

TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 1587970
BY ASCOT (S & F) INTERNATIONAL LIMITED
TO REGISTER A TRADE MARK
KINGFISHER & DEVICE
IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 44315
BY THE PULLMAN SHOE COMPANY LIMITED

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15 BACKGROUND

On 13 October 1994, Ascot (S & F) International Ltd of 59 Standen Road, Wandsworth, London, SW18 5TL applied under the Trade Marks Act 1938 for registration of the trade mark shown below:



In respect of:

30 "Shirts, shorts, socks, skirts, dresses, blouses, panties, vests, brassieres, tracksuits, sweaters, jumpers, cardigans, pullovers, jackets, hats, boots, shoes, slippers and trousers, socks, caps, gloves, wristlets, headbands, sweatbands, leg warmers, dancewear, tops and jeans; all included in Class 25; but not including articles of rainproof clothing."

35 On 11 March 1996, The Pullman Shoe Company Ltd filed opposition to the application. The grounds of opposition are in summary:

1) The trade mark applied for is not adapted to distinguish the goods specified and therefore does not satisfy Sections 9 and 10 of the Trade Marks Act 1938.

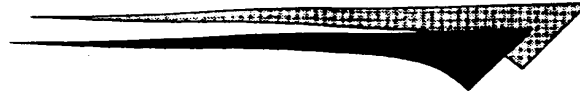
40 2) The opponents are the registered proprietors of the trade mark, number 1570129 (shown below). The trade mark in suit is similar and would offend against Sections 11 & 12 of the Trade Marks Act 1938.

45 3) The applicants claim to ownership of the mark is not bona fide and they do not have a bona fide intention to use the mark in respect of all the goods in the specification of the application. Registration would therefore offend against Section 17(1) of the Trade Marks Act 1938.

4) The application should be refused in accordance with the Registrar's discretion under Section 17(2) of the Trade Marks Act 1938.

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1570129 28 April 1994 (25)



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Sportswear and leisurewear: footwear: all included in Class 25.

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The applicants filed a counterstatement denying all the grounds of opposition. The applicants also ask the Registrar to exercise his discretion in their favour and both sides seek an award of costs in their favour. Both sides filed evidence in these proceedings and the matter came to be heard on 10 August 1999, when the applicants were represented by Mr Engelman of Counsel, instructed by Stevens Hewlett & Perkins, Trade Mark Attorneys. The opponents were represented by Mr Bartlett of W H Beck Greener & Co., Trade Mark Attorneys.

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By the time this matter came to be decided the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision are references to the provisions of the Trade Marks Act 1938 (as amended) unless otherwise indicated.

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OPPONENTS' EVIDENCE

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The opponents filed two statutory declarations. The first, dated 13 February 1997, is by Mr Martin George Warner. He states that:

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"I work for Warndell Investments PLC (Warndell) and its two operating subsidiaries, G H Warner Footwear Plc (Warner), of which I am a Sales Director and The Pullman Shoe Company Limited (Pullman) the opponent in this matter. In this statement I refer to this group of companies as the group."

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Mr Warner deals with the day to day running of the Group's sports footwear business, and has responsibility for the sales of sports shoes by Pullman. He states that the group's principal activity covers the importation and distribution of footwear, including sports shoes.

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Mr Warner claims that in 1994 the group's total turnover was £16.9 million, of which "about 50% was represented by sports shoes." In 1995 the turnover was £22.5 million "of which about 55-60% were sports shoes". He also claims that the group sells its sports footwear in 32 countries ranging from Western and Eastern Europe to South America, that the footwear is at the lower end of the market (budget) and retails for £15 - 20, and that "The sports footwear is sold under the name MERCURY"

Mr Warner states that in addition to a brand name most sports shoes have a logo. He claims that the group commissioned their logo in December 1993, and sought to register it in the UK in April 1994. At exhibit MGW1 is a letter from the designer, dated 2 December 1993 confirming that he will produce ideas for their corporate identity. Mr Warner also provides at exhibit MGW3 a list of applications for the flash mark (solus) and flash mark with the word MERCURY in other countries.

Mr Warner states that having decided to adopt the “Flash logo” the group promoted the mark at exhibitions. A list of European exhibitions in 1994 - 1996 is provided. The mark was also promoted at a trade fair in Dubai in 1996. At exhibits MGW5 & 6 are photographs of the stands at these exhibitions, literature and invoices. The letters mostly refer to the name of the company, Mercury Sports Footwear, whilst those documents and photographs which show the Flash logo have the word MERCURY prominently displayed just above the logo.

At exhibit MGW7 are examples of advertisements in magazines such as *Leather and Footwear Review*, *Shoe and Leather News*, *Footwear Today* and *Sports Update Magazine* dated between August 1994 and July 1995. These all show the name MERCURY together with the Flash logo. Mr Warner states that the opponents have also sponsored Leicester City Football Club and a copy of a match programme and photos of the company stand at the hospitality event are provided at exhibit MGW8, dated November 1994. A photo of a sweatshirt used by the ball boys at these sponsored matches is at exhibit MGW9. All these exhibits show the name MERCURY above the Flash logo.

Mr Warner states that “earlier this year we ran a competition in the Daily Mirror to design an advert for our ‘MERCURY’ brand, incorporating the flash logo.” At exhibit MGW10 are copies from the Daily Mirror which shows the name MERCURY and the registered Flash logo. Above this is a picture of four sports shoes which according to the caption are “Mercury’s Freeway trainers”. The shoes have a logo on them but not that which is registered, as the flash marks do not overlap. In the same exhibit is a copy of the winning advertisement which shows the Freeway shoe with the non-overlapping logo.

Figures for advertising and promotion of “Mercury shoes bearing the logo mark” are provided as follows:

1994	£79,844
1995	£84,794
1996	£147,211

Mr Warner claims that orders were first taken for the shoes with the Flash logo in June 1994 with deliveries being made in October 1994 to customers. The Flash logo has been used on the company’s stationery since June 1994. Mr Warner claims that “since first offering our sports shoes for sale we have delivered some 3.8 million pairs worldwide bearing the Flash logo and approximately 2,900,00 of these pairs in the UK”.

Mr Warner states that the Flash logo is used on most of the opponents’ shoes, either on the

tongue, heel or on the side and in some cases, all three. At exhibit MGW11 two shoes are provided. One has the Flash logo on each side of the shoe, and the Flash logo with MERCURY written above it on the heel and tongue. The other shoe has the word MERCURY above the Flash logo on the tongue and heel but has a variation of the logo on the side of the shoe. At exhibit
5 MGW12 is a catalogue which has been poorly photocopied so that most of the images are indistinct. It is clear on some of the photos of sports shoes that the flash logo (solus) is used on the shoes on the side, and the flash logo and the name MERCURY on the tongue Mr Warner also claims that the mark is used on swing tickets, insole tickets, shoe boxes, shoe shelves, catalogues, stationery, invoices etc. At Exhibit MGW12 & 13 examples are provided, which show
10 the Flash logo being used in conjunction with the name MERCURY.

Mr Warner claims that most sports shoe manufacturers use a logo to identify their products. Typically, he claims the shoe also features the name of the manufacturer but the logo is used solus on the side of the shoe. When offered for sale to the public the shoes tend to be side on and so
15 only the logo is readily visible to identify the manufacturer. Mr Warner states that at the budget end of the market recognition of marks is “not so acute”, and so confusion is more likely between marks. He also refers to the practice of giving a line of shoes a name, and instances NIKE “Air Max” which he claims has the words “Air Max” and the NIKE Tick but not the word NIKE on them. Mr Warner is concerned that the applicants’ shoes could be seen as the “Kingfisher” range
20 form the opponents.

The opponents’ Flash logo is described by Mr Warner as:

“Two long thin triangles which are superimposed to overlap with the ‘heads’ tapering to
25 the ‘tails’. I refer to this triangle shape as a ‘flash’. The tails of the flash are close together on the shoe.”

Mr Warner then describes the applicants’ mark:

“Two superimposed ‘flashes’ which are practically identical in shape to those used in our
30 Flash logo, although in this case one is superimposed completely on the other. Even so, the ‘feel’ of the logo is that the end is two pronged, like our own.”

Mr Warner then states his concern that there will be confusion amongst the public because of the
35 alleged similarity of the marks and that such confusion would damage the opponents either by loss of sales directly or by the loss of goodwill due to the “inferior quality of the Ascot shoe”.

Finally Mr Warner refers to the confusion of one retailer who sent a faulty pair of shoes
40 manufactured by the applicants back to the opponents believing them to be the manufacturers. He states that if a retailer can be confused then “it is inevitable the public will be confused”.

The second statutory declaration is by Mr Robert Charles Andrew, dated 13 February 1997. Mr
45 Andrew is a warehouseman working for Warndell Investments Plc, and is responsible for dealing with returns of faulty shoes, “including MERCURY shoes bearing the flash logo”.

Mr Andrew states that on the 22nd November 1996 a batch of returns was received from Tutte
& Thomas of Romsey. He says the paperwork referred to a “Beta” shoe which is not a line sold

by the opponents. The return slip is at exhibit RCA1. The shoe in question is filed at exhibit RCA2 and has the word KINGFISHER and a logo on the heel and tongue, with the same logo (solus) appearing on the sides of the shoe. Mr Andrew comments that “Evidently, Tutte & Thomas Ltd believed incorrectly that this Kingfisher shoe was one of Warner or Pullman’s shoes”.

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APPLICANTS’ EVIDENCE

This consists of two statutory declarations. The first dated 28 November 1997, is by Mr Guru Dev Seth. Mr Seth is the Managing Director of Ascot (S & F) International Limited, the applicants. Mr Seth founded a company called Ascot Sports (Sussex) Ltd in 1970 which sold sporting equipment but not sports shoes. In 1976 the company changed its name to Ascot (Sports Goods) International Ltd and sold sports shoes and clothing as well as equipment. In 1984 a new company was founded trading under the name of Ascot (S & F) International Ltd. Mr Seth states that this last company has acquired by assignment the ownership of the British and overseas trade mark registrations and applications which were previously owned by Ascot (Sports Goods) International Ltd, together with the associated goodwill of the business in the goods concerned.

Mr Seth claims that the applicants sell their goods in “a number of overseas countries” and in addition to direct advertising in the UK and overseas the applicants have sponsored sporting tournaments, training schemes and individual sportsmen and sportswomen. In addition he claims that the applicants regularly participate in trade fairs including events held in Germany, Canada, the USA and the Far East.

Mr Seth states that in the UK the applicants’ goods are sold through approx. 2000 outlets ranging from large department stores to small sports and shoe shops. He provides turnover figures for the company since its foundation, however I have only shown the more recent and relevant years:

Year	Turnover £
1993	12,077,000
1994	13,948,000
1995	11,233,000
1996	15,209,000

Mr Seth claims that the company has advertised at sports grounds and other sporting venues, and that these fixtures are frequently shown on television.

Mr Seth states that the brand name KINGFISHER was first used on footwear in 1993. A range of drawings for shoes which form part of the KINGFISHER range are provided at exhibit GDS1. The earliest design is dated 11 August 1994 and shows the kingfisher name and device on the heel and tongue with the device(solus) on the side of the shoe. On later designs the name KINGFISHER is shown on the side on some shoes, and there are also versions where the name KINGFISHER has been reduced to the letter’s KF and where the device (solus) is on the side of the shoes.

Mr Seth claims that the applicants have, through a subsidiary Kingfisher Ltd, been selling footwear bearing the KINGFISHER and device in the UK since 1995. Exhibit GDS2 consists of a number of colour photographs which show sports shoes which have the KINGFISHER name and device on them. Mr Seth states that the total value of sales in the UK of Kingfisher Ltd are:

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Year	Turnover
1995	3,050,779
1996	7,239,256
1997 (Jan - Oct.)	7,823,000

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It is not clear whether these figures relate to the mark applied for or include other Kingfisher marks.

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Mr Seth does not believe that the two marks in suit are similar and provides at exhibit GDS3 letters from four retailers, who “were selected as a sample of our customers”. The four letters all state that they have knowledge of both marks, would identify the Kingfisher and device mark as belonging to the applicants and stating that in their personal view the marks are not similar. One of the letters, from Wembley Footwear Ltd, states that products “bearing the mark KINGFISHER and DEVICE “ have been stocked since 15 June 1994.

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Mr Seth refutes the claim that the applicants’ shoes are of inferior quality. He also claims that:

“Trade marks consisting of devices that might be termed ‘arrows’, ‘flashes’ or ‘ticks’ or other such shapes, are widely used by different manufacturers of footwear.”

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At exhibit GDS4 is a range of other trade marks registered for sports clothing in class 25 which consist of arrows or flashes

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The second statutory declaration, dated 11 November 1997, is by Mr Anthony P Livesey, a Director of Livesey Shoe Co. Ltd. Mr Livesey states that he is aware of both parties’ goods and trade marks and that in his opinion they are not confusingly similar. He also claims to have stocked the applicants’ products “since 1994”.

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That completes my review of the evidence.

DECISION

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At the hearing the applicants sought to file an additional statutory declaration by Mr Guru Seth which referred to the date of first use of the applicants’ mark. Counsel for the applicants stated that the date of first use was a central issue in the case and that Mr Seth’s original declaration was not as precise as it might have been as he had erred on the side of caution when giving the date of first use as 1995. Mr Engelman also contended that the declaration of Mr Livesey and the letter from Wembley Footwear Ltd appended at exhibit GDS3 both refer to the applicants’ product

being stocked in 1994, in one instance the precise date of 15 June 1994 was provided. He also opined that the second statutory declaration by Mr Seth was not wholly required as the position from the evidence already filed was clear that the date of first use by the applicants was during 1994.

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In view of the fact that the opponents had not been provided with a copy of the statutory declaration that the applicants were seeking to file as evidence, having only been shown a copy of the document just before the hearing commenced, and since the issue, although important, was said to be covered in previously filed evidence I declined to allow the document to be filed as evidence.

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The grounds of opposition under Sections 9, 10 & 17(1) were withdrawn by Mr Bartlett at the hearing.

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The first ground of opposition is under Section 12(1) of the 1938 Act. This reads as follows:

12. - (1) "Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:

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(a) the same goods,

(b) the same description of goods, or

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(c) services or a description of services which are associated with those goods or goods of that description."

The reference in Section 12 to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

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The established test for objections under Section 12(1) is set down in Smith Hayden & Co. Ltd's application [Volume 1946 63 RPC 101]. Adapted to the matter in hand the test may be expressed as follows:

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Assuming user by the opponents of their registered FLASH Logo in a normal and fair manner for any of the goods covered by the registration of the trade mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their trade mark KINGFISHER & DEVICE normally and fairly in respect of any goods covered by the proposed registration?

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It is accepted by both sides that the goods are similar if not identical.

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I therefore move onto consider the marks themselves. For this purpose I take into account the guidance set down by Parker J in Pianotist Co.'s application (1906 23 RPC 774 at page 777):

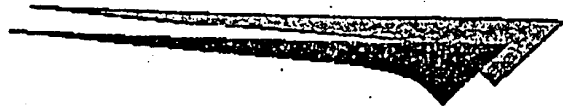
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“You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances: and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering, all those circumstances, you come to the conclusion that there will be a confusion - that is to say- not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.”

Although the above test is framed in terms of word marks the basic principles hold good for other types of mark as well. For ease of comparison the marks are reproduced below:

Applicants' Mark:



Opponents' Mark:



Opponents' Mark (reversed):



The opponents mark is registered in the first of the two forms shown, but both sides accept that “normal and fair use” would include the reversal form shown in the second representation. It is therefore appropriate that the opponents’ mark should be considered in its reversed state.

The opponents contend that the public is used to distinguishing products such as sports shoes and clothing by reference to the logo. Therefore, they claimed, the word “KINGFISHER” in the applicants’ mark will be seen as an “additional mark”, and the comparison should be between the logos solus. I do not agree with this contention as it is the marks as registered or proposed to be registered which must be compared under this ground of opposition.

With regard to the device elements, the opponents contend that both are made up of two extended triangular shapes, one superimposed on the other, and that both had two heads and two

5 tails. I do not fully agree with this analysis. In my view the device in the applicants' mark resembles some form of implement which has a cut out near to the "head"; indeed the applicants refer to it as a "key" device. The opponents' description holds good for their own mark and, in my opinion, the device elements are quite dissimilar, and would not be confused for each other even allowing for the notion of imperfect recollection.

10 I must however compare the marks as wholes. It is accepted that "words speak louder than devices" and the distinguishing feature in the applicants' mark is the word KINGFISHER. Taking into account all of the factors and comparing the marks as wholes, I consider that the degree of similarity between the trade mark KINGFISHER and DEVICE and the opponents registered FLASH device is insufficient to cause deception and confusion amongst a substantial number of persons. In reaching this decision I have taken into account the single instance of confusion outlined in the opponents evidence. However, the statutory declaration by Mr Robert Charles Andrew provides little information about the circumstances in which the confusion arose. It is not clear that the confusion stemmed (only) from the similarity of the respective marks. In a marginal case instances of actual confusion will, if properly substantiated, usually result in an inference that the marks are confusingly similar. However, where, as in this case, the tribunal is clearly of the view that the marks will not be confused by the average consumer of the goods, a claim of a single instance of confusion may not be enough to displace that view, particularly where the full circumstances are unclear. The opposition under Section 12 fails.

The next ground of opposition is under Sections 11 of the 1938 Act. This reads as follows:

25 *"11. - It shall not be lawful to register as a service mark or part of a service mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."*

30 The established test for this section is set down in Smith Hayden and Company Ltd's application (Volume 63 1946 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case (1969 RPC 496). Adapted to the matter in hand the test may be expressed as follows:

35 Having regard to the user of the opponents' mark FLASH device, is the tribunal satisfied that the mark applied for, KINGFISHER and DEVICE, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

40 Under this heading I must consider the actual user of the opponents' mark. It is stated that the opponents had commissioned the design of their logo in December 1993 and sought to register it as a trade mark in April 1994. The mark was used on samples of products at exhibitions and trade fairs as well as by sales staff in discussions with potential purchasers. The first orders it is claimed were taken in June 1994 with the first deliveries being made in October 1994. The exhibits provided by the opponents show that the FLASH device is seldom used in isolation. In the majority of the exhibits the device is used in conjunction with the name MERCURY. The only occasion when this appears not to be the case is on the side of shoes when the FLASH device is used solus, albeit with the device and the name MERCURY appearing on the tongue of the shoe

and on the swing label.

5 The opponents contend that shoes are usually displayed in shops “side on” and therefore only the device element is visible. Even if I were persuaded to this contention, I have already considered the devices solus and found that they are not confusable. As this determines the issue I do not have to consider the applicants’ claim regarding the date of first use. The opposition under Section 11 fails.

10 I do not intend to invoke the Registrar’s discretion in favour of the opponents.

As the opposition has failed, the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £635

15 Dated this 14 Day of October 1999

20 George W Salthouse
For the Registrar
The Comptroller General