

O-358-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2647323
BY THE RETRO BAG SHOP
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 18:**



AND

OPPOSITION THERETO (NO. 400326) BY BRIAN POULTON

The background and the pleadings

1) The protagonists to this dispute are The Retro Bag Shop (the “applicant”) on the one hand and Mr Brian Poulton on the other. The dispute concerns whether the following trade mark, which was filed on 27 December 2012, should be registered:



for the following class 18 goods: imitations of leather, travelling bags, handbags, rucksacks, purses, wallets; flight and shoulder bags.

2) Mr Poulton’s only ground of opposition is under section 3(1)(d) of the Trade Mark Act 1994 (“the Act”). His claim is that:

“The mark is descriptive of a genre as it has been in general use since 1960/70s referring to “mod” culture and the music scene in the North of England. The clenched fist emanates from the “black power” movement of that period. The mark has been [in] common usage on bags, badges and clothing for the past 40 years and on this basis the logo should be free for all traders, clubs and societies to use as they wish.”

3) The applicant filed a counterstatement in which it:

- i) Denies that the mark is descriptive of a genre;
- ii) States that as far as it is aware, it is the only manufacturer of bags with the mark on;
- iii) States that it has been using the mark on bags for 20 years;
- iv) Denies that the mark is in customary use or is in the established practices of the industry.

4) Both sides filed evidence. Neither side requested a hearing, both opting to file written submissions instead.

The legislation and the leading case-law

5) Section 3(1)(d) of the Act prevents registration of:

“...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.

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.”

6) In *Merz & Krell GmbH & Co* [2002] ETMR 21, the Court of Justice of the European Union (“CJEU”) provided guidance on how this provision is to be interpreted:

“24 Accordingly, signs or indications that are not capable of fulfilling the essential function of a trade mark cannot enjoy the protection conferred by registration. As is made clear by the tenth recital in the preamble to the Directive, the purpose of the protection afforded by the registered trade mark is in particular to guarantee that trade mark’s function as an indication of origin.

25 Article 3(1)(d) of the Directive must be interpreted in the light of those considerations.

26 Under Article 3(1)(d) of the Directive, trade marks which consist exclusively of signs or indications which have become customary in the current language or trade practices are to be refused registration.

27 It is true that, unlike Paragraph 8(2)(3) of the Markengesetz, which refers to trade marks that consist exclusively of signs or indications which have become customary in the current language or trade practices “to designate the goods or services”, Article 3(1)(d) of the Directive contains no such qualification. It cannot, however, be concluded from that that, in order to assess the merits of an application for registration of a trade mark, account should not be taken of the connection between the signs or indications constituting the trade mark and the goods or services covered by that mark.

28 The purpose of Article 3(1)(d) of the Directive is to prevent the registration of signs or indications that are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and so do not satisfy the criterion laid down in Article 2 of the Directive.

29 The question whether particular signs or indications possess distinctive character cannot, however, be considered in the abstract and separately from the goods or services those signs or indications are intended to distinguish.

30 That finding is corroborated by Article 3(3) of the Directive. As the Court held at paragraph 44 of the judgment in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee* [1999] E.C.R. I-2779, it is through the

use made of it that such a sign acquires the distinctive character which is a prerequisite for its registration under that provision. However, whether a sign does have the capacity to distinguish as a result of the use made of it can only be assessed in relation to the goods or services covered by it.

31 It follows that Article 3(1)(d) of the Directive must be interpreted as only precluding registration of a trade mark where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought.”

.....

“41 It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services.”

7) In *Stash Trade Mark* BL O/281/04, Prof Annand (sitting as the Appointed Person) provided further guidance, stating:

“...On my reading, there are two separate limbs of section 3(1)(d). A mark must be refused registration if, in relation to the goods or services applied for, it has become customary:

(a) in the current language; or

(b) in the bona fide and established practices of the trade.

It is clear from the proviso to section 3(1), that the general objection to marks which fall within section 3(1)(b) – (d) is that they are lacking in distinctive character (*Case C-299/99 Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd* [2002] ECR I-5475, para. 58) . If the relevant public has come to view a sign in current language use as a generic name for the goods or services in question, then the objection is satisfied because the mark is prima facie lacking in distinctive character. An added requirement that the name must have become customary also in the current language of the trade is superfluous. I note that the District Court of The Hague, Civil Section D, expressed a similar view on parallel

legislation in *Healing Herbs Limited v. Bach Flower Remedies Limited*, Case 02/244, 30 June 2004.

31. Mr. Malynicz based his argument on the ECJ decision in *Merz & Krell*, supra., concerning the equivalent Article 3(1)(d) of Council Directive 89/104/EEC (“the Directive”) and, in particular, paragraph 35 where the ECJ said:

“... marks covered by Article 3(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which marks are sought to be registered.”

But, it is important to realise that, here, the ECJ was considering the overlap between Article 3(1)(c) and (d) of the Directive (section 3(1)(c) and (d) TMA) in the context of the second part of the referred question, whether to fall within Article 3(1)(d) a mark must describe the properties or characteristics of the goods or services concerned. Paragraph 35 on the one hand is to be compared with paragraph 26 on the other hand where the ECJ, in the course of deciding the first part of the referred question to the effect that Article 3(1)(d) must be assessed in relation to the goods or services applied for, said:

“Under Article 3(1)(d) of the Directive, trade marks which consist exclusively of signs or indications which have become customary in the current language or trade practices are to be refused registration.”

32. I was also referred to the Opinion of AG Léger (13 November 2003) and the decision of the ECJ (29 April 2004) in Case C-371/02 *Björnekulla Fruktindustrier AB v. Procordia Food AB*. But I do not believe either support the interpretation that the Applicant seeks to advance. *Björnekulla* involved Article 12(2)(a) of the Directive (section 46(1)(c) TMA), the English and Finnish (but not other language) versions of which state that a trade mark is liable to revocation if:

“in consequence of acts or inactivity of the proprietor, it has become the common name *in the trade* for a product or service in respect of which it is registered.” (emphasis added) The ECJ followed the Advocate General in construing Article 12(2)(a) in the light of the general scheme and objectives of the Directive, particularly Article 3. Thus construed, Article 12(2)(a) could not be confined only to where the trade uses a mark generically. Instead, the relevant circles comprise principally consumers and end users and, depending on the market concerned, all those in trade who deal with the product in question commercially.

33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

8) In *Telefon & Buch Verlagsgesellschaft mbH v OHIM* – T-322/03 the General Court (“GC”) stated:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not

therefore fulfil the essential function of a trade mark (see, by analogy, Merz & Krell, paragraph 37, and BSS, paragraph 40).”

9) Although section 3(1)(d) relates to marks which consist exclusively of offending signs, making a minor embellishment to a sign which would otherwise fall foul of the ground for refusal is unlikely to save the application - see, by analogy, *Starbucks (UK) Ltd v British Sky Broadcasting Group Plc & Others* [2012] EWHC 1842 (Ch) and, also, *Micro Shaping Ltd v OHIM* – T-64/09.

The evidence

10) Rather than summarise the evidence on a piecemeal basis, I will, instead, summarise it by reference to the issues it covers. The witnesses are:

For the opponent

- i) Mr Brian Poulton, part owner of Indie Apparel Limited t/a Atom Retro. Mr Poulton is interested in music and fashion and was part of the mod scene during the 60s/70s. He gives evidence about the musical genre Northern Soul, the origins of this name and the disputed logo. He gives evidence about the use made by Atom Retro, and others, of goods bearing the logo.
- ii) Mr Kevin Roberts, who has worked in various guises in the “Northern Soul business” for 41 years. He gives his views on the origins of the logo and its use.
- iii) Mr Frank Burton, a former owner of the Torch Club in Stoke-on-Trent, a Northern Soul venue in the 70s. He gives evidence about the use of the logo.
- iv) Mr Mark Kelson, who trades under the name Parkaprint and has an eBay shop of the same name selling 60s, 70s, mod, Northern Soul, ska and reggae memorabilia. He gives evidence about his use of the logo and its origins.
- v) Mr Andrew Wilson, Company secretary of Tribal T-shirts Limited which sells goods such as tote bags, duffle bags, men’s and women’s t-shirts, hoodies and long sleeve t-shirts. He gives evidence about the goods it sells bearing the logo.
- vi) Mr Richard Free, a director of The Vintage Clothing Company (“TVCC”), a company which has supplied bags and other goods bearing the logo to businesses, some of which were manufactured by the applicant (or predecessor companies). He gives evidence about this and how the exact logo the subject of the dispute came to be.

- For the applicant
- vii) Mr Walsh, the trader behind the applicant for the trade mark. He has been involved in the bag industry for 20 years and has been involved in the manufacture of goods bearing the logo for 15 years. He gives evidence about such use and provides responses to certain parts of the opponent's evidence.

What is Northern Soul?

11) Mr Poulton's evidence contains most of the information about this, evidence which includes an extract from Wikipedia. Northern Soul is a musical genre/movement that started in the early 70s. The mod scene became influenced by soul music leading to the Northern Soul scene. It was particularly popular in the North of England. Whilst essentially historical, it is still followed, to some degree, today. There is evidence¹ that the term Northern Soul was coined by the journalist Dave Godin to indicate the type of soul music that certain people from the north of England preferred.

Characteristics of Northern Soul

12) There is strong evidence that the genre of music went beyond just listening to it. There are frequent references, particularly in Mr Poulton's evidence, to Northern Soul events taking place, often in clubs. Mr Poulton refers to "all nighters" and that he (and others) would take along flight or bowling bags and that these bags, along with their scooters, would be adorned with patches and other memorabilia. The use of patches (on clothing for example) was to denote the genre, the events and the clubs and their use seems to be a common practice adopted by fans of Northern Soul; this is also supported by information in the Wikipedia entry.

The origins of the logo

13) Mr Poulton states that the logo came to prominence in the 70s and was used on, for example, posters advertising events and was worn by attendees. It was not used by any one entity but simply as a symbol of the Northern Soul scene. The Wikipedia entry for Northern Soul describes a sew-on badge containing "the clenched fist symbol adopted by the Northern Soul movement". The entry explains that those who followed the movement would often adorn their clothing with sew on badges representing club membership. A number of sew-on badges are depicted in the Wikipedia entry, including:



¹ Mr Poulton's exhibits BRP2 and BRP3.

14) Mr Poulton refers to the “black power” salute which forms the basis of the logo. This was as a protest gesture made during the 1968 Olympics in Mexico by the black athletes Tomie Smith and John Carlos, a photograph of which is provided in Mr Poulton’s evidence. He does not know the origin of the phrases “Keep the faith” and “Keeping the faith”, but states that they have become associated with the movement. Mr Poulton’s Exhibit BRP5 contains an extract from a book called “Northern Soul An Illustrated History” which refers to the movement as “a secular religion whose followers sometimes come as close as medieval pilgrims to life-and-death struggles with The Faith and how to Keep It”. Exhibit BRP6 is a photograph of a sew-on badge that celebrated the 40th anniversary of Wigan Casino (one of the venues for Northern Soul events) which includes the text “KEEPING THE FAITH SINCE 1973”. Mr Poulton states that a recent (September 2013) Culture Show documentary had the words “Keep the Faith” in its title; Exhibit BRP9 contains a still from the BBC website from which it can be seen that the title of the documentary was “Northern Soul Keep The Faith”, the date of broadcast is not detailed. The still depicts someone carrying a bowling style bag with lots of patches on – it is difficult to make out what the patches depict, but Mr Poulton states that the logo can be seen on the bag.

15) None of the witnesses (other than Mr Free, whose evidence I will come on to later) provide evidence regarding who brought the elements of the logo together or in what circumstances and when. Whilst the sew-on badge depicted above is similar to the logo, it is missing the KEEP THE FAITH element and the words NORTHERN SOUL are in a different configuration. In Mr Poulton’s evidence there is a picture of a sew-on badge he “remembers everyone wearing from around the 1970s” – it is as per the badge depicted above (paragraph 13). He adds that the tradition of “all nighters” encouraged the use of overnight bags which were adorned with patches. He states that the logo was often included. His exhibit BRP8 is said to support this and is said to contain pictures of the type of bags used during this time. The first picture of what I would characterise as a bowling style bag has what appears to be a printed badge (as opposed to a sew-on one) similar to the one depicted above (so, again, not the logo with three elements as per the subject trade mark). Other patches have been added, but they do not appear to be either the subject trade mark or the logo depicted above. The second is a similar bag, the patches are not that clear, but the clearest is a patch with a fist logo in the centre, but the words around it read “THE TORCH - FOREVER”.

16) Mr Roberts gives a similar explanation regarding the origins of the logo (and its individual components) as Mr Poulton. He says that it is used by businesses to show that the services/products they offer are Northern Soul related and is worn by people to demonstrate that they are fans of the genre. Mr Burton states that the device was used at his club. For example, badges were given away with it on. Mr Kelson states that the artwork for the logo has evolved over the years and he can remember the fist artwork on patches and flyers from the 70s and “keep the faith” was something the fans of Northern Soul used to say to each other. He

states that the logo (or very similar ones) has probably been used by hundreds of manufacturers for various goods.

The resurgence in interest

17) Whilst Northern Soul does not appear to have ever died out completely, it is clear that its popularity decreased with time. However, it is also clear from the evidence that there has been a recent resurgence in interest. Mr Poulton states as much and he explains that its popularity has spread to other countries including Japan. He adds that this has encouraged mainstream accessory and apparel manufactures to use names and images associated with Northern Soul.

18) Mr Robert's evidence also refers to the resurgence. He says that the logo has been used so much that he is sick of seeing it and it is now viewed by many fans as "cheesy". He states that because of the revival over the last few years, new fans have yet to realise that it isn't cool to wear and use the device. Mr Free (whose evidence I will come on to shortly) states that when his company initially started selling goods bearing the logo (in or around 2003), the scene was in a sleepy period but is now growing again with a recent TV documentary and a major film just released.

The use by Mr Poulton/Atom Retro

19) Mr Poulton is part owner of Indie Apparel Limited which trades on eBay as Atom Retro. It sells products which are "Northern Soul inspired and many of the items display the device." Examples are provided in Exhibit BRP10; Mr Poulton states that Atom Retro has sold these goods since 2004. As well as t-shirts, the goods depicted in the exhibit include a patch in essentially the same form as the logo and a "Souler Retro Northern Soul Mod Bag" which looks like this:



20) None of the prints provided by Mr Poulton are dated before the relevant date. He states that some of the goods are manufactured by Atom Retro, others are supplied to it by TVCC. Mr Poulton searched his company records for goods sold with the words "northern soul keep the faith" in their title. He says that the vast majority (if not all) of the 505 items he found would have borne the logo. The

records are in Exhibit BRP11. Whilst Mr Poulton's statements are noted, there are some inherent difficulties with this evidence because many of the goods include other designations such as WIGAN CASINO and LAMBRETTA, so there is nothing to demonstrate how those words are included on the products and whether the logo is in a form with more than a minor embellishment/variation. I do note, however, that 116 "Souler bags" were sold between 2005 and 2013, a designation which matches the description of the bag depicted above.

The use by the applicant/Mr Walsh

21) Mr Walsh is the trader behind the applicant. He has been involved in the manufacture of bags bearing the logo for around 15 years. He was initially an employee of Skorski & Son, a bespoke bag company which manufactured bags including ones depicting the logo. In around 2006/2007, Skorski & Son liquidated the company and Mr Walsh volunteered to buy the contents of the business from the liquidator. He then incorporated J Walsh & Son Limited and traded that business "successfully" until December 2013 when he put that company into liquidation. He states that he continued "to trade as a Limited Company trading as Retro Bag Shop"; it is not clear from this statement what company he was continuing to trade through. Mr Walsh also has a company called Bespoke Bags Limited.

22) Between August 2006 and December 2012 Mr Walsh (presumably trading through J Walsh & Son, or Skorski & Son) supplied TVCC with £125,000 worth of goods, around £80,000 of which were bags bearing the logo. As can be seen from Mr Poulton's evidence, TVCC is a company that supplied goods bearing the logo to Atom Retro. Prior to these proceedings he was not aware of any other company making bags with the logo upon, indeed, it was the discovery that a third party intended to do so which led to the application being made.

23) Mr Poulton comments upon Mr Walsh's claim that prior to liquidation his company was trading successfully. He provides evidence that it owed £70,000 and that its assets consisted of only a motor vehicle, stock and a book debt.

The use by TVCC

24) I find the evidence of Mr Free to be very helpful in understanding what has gone on with regard to the logo. He explains that TVCC is both a wholesaler of vintage/retro clothing, bags and accessories and it also operates a number of retail shops throughout the UK under the mark POP BOUTIQUE.

25) He describes the situation between TVCC and Mr Walsh as one in which TVCC sub-contracted the manufacture of its bags to businesses which Mr Walsh has been involved in. He explains that in or around 2003 he asked a friend (Tom Sutton) to create artwork for use on bags and clothing. Mr Free's instructions to Mr Sutton were based upon his recollection of a northern soul badge he owned

during his youth. He explicitly states that the artwork produced is the exact logo the subject of this dispute. Mr Sutton was paid for the artwork and it was then sent to a screen printing company for the purpose of sub-contracting it for the manufacture of t-shirts and sweatshirts.

26) T-shirts and sweatshirts were the first products sold, it was not until 2004/2005 that TVCC started selling bags. For this purpose the artwork was provided to Skorski & Son to manufacture bags for TVCC. When the owner of Storski & Son retired, its business was carried on by J Walsh & Son, a company run by Mr Walsh's father. When that company ceased trading its business was continued by The Retro Bag Shop. Each of these businesses has been sub-contracted to manufacture bags bearing the logo (other bags have also been manufactured).

27) Mr Free states that TVCC has sold thousands of t-shirts/sweatshirts and thousands of bags bearing the logo. This was to both wholesale customers (of which Mr Poulton is just one) and retail through its shops. He does not have full records, but recent records show that since 2010 TVCC has had manufactured 3,928 bags bearing the logo. Mr Free's witness statement is dated 17 April 2014 so if these figures are to date then they include just under 16 months of sales after the relevant date. Mr Free states that last year (exactly when is not clear) TVCC stopped having the bag made as many other people had started using the logo (or similar).

28) He states that the logo (or similar) has been in use for 40 years, "keep the faith" being a commonly used phrase on the northern soul scene. He feels anyone involved in the scene would feel that the device and slogan are owned by the people who have been involved with northern soul, not a bag manufacturer that has latched on to the idea.

Use by other traders

29) Mr Poulton states that other traders have sold goods bearing the device. His evidence on this is detailed in various exhibits, as follows:

BRP12: These are "current prints" from the Internet which include:

i) Cafe Press selling a number of Northern Soul bags, one of which is a field bag depicting the logo, other bags feature different wording ("keep on burning" and "up all night") and/or different devices (one has an owl, another a hand holding a torch);

ii) Northern Clothing selling a bowling style bag and an overnight bag bearing the logo (or a logo which I accept is very similar to it);

iii) My Icon Art & Clothing selling a tote bag bearing the logo (the fist is slightly different but is essentially the same);

iv) T-shirt Grill selling a t-shirt and sweatshirt bearing a very similar logo;

v) Blue Cat Store selling t-shirts bearing a very similar logo;

vi) Funky Shirt selling t-shirts and hoodies bearing a very similar logo;

vii) Postees selling a t-shirt bearing a very similar logo;

viii) Spreadshirt selling a t-shirt bearing a very similar logo;

ix) Zazzle selling a t-shirt, a greeting card, a badge, a hoody, a sticker and a watch bearing a very similar logo. There is also a bag but the fist is pointing towards the viewer rather than up in the air as per the black power salute.

BRP13: Various bags bearing the subject mark on eBay (none can be placed before the relevant date) including:

ix) Ls Prints selling a duffle bag and pump/school bag bearing a very similar logo;

x) Soul 65 selling a handbag and a shoulder bag bearing a very similar logo;

xi) Guerilla Graphics selling a duffle bag bearing a very similar logo;

xii) A listings page after a search for “Northern Soul Bag” was conducted. A number of bags bearing a very similar logo are listed. Mr Poulton states there are seven suppliers, but this is difficult to see because the supplier name is not included in the listing. Nor is it clear whether these included the bags highlighted in the other prints in the exhibit, I suspect that they are duplicated as the listings appear to be very similar in terms of product photographs;

xiii) A similar eBay listing page but this time after a search for “Northern Soul Keep the faith t-shirt”. 2896 results were found, the majority of which, Mr Poulton states, display the logo. The provided print shows just 35 t-shirts, around 20 of which bear a very similar logo;

BRP14: This exhibit contains a print from the Amazon website. There are around 9 different bags featuring the logo (or ones very similar to it). Two of the traders are Eye Catch Shoes and L& S Prints (one of the e-Bay sellers). Mr Poulton mentions other traders but it is difficult to tie them to

particular products as there are also other Northern Soul bags which do not feature the logo. There are also t-shirts featuring the logo along with many other Northern Soul inspired t-shirts;

BRP15: A Google images print for Northern Soul, a large amount feature the logo, but only 2 or 3 show it on bags;

BRP16: Prints from the Amazon website showing two different CDs bearing a very similar logo;

BRP10: Copies of 10 observations filed in relation to the registration of the trade mark. They all discuss the heritage of the logo the subject of the trade mark and its historic roots. They are all opposed to it being registered by one trader. Little emphasis is placed on the use of the sign on bags, but one of the observations does mention this.

30) Mr Poulton concludes his evidence by stating that the logo has been used on a wide range of goods, but primarily badges, t-shirts and bags over the last 40 years and that it is not capable of functioning as a trade mark. He states that the device has a great meaning to many thousands of enthusiasts and the applicant should not be given exclusive rights in it.

31) Mr Roberts states that he included the logo on a CD in the 1990s and was threatened by the former owner of the twisted wheel nightclub who claimed he owned the device. He was surprised by this because it has been used thousands of times by others. He does not explain what the outcome of this dispute was. He states that the device has been used for so many decades to promote Northern Soul nights and merchandise that it cannot be the trade mark of any one business.

32) Mr Burton states that from the early 70s to the mid eighties he sold merchandise with the logo on, namely badges and t-shirts. He states that hundreds of other companies and individuals have made use of the device on patches, calendars, t-shirts, posters and the like. It is recognised as symbolizing the northern soul movement and so is used on merchandise in order to sell to Northern soul fans.

33) Mr Kelson attaches photographs of some of the products he sells which feature the logo (or essentially the same) which include bags and purses. These are “currently” manufactured and sold, but he states that he has been selling goods bearing the device for about 12 years. Over the last year or so he has sold around 4 items a week. He states that the logo (or very similar) has probably been used by hundreds of manufacturers for various goods including bags. He states that the device is well known in the Northern Soul scene as “our logo” and that it should not be trade marked by one person.

34) Mr Wilson states that since 2007 he has sold such goods bearing the logo (or something indistinguishable from it) on Amazon, eBay, play.com and its own website. Photographs of products bearing the logo (including bags) are provided. Also provided are 2008 and 2009 lists of sales, but the highlighted entries are only for hoodies or t-shirts. He does though also provide some invoices, two of which relate to the sale (in December 2011 and May 2012) of Northern Soul Keep the Faith tote bags.

35) To ascertain whether Mr Poulton's evidence establishes customary use, Mr Walsh undertook a Google search for the term "bags". Unsurprisingly, nothing about the logo was brought up. None of the top hits (ASOS, Next etc) sell bags bearing the logo. He also searched the website of a specialist retro shop (beyondretro.com) which sells 260 bags, but none bear the logo.

Other responses from Mr Walsh

36) Mr Walsh notes that there are two other trade mark registrations similar to the application which has faced no objection. The first is for the words NORTHERN SOUL for clothing, the other is not remotely similar. The rest of Mr Walsh's evidence is more akin to submission, by way of critique of the opponent's evidence. His points are that:

- i) Much of the use is simply historic.
- ii) Use on other products (other than bags) has little impact.
- iii) Atom Retro's goods were manufactured by the applicant.
- iv) The extent/size of the bag industry is not explained.
- v) The historic recollections of the witnesses are not pertinent.
- vi) Mr Burton does not mention bags even though he does refer to other products.
- vii) Journalistic and historical use is not relevant.
- viii) Many of the traders/websites are obscure.
- ix) Expressions such as "handbag" or "sports bag" are the types of designations which are customary in the trade.

Analysis and conclusions

37) The relevant date in these proceedings is 27 December 2012 and it is the commonality in the current language/established practices in the trade at this point in time which must be established in respect of the pleaded ground of opposition under section 3(1)(d). I accept that there are some flaws in the evidence. Firstly, it is not absolutely clear what logo was being used in the 60s/70s and whether it included all three elements of the mark the subject of these proceedings. Although, it is very clear that Mr Free brought the three elements together by at least as early as 2003 when he had the artwork produced for use on t-shirts, and, subsequent to that, bags. Another flaw is that the various Internet prints from Amazon and eBay etc are from after the relevant

date. The opponent submits that this does not matter because the genre has been going for so long that the use demonstrated would not have just sprung up. The problem with this argument is that the popularity of the genre has varied over the years and that there has been a resurgence of interest in fairly recent years. This means that it would be unsafe to infer that the prints are fully reflective of the position at the relevant date. The significance of this post relevant date evidence should, in my view, be watered down, although not ignored completely.

38) Nevertheless, I think it clear that a number of businesses were selling bags with the logo (or a very close variation) on them before the relevant date. Mr Poulton was doing so. It is the applicant's own evidence that between 2006-2012 £80k worth of bags bearing the mark were sold to TVCC. TVCC were selling to retail customers in addition to supplying wholesale customers. Mr Poulton was just one of TVCC's wholesale customers, although I accept that I do not know exactly how many others there were. Mr Wilson's and Mr Kelson's evidence is that they have also sold bags bearing the logo.

39) I should add that the fact that the applicant (or its predecessors) may have made many of the bags is not relevant. The circumstance here appears to be one of simple manufacturing. Manufacturing of goods which have found their way to market via a number of different traders, goods which appear intended to be Northern Soul memorabilia. This is supported by what I consider to be clear evidence that such traders saw the mark solely as a generic badge of allegiance to the Northern Soul movement. Even the applicant does not claim anything else.

40) Also, a number of the opponent's witnesses also seem typical of the section of the public concerned with the trade in products bearing these sorts of signs (because of their interest in the genre), and they appear to view the sign as part of the common "language". There is also use on t-shirts. Whilst this is not directly relevant, it is indirectly relevant because it helps to understand how the relevant public would have regarded the use of the mark on bags at the relevant date.

41) The applicant's evidence that the ground for refusal is intended to deal with terms such as "handbag" sets the bar far too high. The objective of the ground for refusal is to prevent registration of signs which cannot perform the essential distinguishing function on account of them being part of the common language or used in trade. Based on my above assessment, this is a clear example of such a case and the ground is made out. **The opposition succeeds.** This finding extends to all of the applied for goods because they are all bags or are very closely related to them; the term "imitations of leather" would appear intended to cover versions of the goods which are imitations of leather versions of them.

Costs

42) The opponent has succeeded and is entitled to a contribution towards his costs. My assessment is as follows:

Official fee
£200

Preparing a statement and considering the other side's statement
£300

Filing and considering evidence
£1000

Submissions
£500

Total
£2000

43) I hereby order The Retro Bag Shop to pay Mr Brian Poulton the sum of £2000 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 11th day of August 2014

Oliver Morris
For the Registrar,
The Comptroller-General