

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION FOR REGISTRATION
No 2000134 BY L COHEN CLOTHING LIMITED**

AND

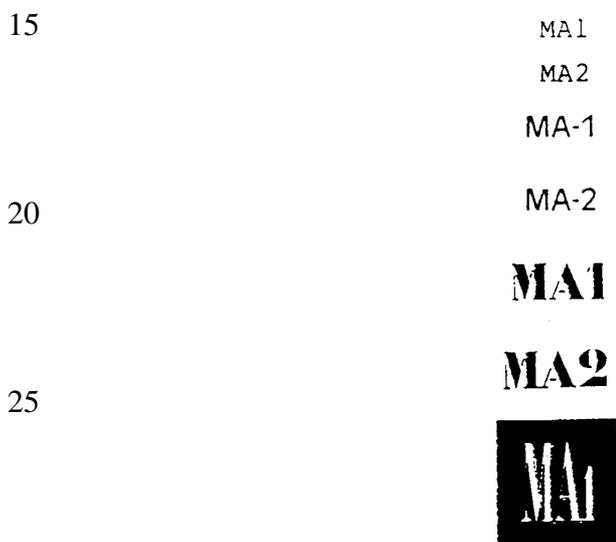
**OPPOSITION No 44450 BY LEITH PRODUCTS AND
THATCHREED LIMITED AS JOINT OPPONENTS**

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10 BACKGROUND

L Cohen Clothing Limited applied on 31 October 1994 to register the series of trade marks shown below:



30 The specification of goods which falls into Class 25 reads: “Articles of clothing, headwear and footwear”.

35 On 24 April 1996 Leith Products and Thatchreed Limited filed Notice of Opposition. The grounds of opposition were, in summary, that the terms MA-1/MA1, MA-2 and MA2 were generic in relation to articles of clothing and in particular to what are termed military or flying jackets such that the marks did not qualify for registration under the provisions of Section 3(1)(a), 3(1)(b), 3(1)(c) and 3(1)(d) of the Act.

40 The applicants denied all of these grounds and both sides seek their costs.

Evidence was filed by both parties and the matter came to be heard on 12 May 1999 when the applicants were represented by Mr Roger Wyand of Her Majesty’s Counsel and the opponents by Mr David Young of Her Majesty’s Counsel.

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After the opposition proceedings got underway, the applicants asked the Trade Marks Registry to amend the application by the deletion of the trade marks in the series featuring the letters M A and the numeral 1. Thus, the application for registration now consists only of those trade marks which consist of the elements MA 2 and the opposition is therefore to that series of trade marks.

Opponent's Evidence

This consists of a Statutory Declaration dated 30 October 1996 by Allan Thomas Blacklock, a partner in Leith Products, wholesalers and suppliers to the retail trade of clothing, and in particular of military style clothing. His personal knowledge of the clothing business extends back to 1986.

Mr Blacklock states that the terms MA1 and MA2 have been used since at least 1986 to describe military type pilot jackets as worn by United States service personnel. The United States Government have used the terms since the 1950's to refer to a specification of flying jacket. Mr Blacklock exhibits a number of articles and brochures in which he states the terms MA1 and MA2 are used as generic terms. Insofar as the trade mark in suit is concerned the CTV Sports Catalogue dated 1996 shows use of the term MA1 in relation to a flying jacket, MA2 in relation to a flying jacket with a collar and MA2F as a flying jacket with a fur collar. The identical brochure from the Transatlantic Trading Co shows use of the term MA1 and MA2 in terms of flight jackets (without and with a collar respectively). The Leith Products price list for 1994/95 shows use of the terms MA1, MA2 and MA3 in relation to pilot and airman jackets. The 1996 GELERT product catalogue includes the sentence "MA1 - MA2 style flying jackets"; the Compass Outdoor Clothing (UK) Ltd pamphlet shows use of the terms MA-1 and MA2 in relation to flight jackets. All of these exhibits are however after the relevant date, the date of the application for registration.

Applicant's Evidence

This consists of a Statutory Declaration dated 18 July 1997 by Patrick James Barry, a partner in Abel & Imray. He attaches as exhibits a Statutory Declaration dated 5 June 1997 by Mr Bradley Stephen Chapman and a Statutory Declaration dated 11 June 1997 by Mr Lawrence Lewis Cohen.

Mr Chapman states that he is the Managing Director of Compass Clothing (UK) Ltd and that he swore a Statutory Declaration, dated 10 February 1997 as part of evidence filed at the Trade Marks Registry in support of opposition no. 44445 to this application by Kolon (UK) Ltd. He has instructed trade mark Agents Venner Shipley & Co to withdraw that declaration. This is because he had linked the MA1 and MA2 terms together but now realises that it was incorrect to do so; MA1 is a generic term whilst MA2 is not. Mr Chapman states that MA2 is the trade mark of the Cobles Company and no other and he unreservedly consents to the registration of the trade mark in suit.

Mr Cohen states that he is Managing Director of L Cohen (Clothing) Limited (trading as 'The Cobles Company') a position he has held since 1963. Mr Cohen says that his company coined the trade mark MA2 in 1988 and exhibits correspondence between the applicants and a

Korean supplier in which the former asks the latter to make up a sample jacket known as MA2, similar to MA1 but with a collar. Also exhibited is an official order form from The Cobles Company to the Korean supplier dated 1989 showing, under the heading 'Product Description', the term MA2 jacket. Also exhibited is a photograph showing a label sewn into the collar seam of a jacket showing the trade mark MA2.

Mr Cohen goes on to state that the approximate annual turnover and promotional expenditure in respect of jackets sold under his company's trade mark was:

Year	Turnover £ 000	Promotion £ 000
88/89	455	
89/90	560	10
90/91	1295	5
91/92	1505	10
92/93	1155	15
93/94	1225	25
94/95	3185	22
95/96	875	13

Exhibited are sample invoices which show use of the term MA2 and promotional material showing the same.

In response to the literature produced by the opponents which purports to show generic use of the trade mark MA2 Mr Cohen says that his company supplied a number of these suppliers with flying jackets under the MA2 trade mark (including Leith Products) and that the Managing Director of Transatlantic Trading Co (Wholesale) Ltd and A N Vincent, a Partner in GTV Sports both acknowledge that his company is the originator and proprietor of the MA-2 trade mark. These written acknowledgements are exhibited.

Mr Cohen further states that Mr Blacklock is incorrect in his belief as to the origin of the term MA2. Mr Alan D Circer, the President of Alpha Industries Inc, the largest manufacturer of flight jackets in the United States acknowledges the term MA2 as the property of the applicants and this acknowledgement is exhibited. Also exhibited are letters from a number of traders which acknowledge that the applicants are the originators of the term MA2.

Opponents' Evidence in Reply

This consists of a further Statutory Declaration by Mr Allan Thomas Blacklock dated 5 November 1999. He says that he does not know what reason the applicants had for deleting the generic term MA1 from their original application but he believes that there is substantial similarity between the terms MA1 and MA2. Mr Blacklock goes on to state that Mr Cohen is incorrect in stating that the MA2 term originated from his company and he exhibits copies of invoices evidencing sales in the United Kingdom by his firm of jackets under the generic term MA2 dated 28 November 1987, 4, 15 and 21 December 1987, 2 February 1988 and two

undated invoices (nos. 1567 and 1569). He also produces a copy of the opponents' price lists dated 1992, 1993, 1994 and 1995 showing use of the term MA2 in, he says, a descriptive way in relation to pilot jackets. Also exhibited is a photocopy of an invoice dated 30 November 1987 from Llewelyn Wynne Ltd to the opponents which makes reference to "MA2 type flight jacket". As this use predates the use by the applicants then they could not, says Mr Blacklock, be originator of the term in relation to flight jackets.

Mr Blacklock comments on the photograph produced by Mr Cohen of a jacket sold by his company showing the label carrying the MA2 name being sewn into the inside of the jacket near the collar. It is very similar to and is typical of the types of flight jackets the opponents and other companies sell in the reproduction military style clothing business. It is important says Mr Blacklock in that business that reproduction flying jackets sold under various different generic terms such as the MA1 (and CWU45) names are as close as possible to the original items specified by, for example, the United States Government, including the labels which, for authenticity, often refer the U.S. Government specification and generic name for such jackets.

Mr Blacklock goes on to comment on the annual turnover figures given by Mr Cohen in his evidence. By comparison he says that the approximate annual turnover in the United Kingdom, exclusive of VAT, in respect of jackets sold under the MA2 name by the opponents in the year 1994 was between £300,000 and £500,000. He exhibits copies of a selection of invoices dated September, October and November 1995 evidencing sales in the United Kingdom by his firm of jackets under the MA2 name. He also comments on the copies of promotional material exhibited by Mr Cohen's company relating to jackets sold under the MA2 name in the United Kingdom. He notes that every time the MA2 name appears it does so following the generic term MA1 and that this serves to further establish his belief that the terms MA1 and MA2 are inextricably linked. Indeed, such is his view that the opponents introduced in 1994 a new style of jacket which is referred to as MA3.

That concludes my review of the evidence. I turn now to the grounds of opposition.

DECISION

The first ground of opposition is based upon Section 3(1)(a) which states:

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

(a) signs which do not satisfy the requirements of Section 1(1),"

Section 1(1) states:

"1.-(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging."

Mr Wyand submitted that this ground of opposition was not appropriate in this case. In his view, the term MA2 was a trade mark which was capable of being represented graphically and able to distinguish the goods of the applicant from those of other undertakings. In support he referred me to the Philips Electronics NV v Remington Consumer Products Ltd (1998 RPC 283) case and now before the Court of Appeal. In my view Mr Wyand is right. The term MA2 is capable of being represented graphically and it is not, in my view, directly descriptive of the goods covered by the specification (or in some other way objectionable) that it is incapable of being considered a trade mark and registered as such. Therefore, the ground of opposition based upon Section 3(1)(a) is dismissed.

I turn next to the ground of opposition based upon Section 3(1)(b) which states:

"3.-(1)

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

This section bars registration of trade marks which are devoid of distinctive character and the test to be employed in determining whether or not the trade mark the subject of an application for registration falls into this category was laid down by Mr Justice Jacob in TREAT [1996] RPC 281 page 306 lines 2-5, where he said:

"What does devoid of distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?"

In this case the sign that is sought to be registered are the letters M and A together with the numeral 2. The Trade Marks Registry will accept such signs prima facie as trade marks. In this case, however, the opponents are seeking to show that the term MA2 is one that should not be registered because it is devoid of distinctive character. In my view that has not been proven. The applicants' specification is for articles of clothing, headwear and footwear and in relation to those goods at large I am not able to hold that the trade mark the subject of the application is devoid of distinctive character. There is nothing in the evidence put forward by the opponents which suggest that either the trade or the public at large, if they saw the term MA2 presented on clothing, in the manner of a trade mark, would see it as anything other than that. Though there might be some items within the specification of goods to which the term MA2 may be descriptive that cannot, in my view, bring a finding that the term MA2 is devoid of distinctive character such, in relation to the goods covered by the specification as a whole, that the application for registration should be refused.

For convenience I will take the next two grounds of opposition together and which are based upon Sections 3(1)(c) and 3(1)(d) which states:

3.-(1)

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value,

geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

- 5 (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

10 Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

15 These two grounds are, I think, the focal point of the opposition. The opponents contend that they, and others, have used the term MA2 to describe a particular type of flying jacket, based upon the American government's flying jacket supplied to service personnel. I am satisfied from the evidence that the original flying jacket is known by the term MA1 and I am satisfied too that once the applicants became fully aware of the descriptive nature of the term MA1 the application in suit was amended to remove reference to that particular sign. One arm of the opponents argument, however, is that the term MA2 is so close to the descriptive term MA1 that everyone in the trade will associate the latter with the former such that both will become terms customary in the current language of the trade. That may be so. However, I have no evidence before me that this is likely to occur in relation to all of the goods covered by the specification of the application though I am sure that in relation to flying jackets and military style clothing some association between the terms MA1 and MA2 is very likely.

25 It is also clear from the evidence that the opponents themselves have used the term MA2 (along with MA1 and MA3) in a descriptive manner to describe variations on the style of flying jackets they supply. Also, I note that they were using the term MA2 in a descriptive manner from a date which preceded any use by the applicants for registration. I have little hesitation therefore in holding that the term MA2 denotes a different style of flying jacket or a flying jacket with additional features to the basic MA1 model. In reaching this view I do take account of the comments from other traders submitted by the applicants that they acknowledge the applicants as the originator of the MA2 trade mark. However, the supporting material, brochures and publicity material, which I have seen all seem to use the term MA2 to describe a particular model of flying jacket. Indeed in their own evidence the applicants seem to do so e.g. in asking the Korean supplier to make up a sample jacket known as MA2, similar to MA1 but with a collar and on an invoice under the heading 'Product Description' inserting the term MA2. The term therefore is not used in such a way as to lead the reader of the correspondence, invoices, price lists, brochures or pamphlets to the conclusion that the term MA2 is a trade mark of the applicant. In the circumstances I consider that the trade mark the subject of the application is one which in use is descriptive of a particular type of flying jacket. Therefore the objections under Section 3(1)(c) and (d) are well founded. However, no evidence has been placed before me, or indeed no submissions were made to me, which would enable me to find that the term MA2 would be descriptive of any other type of clothing or footwear. If the applicants were prepared therefore to make clear that the trade mark was for use on clothing which did not fall into the category of military style clothing, I can see no reason why the objections to the registration of the application should be maintained on the basis of the grounds set out above.

I go on to consider the ground of opposition based upon Section 3(3)(b) which states:

"3.-(3)

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)."

As far as I can see that there is nothing inherent in the term MA2 which is likely to deceive the public as to the nature, quality or geographical origin of the goods covered by the specification. In the circumstances the ground of opposition based on this subsection is dismissed.

Finally I consider the grounds of opposition based upon Section 3(6) which states:

"3.-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

In the course of his submissions Mr Young submitted that the Registrar ought to take cognisance of the fact that, in this case, the opponents had use of the term MA2 which predated that of the applicants. If this earlier use by the opponents was not sufficient under the provisions of Section 11(3) of the Trade Marks Act, which deals with the infringement rights of a registered trade mark in relation to an earlier right in a particular locality, to bring an action for passing off, it was Mr Young's view that that should be a situation in which the Registrar should protect the first user by using the provisions of Section 3(6). Mr Wyand, of course, submitted the opposite. I think that Mr Wyand is right. The Act is perfectly clear in this regard in that earlier use of an unregistered trade mark or sign can be used to oppose the registration of the same or similar trade mark for the same or similar goods (or have a registration declared invalid on that basis) under the provisions of Section 5(4)(a) of the Act. In addition, the Act states that a registered trade mark is not infringed by the earlier use in a particular locality of the same or similar mark in respect of the same or similar goods by another party. Thus the first user has two means by which to protect himself. Section 3(6) requires the Registrar to consider whether the application was made in bad faith. As Sections 5(4) and 11(3) are not in any way related to the issue of an application purported to have been made in bad faith I reject Mr Young's arguments that simply because, in this case, his clients had earlier use of the term MA2 then the application must have been made in bad faith and that his client ought to be protected under the provisions of Section 3(6) because they might not have sufficient use to be protectable under the provisions of 11(3).

In considering the matter of bad faith I take into account the comments of Lindsay J in *Gromax Plasticulture Ltd v Don Low Nonwovens Ltd* [1999] RPC 10 page 379 lines 25 to 33, where he 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."

In this case there is nothing, in my view, which would enable me to find that this application for registration was filed in bad faith. The fact that the applicants filed for a series of trade marks which included one which they later found out was not in fact a trade mark but a descriptive term and subsequently amended the application does not amount to bad faith in the terms set out by Mr Justice Lindsay. Nor is the fact that they pursued the application for registration in the light of the opposition. In that regard the relevant date is of course the date of application and not any subsequent date that an opponent may choose to substitute. The ground of opposition based upon Section 3(6) is therefore dismissed.

In summary I have found that the opposition to this application for registration succeeds under two heads, under Section 3(1)(c) and Section 3(1)(d), because the term MA2 is descriptive of a type of flying jacket. It follows therefore that the trade mark in suit must be devoid of distinctive character for those goods and therefore, to a limited extent the ground of opposition based upon Section 3(1)(b) must succeed. However, no objection has been made out in respect of the remainder of the goods covered by the specification. In the circumstances, subject to the applicants for registration agreeing to an amendment of the application, the application can proceed to registration for the specification of goods as follows:

Articles of clothing, but not including military style clothing, headwear and footwear.

The applicants will have one month from the date of the expiry of the appeal period in which to submit a Form TM21 and so amend the specification of goods. Failure to do so will, under the provisions of Section 37(4) of the Act, mean that the application for registration stands refused.

Insofar as costs are concerned if the application for registration is not amended as proposed above and the application is refused then the applicants must pay to the opponents the sum of £500. In the event that the application proceeds to registration for the limited specification of goods then I consider that the applicants should pay to the opponents, who will have been partially successful, the sum of £50. In reaching this view I bear in mind that the opponents at no time sought to narrow their objections to the goods on which the term MA2 was considered descriptive and the opposition proceedings continued when it must have been clear to the applicants that the opponents had evidence of use which preceded any use by themselves and others.

Dated this 27 day of August 1999

M KNIGHT
For the Registrar
the Comptroller General