impressions created by those marks, bearing in mind the distinctive and dominant components. I must also bear in mind that mere association, in the sense that the later mark simply brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2)(b).

Similarity of goods

28. No issue arises here. The specific items of clothing in the applicants’ specification are encompassed within the general term articles of clothing in the specification of the opponents’ earlier trade marks. For the purpose of the opposition generally I take No. 1472734 (for the mark ROCKPORT) as a convenient starting point. If the opponents do not succeed on the basis of this registration they will be no better placed from the point of view of their other earlier trade marks.

Distinctive character of the opponents’ earlier trade mark

29. I am required to take account of both the inherent distinctive character of the opponents’ ROCKPORT mark and the extent to which its intrinsic qualities have been enhanced through use.

30. It has not been suggested that ROCKPORT is in any way descriptive or non-distinctive in relation to the goods at issue. Mr Edenborough sought to make out a case for an enhanced degree of distinctive character. He relied for this purpose on Ms Telford’s evidence described above. In particular he suggested that the turnover figures demonstrated significant sales. Whilst there was no breakdown between footwear and apparel, it was in his view reasonable to infer that the figures related principally to the former. The absence of

contextual information such as market share was not, he submitted, critical as there may be many traders who could claim a reputation.

31. The relevant date at which the reputation of the opponents' earlier trade mark must be assessed is 28 July 1999. The earliest trading figures given in Ms Telford's witness statement are for 1995. A significant increase in turnover was achieved in 1997. The opponents have, it would seem, engaged in relatively high profile advertising in a variety of media though advertising and promotional spend is only given for 1999 and 2000. The latter year is after the material date and it is not possible to say how much of the 1999 expenditure took place before July of that year. Most of the exhibits relate to either 1999, 2000, are undated or dates are not discernible. Mr Edenborough suggested that it was reasonable to suppose that the promotional activity that had been referred did not start from scratch in 1999. Rather that the evidence from that time reflected a continuation of an established pattern of activity. That may well be true but, taken as a whole, the evidence leaves me in some doubt as to the impact of the mark on consumers at the relevant date. The nature of a claim that a mark has a particularly distinctive character was considered by Mr S Thorley QC, in *DUONEBS* [O/048/01]. He said, referring to the ECJ guidance in *Sabel v Puma*:

“In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by section 5(2), a consideration of the reputation of a particular existing trade mark.”

32. Those comments suggest that the threshold test is a relatively high one. It is possible that the opponents' mark did enjoy a significant reputation at the relevant date but I am not persuaded there is sufficient substantiating detail in the evidence provided to satisfy me that this is the case. Nevertheless I consider that the mark is an inherently distinctive one.

Similarity of marks

33. Mr Edenborough submitted that the first syllable, *ROCK-*, was a visually dominant feature common to both marks; that in handwritten form or embossed on goods the differences between the marks may be less noticeable; that aurally the first syllables are likely to be more important; and that conceptually both marks have associations with water crossings. Mr Mitcheson pointed to the difference in meaning and sound between the elements *-PORT* and *-FORD*. *ROCKPORT*, in his view, conveyed the idea of a seaside town whereas *ROCKFORD* had no marine connotations.

34. The ECJ guidance requires me to consider the visual, aural and conceptual similarities. It will be convenient to start with the conceptual aspect of the marks not least because it provides a key to how consumers are likely to approach them. Whilst it is necessary to be mindful of how marks are made up, consumers do not actually approach marks in a spirit of analysis or look for underlying meanings (*Sabel v Puma*, paragraph 23). Whatever similarities or dissimilarities can be drawn from the elements *-PORT* and *-FORD* seem to me to be outweighed by the fact that it is the totality of each of the marks that will impress itself

on the mind of the consumer. In that respect ROCKPORT seems to me to suggest a place name and ROCKFORD either a place name or a surname. I have not been told whether they are actual place names or surnames but I am of the view that the average consumer would, albeit subconsciously, equate them with such names and exercise the sort of care that is customarily used when faced with such names.

35. Visually there are the obvious and undeniable points of similarity between the marks but they are not such that in my judgment the average consumer would consider them to be similar. The common element is not so dominant that it is likely to outweigh the difference between the second syllables (both of which are after all common dictionary words). Those same considerations seem to me to feed through to an aural comparison. It might be said that the high point of the opponents' case is that conceptually both marks would be seen as (possibly invented) place names but that is altogether too high a level of generality to produce relevant conceptual similarity.

Likelihood of confusion

36. Both Counsel made a number of submissions in relation to the approach of consumers to goods of the kind at issue and the issue of confusion. Mr Mitcheson suggested that clothing, particularly fashion items, are not 'bags of sweets'. A reasonable degree of care is, therefore, likely to be exercised in the purchasing process. In his view that pointed to less likelihood of confusion where such goods were involved. There may be some merit in that submission but I would not want to place too much reliance on it particularly as the applicants' specification includes items such as t-shirts which may not be subjected to the same degree of attention as more expensive clothing.

37. Mr Edenborough noted that the applicants' evidence was silent on the issue of confusion. Actual instances of confusion are uncommon in Registry proceedings. Statements by applicants that no instances of confusion have come to light are rarely significant in determining the issue of likelihood of confusion. It might also be said in the applicants' favour here that both sides claim to have traded in similar goods for a number of years without the opponents being able to point to any instances of confusion. But that may be no more than a reflection of different channels of trade. I draw no conclusion in favour of, or adverse to, either side from the fact that no statements have been made on the subject of instances of confusion.

38. In coming to a global appreciation of the matter I bear in mind the following comments of Mr G Hobbs QC in *Raleigh International* Trade Mark, [2001] RPC 202:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

39. I also bear in mind that more often than not consumers do not encounter marks side by side but are exposed to them in a range of retail environments at different times. Imperfect

recollection may, therefore, play a part. But, even if it can be said that the applicants' mark might bring to mind the opponents' mark, that is insufficient unless it causes the average consumer to consider that the underlying goods came from the same or an economically linked undertaking (Canon v MGM paragraph 29). I have come to the view that there is no likelihood of confusion even allowing for the fact that the marks may be used on identical goods. The opposition therefore fails under Section 5(2)(b).

Section 5(4)(a)

40. Mr Edenborough realistically conceded that this ground did not advance Rockport's case further than the case under Section 5(2)(b). It was not pursued by way of separate submissions at the hearing. The opponents must also fail under this head.

Section 3(6)

41. The Section reads:

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

42. Mr Edenborough referred me to two cases which are often quoted by Hearing Officers when dealing with the issue of bad faith. The first is *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 where Lindsay J said:

“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.”

43. The second is *Eicher Ltd Royal Enfield Motor Units v Matthew Scott Holder* where Mr S Thorley QC said:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning MR in *Associated Leisure v Associated Newspapers* (1970) 2QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v Garrett* (1878) 7 Ch D 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under Section 3(6). It should not be made unless it is distinctly proved and this will rarely be possible by a process of inference.”

44. In relation to this latter case Mr Edenborough suggested that it was wrong to characterise all allegations of bad faith as being equivalent to commercial fraud. In his view the concept of bad faith is much broader than the concept of commercial fraud even though it would naturally include such activities.

45. Mr Mitcheson was, as I understand it, content to rely on the Gromax authority (for the purposes of the hearing before me) supplemented by references to a number of other cases which I will come to in due course. For present purposes, therefore, it is not necessary for me to comment further on the 'commercial fraud' point and whether that sets too high a test.

46. The bad faith issue was put on a number of bases in the opponents' evidence (but not it would seem in the statement of grounds). The only point relied on at the hearing was the applicants' use of the mark XCS which, the opponents claim, is a sub-brand of their own. The applicants are said to use the mark XCS in conjunction with ROCKFORD. I propose to consider the issue of law that the opponents' claim gives rise to and then the facts of this particular case.

47. The opponents have failed in relation to the Section 5(2)(b) ground. Section 3(6) provides a free-standing ground of objection but the question arises as to whether the opponents can succeed under Section 3(6) to the extent that their objection involves a complaint about the mark ROCKFORD where their relative ground objection against this mark has failed.

48. I am aware of two decisions by Registry Hearing Officers where a similar point has arisen. In MAGIGROW/MAGI-GROW Trade Marks, 0-240-01, the Hearing Officer dealt with a claim contained in a magazine article that the applicant, when searching for a name for its soluble plant feed, looked to identify names like or similar to MIRACLE-GRO (said to be a market leader in relation to such goods). An objection under Section 5(2)(b) failed. The Hearing Officer went on to deal with Section 3(6) as follows:

“While it is well established that a tribunal should not be astute to find that there is no dishonesty where there is evidence that the applicant set out to deceive, it does not follow that the adoption of a mark with some similarity to a market leader is prima facie evidence of intention to deceive and association, in the strict sense, can be used as a means of denoting a products suitability as an alternative to the market leader's product. The question in each case is whether there is a likelihood of confusion and if there is not, the use is not objectionable and there is no bad faith. The objection under Section 3(6) fails.”

49. That case was appealed to an Appointed Person and the Hearing Officer's decision was upheld, O-583-01.

50. The second case is TIMBERWEAR Trade Mark, O-042-01, where the Hearing Officer expressed the following view:

“The invalidation case was always likely to turn on the outcome of the Section 5(2) ground of attack. This requires an objective comparison of the similarity between the respective marks and goods and the resulting likelihood of confusion. A separate attack under Section 3(6) is unlikely to succeed on the basis that the registered proprietor tried, but failed, to adopt a mark that was confusingly similar to the mark of the applicant.”

51. The Hearing Officer was, it seems to me, expressing a view on the degree of difficulty likely to be encountered in relation to a bad faith claim when no likelihood of confusion has been found having regard to the marks themselves, rather than excluding completely the possibility of success under Section 3(6).

52. A separate issue arises as to whether an opponent is entitled for Section 3(6) purposes to rely on circumstances that are, strictly speaking, outside the ambit of the application itself (and in particular the mark applied for). In this case the issue is the applicants’ past use of XCS which is also said to be a sub-brand of ROCKPORT. Mr Edenborough submitted that the wording of the Section places no limits on the range of acts that may be pertinent in establishing a pattern of behaviour and hence the applicants’ bona fide in making the application. Mr Mitcheson, on the other hand, submitted that use of XCS was confined to a limited instance some time ago and that XCS was not part of the mark applied for. He referred me to both the wording of the Act which refers to bad faith in the making of the application and the following passage from *DEMON ALE* Trade Mark, [2000] RPC 345:

“The focus of attention under section 3(6) is the propriety of the applicant’s claim to the protection he seeks. The words “*if or to the extent that the application is made in bad faith*” in section 3(6) and the similar wording in the parallel Community legislation emphasise that the propriety of the application must be tested with particular reference to the specification of goods or services (and therefore the scope of protection) for which registration of the sign in issue has been requested.”

53. In *IVANA* Trade Mark, 0-393-00, the Hearing Officer took account of ‘similar fact’ evidence that, by its very nature, involved consideration of circumstances beyond the scope of the registration before him. This was an application for invalidity filed against the mark *IVANA* by House of Ivana Inc (Ivana Trump). The Hearing Officer had before him evidence that, on the same day that the *IVANA* application had been filed, a separate application had been made for the mark *IVANA TRUMP* (that application was subsequently allowed to lapse). There was, additionally, evidence of other attempts by the registered proprietor to register the names and/or drawings of Disney characters. Many had been withdrawn but others had resulted in opposition proceedings being concluded with findings against the applicant under Section 3(6). The Hearing Officer accepted that the combined effect of the evidence before him, including the similar fact evidence, was sufficient to make out a prima facie case of bad faith against the proprietor of the *IVANA* mark.

54. In the *DEMON ALE* case Mr Hobbs QC referred to Lindsay J’s remarks in *GROMAX* (quoted above) and said:

“These observations recognise that the expression “bad faith” has moral overtones which appear to make it possible for an application for registration to be rendered invalid under section 3(6) by behaviour which otherwise involves no breach of any duty, obligation, prohibition or requirement that is legally binding upon the applicant. Quite how far the concept of “bad faith” can or should be taken consistently with its Community origins in Article 3(2)(d) of the Directive is a matter upon which the guidance of the European Court of Justice seems likely to be required: *Road Tech Computer Systems Ltd v. Unison Software (U.K.) Ltd* [1996] F.S.R. 805 at pages 817, 818 *per* Robert Walker J.”

He also observed that:

“I do not think that Section 3(6) requires applicants to submit to an open-ended assessment of their commercial morality.”

55. The combined effect of the passages from the cases referred to above seems to me to suggest that great care should be exercised in introducing into an inquiry under Section 3(6) matters which may go to the propriety of an applicant’s behaviour but which are not directly associated with the application itself. However, as I have said, the opponents’ objection here is based not simply on use of XCS but the fact that the applicants have used that mark as a sub-brand in conjunction with ROCKFORD. To the extent that that is indicative of one of the circumstances in which the applicants have used the mark applied for in the past (and may do so again) it is at least arguable that it should be open to the opponents to ask for it to be considered as part of the bad faith claim. In the circumstances I propose to consider the opponents’ claim on its merits whilst recognising that this is not an area of settled jurisprudence.

56. Turning to the details of the claim in respect of use of XCS, Mr Banse says that the opponents commenced use of the mark in the UK at least as early as September 1992. It is said to have been used in respect of footwear and apparel products. No further information is given on the nature and extent of sales and no invoice or other evidence is provided to substantiate the 1992 date. One of the exhibits (JB5) referred to in Mr Banse’s witness statement has not been included in the evidence bundle. The exhibit purported to show the mark in use on footwear and apparel. I note from the Registry file that the attorney’s covering letter of 26 September 2001 only referred to four exhibits (a position that was confirmed in the indices prepared and circulated by the Registry in advance of the hearing). The exhibits to Ms Telford’s witness statement do show numerous examples of the mark XCS in use in association with the word ROCKPORT. So far as I can see the earliest date of use on any of these exhibits is 1999 (there is a Spring/Summer catalogue for that year). The only evidence relating to XCS prior to this is the opponents’ trade mark filing of 4 May 1995 (claiming a priority date of 14 November 1994).

57. The applicants have countered by explaining that a company called RS Leisurewear in Leicester created a number of their designs "including the sweatshirt bearing the combination of the mark ROCKFORD the letters XCS and the words “extreme clothing system”". There is nothing in the evidence to substantiate the 1995 date or the dealings with RS

Leisurewear relating to the creation of the mark. Equally there has been no request to cross-examine Mr Bassi on his claims.

58. Included in Exhibit AB4a is the applicants' Autumn and Winter 1998 catalogue that shows the use of ROCKFORD XCS on a sweatshirt. Thus if the matter is considered on the basis of the substantiating exhibits the applicants have demonstrated somewhat earlier use than the opponents. The opponents, therefore, face some difficulty in getting their case off the ground. They would in any case face further difficulty in establishing for bad faith purposes that the applicants had prior knowledge of the opponents' earlier use or planned use and intended to take unfair advantage of it.

59. Whilst I accept that Mr Edenborough has expressed reservations about the nature of a bad faith claim (the commercial fraud point) I do not understand him to take issue with Mr Thorley's underlying point in the Royal Enfield case that bad faith is a serious allegation which must be distinctly proved. Mr Thorley went on to say that "this will rarely be possible by a process of inference". Whilst it is possible to see why the opponents have misgivings about the combination of circumstances that have arisen, a feeling of uneasiness is insufficient for me to reach a finding of bad faith against the applicants.

60. The opposition as a whole has failed. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £2000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of October 2002

**M REYNOLDS
for the Registrar
the Comptroller-General**