

O-080-04

TRADE MARKS ACT 1994

APPLICANT: OXFORD LIMITED

INVALIDITY N^o. 80970

AND

REGISTERED PROPRIETOR: H S TANK & SONS LIMITED

REGISTRATION N^o. 2016987

CLASS 25

OXFORD BLUE

BACKGROUND

1. The registered trade mark, the subject of these proceedings, is shown on the first page of this decision. The filing date is 8th April 1995, and the mark is registered in the name of H S Tank & Sons Limited Enterprise House, 60-62 Constitution Hill, Birmingham, B19 3JT Great Britain (the 'RP') for the following goods in Class 25:

“Articles of outer clothing; but not including any such goods coloured blue.”.

2. On 3rd September 2002 Oxford Limited applied for invalidation of the mark under s. 47(2) of the Act, in that the mark was registered in breach of Section 5(4)(a), in that:

“The University of Oxford has both a long-standing reputation and excellent facilities for sport. As sport is an integral part of university life, the University of Oxford has gained much recognition over the years for its sporting achievements.

Terminology has long been introduced to recognise and reward sporting achievements at the University of Oxford. The most well known terminology is the award of an 'OXFORD BLUE'. This term derives from the use of dark blue as the sporting colour of the University of Oxford and has been in use by the University of Oxford for many years – the earliest use of the term being 1829. An 'OXFORD BLUE' is the term applied to anyone playing for or competing on behalf of the University of Oxford at major sports (such as athletics, swimming, rowing, cricket, and rugby). There are many conditions attached to the granting of this award and both 'full blues' and 'half blues' can be awarded by the 'Blues Committee' of the University of Oxford. It is however an absolute condition that the sportsman or woman has competed in the annual varsity match against Cambridge University. An OXFORD BLUE is the highest form of sporting achievement that can be bestowed by the University of Oxford. This is a much coveted award recognised not only within the confines of the University, but also by the public generally.

The words OXFORD BLUE, also describe the colour associated entirely with the University of Oxford which is again recognised internationally and recorded in the Oxford English Dictionary, second electronic edition, 1994.

The reputation and goodwill built up by the University of Oxford (and now licensed exclusively to the Applicant) in the unregistered mark or sign OXFORD BLUE ... is considerable, extending beyond the United Kingdom, into other European Member States including Ireland. The reputation extends not only to sporting activities but also to sporting articles, clothing, footwear, headgear and related items.”

3. The RP filed a counterstatement in which they deny the ground and both sides seek an award of costs.

Hearing

4. The matter came to be heard on 25th November 2003 where the RP was represented by Mr. Mitcheson of Counsel instructed by Forrester Ketley & Co., and the applicant represented by Mr. Jonathan Parker of Rouse & Co.

EVIDENCE

Applicant's evidence

Witness statement of Phil Smith

5. Mr. Smith is Managing Director of Oxford Limited, the applicant in these proceedings. He begins by stating that the applicant is the exclusive licensee of the earlier right OXFORD BLUE from The Chancellor, Masters and Scholars of the University of Oxford (of whom the applicant is a wholly owned subsidiary). Mr Smith states that in order not to tarnish the goodwill and reputation surrounding OXFORD BLUE, the term has not been actively promoted through merchandise.
6. Mr. Smith then details the history of the OXFORD BLUE. In summary, the name derives from the traditional sporting colour of the University of Oxford and it is an award given to sportsmen and sportswomen who have represented the university in a varsity match against their well-known rivals from the University of Cambridge. "Half blues" and "full blues" can be awarded dependent on the status of the sport being played. Attachment A to Mr Smith's statement consists of a number of press articles and documents providing a more in depth history of the term. Also provided in this attachment is an example of a certificate that is used to confer the award on the particular sportsperson. From these documents it is claimed that the origins of the term date back to the year 1829 and that it is an internationally renowned award of sporting excellence.
7. Mr. Smith then repeats that the applicant does not exploit the reputation in OXFORD BLUE through merchandising as to do so would be detrimental to its reputation. He states that the applicant's reputation extends not only to sporting activities but also to sporting articles, clothing, footwear, headgear and related items. Mr. Smith then refers to attachment B which contains a number of documents showing examples of clothing that may be worn by students who have been awarded an OXFORD BLUE. Also shown are examples of the goods that the applicant does merchandise. The examples given are ties, t-shirts and sweatshirts. One of the ties is described as an 'Oxford Blue tie with full colour University logo.. '.
8. Mr. Smith then refers to attachment C to his statement. This contains examples of what he calls the 'Proprietor's recognition of Applicant's goodwill'. Two documents are provided under this heading. The first is a copy of a letter that the registered proprietor sent to the Trade Marks Registry during the examination stage of the mark in suit that points out to the examiner that OXFORD BLUE has a specific meaning relating to sportsmen representing Oxford University. The second is an extract from the registered proprietor's own web-site that refers to the University's Oxford Blue boat race crew.
9. Mr. Smith then refers to attachment D to his statement which consists of further documentation aimed at showing the reputation of OXFORD BLUE. This consists mostly of documentation (much taken from the Internet) relating to people who have received an OXFORD BLUE. Receipt of the award is often listed as one of these people's main achievements even if they were awarded it some time ago. Other material is also provided that again refers to the OXFORD BLUE award.
10. Mr. Smith then details what he describes as the proprietor's use of OXFORD BLUE (their alleged misrepresentation). He refers to attachment E to his declaration which consists of extracts from the proprietor's promotional literature. This literature contains photographs of

various images that Mr. Smith feels establishes that the proprietor is trying to establish a link with the applicant's reputation. Images include photographs of college buildings and playing fields, rowing boats on the river Thames in Oxford and a classic bicycle photograph which Mr. Smith says is synonymous with students of the University of Oxford. Use by the proprietor of terms including 'Cambridge', 'Oxford', 'Oxbridge' & 'Harrow' are said to reinforce this link, as does the offer for sale of a 'college scarf'.

11. Examples are then provided of goods bearing the applicant's Oxford University merchandising and also the manner in which the proprietor is using OXFORD BLUE on their products. The examples show a similar means of presentation with, in both instances, the word OXFORD appearing more predominantly and in a curved manner with the second word BLUE/UNIVERSITY appearing below it. This information is intended to further indicate how the proprietor seeks to associate themselves with the University. Another example given is in relation to the proprietor's application for a Community Trade Mark for the words OXFORD BLUE together with a device of a rowing boat. Mr. Smith reminds me that this term is associated with the University and its rowing team. A final example is given as the use by the proprietor of a sign which contains a belt device; the university also uses a sign (although a different one) which also contains a belt device.
12. Mr. Smith concludes his statement by describing the damage that would occur through the use made by the proprietor. Damage is said to arise by the tarnishing and demeriting of the OXFORD BLUE award; furthermore, through the proprietor's use in a similar manner to the University's own merchandising that could lead to damage through people purchasing the proprietor's products believing them to be the applicant's products or in some way connected with them.

Witness statement of Jean Cooke

13. Ms. Cooke is International Vice President, Licensing of IMG, a worldwide sports management company. Her statements consists of her recounting a conversation she once had with a Mr. Steve Robinson who is the Managing Director of J Nuttall & Co who are the main clothing licensee for the University of Oxford clothing collection. The conversation she recounts relates to Mr. Robinson advising her that he had received a call from a company (although the name of the company is not known, neither is it clear that they were acting for the proprietor's) who manufacture fleeces for OXFORD BLUE. They suggested that his company also manufacture the University of Oxford fleeces as they had assumed the two brands were connected. Mr. Robinson has been unable to provide a statement himself due to ill health.

Witness statement of Jonathan Parker

14. Mr. Parker is a trainee trade mark attorney at Rouse & Co International, the applicant's representatives. He has been working on this application (and other opposition cases before OHIM) in conjunction with another attorney at Rouse & Co International namely Mr. Robert Furneaux.
15. Mr Parker's statement details the carrying out of a "witness collection program in the form of a survey". The survey was conducted by a paralegal, Miss. Slade, of his firm; she has filed a separate witness statement in these proceedings. Forty two questionnaires were completed, but many of the interviewees were not prepared to give formal evidence, so the completed questionnaires have been submitted under cover of Miss. Slade's statement.

16. Mr Parker devised the instructions and questionnaires. Four questionnaires, but with similar questions, were produced but with different signs being the subject, namely: (1) the words OXFORD BLUE on a t-shirt, (2) the words OXFORD BLUE solus, (3) CAMBRIDGE BLUE on t-shirt (a control questionnaire) and (4) the words OXFORD BLUE and rowing boat device on a t-shirt. The interviews were conducted in London, Reading and Oxford. Instructions were given that the interviews in Oxford should take place away from any University buildings or University retail outlets. The primary question asked was “ What would you think if you saw....”.
17. When looking at the responses, which he outlines in attachment B to his statement, he observes that 54.05% of the responses (excluding the control question) associated the relevant OXFORD BLUE sign with the University of Oxford, and the sporting activity most associated with the award of Oxford Blue.

Witness statement of Miss. Katherine Louise Slade

18. Miss Slade is the paralegal working for Rouse and Co International mentioned in Mr. Parker’s statement. Her statement is utilised to introduce the forty two questionnaires taken as part of the survey. Miss. Slade also explains the timings and venues that the interviews took place.

Witness statement of Nicola Sheath

19. Ms. Sheath is Trade Mark Manager of Harley-Davidson Europe Limited. Ms. Sheath explains that on 5th November 2002 she was contacted by Mr. Parker (see his witness statement above) who asked her if she was willing to spare some time to answer a few questions. Mr. Parker asked her what she would think of if she saw the phrase OXFORD BLUE. To this she replied “Oxford Rowing Club”. More questions were then e-mailed to Ms. Sheath that follow the same pattern as those contained in the questionnaires devised by Mr. Parker. The nub of Ms. Sheath’s answers are that she would associate the phrase with Oxford Rowing Club because she believes it to be the colour of the rowing club of Oxford and further that the connection to the University of Oxford would mean good quality and sense of tradition.

Witness statement of Steve Robinson

20. Mr. Robinson has filed his witness statement in support of the evidence contained in Ms. Cooke’s statement detailed above. He explains that his company, J Nuttall & Co Ltd, manufacture under license a range of garments for the University of Oxford. Attachment A contains details of the products his company produces under this licence.
21. Mr. Robinson states that during August 2000 he met a representative of the company Connection Europe Limited (he later states that this representative confirmed that they manufacture products on behalf of H.S. Tank & Sons Ltd, the RP). During this meeting he says that the representative produced a fleece jackets bearing the trade mark OXFORD BLUE and that the representative explained that ‘he had bought the sample along because it bore the name Oxford and as we produced a range of clothing for the University of Oxford a similar garment may well fit into our range’.
22. Mr. Robinson explained to the representative that his products were made under licence whereas the OXFORD BLUE garment was not. He states that he was surprised that the

representative confused the two. Attachment B to his statement contains photographs of the garment, including their swing tags and sewn in labels which contain the word OXFORD BLUE.

Registered proprietor's evidence

Witness statement of Victor Edward Cogger

23. Mr. Cogger is Chief Executive of H S Tank & Sons Limited, the RP in these proceedings. Mr. Cogger states that he first came up with the name OXFORD BLUE as a new brand of clothing in 1985. The inspiration for the name came to him following his attendance at the Badminton Horse trials; a horse called OXFORD BLUE was competing in the trials, after hearing the name mentioned repeatedly during the commentary it stuck in his mind.
24. Mr. Cogger purchased an off the shelf company to exploit the mark in 1985. Later, in 1991 or 1992, he joined a company called Rongar Leisure Wear Limited (now called H S Tank & Sons Limited) and agreed to transfer the OXFORD BLUE brand to them. He states that between 1985 and 1992 an average turnover of £750,000 per year was achieved on OXFORD BLUE branded garments. Most of these products were casual jackets and were sold to a number of high street stores. He estimates that approximately half a million garments were sold in this period.
25. Following the transfer of the brand to Rongar Leisure Wear Limited it was shown at a number of exhibitions including twice yearly exhibitions in Cologne, Munich and Paris. He also states that shows were also attended in Harrogate, Manchester and Birmingham. Mr. Cogger states that in 1993 the main focus of the brand was on wax jackets as he says that these items were a fashion item in Europe at the time. However, he states that the brand was then expanded to other garments such as trousers, socks, waterproofs and other garments not only for men but also for women and children.
26. Mr. Cogger states that in 1997, due to economic conditions, his company redirected their focus back into the UK market (presumably away from mainland Europe). This included ceasing to attend the European shows mentioned above. He also explains that the brand was marketed towards garden centres who he says had started to include clothing sections in their non-garden retail areas. He states that in 1998 a UK sales manager was taken on to develop UK sales; also at this time exhibitions were attended in the UK, these being "Glee" aimed at garden centres and the Spring Fair in Birmingham aimed at the giftware and the tourist market. Mr. Cogger states that between 1998 and 2002 the company established itself as the leading brand in the UK of clothing in quality garden centres.
27. Mr. Cogger then explains that since 1999 his company has been supplying a number of independent department stores with OXFORD BLUE clothing. He says that that was achieved by showing the range at two shows each year in the offices of Associated Independent Stores Limited, a buying group for department stores based in Solihull, West Midlands. He states that in the first show 6 or 7 stores placed orders, but the number of orders has increased with each show. His company now supplies to nearly 70 department stores (they are listed in Exhibit VEC1). He also states that in 2000 his company developed two new OXFORD BLUE ranges aimed at women and children (the latter is called Oxford Blue Jnr.)

28. Mr. Cogger then refers to Exhibit VEC2 which consists of promotional material for goods sold under the OXFORD BLUE mark. Catalogues, display material and flyers are provided dated between 1993-2003. Various swing tickets, labels and packaging used in connection with the OXFORD BLUE brand used between 1993-2000 are provided at Exhibit VEC3. Financial figures for H S Tank & Sons Limited between the years 1993-2003 are also provided:

Year	Turnover (millions)	Approx % turnover Oxford Blue brand	Approx % outer wear in Oxford Blue	Approx % sold in UK	Approx % for export
1993	£3.8	50%	99%	70%	30%
1994	£3.6	60%	99%	60%	40%
1995	£4.2	70%	99%	50%	50%
1996 (9 mths trade)	£3.2	75%	99%	40%	60%
1997	£5.0	80%	99%	30%	70%
1998	£4.2	85%	99%	40%	60%
1999	£5.1	90%	99%	60%	40%
2000	£4.4	90%	95%	75%	25%
2001	£4.9	90%	95%	75%	25%
2002	£4.6	90%	95%	75%	25%

29. Mr. Cogger states that he would estimate that in the period 1992-2002 approximately 2.5 million garments branded as OXFORD BLUE have been sold. He also states that in the period 1993 - 2002 between £60,000 and £75,000 has been spent on promoting the brand. Mr. Cogger also confirms that he is not aware of any confusion as to the source of the OXFORD BLUE garments nor that anyone has mistakenly considered that his company has any connection with Oxford University.

30. Mr. Cogger then refers to the evidence provided by Mr. Robinson on behalf of the applicant. He states that Mr. Robinson's statement reads as if he was unaware of his company's use of OXFORD BLUE. Mr. Cogger states that it is his belief that Mr. Robinson was well aware of his company's OXFORD BLUE brand well before his encounter with the representative of Connection Europe Limited. He bases this on the fact that in the summer of 1996, whilst participating in a show in Munich, he noticed a stand under the banner Oxford University. The person on the University's stand worked for Phillip Whitfield and Sons Textiles Limited of which Nuttals (Mr. Robinson's company) is part. Mr. Cogger spoke to the person on the stand to enquire if their company would be able to supply cotton shirts. The person on the stand advised Mr. Cogger to contact Mr. Robinson. Exhibit VEC4 consists of a letter that Mr. Cogger sent to Mr. Robinson regarding this potential order. I note, however, that the brand OXFORD BLUE is not mentioned in this letter.

Applicant's evidence in reply

31. None was filed

LAW

32. The only ground pleaded in these proceedings is under Section 5(4)(a). The relevant legislation reads:

“5(4)(a) 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.”

APPLICATION OF THE LAW

33. The common law relating to the tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the appointed person, in *Wild Child* [1998] 14 RPC, 455:

“A helpful summary of the element 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:

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

(b) 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

(c) 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 element of passing off in the form of this classical trinity has been referred to 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 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, the courts will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective field 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 matter 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.’ ”

34. There is other case law to which I wish to refer, but will do so in the course of my decision.
35. As to the relevant date, there was some disagreement about this at the hearing. Following *Cadbury Schweppes Property Ltd v The Pub Squash Co Ltd* [1981] RPC 429, 494, as per Lord Scarman, (also cited in *Inter Lotto (UK) Ltd v. Camelot Group plc* [2003] EWCA Civ 1132) this is taken to be the date of the commencement of the conduct complained of. As this is an application for invalidation, that must be 8th April 1995, the filing date of the mark in suit (see also *Kerly’s Law of Trademarks and Tradenames* (13th Edition, Sweet & Maxwell, paragraph 9-18).

DECISION

36. It is inherent in the extracts of case law reproduced above that the basis of a right that may be safeguarded by the law of passing off is goodwill. This has been variously defined: for example, as ‘Nothing more than the probability, that the old *customers* will resort to the old place’ (as per Lord Eldon in *Cruttwell v Lye*, (1810) 17 Ves 335 at 346) and, more famously, Lord Macnaghten’s ‘..the attractive force which brings in *custom*.’ The stress I place in these two quotations is to emphasise the fact that goodwill has no life outside trade. A *trade* mark is the token for the goodwill, that is, a label for the advantage arising from the reputation and trade connections of a business measured, as stated, by the likelihood that existing customers will continue to patronise it. *Reckitt & Colman* and *Erven Warnink BV*, cited above, both emphasise this point: the plaintiff’s goods or services have acquired a goodwill or reputation *in the market* and are known by some distinguishing feature. I also note the following extracts from the case law:

“ A passing off action is a remedy for the invasion of a right of property in the business or goodwill likely to be injured by any actionable misrepresentation, not in the name or get-up itself. Goodwill does not exist apart from the business to which it is attached.”
(*Medgen Inc. v. Passion for Life Products Ltd* [2001] F.S.R. 30)

“A passing-off action is a remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill likely to be injured by the misrepresentation made by passing off one person’s goods as the goods of another. Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached. It is local in character and divisible; if the business is carried on in several countries a separate goodwill attaches to it in each.” (as per Lord Scarman, *Star Industrial Co. Ltd v. Yap Kwee Kor* [1976] F.S.R. 256 at 269)

“... the basis of a right of action in passing off is that the conduct of the defendant is such that the public may be led to believe that the goods which the defendant is offering or the services which he is offering are in fact the goods or services of the plaintiff. The property which is said to be injured in that situation is not the name or the description of the goods but the right to the goodwill of the business which results from the particular commercial activity. Therefore the courts do not in general interfere to protect a non-trader. I hasten to add that of course the word ‘trade’ is widely interpreted and includes persons engaged in a professional, artistic or literary occupation.

Thus the action lies where there is a real possibility of damage to some business or trading activity. Therefore the plaintiff must establish that in some sense he is carrying on a business with which the trade or public will be led to associate the defendant’s activities.” (as per Ackner LJ, *Kean v McGiven* [1982] FSR 119).

37. I now wish to apply this to the current case. I have examined the evidence submitted by the applicant. First, I think I should note that ‘Oxford Blue’ is descriptive of a colour, that is dark blue. Which could well explain the exclusion based on the blue colour in the RP’s registration. The claim in the applicant’s Statement of Grounds is that ‘OXFORD BLUE also describes the colour associated entirely with the University of Oxford’ is not proven. In my view it is ‘entirely’ associated with a colour. Consumers might, given thought, surmise that the colour may have somehow derived from the University of Oxford – as they might for the name ‘Oxford Bags’ – but that does not change the fact that one is descriptive of clothing and the other of a colour.
38. Next, the applicant also attempts to show in their evidence that the term is well known as an appellation of a sporting award. In fact, as they point out, the RP accepts this as definition of the term (see ‘Attachment C’ of Mr. Smith’s Statement). As to other of the evidence they supply in regard to the extent to which this understanding is extant, this was the object of – in my view somewhat justified – criticism by the RP. But I do not believe that it is necessary for me to comment on the efficacy of the applicant’s evidence, nor on the analysis thereof made by the RP. Even accepting that the term OXFORD BLUE is representative of a certain notoriety as a sporting award, this case appears to me to a classic example of reputation without goodwill. There appears to me nothing in the nature of the repute under the name proposed by the applicant that would draw ‘customers’ to Oxford University to engage and re-engage in a trade under the name. The ‘Oxford Blue’ award is not to be bought or sold in the marketplace. It is for sport excellence, in a limited number of sports, for individuals who engaged in those sports on behalf of the University of Oxford against the University of Cambridge. Though it is clear from the evidence that sportsmen and women of note have been attracted to Oxford with the purpose of gaining a ‘Blue’ – it, no doubt, carries a certain status – this cannot be regarded as the magnetic effect of goodwill as understood in law. As I say, there is no *trade* under the mark. *Wadlow’s The Law of Passing Off* (Sweet & Maxwell, 2nd Edition) states:

“.. the action for passing-off is only open to traders, because private individuals can have no goodwill. However, the concepts of trader and goodwill are very widely interpreted so as to cover virtually every economic activity. The action for passing-off is therefore open to the liberal professions, entertainers, artists, writers and almost anyone who can be said to derive an income from the provision of goods or services.”

Nevertheless, it is not so wide as to extend to the name given to sporting awards. Goodwill has to be generated in the course of a business conducted by the applicant under the name – and there is no evidence to show that this has occurred. In fact, the applicant itself denies that it has (Mr. Smith, paragraph 3):

“As outlined above, an OXFORD BLUE is a coveted award and so as to not tarnish the kudos, goodwill and reputation surrounding OXFORD BLUE, the Company does not exploit the reputation in OXFORD BLUE through merchandising as to do so would be detrimental to the reputation.”

There is some reference in Mr. Smith’s declaration to use of the name associated with clothing (see Smith, paragraph 4, Attachment B) – apart from the observation that it can amount to nothing in view of the statement made by the applicant itself – the use submitted in evidence, I believe, is not representative of a trade under the mark. It is either symbolic of receipt of the award (as per the blazers and ties, etc. in Attachment B), or a badge of allegiance to the University of Oxford (again, see Attachment B). (I note that Mr. Smith, at times in his evidence, tends to elide the reputation of the College with that attached to the name Oxford Blue, a supposition that requires proof). Finally, in relation to the relevant date in these proceedings (1995), it is not clear that these items – particularly those from the University Shop – were available before that date.

39. To labour the point, an Oxford Blue is the name for an award, an accolade, like a gold medal in the Olympic games: to win one is desirable, but the award is not representative of a trade in awards. Though it might seem unmerited that any business can take advantage of the ‘cache’ of reputation that has accumulated around such awards, there has been no attempt by the applicant in this case to monopolise on this notoriety itself. Specific provisions of trade mark law exist to protect reputation where there is positive fame and no goodwill (– my reference to the Olympics is apposite – see s. 4 of the Act and the amendment thereto by s. 13 of the Olympic Symbol, etc (Protection) Act 1995). There is no equivalent protection here.
40. On the contrary, it is the RP who has the requisite goodwill under the name in the trade of clothing by carrying on a significant trade under the mark. I note the evidence of trade over many years (see paragraphs 27ff above). By the standards of the clothing industry this trade is not huge, but there is enough evidence here to demonstrate a goodwill under the name.
41. I think it is fair to infer, without doubting Mr. Cogger’s explanation of how he came *by* the mark, that he has not been blind to the association of the name with quality and selectivity. This is not to, in any sense, cast aspersions on Mr. Cogger’s motives: he was the first to spot the potential. The applicant did not – they have even said that they purposefully would not – seek to exploit that potential.
42. The only ground under s. 5(a) must therefore fail at the first hurdle. The applicant has no protectable goodwill. The application thus fails.

43. In my view this is the end of the matter. However, the finding I have made on this case is unrepresentative of the exchanges that occurred at the hearing. This focused largely on the RP's proposition that it had, in effect, two defences to the attack made on its registration. First, the application is invalid because the applicant has no title whatsoever to bring it and, the other is acquiescence. I do not consider it is necessary to deal with these in any detail, in view of the above result. They are surplus to requirements in this matter owing to my finding on the applicant's main weapon of assault, s. 5(4)(a). The RP does not need a shield as the applicant has no sword. Nevertheless, I will briefly comment.

44. In relation to the issue as to title, the claim by Mr. Mitcheson is, as expressed at the hearing:

"In this particular instance, we say that there is nothing before you in the evidence to suggest that the Applicant had any title whatsoever to bring an application such as this. There is nothing to suggest that the Applicant owns any goodwill or reputation in Oxford Blue. It is conceded that Oxford Blue is a term that can apply to some persons who attended Oxford University and attained sporting recognition at that establishment but that is quite different from saying that the Applicant possesses goodwill and reputation in the words "Oxford Blue". For that reason, my primary submission is that the Applicant has no title to bring the current proceedings."

45. I do not see this point as relevant to passing off proceedings under s. 5(4)(a), under s. 47. In particular, s. 47(3) states: 'An application for a declaration of invalidity may be made by any person...'. I also note the following from *Kerly*, paragraph 9-21:

"Section 47(2) of the 1994 Act applies, by way of cross-reference, the relative grounds contained in subsections (1), (2) and (3) of section 5 (conflict with earlier trade marks) and section 5(4) (conflict with earlier rights, including passing off). These grounds for invalidity are not available if the proprietor of the earlier trade mark or other earlier right has consented to the registration. This reflects the fact that these grounds may be raised by any person, whether they are entitled to an earlier trade mark or earlier right or not. Section 47(2) raises the same issues as are raised under section 5."

This is not a passing off case before the courts and the objection to the application made by Mr. Mitcheson is without basis in law.

46. As for acquiescence, this is succinctly set out in Mr. Mitcheson's skeleton argument as follows:

"The second fatal argument to the application is that of acquiescence. The registered proprietor relies on section 48(1)(a) of the 1994 Act in that the Applicant and/or the University of Oxford has acquiesced for a continuous period of at least five years in the use of the Proprietor's registered mark in the United Kingdom, being aware of such use, and accordingly is not entitled to apply for a declaration that the registration of the Proprietor's mark is invalid. The Proprietor's predecessor in title, Oxford Blue Limited, commenced use of OXFORD BLUE in respect of articles of outer clothing in 1985. The Proprietor commenced use of OXFORD BLUE in respect of articles of outer clothing in 1993. The mark was registered as of its filing date 8th April 1995 – see section 40(3) of the 1994 Act.

Accordingly there has been at least 5 years acquiescence between the registration of the OXFORD BLUE mark on 8th April 1995 and the application for invalidity made on 4th September 2002. It is to be inferred that the Applicant has been aware of the use of the

registered mark since at least before 4th September 1997 for the following reasons. Firstly, as set out in paragraph 11 of the evidence of Mr Cogger, the turnover in the UK for outer ware marketed under the OXFORD BLUE brand in 1995 was approximately £1.47 million, in 1996 approximately £0.96 million and in 1997 approximately £1.2 million. The Applicant and/or the University of Oxford would therefore have been aware of the use of the OXFORD BLUE mark as a result of the business activities of the Registered Proprietor alternatively as a result of the Proprietor's trademark application.

Secondly the existence and business activities of the Registered Proprietor were specifically drawn to the attention of Steven Robinson, the managing director of the Applicant/University of Oxford's clothing licensee, in the summer of 1996 – see paragraph 15 of Mr. Cogger's statement. It is submitted that it is inevitable that Mr. Robinson would have told his Licensor (i.e. the Applicant/University of Oxford) of this meeting.

The Proprietor's amended counterstatement specifically drew this issue of acquiescence to the attention of the Applicant. Yet the Applicant has failed to adduce, any evidence whatsoever as the state of its knowledge of the existence of the OXFORD BLUE mark. The evidential burden of proving the existence or otherwise of a state of knowledge clearly falls upon the party said to possess that knowledge – there is no way the Proprietor can do any more than draw inferences in relation to its existence. Accordingly in the light of the Proprietor's evidence as to turnover and the meeting with Mr Robinson the failure of the Applicant to adduce any evidence on this issue should result in a finding that the Applicant did possess the requisite awareness of the Proprietor's mark prior to 4th September 1997.”

47. *Kerly's Law of Trade Marks and Trade Names* (13th Edition, Sweet & Maxwell), at paragraph 13-120 describes acquiescence as no more or less than inaction with actual knowledge of use. The key to Mr. Mitcheson's submission is the knowledge of the applicant in respect of use of the mark by the RP. Aside from the activities of the RP under the name, and the written communication between the RP and Mr. Robinson, from which I am counselled to infer the knowledge required by s. 48, Mr. Mitcheson also pointed out at the hearing, nowhere in their evidence does the applicant deny they knew of the RP's activities or registration. In fact, the only denial came in the form of Mr. Parker's skeleton argument, that the applicant and the University of Oxford became aware of the existence of the registration subject to these proceedings in or around February 1999. Mr Parker states:

“It will be noted from the evidence filed by both parties showing the Proprietor's mark in use that OXFORD BLUE is not depicted as being a registered trade mark.”

As Mr. Mitcheson pointed out, this is evidence given by way of a skeleton argument, which is not permissible. He also added that not being aware that the mark had been registered, is quite different from the condition in s. 48(1), which concerns whether or not the applicant is aware of the use of the mark.

48. In this context, there was some debate, at the hearing, as where, in relation to acquiescence, the burden of proof lay. Though it can be important to distinguish between onus and evidential burden – the onus in this case being on the applicant overall to prove that the mark was wrongly registered (see Kerly paragraph 9-08) – as Mr. Mitcheson pointed out, the ball was in the applicant's court, on the basis of the evidential burden at the very least (which can shift from party to party in the conduct of a case). Mr. Mitcheson stated:

“... whatever the position on the legal burden, once all the evidence is before you there is clearly a strong evidential burden on the Applicant to bring *prima facie* evidence that it did not know of the use of the mark.

In this instance, we raised the issue in the amended counter statement, then made the case in the evidence that it was clear that the Applicant knew of the mark. The Applicant has chosen to do nothing about that evidence.”

49. I note the following from Mr. Parker, from the hearing:

“...we draw your attention to the statement of case filed and Mr Smith’s witness statement, which both clearly outline that oppositions were put forward to the Community Trade Marks Office in 1999, which was only three years after the Munich show. Therefore, steps were taken with regard to the use or attempted registration of the mark Oxford Blue within the five-year period, which defeats any claim of acquiescence.”

50. I am inclined to believe that Mr. Parker is right, on this point. However, as I have said, the issue is of academic interest only. The application has failed.

COSTS

51. The applicant has failed, and the RP is entitled to an award of costs. I order the applicant to pay them £2000. This 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 23rd Day of March 2004.

**Dr W J Trott
Principal Hearing Officer
For the Registrar**