

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATIONS 2489547 AND 2534122

IN THE NAME OF JUSTIN DEAKIN

AND OPPOSITIONS 98234 AND 100434 THERETO

IN THE NAME OF NICHOLAS DEAKINS LTD

AND:

TRADE MARK APPLICATION 2501575

IN THE NAME OF NICHOLAS DEAKINS LTD

AND OPPOSITION 98759 THERETO

IN THE NAME OF JUSTIN DEAKIN

AND:

REGISTERED TRADE MARK 2443925

IN THE NAME OF JUSTIN DEAKIN

AND INVALIDITY APPLICATION 83950

IN THE NAME OF NICHOLAS DEAKINS LTD

D E C I S I O N

1. Three sets of opposition proceedings were determined in a single decision issued by Mr. Oliver Morris on behalf of the Registrar of Trade Marks under reference BL O/157/12 on 16 April 2012. The parties to the proceedings were Nicholas Deakins Ltd ('NDL') and Justin Deakin ('JD'). Each sought to prevent the other from registering

DEAKIN or **DEAKINS** as their trade mark. NDL was successful in two of the three oppositions and partially successful in the third. JD maintains on appeal under Section 76 of the Trade Marks Act 1994 that all three oppositions should have been determined entirely in his favour.

2. The Notice and Grounds of Appeal filed on behalf of JD also raise a discrete point with regard to the Hearing Officer's order as to costs. Paragraph [43] of the Decision under appeal shows that the Hearing Officer ordered JD to pay £200 to NDL as a contribution towards its costs of the opposition proceedings. The complaint is that in awarding costs by reference only to the outcome of the opposition proceedings, the Hearing Officer overlooked or ignored the fact that a claim for invalidity brought by NDL in relation to JD's registered trade mark 2443925 had been listed for hearing at the same time as the three sets of opposition proceedings and that JD had an acknowledged and accepted request for an award of costs to be made in his favour as a result of the late abandonment of that claim.

3. The competing claims of the parties with regard to proprietorship of and entitlement to use the trade mark **DEAKIN/DEAKINS** had to be assessed on the basis that:

- (i) the 1994 Act establishes a system in which title to a protected trade mark arises solely by virtue of an entry in the register identifying the natural or legal person(s) to whom the original certificate of registration is issued on completion of a procedure initiated by a simple request for registration filed in the required manner;

- (ii) there is no legal or administrative requirement under the Act for a person requesting registration to make an a priori claim to proprietorship of the trade mark he is putting forward for protection, since the present system factors nothing more than the concept of acquiring ‘title by registration’ into the application stage and leaves it to those who would wish to contend that title has not been validly acquired to object on grounds available for that purpose under the Act; and
- (iii) although trade mark rights acquired by use remain protected, they are taken into account ‘*only in regard to the relationship between them and trade marks acquired by registration*’ as envisaged by the fifth recital in the preamble to the Trade Marks Directive (Directive 2008/95/EC of 22 October 2008).

See THE SWINGING BLUE JEANS Trade Mark (BL O/148/14; 3 April 2014) at paragraphs [9] and [10].

4. With these considerations in mind, I think it is essential for the purposes of the present appeal to take each of the opposition proceedings in turn and focus upon the question whether the Hearing Officer’s findings with regard to the particular objections raised for determination were vitiated by error as JD contends. When I have done so, I will deal with the discrete point that has been raised in relation to the Hearing Officer’s award of costs.

Opposition 98234 to Trade Mark Application 2489547

5. On 9 June 2008, JD applied under number 2489547 to register **DEAKIN** as a trade mark for use in relation to ‘*Footwear & Clothing*’ in Class 25. The application for

registration was opposed by NDL in opposition proceedings commenced under reference number 98234 on 10 November 2008. Objections to registration were raised under Sections 3(6), 5(2)(b), 5(3) and 5(4)(a) of the 1994 Act and maintained at the hearing which subsequently took place on 12 October 2011.

6. The question for determination under Section 3(6) was whether the application for registration had been made in bad faith on the basis pleaded in paragraphs 5.1 to 5.4 of NDL's Grounds of Opposition:

5. Bad Faith

- 5.1 The Applicant was a founding partner of a business called Nicholas Deakins, now Nicolas Deakins Limited, the Opponent. The partnership between Mr. Justin Deakin and Mr. Craig Tate in relation to the Nicholas Deakins business was dissolved in 1993, when the Applicant sold his rights in the business to Mr. Tate.
- 5.2 As part of the Deed of Dissolution, the Applicant acknowledged that he has no rights to use the firm name NICHOLAS DEAKINS, and he covenanted with Mr. Tate of the Opponent not to use any name for his own business which is the same or might be confused with the firm name whether visually, audibly or in some other manner.
- 5.3 The Applicant was therefore fully aware of the rights of the opponent in the marks NICHOLAS DEAKINS at the time of the application. In addition, due to his activities and proximity to the Opponent's retail channels it is apparent that the Applicant must also have been aware of the Opponent's rights in the mark DEAKINS.
- 5.4 The Opponent therefore believes that the Applicant acted in bad faith when the

Application was filed, as he was not only aware of the Opponent's earlier rights, but was also acting in breach of contract.

7. The Hearing Officer decided not to determine that question: paragraph [40]. That was a case management decision within the scope of Rule 62 of the Trade Marks Rules 2008. Although it would appear to have been made without giving the parties an opportunity to be heard in relation to it under Rule 63, his decision to that effect has not been challenged by either party on appeal.

8. NDL's objection under Section 5(2)(b) was based on the rights to which it was entitled as proprietor of earlier trade mark 2396693:



Mark Description: The colours shown in the mark are gold
Pantone 17-1047tc and black

Filed: 12 July 2005

Registered: 30 December 2005

Class 25: Mens and ladies clothing, shirts, T-shirts, hats, gloves, socks, underwear, trousers, jeans, jackets, sweaters, jumpers, hooded tops, track tops, combat pants, shorts, swimming shorts, swimming trunks, formal shoes, casual

shoes, boots, moccasins, trainers and sneakers.

9. The registration details set out in the preceding paragraph were obtained from the Register kept in electronic form by the Registrar. They indicate that the earlier trade mark was recorded in black-and-white, but registered in colour using the mark description for the purpose of specifying the colour scheme. That is borne out by the documents (provided to me by the Registry at my request) at Annex A to this Decision.

10. The question raised by the objection was whether there were similarities (in terms of marks and goods) which would have combined to give rise to the existence of a likelihood of confusion if the gold-and-black mark identified in paragraph 8 above and the mark **DEAKIN** had been used concurrently for goods of the kind for which they were respectively registered and proposed to be registered in the United Kingdom in June 2008.

11. Both as between marks and as between goods and services the evaluation of '*similarity*' is a means to an end. It serves as a way of enabling the decision taker to gauge whether there is '*similarity*' of a kind and to a degree which is liable to give rise to perceptions of relatedness in the mind of the average consumer of the goods or services concerned. This calls for a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue, giving the similarities and differences as much or as little significance as the relevant average consumer (who is taken to be reasonably well-informed and reasonably observant and circumspect) would have attached to them at the relevant point in time.

12. The Hearing Officer found that the application for registration covered goods identical to those for which NDL's earlier trade mark was registered: paragraphs [14] and [15]. He considered that the marks in issue were similar (not to a high or a low degree, but to a degree midway between the two extremes) for the following reasons:

10) When making a comparison, it is to be noted that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. In terms of Mr. Deakin's DEAKIN mark, it has only one element, the word DEAKIN itself. In terms of NDL's mark, this consists of the words NICHOLAS DEAKINS (in title case) and a flower device. Both the word element and the device element make a roughly equal contribution to the overall impression of the mark, contributions that are independent from each other. The Nicholas Deakins element is dominated more by Deakins than by Nicholas. I say this because whilst Nicholas Deakins will be perceived as a full personal name (notwithstanding the fact that Nicholas is a surname in its own right), I come to the view, on account of the levels of relative unusualness, that Deakins will be seen as the more dominant component; my own experience tells me that Nicholas is a fairly common forename whereas Deakins is not a common surname... .

...

13) In terms of the visual and aural comparison, DEAKIN and DEAKINS are very similar, which provides a certain degree of similarity between the marks as a whole. The differences (the device element and the word NICHOLAS) need to be factored in to that. Having done so, this results, in my view, in there being a moderate degree of visual and aural similarity. In terms of concept, although DEAKIN and DEAKINS do not strike me as common surnames, the conceptual significance will still be surnominal. To that extent, there is some conceptual similarity because both marks refer to a person with extremely similar surnames (Deakin/Deakins); the concept is not, though, identical because one of the marks also indicates that such a person goes by the forename NICHOLAS. The net effect of all this

is that there is neither a high nor low degree of overall similarity, the degree falling midway between the two extremes.

13. He found that the marks were distinctively similar on the following basis:

16) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In terms of the earlier mark's inherent qualities then, as a whole (with its device element borne in mind), it is, at the least, reasonably distinctive. I would make this finding even if the device were not there as although names are often used in trade then, as indicated earlier, DEAKINS does not strike me as a particularly common surname, so the name as a whole has at least a reasonable degree of distinctive character... .

14. His conclusion with regard to the objection under Section 5(2)(b) was as follows:

17) That then leads to whether the factors I have assessed combine to create a likelihood of confusion. The factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and a global assessment of them must be made when determining the matter (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion may be direct i.e. confusing one trade mark for the other or, alternatively, indirect, whereby the average consumer considers that the goods marketed under the respective trademarks emanate from the same or an economically linked undertaking. In my view, the identity of the goods, together with the reasonable degree of distinctiveness of the earlier mark means that the degree of similarity between the marks is enough for confusion to be likely. Whilst the degree of similarity is only at a mid-level, it is enough, particularly given that the surname DEAKINS is not, in my experience, a common one, for confusion to

arise. The consumer will assume that the DEAKIN/DEAKINS in question is a reference to the same person or company, even though the forename is not specified in the applied for mark. The differences between DEAKIN and DEAKINS is something that is likely to be lost through imperfect recollection. I have borne in mind the whole mark comparison and that, in addition to the words, the earlier mark has a device, but I do not consider the difference this creates to be such to avoid a likelihood of confusion, particularly indirect confusion as described earlier. **My finding is that there is a likelihood of confusion. The opposition to the registration of Mr. Deakin's mark is upheld.** It should be noted that the finding of goods identity was based on the principle set out in *Gerard Meric* but that, potentially, non-identical goods may also be included in the applied for specifications. However, Mr. Deakin has put forward no fall-back specification and, given his evidence, the likely use of the mark would fall squarely within what the earlier mark is registered for. In such circumstances, it is not appropriate to countenance revised specifications.

15. I pause at this point to observe that the Hearing Officer made no reference in his Decision to the earlier trade mark being registered in colour with a colour scheme in which the device element and the word element were presented in a single accent colour (gold Pantone 17-1047tc) on a black rectangle.

16. The Hearing Officer mentioned, but did not address, NDL's objection to registration under Section 5(3). There is no appeal in respect of that. I was informed at the hearing of the appeal that the objection had been dropped: Transcript, p.57 line 18 to p.58 line 5.

17. The question for determination under Section 5(4)(a) was whether use of the mark **DEAKIN** for the purpose of distinguishing '*footwear and clothing*' supplied by JD from footwear and clothing provided by other suppliers of such goods was liable to be

prevented at the date of the application for registration of trade mark 2489547 (9 June 2008) by enforcement of rights which NDL could then have asserted against JD in accordance with the law of passing off. NDL claimed to have acquired such rights through use of the names **NICHOLAS DEAKINS** (since 1991) and **DEAKINS** (since 2000) as trade marks for clothing, footwear and headgear.

18. The Hearing Officer upheld the objection on the basis of the following assessment:

36) In terms of NDL's opposition to Mr. Deakin's application (2489547) to register DEAKIN as a trade mark then the material date is 9 June 2008. It is necessary to consider the factual position at this date (and earlier) in terms of what use the respective parties had made of the mark (the subject of Mr. Deakin's application) and of the signs relied upon by NDL. In terms of NDL's use, the evidence of Mr. Craig Nicholas Tate, NDL's managing director, is relevant. It is abundantly clear that the sign NICHOLAS DEAKINS has been used as the primary name associated with NDL's business. This much is not really in dispute. In terms of the use of DEAKINS alone, Mr. Tate provides separate turnover figures for goods sold under both the NICHOLAS DEAKINS and DEAKINS signs. In the four years prior to the material date the use had risen from around £1/2 million to around £1 million per annum in respect of DEAKINS alone. He provides a number of exhibits which show use of the mark DEAKINS used on its own including articles/advertisements in magazines and product photographs. Much of this is criticized because it is not clearly from before the material date. However, whilst I agree that it could have been clearer, on the basis of what has been filed (including use in magazines in 2003 & 2006), together with Mr. Tate's narrative and turnover figures, I am prepared to accept that as of the material date NDL's goodwill was associated with DEAKINS alone and not just NICHOLAS DEAKINS, at least in relation to footwear.

37) I also need to consider whether Mr. Deakin was either the senior user or a concurrent user of the mark he seeks to register. Mr. Deakin has provided a large amount of evidence about his activities. However, for it to be relevant I need to be satisfied that the mark (DEAKIN) sought for registration

has been used in relation to the goods sought to be registered (footwear and clothing). The evidence of Mr. Deakin establishes that he is a footwear designer. His name has been associated as the designer of a number of footwear products. However, such use primarily indicates him as the designer but with the origin identifying sign for the actual goods being different; there is certainly no evidence of a product sold under DEAKIN solus. The only real use of DEAKIN solus is in the context of articles written about him or the products he has designed which sometimes abbreviate Justin Deakin's name to Deakin, but normally after already having referred to him as Justin Deakin. I do not consider that such use assists Mr. Deakin in the confines of the decision before me. It does not show that he was a senior or concurrent user of DEAKIN solus in relation to footwear and clothing products.

38) In view of this, it seems to me to be a fairly inevitable conclusion that NDL would, therefore, succeed under this ground in opposing Mr. Deakin's DEAKIN application as a misrepresentation (and subsequent damage) between DEAKINS and DEAKIN is very likely, even for clothing products other than footwear. NDL would, therefore, also have succeed under section 5(4)(a). As NDL also has a protectable goodwill in relation to NICHOLAS DEAKINS then, by parity of reasoning with my decision under section 5(2)(b), misrepresentation (and subsequent damage) will also have occurred; I make this finding because this puts NDL in a slightly stronger position on account that there is no device mark to bear in mind in terms of the earlier sign being relied upon.

19. It was acknowledged in the Grounds of Appeal filed on behalf of JD that '*Neither party to the proceedings submitted any evidence to suggest that the name DEAKINS or DEAKIN was either common or not*': paragraph 7. Even so, it was contended that: '*The Hearing Officer erred when making a finding in paragraph 10, page 9 of the decision that the surname DEAKINS is not a common surname*': paragraph 6; and it was further maintained '*that DEAKIN or DEAKINS is a common surname in that it is an immediately identifiable surname and one would expect there to be several different persons of such a surname. Furthermore it is not an unusual or peculiar sounding name.*': paragraph 8.

20. The Hearing Officer considered the marks in issue to be distinctively similar for the purposes of the objection to registration under Section 5(2)(b) on the basis stated in paragraph [16] of his decision: see paragraph [13] above. It was open to him to approach the determination of the objection from the perspective that the earlier registered trade mark was in part composed of a name (i.e. NICHOLAS DEAKINS) which possessed ‘*at least a reasonable degree of distinctive character*’ since ‘*DEAKINS does not strike me as a particularly common surname.*’

21. It is quite unusual to find an applicant (in this case JD) contending that the mark he is seeking to register (in this case **DEAKIN**) is either not distinctive or not as distinctive as the Registrar considers it to be. This aspect of JD’s case is best understood on the basis that the argument he wished to advance on appeal under Section 5(2)(b) was essentially an argument to the effect that there was insufficient similarity between **DEAKIN** and the earlier mark graphically represented in paragraph [8] above to support the Hearing Officer’s finding of conflict under that section of the Act.

22. The Hearing Officer directed himself as to the law by reference to Becker v. Harman International Industries Inc. C-51/09P, EU:C:2010:368, where the CJEU emphasised at paragraph [38]:

Furthermore, it must be held that, in a composite mark, a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case.

In paragraph [39] the Court rejected the suggestion that a mark consisting of a surname would always or necessarily be conceptually similar to a mark composed of a first name plus that surname from the viewpoint of the relevant average consumer. The Hearing Officer rightly observed that the Judgment of the CJEU in Becker does not establish ‘*a rule that surnames cannot cause confusion with full names (or vice versa)*’: paragraph [12]. However, that did not dispose of the question whether the differences outweighed the similarities between the marks in issue on a proper appreciation of the fact that, in the earlier mark, **DEAKINS** is presented as an integral part of the full name **NICHOLAS DEAKINS**, with the full name **NICHOLAS DEAKINS** being presented in gold alongside the device of a rose presented in the same colour on a black rectangle so as to form a single composite trade mark registered in gold-and-black.

23. The Hearing Officer viewed the earlier trade mark as a collocation of two independent word and device elements on the basis stated in paragraph [10] of his Decision (with emphasis added):

In terms of NDL’s mark, this consists of the words NICHOLAS DEAKINS (in title case) and a flower device. Both the word element and the device element make a roughly equal contribution to the overall impression of the mark, contributions that are independent from each other. The Nicholas Deakins element is dominated more by Deakins than by Nicholas.

This went to the heart of his reliance on the concept that an element of a composite mark may retain an independent distinctive role. However, it is not apparent either from paragraph [10] or from his Decision as a whole that he fully and correctly applied the law relating to that concept in the context of the present objection to registration.

24. It is not correct to proceed on the basis that an element of a composite mark retains an independent distinctive role if, together with the other component or components of the mark, it *'forms a unit having a different meaning as compared with the meaning of those components taken separately'*: Bimbo SA v. OHIM C-591/12P, EU:C:2014:305 at paragraph [25]. And even if a component of a composite mark is found to be sufficiently 'unitary' to retain an independent distinctive role, it still remains necessary for any assessment of '*similarity*' to be made by reference to the composite mark as a whole in the manner summarised in Bimbo SA at paragraphs [34] and [35]:

[34] Indeed, as the Advocate General observed in points 25 and 26 of his Opinion, it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.

[35] The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.

25. In accordance with that approach, the present opposition had to be determined on the basis that: (i) the word element (NICHOLAS DEAKINS); (ii) the device element (a

figurative representation of a rose); and (iii) the specified colour scheme (gold for the presentation of the word element and the device element, with black for the presentation of the rectangle); each contributed to the overall impression created by NDL's earlier registered trade mark. It was not disputed that the word element and the device element contributed distinctively to the overall impression created by the composite mark. And those elements could not fail to contribute jointly (with each other and with the colour scheme in which they were presented) to the distinctive character of the composite mark if, as the Hearing Officer determined, the contribution to overall impression made by the word element (presented in gold) was roughly equal to that made by the device element (presented in gold). That being so, the words **NICHOLAS** and/or **DEAKINS** could not be found to have retained an independent distinctive role without first evaluating whether the meaning and significance the relevant average consumer would attach to them in the context of the earlier registered trade mark as a whole, would be unaffected by the device element and the colour scheme. The same goes for the device element relative to the word element and the colour scheme. And even then there could be no escape from the overarching requirement for '*similarity*' to be assessed by reference to the gold-and-black composite mark as a whole.

26. I cannot see from the Hearing Officer's statement of reasons for his decision under Rule 69 of the Trade Marks Rules 2008 that he made the required determination in accordance with the required approach to the assessment of '*similarity*' between the marks in issue. It appears to me that he overlooked or ignored the colour scheme of the earlier registered trade mark and, having sub-divided it into the two elements which he expressly treated as '*independent from each other*'; he proceeded with an evaluation of

'similarity' in which the gold-and-black mark was effectively re-configured for the purposes of comparison as consisting of **NICHOLAS** and/or **DEAKINS** with insignificant additions. I consider that the Hearing Officer's approach to refusal of registration under Section 5(2)(b) on the basis of earlier registered trade mark number 2396693 was flawed and should be set aside. However, that is not sufficient to enable me to allow the Appeal in Opposition 9823 as I shall now go on to explain.

27. Having reviewed the evidence on file, I am satisfied that the Hearing Officer was entitled to come to the conclusion he did in relation to the objection to registration under Section 5(4)(a). Uncontroverted evidence of use of the mark **DEAKINS** was provided by Mr. Tate (NDL's Managing Director). It was suggested on behalf of JD at the hearing of the Appeal that this should be regarded as evidence of nothing more than unsubstantiated belief. That was an untenable position to adopt in circumstances where Mr. Tate's evidence on that point had been accepted by JD without cross-examination and without tendering any evidence to the contrary. I therefore consider that the Hearing Officer's refusal of registration under Section 5(4)(a) on the basis of the rights which NDL was entitled to assert against JD by virtue of the law of passing off should be upheld.

28. It was further contended in the Grounds of Appeal filed on behalf of JD that his application for registration under number 2489547 should have been allowed to proceed under Section 5(5) of the 1994 Act, which provides that: *'Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration'*. JD claimed to have received consent sufficient for the purposes of Section 5(5) as an integral part of the Agreement for Dissolution of Partnership he had entered into with Mr. Tate in 1993 (this was referred to as the 'Deed of

Dissolution’ in support of NDL’s objection to registration under Section 3(6): see paragraphs [6] and [7] above). The Hearing Officer was criticised for not dealing with the point. It was said that: *‘Whilst the Section 5(5) defence may be badly pleaded we submit that it is nevertheless pleaded’*.

29. Clauses 1 and 2 of the Agreement for Dissolution of Partnership stated (with ‘Mr. Tate’ referring to Craig Tate and ‘Mr. Deakin’ referring to Justin Deakin):

1. Dissolution

The said Partnership is dissolved.

2. Mr. Tate will carry on in business under the style and firm name of Nicholas Deakins (“the firm name”) and Mr. Deakin acknowledges that he has no rights to use the firm name and he covenants with Mr. Tate not to use any name for his own business which is the same or might be confused with the firm name whether visually, audibly or in some other manner. Notwithstanding the above Mr. Deakin is free to use his own name in any business of [which] he is a part.

The last sentence of Clause 2 is said to have provided JD with authorisation to register *‘his own name’* as a trade mark without objection from Mr. Tate or anyone claiming through or under Mr. Tate.

30. No claim to the effect that Clause 2 of the 1993 Agreement provided contractual consent to registration for the purposes of Section 5(5) was asserted in any pleadings, evidence or skeleton argument put forward by or on behalf of JD in the Registry proceedings. There was a glancing reference to the point in oral submissions at the hearing on 12 October 2011: Transcript, p. 37. The Hearing Officer cannot properly be criticised for not dealing with it. The failure to raise it fairly and squarely for

determination in the Registry proceedings is sufficient to prevent it from being raised for the first time on appeal. The point is in any event untenable. Permission to use a personal name in personal circumstances of the kind envisaged by Clause 2 of that Agreement does not carry with it either a right to register the name as a trade mark (and thereby turn it into a free-standing, transmissible item of property) or a right to use it in a context or manner liable to deceive or mislead the public as to the provenance of any goods or services. For all of these reasons I reject the claim for consent under Section 5(5). I do so without pausing to consider the position of NDL as compared with the position of Mr. Tate relative to the implementation and operation of the Agreement made between Mr. Tate and JD in 1993 or whether JD's surname (alone) could be regarded as 'his own name' for the purposes of Clause 2 of that Agreement.

Opposition 98759 to Trade Mark Application 2501575

31. On 3 November 2008 NDL applied under number 2501575 to register **DEAKINS** as a trade mark for use in relation to the following goods and services:

Class 18: Leather and imitations of leather and goods made of these materials (not included in other classes); bags; trunks and travelling bags; vanity cases; holdalls, back packs and rucksacks; wallets, key cases, purses and pouches; credit card cases, tote bags, bottle bags, record bags, book bags; handbags; sports bags; shopping bags; luggage and suitcases, weekend bags; jewellery rolls; attaché cases and briefcases; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods.

Class 25: Clothing, footwear and headgear.

Class 35: Retail services connected with the sale of leather and imitations of leather and goods made of these materials (not included in other classes), bags, trunks and travelling bags, vanity cases, holdalls, back packs and rucksacks,

wallets, key cases, purses and pouches, credit card cases, tote bags, bottle bags, record bags, book bags, handbags, sports bags, shopping bags, luggage and suitcases, weekend bags, jewellery rolls, attaché cases and briefcases, umbrellas, parasols and walking sticks, clothing, footwear and headgear; advertising services; information relating to all these services.

The application for registration was opposed by JD in opposition proceedings commenced under reference number 98759 on 13 February 2009. Objections to registration were raised under Sections 3(6), 5(2)(b) and 5(4)(a) of the 1994 Act and maintained at the hearing which subsequently took place on 12 October 2011.

32. The question raised for determination under Section 3(6) was whether the application for registration had been made in bad faith on the basis put forward in paragraph 11 of JD's Grounds of Opposition:

11. I further submit that UK Trade Mark Application No. 2501575 DEAKINS should be denied registration by virtue of Section 3(6), because the mark was filed in bad faith since both its use and registration are an attempt by the Applicant to move away from the mark NICHOLAS DEAKINS and progressively use a mark which is similar to my name DEAKIN, for the purposes of taking advantage of my reputation as a designer of footwear. As stated in the deed of dissolution, paragraph 2, last sentence, I was free to use my own name in any business of which I am a part. While I acknowledge that I have no right to use the firm name NICHOLAS DEAKINS it is an obvious implied term of the contract between the parties that Mr. Tate or his successors in title should not amend the firm name in a manner to make it more similar to my own name, in addition or in the alternative, the progressive abbreviation of the name NICHOLAS DEAKINS to simply DEAKINS, knowing of the fashion industry, falls below the expected conduct in our industry. In the fashion

industry it is common for goods to be associated or otherwise marked with the designer's name and it is inappropriate conduct to amend, adjust or abbreviate a trade mark such as to make it progressively similar to my own name. It is apparent that the firm name NICHOLAS DEAKINS consists of joining Mr. Tate's christian name with my surname and it is therefore evidence that by removing Mr. Tate's christian name you are left solely with my surname. In my agreement not to use the firm name NICHOLAS DEAKINS it must be logically implied that Nicholas Deakins would not amend its trade mark to simply my name which he agree I was allowed to use. Registration of the mark applied for would prevent the terms of the agreement, namely, my right to use my own name.

33. The Hearing Officer decided in paragraph [40] of his Decision not to determine that question in relation to any of the goods or services identified in paragraphs [36] and [37] below. That was a case management decision within the scope of Rule 62 of the 2008 Rules. Although it would appear to have been made without giving the parties an opportunity to be heard in relation to it under Rule 63, his decision to that effect has not been challenged by either party on appeal. In relation to the remainder of the goods and services for which registration had been requested, he rejected the objection to registration on the following basis:

41) In respect of section 3(6) of the Act, Mr. Deakin's claim is that NDL is attempting to move away from its name of NICHOLAS DEAKINS in order to progressively use a mark similar to those of Mr. Deakin so as to benefit from Mr. Deakin's reputation as a shoe designer. As stated earlier, both parties have filed evidence relating to the relationship that existed between Mr. Deakin and NDL's predecessor. Whilst it has all been borne in mind, I do not consider it necessary to undertake a detailed analysis of such evidence. This is for two reasons; firstly, there is no strong evidence pointing to the alleged intention of NDL, but, more

importantly, in relation to the residue of the goods and services under consideration, none of which relate to shoes or the design of shoes, then it is difficult to see how the filing of the mark for such goods would take advantage of a claimed reputation of a shoe designer. **The claim under section 3(6) is dismissed.**”

34. So far as material for the purposes of the present appeal, JD’s objection under Section 5(2)(b) was based on the rights to which he was entitled as proprietor of earlier trade mark 2443925:

JUSTIN
DEAKIN

Filed: 18 January 2007

Registered: 27 July 2007

Class 25: Clothing, footwear, headgear.

35. The question raised by the objection was basically the same (but as between this earlier trade mark and the mark **DEAKINS**) as that raised under Section 5(2)(b) (as between earlier trade mark 2396693 and the mark **DEAKIN**) in Opposition 98234: see paragraphs [10] and [11] above.

36. The Hearing Officer concluded in paragraph [19] of his Decision that the objection should be upheld in relation to the application for registration for '*clothing, footwear and headgear*' in Class 25:

... the goods are self-evidently identical ... the marks have a slightly above mid-level point of similarity. There is slightly more similarity here than in the first opposition because the earlier mark relied upon does not have a device element and, also, DEAKIN is given slightly greater prominence than the word JUSTIN, so, the respective marks in this opposition have a higher degree of similarity to each other than those in the previous opposition. That being said, it is still not of a high degree of similarity ... Weighing all these factors, then, again, and for similar reasons expressed earlier, there is also a likelihood of confusion in relation to this application at least in terms of class 25.

37. He also upheld the objection in relation to the following goods and services (but allowed the application to proceed for the remainder of the goods and services specified by NDL in Classes 18 and 35):

Class 18: [Leather and imitations of leather and] goods made of these materials (not included in other classes); bags; purses; handbags

Class 35: Retail services connected with the same of clothing, footwear and headgear; information relating to all these services.

38. His reasons for doing so were as follows:

21) The question arises as to whether the above goods/services are similar to the class 25 goods (clothing, footwear & headgear) of earlier mark 2443925 and whether such similarity, when the degree of similarity between the marks as assessed above is also borne in mind, results in there being a likelihood of confusion. It is noted that the GC has identified a complementary relationship between clothing on

the one hand and, on the other, those goods in class 18 which could be characterised as fashion accessories and with services in class 35 for the retailing of clothing (see *El Corte Inglés SA v. OHIM* Case T-443/05 and *Oakley, Inc v. OHIM* Case T-116/06, respectively). Such findings, for obvious reasons, do not result in an identical or highly similar relationship but, nonetheless, there is certainly more than a low degree of similarity. Having considered such degree of similarity together with the various other factors before me, I extend my finding of there existing a likelihood of confusion to such goods and services. I believe, again, that the similarities between the marks and the goods/services will be put down to there being an economic connection between the responsible undertakings. ...

22) I have only considered it appropriate to uphold the opposition for a limited range of goods in class 18 for which there seems to me to be a self-evident capacity for such goods to be characterized as fashion accessories likely to be co-ordinated with clothing. For the remaining goods, there is no such self-evident link, and no evidence has been filed to demonstrate one. **The opposition to the registration of NDL's mark is upheld to the extent identified above.**

39. The question for determination under Section 5(4)(a) was whether use of the mark **DEAKINS** for the purpose of distinguishing NDL's goods and services of the kind specified from those of other suppliers of such goods and services was liable to be prevented at the date of the application for registration of trade mark number 2501575 (3 November 2008) by enforcement of rights which JD could then have asserted against NDL in accordance with the law of passing off. JD claimed to have acquired such rights through use of the names **DEAKIN** and **JUSTIN DEAKIN** as trade marks for clothing, footwear and headgear since 1997.

40. The Hearing Officer decided in paragraph [30] of his Decision to confine his consideration of that question to the goods and services in Classes 18 and 35 with respect to which JD's objection to registration under Section 5(2)(b) had failed. That was a case

management decision within the scope of Rule 62 of the 2008 Rules. Although it would appear to have been made without giving the parties an opportunity to be heard in relation to it under Rule 63, his decision to that effect has not been challenged by either party on appeal. He proceeded by carrying forward the findings he had made in paragraphs [36] to [38] of his Decision (these are set out in paragraph [18] above). On that basis he concluded that JD's objection under Section 5(4)(a) should be rejected in relation to all of the goods and services for which his objection under Section 5(2)(b) had failed:

39) Taking the above findings forward, and by parity of reasoning, it seems to me that Mr Deakin would not have succeeded under section 5(4)(a) in his opposition to NDL's DEAKINS mark to the extent that he relied upon the use of DEAKIN alone given that any goodwill he had would have been associated with the full name JUSTIN DEAKIN; there is no need to consider the position on the basis of JUSTIN DEAKIN under section 5(4)(a) as this places him in no stronger position than he was in under section 5(2)(b). This means that the goods/services unsuccessfully opposed by Mr Deakin remain unsuccessfully opposition.

41. In the Notice and Grounds of Appeal filed on behalf of JD it was contended that his objection to registration under Section 3(6) ought to have succeeded in relation to all of the goods and services in Classes 18 and 35 with respect to which his objections to registration under Sections 5(2)(b) and 5(4)(a) had failed. It was not so far as I can see contended in the Grounds of Appeal relating to Opposition 98759 that the Hearing Officer had wrongly rejected either of the latter objections to Trade Mark Application 2501575.

42. The Appeal in Opposition 98759 proceeded within those parameters on the following basis:

23.

The Appellant submits that use of the mark **DEAKINS** in respect of the remaining goods would still be in bad faith because the progressive abbreviation of the mark **NICHOLAS DEAKINS** to simply **DEAKINS** is an attempt to trade on the Appellant's name and reputation as a designer. No response has been made to explain the progressive abbreviation of the name **NICHOLAS DEAKINS** to simply **DEAKINS** by Nicholas Deakins Ltd. Taking into account that the element **DEAKINS** in the original trade mark is a direct reference to the Appellant we submit the onus is on Nicholas Deakins Ltd to explain the progressive removal of Mr. Tate's Name in favour of his former partner's name.

24.

The Hearing Officer concludes in paragraph 41, that the Section 3(6) claim is dismissed as regards the residue of the specification because that residue i) does not relate to shoes or the design of shoes and it is therefore difficult to see how the filing of the mark **DEAKINS** for such goods would ii) take advantage of the claimed reputation of a shoe designer.

25.

Bad faith does not require that the Appellant "*take advantage of*" a reputation. The Appellant submits that is not the proper test and the test to bad faith applies regardless of the similarity of goods. The provisions of Section 3(6) do not relate to relative grounds. It is sufficient that the mark was chosen in bad faith, even if the use of the applied for mark is intended to be in respect to totally dissimilar goods.

26.

The reason why there is no strong evidence pointing to the alleged intention of Nicholas Deakins Ltd when abbreviating its trade mark from **NICHOLAS DEAKINS** to simply **DEAKINS**, is because they have failed to address the issue and their Witness Statements have remained completely silent despite the clear accusation that in abbreviating their name they have increasingly traded on the Appellant's reputation as a designer.

43. The basic proposition is that the right to apply for registration of a trade mark cannot validly be exercised in bad faith. The invalidity of the application is not conditional upon the trade mark itself being either registrable or unregistrable in relation

to any goods or services of the kind specified. The objection is absolute in the sense that it is intended to prevent abusive use of the system for acquiring title to a trade mark by registration. Any natural or legal person with the capacity to sue and be sued may pursue an objection on this ground: see the Judgment of the CJEU in *Lancôme parfums et beauté Cie SNC v. OHIM* C-408/08P, EU:C:2010:92 at paragraph [39] and paragraphs [63] and [64] of the Opinion of Advocate General Ruiz-Jarabo Colomer at EU:C:2009:634; and the Judgment of the CJEU in Donaldson Filtration Deutschland GmbH v Ultra Air GmbH C-450/13P, EU:C:2014:2016.

44. Any attempt to establish bad faith must allow for the fact that there is nothing intrinsically wrong in a person exercising *'the right to apply the rules of substantive and procedural law in the way that is most to his advantage without laying himself open to an accusation of abuse of rights'* as noted in paragraph [121] of the Opinion delivered by Advocate General Trstenjak in Budejovicky Budvar NP v. Anheuser-Busch Inc. C-482/09, EU:C:2011:46.

45. In paragraph [189] of his judgment at first instance in Hotel Cipriani SRL v Cipriani (Grosvenor Street) Ltd [2009] EWHC 3032 (Ch); [2009] R.P.C. 9 Arnold J. emphasised:

... that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their

position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the basis discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Art.107 can hardly be said to be abusing the Community trade mark system.

46. These observations were not called into question in the judgment of the Court of Appeal in that case: [2010] EWCA Civ 100. They were re-affirmed by Arnold J. in Och-Ziff Management Europe Ltd v. OCH Capital LLP [2010] EWHC 2599 (Ch) at paragraph [37] and they accord with the approach endorsed by the CJEU in Malaysia Dairy Industries Pte Ltd v. Ankenaevnet for Patenter og Varemaerkte C-320/12, EU:C:2013:435 at paragraphs [36] and [37] to the effect that the filing of an application for registration of a sign which the applicant knew or should have known was identical or similar to a sign used by a third party for an identical or similar product is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith.

47. The line which separates legitimate self-interest from bad faith can only be crossed if the applicant has sought to acquire rights of control over the use of the sign graphically represented in his application for registration in an improper manner or for an improper purpose. The appropriate remedy will in that case be rejection of the offending application for registration to the extent necessary to render it ineffective for the purpose which made it objectionable in the first place.

48. In a case such as the present, where the relevant application fulfils the requirements for obtaining a filing date, the key questions are : (1) what, in concrete terms, is the objective that the applicant has been accused of pursuing? (2) is that an objective for the purposes of which the application could not properly be filed? (3) is it established that the application was filed in pursuit of that objective? The first question serves to ensure procedural fairness and clarity of analysis. The second question requires the decision taker to apply a moral standard which, in the absence of any direct ruling on the point from the Court of Justice, is taken to condemn not only dishonesty but 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'*: Gromax Plastics Ltd v. Don & Low Nonwovens Ltd [1999] RPC 367 at 379 (Lindsay J.). The third question requires the decision taker to give effect to the principle that innocence must be presumed in the absence of evidence sufficient to show that the applicant has acted improperly as alleged.

49. The objective that NDL was accused of pursuing was progressive abbreviation on **NICHOLAS DEAKINS** to **DEAKINS** in an attempt to trade on JD's name and reputation as a designer. Its application for registration was said to have been improper for having been filed with a view to acquiring rights of control over use of the mark **DEAKINS** in furtherance of that objective in relation to goods and services of the kind which remain in issue. If that were the case, the application for registration would have been filed for an improper purpose. However, the Hearing Officer was not prepared to accept that the application had been improperly filed because he was not prepared to

accept that use of the mark **DEAKINS** for such goods and services *'would take advantage of the claimed reputation of a shoe designer'* as JD had alleged.

50. JD maintains that NDL's application for registration could be found to have been made in bad faith even if use of the mark **DEAKINS** for goods and services of the kind in issue would not 'take advantage' of his reputation as a designer. Whilst that may be true in the abstract, it is nothing to the point in circumstances where taking advantage of JD's reputation as a designer has at all stages of the proceedings been specifically identified as the unacceptable behaviour improperly encompassed by NDL's application. The Hearing Officer's refusal to accept that the allegation of bad faith was well-founded is, as matters now stand, buttressed by the following considerations: the rejection of JD's objection under Section 5(2)(b) in relation to the goods and services which remain in issue; the absence of any objection by JD under Section 5(3) in relation to those goods and services; the rejection of JD's objection under Section 5(4)(a) in relation to those goods and services; and the unsuccessfully appealed finding under Section 5(4)(a) in Opposition 98234 that NDL had, before June 2008, built up and acquired a goodwill and reputation under the names **DEAKINS** and **NICHOLAS DEAKINS** which entitled it to prevent JD from using the name **DEAKIN** as a trade mark for *'footwear and clothing'* in Class 25 on the basis of passing off.

51. These matters tend to confirm the legitimacy of NDL applying to register **DEAKINS** as a trade mark for use in relation to goods and services of the kind which remain in issue. There is no substance in the suggestion made on behalf of JD to the effect that NDL should be condemned for remaining *'completely silent despite the clear accusation that in abbreviating their name they have increasingly traded on the*

Appellant's reputation as a designer'. Failing to prove a negative (i.e. that NDL's application was not filed in bad faith) does not prove a positive (i.e. that NDL's application was filed in bad faith). The simple position is that the evidence on file in the Registry proceedings was not sufficient to substantiate, directly or by inference, the allegation that NDL had acted in bad faith. And that was all the more so in circumstances where no attempt was made either to cross-examine Mr. Tate on the contents of his witness statements or to controvert the evidence he had given with regard to use of the names **DEAKINS** and **NICHOLAS DEAKINS** by NDL. For the reasons I have given, I consider that there is no basis upon which this Tribunal could properly interfere with the Hearing Officer's rejection of JD's objection to registration under Section 3(6).

Opposition 100434 to Trade Mark Application 2534122

52. On 11 December 2009 JD applied under number 2534122 to register the following trade mark:

MASTER
DEAKIN
SON OF MR. DEAKIN

Filed: 11 December 2009

Class 25: Clothing, Footwear & Headgear

The application for registration was opposed by NDL in opposition proceedings commenced under reference number 100434 on 21 April 2010. Objections to registration were raised under Sections 3(6), 5(2)(b) and 5(4)(a) of the 1994 Act and maintained at the hearing which subsequently took place on 12 October 2011.

53. The question for determination under Section 3(6) was whether the application for registration had been made in bad faith on the basis pleaded in paragraphs 5.1 to 5.4 of NDL's Grounds of Opposition (which repeated paragraphs 5.1 to 5.4 of its Grounds of Opposition in Opposition 98234: see paragraph [6] above).

54. The Hearing Officer decided not to determine that question: paragraph [40]. That was a case management decision within the scope of Rule 62 of the 2008 Rules. Although it would appear to have been made without giving the parties an opportunity to be heard in relation to it under Rule 63, his decision to that effect has not been challenged by either party on appeal.

55. NDL's objection under Section 5(2)(b) was based on the rights to which it was entitled as proprietor of each of the following earlier trade marks:

- (i) trade mark 2396693 (the details of which are set out in paragraphs [8] and [9] above)
- (ii) trade mark 2501575 (the details of which are set out in paragraph [31] above)
- (iii) trade mark 2501576, the details of which are:

NICHOLAS DEAKINS

Filed: 3 November 2008

Registered: 13 March 2009

Class 18: Leather and imitations of leather and goods made of these materials (not included in other classes); bags; trunks and travelling bags; vanity cases; holdalls; back packs and rucksacks; wallets, key cases, purses and pouches; credit card cases, tote bags, bottle bags, record bags, book bags; handbags; sports bags; shopping bags; luggage and suitcases, weekend bags; jewellery rolls; attaché cases and briefcases; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods

Class 25: Clothing, footwear and headgear

Class 35: Retail services connected with the sale of leather and imitations and leather and goods made of these materials (not included in other classes), bags, trunks and travelling bags, vanity cases, holdalls, back packs and rucksacks, wallets, key cases, purses and pouches, credit card cases, tote bags, bottle bags, record bags, book bags, handbags, sports bags, shopping bags, luggage and suitcases, weekend bags, jewellery rolls, attaché cases and briefcases, umbrellas, parasols and walking sticks, clothing, footwear and headgear; advertising services; information relating to all these services.

56. The Hearing Officer decided in paragraph [23] of his Decision to '*consider the opposition firstly on the basis of earlier mark 2501576*' because '*Given my findings above, 2501575 can no longer be relied upon in respect of its class 25 goods, but it can be relied upon for certain of its goods and services in classes 18 and 25*' and also because '*2396693 need not be discussed further*' since '*2501576 is closer to the applied for*

mark'. His decision to proceed without determining the objection based on earlier trade mark 2396693 was a case management decision within the scope of Rule 62 of the 2008 Rules. Although it would appear to have been made without giving the parties an opportunity to be heard in relation to it under Rule 63, his decision to that effect has not been challenged by either party on appeal.

57. The question raised by the objection based on earlier trade mark 2501576 was basically the same (but as between the mark **NICHOLAS DEAKINS** and the mark shown in paragraph [52] above) as that raised under Section 5(2)(b) (as between earlier trade mark number 2396693 and the mark **DEAKIN**) in Opposition 98234: see paragraphs [10] and [11] above.

58. The Hearing Officer concluded that the objection should be upheld by parity of reasoning with his determinations in Opposition 98234 and Opposition 98759:

24) Again, both the specifications cover clothing, footwear and headgear and are, therefore, identical. The earlier mark, by parity of reasoning with my earlier decisions, is reasonably distinctive from an inherent perspective and the evidence filed does not enhance this (for the same reasons as per NICHOLAS DEAKINS and device).

25) The comparison is somewhat different from the other oppositions because the applied for mark is not DEAKIN/DEAKINS alone. However, in terms of the more dominant elements of the mark, then the mark NICHOLAS DEAKIN, by parity of reasoning with my earlier findings, will be dominated more by DEAKIN than by NICHOLAS. I consider the same to apply in relation to the applied for mark. This is particularly so given that the word DEAKIN is larger in size than the other words and, also, because the focus of the mark is on the name DEAKIN, i.e. the Master DEAKIN who is the some of Mr. DEAKIN.

26) In terms of the visual comparison, given the prominence of the word DEAKIN in the applied for mark, and its similarity to the DEAKINS element of NICHOLAS DEAKINS, there is certainly a degree of visual similarity. The differences, though, need to be borne in mind. I assessed the degree of similarity in the oppositions above to be midway (the first opposition) or slightly above midway (the second opposition) between low and high - it is fair to say that the degree here is slightly less than that assessed already but I still do not consider it to be of only a low degree. In terms of the concept, then, again, both marks are referring to a person called DEAKINS/DEAKIN, albeit one is specifically identified as having the forename Nicholas, whereas the other has the title of Master and is the son of another DEAKIN. Overall I consider the marks to be moderately similar.

27) The question is whether, as in the other oppositions, the factors combine to create a likelihood of confusion, in my view, and whilst the degree of similarity between the marks is slightly less than in the other oppositions, there is a likelihood of confusion. The name DEAKIN/DEAKINS not being a common surname means that the presence of it in the respective marks will lead the consumer to believe that the identical goods at issue are the responsibility of the same or an economically linked undertaking. The marks will likely be perceived as an off-shoot of each other but still originating from the same stable. **There is a likelihood of confusion. The opposition to the registration of Mr Deakin's mark is upheld.**

59. NDL's objection under Section 5(2)(b) on the basis of earlier trade mark 2501575 was rejected as a result of JD having succeeded in restricting the coverage of it in Opposition 98759: see paragraphs [36] and [37] above. The determination was:

28) Although the above findings results in the opposition being upheld, I will also give my view on the basis of earlier mark 2501575. As stated above, the opposition failed in respect of certain goods and services in class 18 and 35, but this was largely due to the lack of similarity with such goods to clothing goods. In view of this, and by parity of reasoning, the remaining goods of 2501575 cannot assist NDL in its

opposition. The position in respect of this earlier mark need not be addressed further.

There is no appeal against that determination.

60. The question for determination under Section 5(4)(a) was whether use of the mark shown in paragraph [52] above for the purpose of distinguishing ‘*clothing, footwear and headgear*’ supplied by JD from clothing, footwear and headgear provided by other suppliers of such goods was liable to be prevented at the date of the application for registration of trade mark 2534122 (11 December 2009) by enforcement of rights which NDL could then have asserted against JD in accordance with the law of passing off. As before, NDL claimed to have acquired such rights through use of the names **NICHOLAS DEAKINS** (since 1991) and **DEAKINS** (since 2000) as trade marks for clothing, footwear and headgear.

61. The Hearing Officer proceeded by carrying forward the findings he had made in paragraphs [36] to [38] of his Decision (these are set out in paragraph [18] above). On that basis he decided that NDL’s objection under Section 5(4)(a) should be upheld:

39) ... Furthermore, NDL would also have succeeded in its opposition to the MASTER DEAKIN SON OF MR DEAKIN mark for similar reasons to that expressed in paragraph 38 (which the conflict this time being between DEAKIN and a mark with DEAKIN as its most prominent element). I have borne in mind in this paragraph the later material dates, but the evidence does not paint a materially different picture.

62. In the Notice and Grounds of Appeal filed on his behalf, it was stated that JD ‘*further appeals Opposition No.100434 ... for the same reasons indicated above*’. These

were the reasons on the basis of which it was contended that, to the extent that it had been decided in favour of NDL, Opposition 98234 had been wrongly decided. At this point, I must observe that no attempt was made in the Grounds of Appeal or in JD's Skeleton Argument for the Appeal to explain how, if at all, those reasons might enable the Appeal in Opposition 100434 to succeed even if the Appeal in Opposition 98234 failed.

63. The Skeleton Argument for the Appeal purported to incorporate, by reference, the arguments put forward in JD's Skeleton Argument dated 10 October 2011 for the hearing in the Registry and also the arguments presented orally on his behalf as recorded in the Transcript of that hearing. Again, I can see no argument to the effect that Opposition 100434 should fail even if Opposition 98234 succeeded.

64. In the circumstances, it appears to me that JD's case as presented before the Hearing Officer and before me proceeds upon the premise that his Appeal in Opposition 100434 should stand or fall with his Appeal in Opposition 98234. How is that affected by my decision to set aside the Hearing Officer's determination under Section 5(2)(b) in Opposition 98234? I think it remains unaffected for the following reasons. In Opposition 98234, the Hearing Officer's determination in favour of NDL under Section 5(2)(b) was based only upon earlier trade mark 2396693 (which combines the name **NICHOLAS DEAKINS** with features material to the distinctive character of the mark as a whole that were, in my view, insufficiently considered for the purposes of that Opposition). In Opposition 100434, the Hearing Officer's determination in favour of NDL under Section 5(2)(b) was based only upon earlier trade mark 2501576 (which consists of the name **NICHOLAS DEAKINS** without the features of earlier trade mark 2396693 that were, in my view, insufficiently considered for the purposes of Opposition 98234). That,

combined with the fact that NDL's objections under Section 5(4)(a) succeeded in both Oppositions on the strength of the rights to which it was entitled through use of the names **NICHOLAS DEAKINS** and **DEAKINS**, leads me to conclude that nothing of any materiality to JD's 'stand or fall together' approach is added or subtracted by the outcome of the objection under Section 5(2)(b) in Opposition 98234.

65. I am therefore not convinced that it is open to me to proceed as if JD had abandoned or never adopted an 'all or nothing' approach to the two Oppositions at first instance and on appeal. And even if it is open to me to proceed on that basis, I would not be willing to interfere with the Hearing Officer's determination of the objection under Section 5(4)(a) in favour of NDL in Opposition 100434, which is buttressed by the unsuccessfully appealed finding under Section 5(4)(a) in Opposition 98234 that NDL had, before June 2008, built up and acquired a goodwill and reputation under the names **DEAKINS** and **NICHOLAS DEAKINS** which entitled it to prevent JD from using the name **DEAKIN** as a trade mark for '*footwear and clothing*' in Class 25 on the basis of passing off. I recognise that NDL's unregistered right to claim protection for the name **DEAKINS** provided it with a discernibly stronger platform upon which to object to JD's trade mark application 2534122 than its registered and unregistered rights to claim protection for the full name **NICHOLAS DEAKINS**. However, it does not necessarily follow that the differences between **NICHOLAS DEAKINS** and the mark shown in paragraph [52] above are sufficiently pronounced to avoid the existence of a likelihood of confusion. Was it open to the Hearing Officer to come to the conclusion he did in relation to the objection under Section 5(2)(b)? I am prepared to accept that it was. And the

claim to consent under Section 5(5) is no less unpleaded and untenable in relation to Opposition 100434 than it is in relation to Opposition 98234.

66. I do not overlook the fact that in Opposition 98759 JD succeeded in preventing NDL from registering **DEAKINS** as a trade mark for use in relation to '*clothing, footwear and headgear*' in Class 25. However, that was the result of a successful objection under Section 5(2)(b) on the basis of JD's earlier trade mark 2443925: see paragraphs [34] to [36] above. It was not the result of a successful objection under Section 5(4)(a): the Hearing Officer decided not to determine that objection in relation to NDL's application to register **DEAKINS** for '*clothing, footwear and headgear*' in Class 25 and there is no appeal in respect of his failure to do so; see paragraphs [39] to [41] above. So JD could not rely on the registration of his earlier trade mark 2443925 to defeat NDL's objection under Section 5(4)(a) in Opposition 100434: see the tailpiece to Section 2(2) of the 1994 Act and the seventh recital in the preamble to the Trade Marks Directive. He had no finding in his favour under Section 5(4)(a) in Opposition 98759 to set against NDL's objections under Section 5(4)(a) in Opposition 98234 or Opposition 100434. The unregistered rights which, on the evidence as it stood, were found to have been acquired by NDL through use of the names **DEAKINS** and **NICHOLAS DEAKINS** were therefore apt to provide it with the result for which it contended in Opposition 100434.

67. For all these reasons I consider that the Appeal in Opposition 100434 should, as with the Appeal in Opposition 98234, be dismissed.

Application 83950 for invalidity of Trade mark 2443925

68. JD was registered on 27 July 2007, with effect from 18 January 2007, as the proprietor of trade mark number 2443925 (the details of which are set out in paragraph [34] above). On 23 December 2010 NDL applied for a declaration to the effect that the trade mark was invalidly registered, citing objections to validity under Sections 5(2)(b) and 5(4)(a) of the 1994 Act. The application for invalidity was abandoned shortly before the hearing on 12 October 2011, at which it was listed to be heard along with the three oppositions I have considered above.

69. At the hearing on 12 October 2011 it was acknowledged on behalf of NDL and accepted by the Hearing Officer that the late abandonment of the claim for a declaration of invalidity should be reflected in the award of costs: Transcript, pp. 51, 52. There is, however, no reference to any of that in the paragraph of the Hearing Officer's Decision relating to costs:

43) In relation to costs, it is noted that NDL have won two oppositions but partially lost the other, and vice versa from Mr. Deakin's perspective. However, I bear in mind that the statements of case on all were broadly similar and that the proceedings were consolidated which will have kept the costs relating to evidence in check and that only one hearing took place. The measure of success/failure achieved by the parties is, therefore, roughly equal in relation to the primary battleground of class 25. However, I think it fair to reflect the fact that NDL's official fees were for filing two oppositions as opposed to one by Mr. Deakin (in effect, NDL receiving £400 for its official fees but balanced by Mr. Deakin's opposition fee of £200; so making an award of £200 in NDL's favour). I have borne in mind that the opposition launched by Mr. Deakin was not fully successful, but the evidence and submissions relating to the unsuccessfully opposed goods and services were limited, therefore, I do not consider it appropriate to make a specific

award for this. I therefore order Mr. Justin Deakin to pay Nicholas Deakins Limited the sum of £200. The above sum should 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.

70. NDL maintains that the costs of the claim for invalidity can and should be taken to have been factored into the Hearing Officer's observations relating to the contours and parameters of the opposition proceedings. I do not agree. The costs of the invalidity proceedings were clearly not addressed and there is no apparent reason or justification for the failure to do so. The omission was obvious and the right way of dealing with it was for JD's attorneys to write to the Hearing Officer asking him to issue an addendum to his Decision covering that aspect of the costs of the proceedings in the Registry. If that had been done (and so far as I am aware it was not) the minor procedural irregularity which had occurred would and should have been rectified at negligible cost to the parties. It is sufficient for me to resolve this matter by directing that an addendum to the Hearing Officer's Decision is to be issued by the Registrar with respect to the costs of invalidity application 83950 if and in the event that JD so requests in writing and on notice to NDL, with any such request to be made by no later than 4:00 pm on 21 October 2014.

Conclusion

71. For the reasons I have given:

- (1) the Appeal in Opposition 98234 is dismissed save as to the objection upheld under Section 5(2)(b) of the Trade Marks Act 1994 with respect to which the Hearing Officer's determination is set aside,

- (2) the Appeal in Opposition 98759 is dismissed;
- (3) the Appeal in Opposition 100434 is dismissed;
- (4) it is directed that an addendum to the Hearing Officer's Decision is to be issued by the Registrar with respect to the costs of invalidity application 83950 if and in the event that JD so requests in writing and on notice to NDL, with any such request to be made by no later than 4:00 pm on 21 October 2014.

72. JD has for the most part been unsuccessful on appeal. The limited extent to which he has succeeded is not, in my view, sufficient to relieve him of the requirement to make a payment by way of contribution to the costs incurred by NDL in defence of the Hearing Officer's Decision. Looking at matters in the round, I think that £850 is a fair and reasonable amount to award in that connection. That sum is to be paid by JD to NDL within 21 days of the date of this Decision. It is payable in addition to the sum of £200 awarded by the Hearing Officer in respect of the opposition proceedings in the Registry.

Geoffrey Hobbs QC

30 September 2014

Mr. Rowland Buehrlen of Beck Greener appeared on behalf of the Appellant.

Mr. Alan Fiddes of Urquhart-Dykes and Lord LLP appeared on behalf of the Respondent.

The Registrar did not take part in the proceedings on Appeal.

TRADE MARKS ACT 1994.

IN THE MATTER OF:

TRADE MARK APPLICATIONS 2489547 AND 2534122

IN THE NAME OF JUSTIN DEAKIN

AND OPPOSITIONS 98234 AND 100434 THERETO

IN THE NAME OF NICHOLAS DEAKINS LTD

AND:

TRADE MARK APPLICATION 2501575

IN THE NAME OF NICHOLAS DEAKINS LTD

AND OPPOSITION 98759 THERETO

IN THE NAME OF JUSTIN DEAKIN

AND:

REGISTERED TRADE MARK 2443925

IN THE NAME OF JUSTIN DEAKIN

AND INVALIDITY APPLICATION 83950

IN THE NAME OF NICHOLAS DEAKINS LTD

**ANNEX A TO DECISION DATED
30 SEPTEMBER 2014**



INVESTOR IN PEOPLE

NICHOLAS DEAKINS LTD
Solk House
69 Armley Road
Leeds
West Yorkshire
LS12 2EJ

**The Patent Office
Trade Marks Registry**

Cardiff Road, Newport
South Wales, NP10 8QQ
United Kingdom

Switchboard: +44(0)1633 814000
Minicom: 08459 222250
DX: 722542 Cleppa Park 3

Website: www.patent.gov.uk

Tel: +44(0)1633 811152
Fax: +44(0)1633 811037
O/Ref: 103996-1/New Apps/APOWE
Y/Ref:
Date: 24 May 2005

Please reply by 24 July 2005 quoting our reference.

Dear Sir or Madam,

Application for the Mark: NICHOLAS DEAKINS
In the name of: NICHOLAS DEAKINS LTD

I am writing to confirm that we received your application on 21 May 2005.

You have not satisfied the basic requirements for making an application, because you have failed to supply the information detailed in the paragraph(s) below.

Following a conversation this morning 24.05.05 with Mr Craig Tate and Mrs Phelps please confirm the correct applicant details for this TM3. It was supplied as Nicholas Deakins Ltd is this correct?.

You have stated in box 4 that your mark should be 'Black background, gold rose and gold text'. if this is the case then you must provide a coloured mark at the time of filing. Please provide this A.S.A.P.

If you do not reply by the above date, the application will be deemed never to have been filed.

If you have any queries about your application, please contact me as soon as possible.

Yours faithfully,

Anne Powell
Trade Marks New Applications Unit

Nicholas Deakins Ltd[®]



Anne Powell
(New Trade Mark Application Unit)
The Patent Office
Cardiff Road
Newport
South Wales
NP10 8QQ



Ref: CT/81
Y/Ref – 103996-1/New Apps/APOWE

11th July 2005

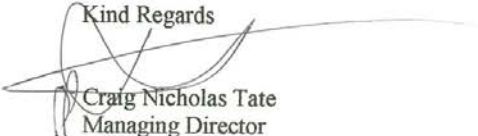
Dear Anne

Further to your correspondence dated 24th May 2005. I have enclosed the coloured mark as requested.

Should you require any further information I will be more than happy to oblige?

I thank you in advance and look forward to a now successful application.

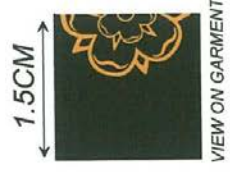
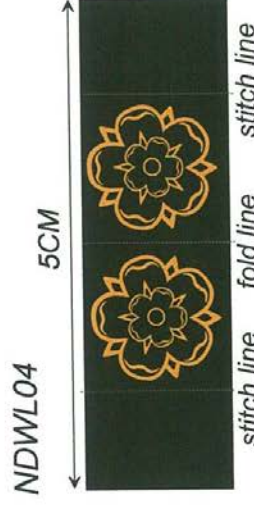
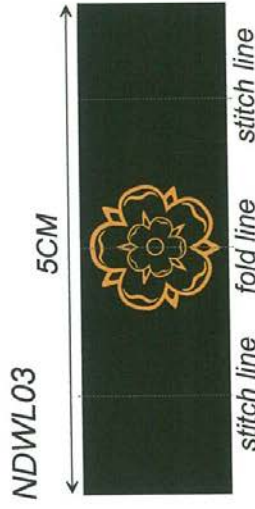
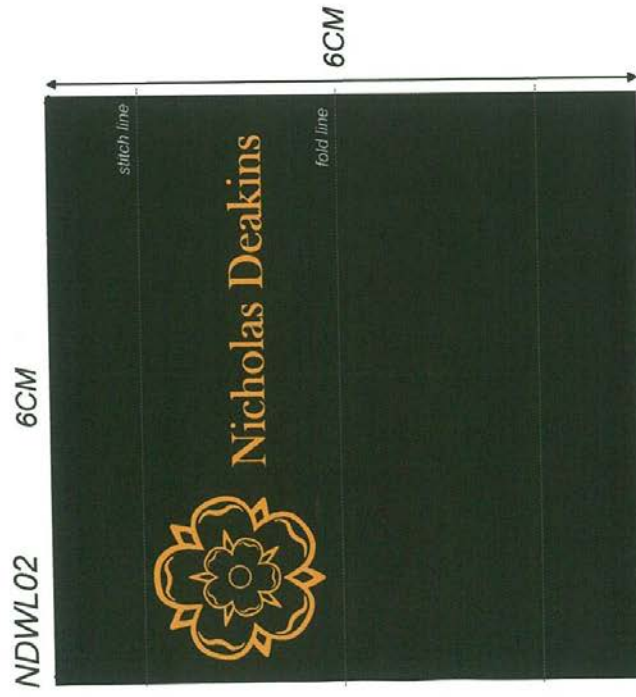
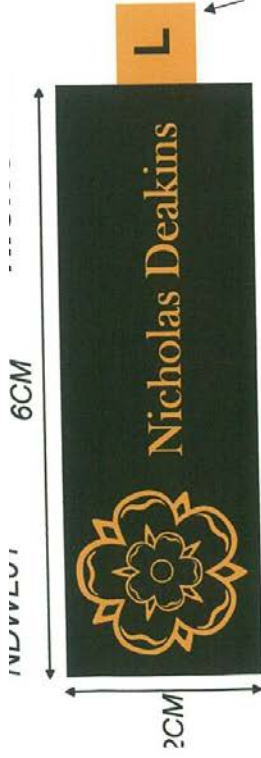
Kind Regards


Craig Nicholas Tate
Managing Director



Enc.

Registered Office
37 warren street
london W1P 5PD

Head Office
solk house 68 armley road
leeds LS12 2EJ
v.a.t. no. 526 0407 74
registration no. 320 1284
telephone 0113 244 6875
facsimile 0113 244 6873
email info@nicholasdeakins.com
www.nicholasdeakins.com



LABEL COLOURS

| | | | |
|-------------|--|----------------|---|
| BASE |  | ARTWORK |  |
| | BLACK | | GOLD |
| | | | palette 17-1047c |



INVESTOR IN PEOPLE

NICHOLAS DEAKINS LTD
Solk House
69 Armley Road
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**The Patent Office
Trade Marks Registry**

Cardiff Road, Newport
South Wales, NP10 8QQ
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Switchboard: +44(0)1633 814000
Minicom: 08459 222250
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Website: www.patent.gov.uk

Tel: +44(0)1633 811152
Fax: +44(0)1633 811037
O/Ref: 103996-1/New Apps/APOWE
Y/Ref:
Date: 14 July 2005

Please quote our reference when replying.

Dear Sir or Madam,

Application for the Mark: NICHOLAS DEAKINS
In the name of: NICHOLAS DEAKINS LTD

APPLICATION FOR A TRADE MARK - PROCEEDING TO EXAMINATION

I wrote to you on 24 May 2005 confirming receipt of your application form, and notifying you that certain other requirements would have to be met.

As you have now satisfied those requirements, the application will proceed to examination.

We will write to you as soon as the examination has been completed

Yours faithfully,

Anne Powell
Trade Marks New Applications Unit

TMER09

OPTICS - TRADE MARKS - USER: MCAN 23.08.2005 13.52.24

CASE DETAILS FOR TRADE MARK No. 2396693 ✓

Page 1

Customer Ref:

----- CURRENT DETAILS HELD FOR THIS TRADE MARK -----

Status: EXAMIND

Mark Type: Word and Device ✓
Class : 25 ✓

Mark Text:
Nicholas Deakins ✓

Mark Description:
The colours shown in the mark are gold Pantone 17-1047tc and black.

| | | | |
|---------------------------|--------------|--------------------|----|
| Date Filed: | 12.07.2005 ✓ | Next Renewal Date: | |
| Date Progress Stopped: | | Registration Date: | |
| (Earliest) Priority Date: | | Expiry Date: | |
| Priority Country Code: | | Archived Date: | |
| IF Series, No. in Series: | 001 | Licensee: | No |

| | | |
|------------------|-------------|-------------------|
| Journal Section: | Journal No: | Publication Date: |
| First Advert | page | |
| Registration | | |
| Renewal | | |
| Expiry | | |
| Assignment | | |
| Division | | |
| Merger | | |
| Removal | | |
| Restoration | | |

Specification of goods / services:

Class 25
Mens and ladies clothing, ✓shirts, ✓T-shirts, ✓hats, ✓gloves, ✓socks, ✓underwear, ✓trousers, ✓jeans, ✓jackets, ✓sweaters, ✓jumpers, ✓hooded tops, ✓track tops, ✓combat pants, ✓shorts, ✓swimming shorts, ✓swimming trunks, ✓formal shoes, ✓casual shoes, ✓boots, ✓moccasins, ✓trainers and sneakers. ✓

Residence Country Code: GB

Effective Date of Assignment :

Proprietor: Nicholas Deakins Ltd

ADP Number
0870017001

Address: Solk House ✓
68 Armley Road
Leeds
West Yorkshire

TNER09

OPTICS - TRADE MARKS - USER: MCAN 23.08.2005 13.52.24

CASE DETAILS FOR TRADE MARK No. 2396693

Page 2

LS12 2EJ



INVESTOR IN PEOPLE

**The Patent Office
Trade Marks Registry**

Cardiff Road, Newport
South Wales, NP10 8QQ
United Kingdom

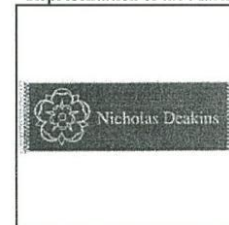
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Website: www.patent.gov.uk

Nicholas Deakins Ltd
Solk House
68 Armley Road
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West Yorkshire
LS12 2EJ

Tel: +44(0)1633 811133
Fax: +44(0)1633 811425
O/Ref: 2396693/Team D/CEVAN
Y/Ref:
Date: 12 August 2005

Representation of the Mark



Please quote our reference when replying.

Dear Mr Tate,

Application No: 2396693 in Class 25
For the Mark: Nicholas Deakins (and Device)
Applicant: Nicholas Deakins Ltd

ACCEPTANCE OF TRADE MARK APPLICATION

I refer to our telephone conversation earlier this afternoon.

As agreed, the specification has now been amended as outlined in my examination report and the Form TM3 (Application Form) has been altered accordingly.

Therefore, the requirements for registration have been met so the application is accepted. We will now publish it in the Trade Marks Journal on our website for opposition purposes. We will tell you the Journal number and date of publication shortly.

After the mark has been published, there is a three month period in which anybody may oppose its registration. If we receive any such opposition, we will write to tell you.

If nobody opposes the mark, we will automatically register it three weeks after the end of the opposition period and send you the registration certificate soon afterwards.

Yours sincerely,

Cheryle Evans
Trade Mark Examiner

Form TM3

Official fee charged

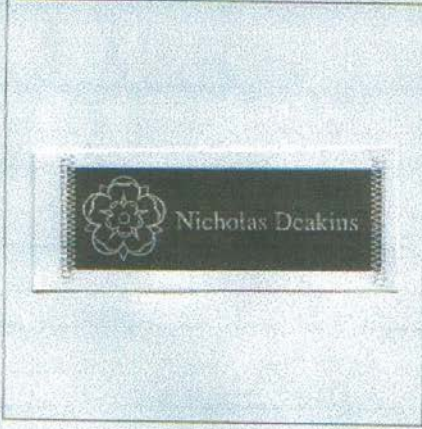


J103996/ 001 B39218 TM03.....
24MAY05 200.00 CHEQUE

Application to register a trade mark

The Patent Office
Trade Marks Registry
Cardiff Road, Newport
South Wales NP10 8QQ

Please read the guidance notes about filling in this form.

| 1. Your reference | PRIVATE APPLICANT 2396693 | | | | | | |
|--|--|---------------------|---------------------|--------|-----|--|--|
| 2. Illustration of your mark(s). |  | | | | | | |
| 3. If your mark is a three-dimensional shape or a sound or a repeating pattern, say here which it is. | N/A | | | | | | |
| 4. If you have shown the mark in colour we will assume you want the mark registered in these colours unless you tell us something different here. | BLACK BACKGROUND GOLD ROSE GOLD TEXT | | | | | | |
| 5. If you have shown the mark in black and white we will not consider these colours are a feature of the mark unless you tell us something different here. | | | | | | | |
| 6. If your application is for a series of marks, how many marks are in the series? | N/A | | | | | | |
| 7. If your application claims priority, give these details. | <table border="1"> <thead> <tr> <th>Priority Date</th> <th>Country</th> <th>Number</th> </tr> </thead> <tbody> <tr> <td colspan="3">N/A</td> </tr> </tbody> </table> | Priority Date | Country | Number | N/A | | |
| Priority Date | Country | Number | | | | | |
| N/A | | | | | | | |
| 8. If you are applying to transform a UK designation under an international registration into a UK application, give these details. | <table border="1"> <thead> <tr> <th>Transformation date</th> <th>Registration number</th> </tr> </thead> <tbody> <tr> <td colspan="2">N/A</td> </tr> </tbody> </table> | Transformation date | Registration number | N/A | | | |
| Transformation date | Registration number | | | | | | |
| N/A | | | | | | | |

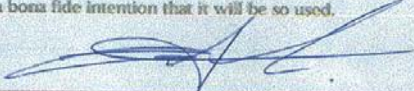
(REVMAY04)
W

Form TM3

9. List the goods or services on which you are using, or intend to use, your mark.

| Class Number | List of goods or services |
|--------------|--|
| 25 | <p>^{and} MENS & LADIES CLOTHING, APPAREL TO INCLUDE: SHIRTS, T-SHIRTS, HATS, GLOVES, SOCKS, UNDERWEAR, TROUSERS, JEANS, ALL TYPES OF JACKETS, SWEATERS, JUMPERS, HOODED TOPS, TRACK TOPS, COMBAT PANTS, SHORTS, SWIMMING SHORTS, SWIMMING TRUNKS, FORMAL SHOES, A BOOT, CASUAL SHOES, & BOOTS, MOLCASINS, TRAWERS AND & SNEAKERS.</p> |

Ted conversateu
12/8/05
9.

| | |
|---|--|
| 10. If you are applying for a certification or collective mark, say which type you want. | N/A |
| 11. List any limitations or disclaimers you want to record. | N/A |
| 12. Applicant's full name and address (including postcode). Trade marks ADP number (if you know it). If you are applying in the name of a company where is it incorporated? If incorporated in the USA, in which State is it incorporated? | NICHOLAS DEAKINS LTD SOLK HOUSE 68 ARMLEY ROAD LEEDS WEST YORKSHIRE LS12 2EJ UNITED KINGDOM 0870017001 |
| 13. Name and address (including postcode) of agent (if any); or your contact address (including postcode) if not the same as in section 12 above. Trade marks ADP number (if you know it). | N/A |
| 14. Declaration. Signature. | The trade mark is being used by the applicant or with his consent, in relation to the goods or services stated, or there is a bona fide intention that it will be so used.  |
| Name in BLOCK CAPITALS. | CRAIG NICHOLAS TATE |
| Date. | 20 th MAY 2005 |
| 15. Name and daytime phone number of the person we should contact in case of query. | CRAIG NICHOLAS TATE 0113-2446875 |
| Number of sheets attached to this form. | |

Fees It costs £200 to apply to register a trade mark in one class of goods or services, and £50 for each extra class. We cannot refund this fee for any reason - it covers the cost of us examining your application and our other administrative costs. Please make cheques payable to 'The Patent Office'.