

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2025871  
BY MRS D J ASPEY AND M A ASPEY TO REGISTER  
THE MARK MENTAL IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
NO 44745 BY DO RAGS, INC**

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**by Mrs D J Aspey and M A Aspey to register**  
**the mark MENTAL in Class 25**

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10 **IN THE MATTER OF Opposition thereto under**  
**No 44745 by Do Rags, Inc**

15 **DECISION**

On 29 June 1995 Mrs D J Aspey and M A Aspey applied to register the mark MENTAL for a specification of goods which reads as follows:

20 “Trousers; sweatshirts; hooded tops; T-shirts; shirts; baseball hats; flat caps; skull caps;  
dungarees; shorts; jackets; dresses.”

The application is numbered 2025871.

25 On 13 June 1996 Do Rags, Inc of Waco, Texas filed notice of opposition to this application.  
In summary the grounds of opposition are:

- 30 i under Section 5(4) in that use of the mark applied would be liable to be  
prevented by virtue of any rule of law and in particular the law of passing off
- ii under Section 3(6) in that the applicants cannot claim to be the proprietors of  
the mark and that the application was made in bad faith.

35 The applicants filed a counterstatement denying these grounds.

Both sides ask for an award of costs in their favour.

40 Only the opponents filed evidence in these proceedings. Neither side has requested a hearing  
in relation to the matter. Acting on behalf of the Registrar and after a careful study of the  
papers I give this decision.

Opponents' evidence (Rule 13(3))

5 The opponents filed three statutory declarations in support of their case. The first comes from Alan Wills who is the President of Do Rags, Inc. He has been employed by his company since 1990.

10 Mr Wills says that his company has been making headgear since 1990 and in 1994 launched a line of headgear and casual clothing such as T-shirts under the trade mark MENTAL. He says that "awareness" of the trade mark MENTAL in the United Kingdom started towards the end of 1994. He exhibits (AW1) a copy of a letter dated 28 February 1995 from The Wholesale Cap Shop Ltd indicating that the Managing Director of that company had been introduced to MENTAL headgear in November 1994. The letter goes on to explain the serious interest expressed by major retailers (Harrods, Lillywhites and Top Man) in the company's goods. He says that, whilst the letter of 28 February does not specifically refer to the mark it is Do Rags, Inc's snowboarding products which are referred to and these goods bear the mark MENTAL. He also exhibits (AW2) further correspondence from The Wholesale Cap Shop Ltd.

20 To illustrate the range of goods being discussed in early 1995 with The Wholesale Cap Shop Ltd, Mr Wills exhibits (AW3) a copy of his company's 1995 catalogue. The first United Kingdom order and delivery of clothing under the MENTAL trade mark was in April 1995 and he exhibits (AW4) a copy of Invoice No 002418 dated 26 April 1995 for \$10,599.42 of goods (which, he says, will have had a significantly higher value at retail) indicating a shipment date of 26 April 1995 to the United Kingdom. The invoice indicates a shipment of ten boxes with a total weight of 489 lbs. These goods will, he says, have been distributed to retailers by The Wholesale Cap Shop Ltd, and the references in Invoice No 002418 correspond to articles featured in his company's 1995 catalogue, confirming the use of the MENTAL trade mark in the United Kingdom.

30 He says that further distribution of MENTAL goods was made by The Wholesale Cap Shop Ltd. By way of example he exhibits (AW5) a copy of an Invoice No 022996 dated 19 October 1995 for \$19,163.00 of MENTAL goods.

35 Mr Wills says that in 1996 his company changed distributor. He exhibits (AW6) a copy of an invoice No 30293 in respect of \$6,272.28 of clothing supplied in September 1996 to Orion Equipment. He adds that both The Wholesale Cap Shop Ltd and Orion Equipment will have distributed their consignments to a spread of retailers in the United Kingdom. He also exhibits (AW7) an assembly of MENTAL labels as used by his company on the clothing distributed in the United Kingdom and (AW8) a copy of part of an article from The Times believed to have been in May 1995 showing a MENTAL hat in a photograph supporting an article on The Burton Group, owners of the Top Man chain referred to above. Finally Mr Wills refers to trade mark filings in other countries and makes a number of observations on the background to this opposition.

45 The second declaration dated 17 March 1997 comes from Robert Ferrell, a Director of Nevisport Ltd. He is responsible for a Division of that firm which trades as Orion

Equipment. Orion is currently responsible in the United Kingdom for distribution of clothing from Do Rags, Inc under the trade mark MENTAL.

5 He says that in February 1996, his company was invited to establish a new contract with Do Rags, Inc, to represent them and show their MENTAL clothing at the Soltex Trade Show in Manchester later that month. At the Soltex Show they took orders from retailers for distribution later in 1996 throughout the United Kingdom. The retailers who took MENTAL clothing (mainly headgear) included the John Lewis Group, Ellis Brigham (a specialist winter sport and mountaineering equipment chain which has branches throughout the  
10 United Kingdom) and independent sports retailers. For 1996, Orion handled distribution of MENTAL clothing which would have had a value at retail in the region of £25,000 in broad terms, corresponding to a figure of between £6,000 and £7,000 of sales invoiced by Do Rags, Inc. Clothing under the MENTAL trade mark of Do Rags, Inc was distributed by Orion to retailers throughout the United Kingdom in 1996.

15 Mr Ferrell says that Orion continue to represent Do Rags, Inc in the United Kingdom as distributors of their clothing bearing their trade mark MENTAL. They have attended recently the 1997 Soltex Show in Manchester and there was a favourable response from retailers to the 1997 range of MENTAL clothing. The MENTAL clothing range continues to be mainly  
20 headgear, although there are other clothing articles such as t-shirts, but the range of headgear has been broadened. It is said that retailers have commented on the distinctiveness of the MENTAL trade mark of Do Rags, Inc in relation to headgear and other clothing. He exhibits (RF1) an example of the current catalogue of Do Rags, Inc showing clothing under their MENTAL trade mark.

25 The third declaration comes from Andrew T Hathaway who in 1995 was Managing Director of The Wholesale Cap Shop Ltd. He describes the company as being a major distributor of clothing and headgear with retail customers throughout the United Kingdom. The company has since been taken over by Cap Shop Ltd.

30 Mr Hathaway confirms the relationship that existed between Do Rags, Inc and The Wholesale Cap Shop Ltd as previously described by Mr Wills. He confirms also that a significant order for MENTAL products was fulfilled at the beginning of May 1995. He exhibits (AH2) a copy of an invoice dated 26 April 1995 from Do Rags, Inc. He says that the total referred to  
35 in that invoice, in excess of £10,000 (Mr Wills, in relation to the same invoice, referred to it as being denominated in dollars) would represent about £40,000 at retail sales values. The consignment of goods relating to that invoice would, he says, have been distributed by his company to retailers throughout the United Kingdom during the course of May 1995 and there would as a result be significant awareness of the MENTAL trade mark both among  
40 retailers and customers from that date. Mr Hathaway adds that his company arranged for the MENTAL range of goods to be sold in Top Man at Oxford Circus, London on a concession basis and MENTAL goods were featured in The Sunday Times. He also describes the circumstances under which his company ceased to distribute MENTAL goods but I do not think this is necessarily relevant to the proceedings before me.

45 That completes my review of the evidence.

I will deal firstly with the opponents' claim that the application was made in bad faith and should, therefore, be refused under Section 3(6) of the Act. The opponents say in effect that the applicants cannot claim to be the proprietors of the mark. The applicants have filed no evidence and so have not explained how they came to adopt the mark. Equally there is no indication that they were aware of the opponents' rival claim when they filed their application. The opponents, for their part, have not filed evidence to suggest that I should come to a different view. There is, for instance, no indication that the applicants had any kind of past relationship with the opponents either as employees or agents or that they might otherwise have been aware of the opponents' mark through business activities in countries where the opponents are also active. I, therefore, take the view that the opposition fails under Section 3(6) and that the rival claims properly fall to be decided under the other ground of opposition, that is to say Section 5(4) of the Act. This reads as follows:

“ (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

In their statement of grounds the opponents adopt the wording of sub-section (a) and, in the absence of any further (or different) particularisation of their claim I assume their view is that use of the mark applied for is liable to be prevented by the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

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

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

5 (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

10 The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

15 Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

20 "To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

25 (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

30 (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

35 While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

40 (a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

45 (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;

- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

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For the purposes of deciding whether there has been a misrepresentation, it appears to me that I should compare the applicants' trade mark as applied for with the sign used by the opponents. The evidence filed by the opponents shows that they use the mark in a variety of ways either on its own; in conjunction with the company name; with a stylised letter M; in an oval surround; and with a variety of background or surrounding logos. However I do not think that the "other matter", when present, detracts from the fact that the word MENTAL is the central feature of the mark. The evidence also shows that most of the use relates to headgear of various kinds along with T-shirts. The application at issue is for the word MENTAL in plain block capitals and the specification covers goods which are identical and/or similar to those of the opponents. In these circumstances, and in the light of the three main elements of the test for passing off, it seems to me that misrepresentation and damage are likely to follow if the opponents' goods have acquired goodwill or reputation. The crucial issue is, therefore, whether such goodwill or reputation had been established at the date the application at issue was filed ie 29 June 1995 (see also Article 4(4)(b) of the Directive, 89/104/EEC, in relation to the date at which the test must be applied).

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The opponents say that "awareness" of their mark in this country started towards the end of 1994. This appears to be based on the fact that Mr Hathaway of The Wholesale Cap Shop Ltd was introduced to the mark in November 1994. The first United Kingdom order and delivery was not until 26 April 1995. This is a relatively short period before the applicants filed for registration on 29 June 1995. This is not necessarily fatal to the opponents' cause. In *Stannard v Reay* 1967 RPC 589 use of MR CHIPPY on a mobile fish and chip van over a three week period on the Isle of Wight was held to be sufficient to establish a local goodwill. However where a party relies on such a short period of use (particularly where a more than purely local reputation is being claimed) it seems to me that there is an onus on them to substantiate and support their case to the fullest possible degree. I, therefore, go on to consider in more detail the case put forward by the opponents.

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I do not think the opponents can make any claim to public awareness of their mark arising from the contact with The Wholesale Cap Shop Ltd in November 1994. The original contact thus established was not followed up until Mr Hathaway's faxed letter to Mr Wills of Do Rags, Inc of 24 February 1995 (the date on the copy correspondence is indistinct and Mr Wills refers to the letter being dated 28 February but nothing turns on this slight discrepancy). This letter refers to the fact that The Wholesale Cap Shop Ltd had recently shown Do Rags, Inc's catalogue to Harrods, Lillywhites and Top Man. The extent of these organisations' awareness of the mark resulting from this is not clear. Two further items of correspondence from The Wholesale Cap Shop Ltd indicate that by early March 1995 Do Rags had sent sample goods to this country and that these had been well received by the former's sales agents. The first evidence of actual trade in the goods is an invoice dated 26 April 1995 relating to a consignment made up mainly of items of headgear and T-shirts.

The goods are said to have been distributed to retailers by The Wholesale Cap Shop Ltd. The next substantiated transaction is an invoice dated 19 October 1995 which is after the material date in these proceedings. If there were intervening orders they have not been brought to my attention in the evidence.

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Based on the above there are a number of weaknesses in the opponents' case considered as at the date the applicants filed their application:

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- (i) the only substantiated order by that time is the invoice dated 26 April 1995. It is for a modest sum of \$10,599 (or £10,599 if Mr Hathaway's version is taken) albeit that the retail sales value is likely to have been significantly higher.
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- (ii) although it is said that The Wholesale Cap Shop Ltd distributed goods to a spread of retailers throughout the United Kingdom no detailed information as to numbers and locations is given. The claim that there was "significant awareness" of the MENTAL mark both among retailers and customers from May 1995 onwards has not in my view been substantiated.
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- (iii) no indication has been given as to how much of the original consignment had been distributed by 29 June 1995. If the 19 October 1995 invoice represents the first follow-up order it suggests that the original consignment of stock lasted for almost 6 months. If this is so market penetration and awareness in the period between 26 April 1995 and 29 June 1995 must have been very limited indeed.
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- (iv) The Wholesale Cap Shop Ltd's activities in showing the Do Rags catalogue to Harrods, Lillywhites and Top Man may have resulted in some awareness of the MENTAL trade mark amongst those companies' buyers but it does not establish any public recognition of the mark. Nor can I place any great
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- reliance on the unspecified effects of the goods being offered for sale in Top Man at Oxford Circus.
- (v) the impact of the market testing at the Soltex exhibition is similarly difficult to gauge. No information is given about the exhibition itself, the prominence given to promotion of Do Rags' goods or the nature of the audience (trade or public). Whilst the exhibition may have confirmed that a market was considered to exist for the goods I cannot assume in the absence of clear evidence that it achieved any significant recognition for the mark.
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- (vi) the reference in Mr Wills' declaration to the products being shown in The Times article on the Burton Group is altogether too tenuous a connection to support any claim to a reputation in the mark MENTAL.
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45 In the light of the above points, and particularly the first three, I am not persuaded that the opponents could reasonably claim to have established a reputation in the mark MENTAL as at the material date in these proceedings. The fact that the goods are said by Mr Hathaway to



have been “distributed by my company to retailers throughout the United Kingdom during the course of May 1995” suggests a geographical spread that can only serve to further dilute the effect of the only order that appears to have been placed prior to 29 June 1995. The test for passing off also makes it clear that what counts is whether goodwill or reputation exists in the minds of the purchasing public. Even if some trade awareness existed at the relevant date there is no evidence to support the claim that the mark enjoyed any significant degree of recognition or reputation amongst the public at large who would be the customers for the goods. It follows, therefore, that the opposition under Section 5(4) of the Act fails.

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- 10 The opposition as a whole having failed the applicants are entitled to a contribution towards their costs. I, therefore, order the opponents to pay the applicants the sum of £235.

Dated this 22nd day of July 1998

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**M REYNOLDS**  
**For the Registrar**  
**the Comptroller General**