

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1583249 IN THE
NAME OF INTRAPORT LIMITED TO REGISTER THE
MARK ROUGHNECK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 42901 BY COURTESY SHOES LIMITED**

**TRADE MARKS ACT 1938 (AS AMENDED) AND
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**IN THE MATTER OF Application No 1583249
in the name of Intraport Limited to Register the
mark ROUGHNECK in Class 25**

10 **and**

**IN THE MATTER OF Opposition thereto under
No 42901 by Courtesy Shoes Limited**

15

DECISION

20 On 30 August 1994 Intraport Limited applied under Section 17 of the Trade Marks Act 1938 to register the mark ROUGHNECK in Class 25 for a specification of goods which, after amendment, reads “shirts for men and boys”.

The application is numbered 1583249.

25 On 2 August 1995 Courtesy Shoes Limited filed notice of opposition to this application. The grounds of opposition are, in summary, as follows:-

- 30
- (i) under Section 11 by reason of the opponents’ use of and reputation in their mark RUFF NECKS and device;
 - (ii) under Sections 9 and 10 in that the mark at issue would indicate that the goods were suitable for wear by workers on oil rigs.

35 They also ask the Registrar to refuse the application in the exercise of his discretion.

I should add that the opponents have a registration of the mark referred to above in respect of “articles of footwear and parts and fittings therefor”. They have not, however, specifically pleaded Section 12(1) and I do not propose to consider this matter as a formal ground though I will touch on it later in the decision. The opponents also refer to their registration of the mark RUGGED SCENE in respect of outerclothing. The relevance of this registration is not explained.

45 The applicants filed a counterstatement denying the above grounds. Both sides seek an award of costs in their favour. Only the opponents filed evidence in these proceedings.

Neither side has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

5 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994.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

10 Opponents' evidence

15 The opponents filed a statutory declaration dated 19 June 1996 by Barry John Lynch, the Managing Director of Courtesy Shoes Ltd (CS), a position he has held since 1977. He says that CS source and market footwear to their own specifications and sell, both in their own retail outlets and through an associated company Jay-Bill Limited (JB) who are footwear retailers and have at all times exercised complete control over the marketing and quality of goods offered for sale by JB.

He exhibits the following:-

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BJL1 - a catalogue for Spring/Summer 1992 distributed by JB. Approximately 4000 copies were printed. The catalogue shows a child's leisure wear shoe offered under the mark and the device mark appearing on the shoe itself.

25

BJL2 - an Autumn/Winter 1995 catalogue showing the mark in various formats.

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BJL3 - a sole showing use of the mark.

BJL4 - four photographs illustrating other forms of usage of the mark RUFFNECKS.

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Over the period September 1991 to 30 August 1994 (the application filing date) CS or JB sold approximately one hundred thousand pairs of shoes carrying the mark RUFFNECKS over a wide area of the United Kingdom equating to a retail value of about £1 million. Approximately £15,000 was spent on advertising and publicity during that period.

40

Mr Lynch goes on to say that:

“My company's marketing strategy has placed great emphasis on the mark and it is my belief that use of the mark **RUFFNECK** or **ROUGHNECK** on clothing, particularly for children and adolescents, in the leisurewear market would inevitably be associated with my company CS or JB.

45

In multiple product trading outlets, such as supermarkets, department and chain stores, street trading markets and self-service establishments, several types of clothing and footwear are usually displayed together for example in the casual clothing department, and marketed under a certain dress style such as “weekend wear”, “leisure wear” as example. In my opinion the public would not perceive any difference between a mark applied to footwear and the same or similar mark applied to articles of casual clothing such as sweat shirts or tee-shirts for sale alongside or on adjacent display stands.

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10

I firmly believe that any article of leisure clothing carrying the Trade Mark **ROUGHNECK** would be assumed by the public to be associated with footwear marked under the Trade Mark **RUFFNECKS**, there being no practical means of distinguishing between the marks.”

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In support of the above Mr Lynch exhibits (BJL5) the results of a questionnaire sent to seven current retailers of his firms’ products. I will return to the questionnaire and the conclusions drawn from it later in this decision.

He adds that:

20

“Since 17th September 1991, the general trade marketing strategy in leisure footwear and clothing have changed considerably and it is now quite common for the public to expect to purchase a “kit”, i.e. shoes, socks, jeans, slacks, shorts, shirts from one retailer all carrying the same Trade Mark forming a distinct badge of origin on all the goods. Thus our reputation and goodwill in footwear, which has been built up over several years under the mark **RUFFNECKS**, would inevitably attach itself to other articles of clothing.

25

30

Our mark **RUFFNECKS** was selected because of association with the oil industry. In such an industry protective boots, clothing, and headwear for oil workers would all be the same or similar goods sold together. I see no reason why the same marketing logic would not apply to leisure footwear and clothing.

35

If the mark of the application proceeds to registration it would inhibit my company CS or JB from using and advertising the mark of our registration on printed tee-shirts, as example, this being a customary method of using low cost clothing to promote more costly goods or services in the market place.”

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Finally he comments on the applicants’ claim in their counterstatement that their mark was accepted by the Registrar (at the examination stage) in the face of other registrations owned by third parties including the word RUFF or ROUGH. He says that the mark applied for cannot be distinguished verbally from the opponents RUFFNECKS (and device) registration. Under modern day trading he considers articles of clothing for men and boys to include goods similar to those marketed under his company’s trade mark.

45

That completes my review of the evidence.

I will deal firstly with the objections based on Sections 9 and 10 of the Act. The opponents claim that use of the mark ROUGHNECK would indicate that the goods were suitable for wear by workers on oil rigs. On this basis it is said that the mark is neither adapted to distinguish or capable of distinguishing the applicants' goods. I accept of course that the
5 word 'roughneck' is a slang term for a worker in an oil-drilling operation. However no evidence has been provided to show that any items of personal apparel are adapted for use by oil workers. Nor has any indication been given as to how any objection relates to the shirts of the applicants' specification. To the extent that oil rig workers have any particular clothing needs it is likely to be protective clothing (proper to Class 9). It seems to me to be a highly
10 improbable proposition to suggest that ROUGHNECK is likely to be required by other traders as a descriptive term in relation to shirts. In short I can see no basis for objection under Sections 9 and 10 and the opposition fails on these grounds.

I referred earlier to the references in the opponents' statement of grounds to their registration
15 of the mark RUFF NECKS (and device) in relation to footwear. However they did not specifically indicate whether they intended to formally raise an objection based on Section 12(1) of the Act. Against this I note that Mr Lynch in his declaration suggests that the applicants' goods are under current trading circumstances "similar to those which have been marketed under my company's trade mark RUFF NECKS". I am, therefore, left in some
20 doubt as to whether it was intended to formally plead Section 12(1). Mr Hobbs QC sitting as the Appointed Person in relation to an opposition matter under the Trade Marks Act 1994 (WILD CHILD Trade Mark 1998 RPC 455) commented on the need for full and clear particularisation of pleadings. I regard his comments as being applicable also in the case before me. Whilst I do not consider myself bound to reach any formal finding I propose to
25 make a few comments in relation to Section 12(1). I am conscious also that the ambiguity in the opponents' pleadings may simply reflect their awareness of the long standing Registry practice whereby footwear is generally not regarded as goods of the same description as other items of clothing. The issue also arose in the SILVER SHADOW Trade Mark case which involved opposition by Rolls Royce Motors Limited to applications by Inter-Footwear Ltd (to
30 the best of my knowledge the case is unreported but is under opposition numbers 17815 and 17614). In dealing with the comparison between the applicants' sports and leisure shoes and the opponents' clothing the Hearing Officer put the position as follows:

"This brings me to the final registration which is within Class 25 and covers a range
35 of clothing including "Cravats, scarves, shirts, underwear, jackets, track suits, beachwear and socks". As regards goods of the same description Mr Hamer based his arguments on the last three items with particular reference to the fact that such goods could be sold side by side at point of sale. Again applying the tests referred to earlier it appears to me that such goods are not goods of the same description as sports shoes.
40 The nature of the goods are different, the closest being perhaps socks which are closely associated with shoes in that they are both used in relation to the feet. Generally socks are either knitted or made from knitted materials, as compared to sports shoes which are likely to be made from leather or canvas. While both socks and shoes are used to cover the foot it seems to me that the use of the respective goods
45 is quite different. Socks basically have the function of ensuring warmth and comfort when wearing shoes and protect the foot to some extent from the shoe. Shoes on the

other hand protect the foot from injury when walking over rough surfaces; provide protection against damp and cold; cushion the foot and provide arch support and in the case of sports shoes provide “grip” on most surfaces. This leaves channels of trade and while it is true that nowadays sports socks and tracksuits may be sold through the same sales outlets as sports shoes they are invariably sold in different parts of the shop. However, even if they are sold side by side I consider that their nature and purpose is so different that the satisfying of one of the Jellenik tests is insufficient for a finding of goods of the same description.”

10 It is clear from the above extract that the Hearing Officer, in applying the Jellinek criteria, did not consider that shirts (the applicants’ goods in the case before me) were of the same description as sports and leisure shoes. I accept that neither Registry practice or the case quoted above can necessarily be determinative of the issue before me but in the absence of evidence or submissions in support of a contrary position I would have seen no basis for coming to a different view of the matter if I were called upon to reach a formal finding.

It has perhaps been useful to record the above comments if only as a starting point for the rather different considerations that apply under Section 11. This Section reads as follows:

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

25 The established test is that set down in Smith Hayden & Co Ltd’s application but as adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand the test may be expressed as:-

30 Having regard to the user of the opponents’ mark (see below), is the tribunal satisfied that the mark applied for, ROUGHNECK, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

35 The opponents’ mark is as follows:-



In fact the mark seems to be used in a number of slightly different formats but the principal element is RUFF NECK so nothing turns on the variant forms.

5 The test under Section 11 is not restricted in the same way as under Section 12 but it does
require me to consider the user of the opponents' mark. Leaving aside for the moment the
questionnaire evidence, only two of the exhibits filed by the opponents bear dates. The first
(Exhibit BJL1) is a catalogue (for the Spring and Summer of 1992) showing a range of
sports, leisure and casual shoes. The catalogue is headed JAY BILL. Over 170 styles of
shoes are shown, one of which carries the RUFF NECKS mark. If the mark appears on
10 any of the other shoes in the range (or their soles) it is certainly not obvious from the
photographs. A second catalogue (BJL2) relates to the Autumn/Winter 1995 collection and
as such is well after the material date in these proceedings (30 August 1994). The
catalogue is still headed JAY BILL but rather more prominence is given to the RUFF
NECKS mark at least on the first two pages. I am left with the impression that between the
15 dates of the two catalogues it was decided to place greater emphasis on RUFF NECKS as a
sub-brand. It is not possible to gauge from the evidence the pace at which this change took
place but the opponents say that between September 1991 and 30 August 1994 some
100,000 pairs of shoes were sold under the mark with a retail value of £1 million. There is
no evidence of any trade under the mark outside the footwear field.

20 It is, however, said in the statement of grounds that the opponents had a wider interest in
the clothing market and had "made effective preparation to use their mark on a range of
leisure clothing". Despite a number of very general comments in Mr Lynch's declaration
suggesting that his company had an interest in clothing for the leisurewear market I can see
25 nothing in the trading circumstances of the company that suggests they have used the mark
for such goods. Nor do I consider that a reputation in footwear inevitably or necessarily
extends to other forms of clothing.

30 That is not an end to the matter, however, as the opponents point to two other circumstances
which they say are in their favour. The first is the nature of the retail trade in footwear and
clothing and the fact that such goods can meet in a number of retail circumstances. Mr Lynch
suggests that as a result of this the public would make an association between the applicants'
mark used on shirts and the opponents. Footwear is commonly sold through high street shops
specialising in such goods though I have no doubt that the opponents are correct to say that
35 such goods are also sold through other retail outlets such as department stores and self-service
establishments. But then so is a wide range of other goods. I do not think this factor on its
own can assist the opponents unless they establish that confusion would result. The
opponents have sought to substantiate their claim with questionnaire evidence. The
questionnaire was sent to seven of their current retailers. All seven questionnaires were
40 returned. I attach at Annex A a copy of one of the completed versions to give an indication of
the questions asked. It seems to me that the questionnaire is open to a number of criticisms in
the context of the guidance given, for instance, in *Imperial Group plc v Philip Morris Ltd* 1984
RPC 293:

45 - there is no indication as to how the questionnaire was introduced to the
retailers concerned. Presumably it was under cover of a letter. If so the

content of the letter should also have been disclosed to confirm the neutrality of the request;

- 5 - the letter was sent to a narrow group of people who were already familiar with the company and its goods;
- with the exception of Mr Callard of MM Accessories Ltd all the respondents are footwear retailers;
- 10 - the structure of the questionnaire seems to me to result in leading questions or at least invites an association to be made;
- none of the replies indicate that they associate RUFF NECKS with goods other than footwear;
- 15 - no statutory declarations have been filed to indicate why the individuals make the associations claimed and, of course, there has been no cross-examination.

20 I regard the questionnaire evidence as being too few in number and too restricted in scope to support the opponents' claim. It does not substantiate the proposition advanced namely that the public would regard articles of leisure clothing sold under the mark ROUGHNECK to be associated with footwear marked RUFF NECKS.

25 The opponents also say that since September 1991 the "general trade marketing strategy in leisure footwear and clothing have changed considerably and it is now quite common for the public to expect to purchase a "kit" ie shoes, socks, jeans, slacks, shorts, shirts from one retailer all carrying the same trade mark ..." I accept of course that any such trends cannot be pinned to a particular date but if, as seems to be suggested, it is a relatively recent phenomenon then the opponents needed to establish their case with some care and to provide independent evidence to confirm this claimed trend in marketing. The clothing and footwear market is not, it seems to me, an homogenous one. I do not think the concept of brand extension which is sometimes said to apply in the context of "designer labels" necessarily works at all levels of the market. Rather it is for an opponent to establish their own position, and customer expectation, on the basis of the particular circumstances of their own trade and the market they serve. I am by no means convinced that they have done so on the facts of the case before me.

40 Mr Lynch also expresses concern that "if the application proceeds to registration it would inhibit my company CS or JB from using and advertising the mark of our registration on printed tee-shirts, as example, this being a customary method of using low cost clothing to promote more costly goods or services in the market place". I do not think I should make too much of this statement but it does seem to me to call into question whether the opponents' interest in clothing is to develop a trade in such goods under the mark or simply to use it as an advertising medium for their footwear (see KODIAK Trade Mark 1990 FSR 49).

45

In summary I have come to the view that the opponents' own use of the mark RUFF NECKS is in the area of footwear and that there is no evidence to support a wider claim. Nor am I persuaded that the circumstances of trade referred to by the opponents have been sufficiently substantiated to justify a finding in their favour. The opposition therefore fails under

5 Section 11.

There remains the matter of the Registrar's discretion. However I see nothing in the circumstances of the case that suggests I should exercise discretion against the applicants.

10 As the applicants have been successful they are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of **£235**.

Dated this 14th day of October 1998

15

20 M REYNOLDS
For the Registrar
the Comptroller-General

QUESTIONNAIRE

1. PLEASE WRITE YOUR
NAME IN FULL

John. Cooper's

2. Please state:-

(a) the name and address
of the company or firm
for whom you work,

Goody Two Shoes.

(b) the general nature of
the business of the company
or firm,

Foot-wear Retailer.

(c) the position you hold,

OWNER.

(d) the number of years you
have been in the trade

15 years.

3. (a) Have you heard of
RUFFNECK(S)?

yes.

(b) if so, how long have
you known the name?

6 months

(c) with whom do you associate
the name RUFFNECK(S)?

Jay-Bill

(d) with what products do you
associate RUFFNECK(S)?

CHILDRENS FOOTWEAR.

4. If you saw the name RUFFNECK(S)
on or relating to articles of
clothing, with whom would you
associate the goods?

Jay Bill

5. If you saw the name ROUGHNECK(S)
on or relating to articles of
clothing, with whom would you
associate the goods?

Jay Bill

Dated. 27. ~~Tue~~ day of 199.6

Signed.. *John Cooper's*