

**TRADE MARKS ACT 1938 (as amended)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1490994
BY ROCFORM LTD
TO REGISTER THE MARK TIMBER JACK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 43353 BY THE TIMBERLAND COMPANY**

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15 **DECISION**

On 14 February 1992 Rocform Ltd applied to register the mark TIMBER JACK in Class 25 for a specification of goods which reads: "Shirts, sweat-shirts, jackets, sportswear, blouses, windcheaters, anoraks, polo shirts, dresses, scarves, swimsuits, coats, beach-wear, leisure clothing, vests, blousons; all included in Class 25; but not including footwear."

The application is numbered 1490994.

25 On 2 October 1995 The Timberland Company filed notice of opposition to this application. The grounds of opposition are in summary:-

- (i) under Section 12(1) by reason of a number of registrations standing in the name of the opponents (see Annex for details)
- (ii) under Section 11 by reason of the use made by the opponents of their trade mark TIMBERLAND
- (iii) under Section 17 in that the applicants had no intention to use the mark in the form TIMBER JACK
- (iv) under Section 10 in that the mark applied for is not capable of distinguishing the applicants' goods (this being a Part B application)

40 The opponents also ask that the application be refused in the exercise of the Registrar's discretion.

The applicants filed a lengthy counterstatement which in essence denies the above grounds. Reference is also made to a number of other issues notably a raid on the premises of Boston (London) Ltd by police and trading standards officers in the belief it seems that garments

bearing the mark TIMBERLAND were present. The raid was apparently terminated when it was found that the word appearing on the garments was TIMBERJACK. A number of observations are also made in relation to other registrations containing the word TIMBER.

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

10 Both sides filed evidence and the matter came to be heard on 8 June 1999 when the applicants were represented by Ms J Reid of Counsel instructed by Williams Powell & Associates, Trade Mark Attorneys and the opponents by Mr C Morcom of Her Majesty's Counsel instructed by Wildbore and Gibbons, Trade Mark Attorneys.

15 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994.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.

OPPONENTS' EVIDENCE

20 The opponents filed an affidavit dated 14 November 1996 by Gennaro R Hathaway, Counsel of the Timberland Company, a position he has held since 1996. He confirms that he has full access to his company's books and records. A number of issues arose at the hearing in relation to the form and content of this and other affidavits filed on behalf of the opponents. I comment on these points later in the decision. A summary of the main points to emerge from the evidence is as follows.

30 Mr Hathaway firstly describes the corporate history of the current company and exhibits (Exhibit 1) excerpts from the Articles of Incorporation. He says the company sells footwear, clothing, headgear, leather products and leather care products bearing the TIMBERLAND mark into the United Kingdom and has done since at least as early as 1980 for footwear and 1987 for clothing. In support of this he provides:

- Exhibit 2 - samples invoices from the period 1980 to the present
- 35 Exhibit 3 - catalogues for spring and fall/winter 1995
- Exhibit 4 - hang-tags and sample shoe box cover
- 40 Exhibit 5 - details of the TIMBERLAND "concept shops" which form part of the company's UK distribution network

Sales figures for TIMBERLAND products in the UK in the in the years immediately preceding the material date are said to have been:

45		£
	1988	5,557,000
	1989	9,907,000

1990	17,160,000
1991	22,928,000

Advertising expenditure was approximately as follows:-

5		£
	1988	45,000
	1989	213,000
	1990	380,000
10	1991	553,000

These figures represent what are referred to as placements in the media (magazines, billboards, radio, TV) and do not include the cost of production, point of purchase items, special events etc. Examples of advertising are contained in Exhibit 6.

15 Mr Hathaway goes on to give an account of his company's business on the world scene supported by Exhibits 7 to 18.

20 It seems to me that this material is of marginal relevance only in assisting me to come to a view on the specific issues before me in these proceedings. I do not, therefore, propose to summarise it but will refer to specific points if necessary in my decision.

25 Reverting back to activity in this country, Mr Hathaway exhibits (Exhibits 19 & 20) advertisements which have appeared in British publications between 1980 and 1994 including in the context of fashion news. He says that the TIMBERLAND mark usually appears in close proximity to a tree design, the totality being the company's worldwide corporate logo. The tree design is said to visually reinforce the products' image as being connected to rugged wilderness such as timber land and accordingly that the products are rugged ones for outdoor activities. He concludes by commenting on the respective marks including the fact that the applicants use their mark in unitary form (Exhibit 21); commenting on the raid referred to by the applicants in their counterstatement; making observations on registrations incorporating a TIMBER- element.

35 A supporting affidavit has also been filed by Martin B Schwimmer, an attorney with Weiss David Fross Zelnick and Lehrman, the New York law firm that represents The Timberland Company. The purpose of his declaration is to exhibit (Exhibits 1-12) various news articles about the company and its products obtained from a LEXIS/NEXIS database. The articles are mainly at any rate from UK newspapers or publications though only three appear to be before the relevant date in these proceedings.

40 **APPLICANTS' EVIDENCE**

The applicants filed a Statutory Declaration by Anthony James Axe of Williams Powell & Associates, their professional representative in this matter. His declaration takes the form of a detailed commentary on and criticism of various aspects of the opponents' evidence.

In relation to Mr Hathaway's evidence his main points are that:

- the invoice evidence (Exhibit 2) is mainly in respect of shoes and leather goods rather than clothing

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- it is a general criticism that material relating to the period after 14 February 1992 is not relevant to these proceedings. This applies also to, for instance, the list of concept shops which was produced in November 1996.

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- overseas publication (see Exhibit 7) are irrelevant unless it is demonstrated that they are also available in this country

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- in relation to the applicants' choice of mark he says that they wished to bring to the market a heavier-weight shirt in checks and plaids. Such shirts are known as lumberjack shirts. The dictionary word TIMBERJACK is said to convey much the same idea. Mr Axe adds that "the use of surrounding images of an outdoor scene including trees arose simply because that is where timberjacks work"

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- the applicants' mark has since been redrawn to present the words on separate lines and with the logo of a baseball cap

- Mr Axe notes that there is no independent evidence as to the opponents' reputation or comment on the possibilities of confusion

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- no actual instances of confusion have come to light

- there is nothing to suggest that the opponents made any attempt to contact the applicants prior to the filing of the opposition in October 1995 despite the raid having taken place in January 1994

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- comment is offered on the TIMBER- marks on the register. He suggests that at the examination stage the Registry was more concerned about the second element of the mark (JACK) than the word TIMBER in view of the citations raised against the applicants' mark

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- Mr Axe concludes with a number of observations on the principles which should govern or inform my approach to the issue of confusion. I bear all these comments in mind in the decision which follows

OPPONENTS' EVIDENCE IN REPLY AND FURTHER EVIDENCE

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The opponents filed an affidavit by Danette Wineberg, the Vice President and General Counsel of The Timberland Company. She provides a more detailed estimated breakdown between footwear and apparel/accessory sales. These are

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Year	Net Sales
	£
1988	222,280
1989	990,770

1990	2,865,720
1991	3,828,976

Accessories are said to be de minimis within the above sums in comparison to apparel.

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The other main points to emerge are

- 10 - it is claimed that the UK public is familiar with the use of a single trade mark to designate an entire line of footwear and apparel. Ms Wineberg exhibits example advertisements promoting NIKE and DR MARTENS marks in relation to apparel
- further catalogue exhibits are provided for the years 1989 to 1991. UK distributors are identified
- 15 - copies of advertisements in UK national newspapers dating from 1989 are exhibited

Again the above is only a brief review of the reply evidence but I bear in mind the totality of the evidence in reaching my decision. Finally, the opponents have provided certified translations of decisions in a number of other jurisdictions which it is suggested support
20 TIMBERLAND's reputation as a famous mark.

That concludes my review of the evidence.

At the commencement of the hearing Ms Reid, for the applicants, indicated that she wished to challenge the form and content of the opponents' evidence. The points of criticism can be summarised as being that the opponents' evidence was in affidavit and not statutory declaration form; no directions had been given permitting affidavit evidence; the affidavits were in any case not properly sworn; Mr Schwimmer, the notary public before whom Mr Hathaway's affidavit was subscribed and sworn, should not have acted in that capacity as he had an interest in the proceedings; furthermore Mr Hathaway's affidavit was not sworn when first lodged and not redated when the matter was corrected. Additional points arise in relation to the content of the affidavits in as much as they include hearsay matter. I propose to deal with this latter point when I come on to consider the substantive issues and the evidence relating thereto. I propose to give my views on the other general criticisms as a preliminary
35 matter.

Section 55 of the Act deals with the mode of giving evidence and insofar as is relevant reads:

40 **“55.** In any proceeding under this Act before the Board of Trade or the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which the tribunal thinks it right so to do, the tribunal may take evidence viva voce in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the
45 incidents and consequences of evidence by affidavit.”

The above can be contrasted with Section 69 of the Trade Marks Act 1994 which provides for the giving of evidence in proceedings before the Registrar by affidavit or statutory declaration. Section 55 does not rule out the possibility of affidavit evidence but requires a direction from the tribunal before it can be admitted into proceedings. Ms Reid’s first point, therefore, was that no such direction had been given in these proceedings. She then went on to consider the form of the affidavits and noted that the documents had not been properly verified. Section 3 of The Commissioners for Oaths Act 1889 deals with ‘Taking of oaths out of England’ and reads:

“(1) Any oath or affidavit required for the purpose of any court or matter in England, or for the purpose of the registration of any instrument in any part of the United Kingdom, may be taken or made in any place out of England before any person having authority to administer an oath in that place.

(2) In the case of a person having such authority otherwise than by the law of a foreign country, judicial and official notice shall be taken of his seal or signature affixed, impressed, or subscribed to or on any such oath or affidavit.”

Notes to the above provision indicate that “Where the person administering the oath is not within sub-Section (2) above nor within the terms of RSC Ord 41 r12, verification of his authority is required;”.

Order 41 Rule 12 of the Supreme Court Practice 1997 deals with out of jurisdiction affidavits. In fact the Rule is headed ‘Affidavit taken in Commonwealth country admissible without proof of seal etc’. The ‘etc’ appears to cover a number of different situations including those not limited to Commonwealth countries. Six cases in particular are referred to. It is not, I think, disputed that it is the final category that is relevant. It reads:

“(6) affidavits sworn before a foreign official having authority to administer an oath in that place.”

with the footnote:

“Affidavits sworn under (1) to (5) do not require verification. But affidavits sworn abroad in non-Commonwealth countries, unless falling within (1), (4) or (5) will require certification from the local court.”

On the basis of the above it is said that verification from the local court was required for the opponents’ affidavits to be properly accepted. I note also that further guidance is given at 41/12/6:

“**Before foreign official** - By the Commissioners for Oaths Act 1889, s.3(1) any oath or affidavit required for the purpose of any Court or matter in England, or for the purpose of registration of any instrument in any part of the United Kingdom, may be taken or made in any place out of England before any person having authority to administer an oath in that place. The present practice is to require verification of the signature of a foreign official, authorised by the law of his country to take oaths, to be

made by the High Court of his country. In U.S.A. cases a certificate of the President and clerk of the country court verified by its seal has been accepted (*Cooper v. Moon* [1884] W.N.78).”

5 So far as is apparent the opponents’ affidavits were subscribed and sworn before notaries public but the necessary verification is not present. I should say in passing that in referring to the Rules of the Supreme Court I do not forget that it was held in *ST TRUDO Trade Mark* 1995 RPC 370 that these Rules had no part to play before the Registrar (though as was stated in that case the Registrar is a tribunal to which the strict rules of evidence apply). That
10 position recognises inter alia that procedure in the Registry is governed by its own separate Rules. However, it seems to me to be reasonable to take cognisance of the above provisions on the form and presentation of affidavit evidence not least because such evidence may, on appeal, need to withstand the scrutiny of the Courts.

15 A particular problem arises in relation to Mr Hathaway’s affidavit as it was subscribed and sworn before Martin B Schwimmer. Mr Schwimmer has filed an affidavit of his own in these proceedings and is an attorney with Weiss Dawid Fross Zelnick & Lehrman, the law firm which represents The Timberland Company in trade mark and unfair competition matters. The question, therefore, arises as to whether Mr Hathaway’s affidavit (if it were free of other
20 defects) should have been subscribed and sworn before him. My attention was drawn to Section 1(3) of the commissioners for Oaths Act which reads:

25 “(3) Provided that a commissioner for oaths shall not exercise any of the powers given by this section in any proceeding in which he is solicitor to any of the parties to the proceeding, or clerk to any such solicitor, or in which he is interested.”

and Order 41 Rule 8 of the Rules of the Supreme Court which reads:

30 “8. Without prejudice to section 1(3) of the Commissioners for Oaths Act, 1889, no affidavit shall be sufficient if sworn before the solicitor of the party on whose behalf the affidavit is to be used or before any agent, partner or clerk of that solicitor.”

35 Mr Morcom was firmly of the view that Mr Schwimmer did not fall foul of the above provisions because he is a US attorney and not a solicitor to a party in these proceedings or in any other way ‘interested’. The statutory provisions did not, therefore, in his view apply.

Notes to the Commissioners for Oaths Act comment as follows on the term “interested”.

40 “**Interested.** What is sufficient to amount to an “interest” in the proceedings is not defined. But so far as affidavits are concerned, RSC Ord 41, r 8, states before whom an affidavit should not be sworn, and Ord 75, r 16(1), forbids any commissioner taking bail on behalf of any person for whom he or his partner is acting as solicitor or agent.”

Some examples are given as follows:

45 “Affidavits sworn before partners of solicitors engaged in litigation on behalf of a client (*Duke of Northumberland v Todd*) (1878) 7 Ch D777, 47 LJ Ch 343), or before a

country solicitor, the “correspondent” of a litigant’s London solicitors (*Parkinson v Crawshay* (1894) WN 85) were held to be and still are insufficient.”

5 A note to Order 41 Rule 8 of the Rules of the Supreme Court also draws on the *Parkinson v Crawshay* case and comments on the term ‘proceedings’. It reads:

10 “**Effects of rule** - By the Commissioners for Oaths Act 1889, s.1, proviso (3) it is provided that a commissioner shall not administer any oath, etc., “in any proceeding in which he is solicitor to any of the parties to the proceeding, or clerk to any such solicitor, or in which he is interested.”

15 “Proceeding” in this proviso includes all matters comprised in the earlier part of the section and is not confined to litigious proceedings. So where one of the affidavits registered with a deed under the Deeds of Arrangement Act 1887 (now replaced by the Act of 1914) was sworn before the solicitor to the trustee of the deed, the deed was void (*Re Bagley* [1911] K.B. 317, CA) and similarly an affidavit taken before the solicitor to the grantee of a bill of sale invalidates the registration (*Baker v. Ambrose* [1896] 2 Q.B. 372).

20 Affidavits sworn before a country solicitor who was the correspondent of the London solicitor were ordered to be taken off the file (*Parkinson v. Crawshay* [1894] W.N. 85); but where the plaintiff, being a solicitor, was represented by independent solicitors, an affidavit sworn before his own clerk, who was a commissioner, was held admissible (*Foster v. Harvey (No. 1)* (1863) 11 W.R. 899). As to the duty of
25 commissioners when administering oaths, see observations of Kay J., in *Bourke v. Davis* (1889) 44 Ch.D. 110 at 126.)”

30 No other authorities have been drawn to my attention to assist in my reaching a view on the matter.

35 The opponents are a US company. Although it seems from the evidence that there is, now at least, a UK subsidiary the proceedings have been conducted in the name of the US company. Mr Schwimmer acknowledges that his firm represents the US company in trade mark matters. However, it is UK trade mark attorneys who have been prosecuting the case and, presumably, if this matter went to the Courts on appeal it would be UK solicitors who would be given
40 conduct of the proceedings. Technically, therefore, Mr Morcom may be right to say that Mr Schwimmer is not a solicitor to a party in these proceedings. But such a finding rests on a narrow interpretation of the words of the Act and in any case does not dispose of the objection that these are proceedings “in which he is interested”. The generality of the term ‘interested’ and the fact that it is not defined or interpreted in a restrictive manner (the interest is not confined to a financial one for instance) suggests that the spirit of the provision should be observed in terms of the underlying objectives which I take to include the avoidance of potential conflict of interests and preservation of the true independence of the notary. In this respect I note that in the *Parkinson v. Crawshay* case referred to above affidavits sworn before

a country solicitor who was the “correspondent” of a litigant’s London solicitors were held to be insufficient. It is not expressly said that Mr Schwimmer’s firm in the US were instructing principals in the matter before me though it is not unreasonable to suppose that they had some such role.

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The closeness of Mr Schwimmer’s involvement is also brought out by the fact that he has filed affidavit evidence of his own in support of the opponents’ case. Although not without hesitation, I have come to the view that there must be some doubt as to the sufficiency of evidence in these proceedings subscribed and sworn before Mr Schwimmer. Whilst I note Mr Morcom’s view that under Order 41 Rule 4 “an affidavit may, with the leave of the Court, be filed or used in evidence notwithstanding any irregularity in the form thereof” I doubt that I should rely on this provision in all the circumstances here even assuming that I have an inherent and analogous jurisdiction to follow such a course.

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As a yet further issue it is said that Mr Hathaway’s affidavit which is dated 14 November 1996 was not sworn when first filed. That defect was belatedly picked up by the Registry when the case was being made ready for a hearing. The notarised document appears to have been returned to the Registry towards the end of May 1999 but the date on the affidavit was not altered. There is nothing to suggest that this was anything other than an oversight but, of course, it occurs against the background of the other defects.

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I conclude from the above that the applicants have raised significant questions about the opponents’ evidence. It is, however, wholly unsatisfactory that such issues should be raised at the hearing. Strictly speaking I understand the opponents may have been alerted just prior to the hearing but this hardly allowed time for a full and proper consideration of the issues let alone for any corrective action to be taken.

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In the event I decided to take note of the criticisms of the evidence and to give a view thereon in my decision as set out above. It would clearly have been open to me to adjourn the hearing to have the defects in the evidence corrected or to have the issues aired at a preliminary hearing. In deciding to hear the parties on the substantive issues I had regard, inter alia, to the nature of the objections; the timing of the objections; whether the defects in the evidence were capable of correction; the additional costs and inconvenience to the parties of adjourning; and the possible difficulties I would be creating for an appeal tribunal in proceeding with the case. I have already indicated that the issues raised are significant albeit that they have only been identified late in the day. Importantly, however, I do not regard any of them as being incapable of correction.

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The notarisation of Mr Hathaway’s affidavit should in my view have been undertaken by someone other than Mr Schwimmer but I do not think anything more sinister should be read into it. The likelihood is, therefore, that the defects in the evidence could be corrected (and any necessary direction under Section 55 given). The case would then have been heard on substantially the same material. I intend, therefore, to deal with the substantive issues on the basis that all the evidence is in play (taking account of Ms Reid’s other criticisms as regards

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the content as opposed to the form of the evidence). However, in the event that the matter is appealed the opponents should in my view give consideration to putting right the points identified above or risk an appeal tribunal taking a more severe line now that the issues are in the open.

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I will deal firstly with the objection based on Section 10 of the Act.

This reads:

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“10. (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, or distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.”

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Mr Morcom’s submissions at the hearing were based on observations in Mr Axe’s declaration taken together with the fact that the word timberjack according to Webster’s Dictionary signifies a logger or lumberjack. It seems that lumberjack may have descriptive connotations either in relation to ‘lumber jackets’ (see Websters) or perhaps the slang term lumberjack shirts. I note that this application has been advertised as being in Part B suggesting that the Registry took some objection at the examination stage. No information has been filed to say what that objection was. Whatever objection might arise in relation to the term ‘lumberjack’ does not in my view necessarily carry over to the mark applied for simply because of the conceptual link. There is no evidence that the words TIMBER JACK have any descriptive significance to the public or the trade for the goods at issue. The opposition fails on this ground.

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The principal grounds of objection are under Sections 11 and 12. These sections read:

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“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.

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

S the same goods

S the same description of goods, or

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S services or a description of services which are associated with those goods or goods of that description.”

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

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The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

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(Under Section 11) Having regard to the user of the mark TIMBERLAND or TIMBERLAND and device (see note), is the tribunal satisfied that the mark applied for, TIMBER JACK, 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?

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(Under Section 12) Assuming user by the opponents of their mark TIMBERLAND in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark TIMBER JACK normally and fairly in respect of any goods covered by their proposed registration?

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Note Much of the usage shown by the opponents is of the following composite mark.

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I will deal with Section 12 first. Mr Morcom indicated at the hearing that he intended to rely on the two Class 25 registrations, that is to say Nos 1107755 and 1209696. Self evidently the latter has the broader specification covering as it does outer clothing at large. If the opponents do not succeed on the basis of this registration they would stand no better chance of success on the basis of No 1107755. At the hearing there was some argument at the margins as to the status of the element <articles of sports clothing' in No 1209696 and whether it was a stand-alone item or a supporting description in relation to the preceding term <footwear'. In my view it is the latter but the point is largely academic as the term outer clothing would encompass most, if not all, sports clothing. The applicants' specification consists entirely of items which would be classed as outer clothing with the possible exception of <vests'. However even this latter term can be used to signify a form of outer clothing akin to, or alternative to, a T shirt. In practice, therefore, I am unable to distinguish the applicants' goods from those covered by the specification of No 1209696. For the record I do not regard

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the applicants' specification (given the exclusion) as clashing with No 1107755. The matter, therefore, resolves itself into a comparison of the marks themselves, that is TIMBERLAND and TIMBER JACK. I was referred at the hearing to the well known test propounded by Parker J in Pianotist Co's application. I accept that this is the proper test to apply. The relevant passage reads as follows:-

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

Ms Reid's principal submissions were that there was no danger of confusion because the opponents' mark suggests a geographical description whereas the applicants' connotes an individual; TIMBER is an element common to a number of other marks; the opponents goods are expensive and sold mainly through their so-called concept shops thus trade channels were different. Mr Morcom rejected these submissions and reminded me that the test under Section 12 is a notional one and I should not be drawn into deciding the matter on the basis of what may or may not be the position in the marketplace hitherto. I accept that Mr Morcom was correct to say that I must bear in mind what it will be open to the applicants to do if they secure a registration (and indeed what the opponents are free to do). I also reject the applicants' submission based on the conclusion in Mr Axe's declaration that the Registry was willing at the examination stage to "consider the word TIMBER as lacking in distinctiveness ..." and hence by implication that attention should be focussed on the second elements of the respective marks. I will comment briefly below on the related state of the register arguments but there is no evidence or explanation as to why the element TIMBER merits less attention because it is in some way lacking in distinctiveness. In my view that is simply not the case. On the contrary I regard it is a strong and important element of both marks. Reference has been made in the evidence and at the hearing to various other TIMBER- marks that is TIMBERMAN, TIMBERWEAR and MINNESOTA TIMBERWOLVES and device. The opponents say they have acquired the first of these by assignment and are attacking the second by means of a revocation and invalidity action. The third of the marks is apparently in the ownership of a Basketball Association and the opponents are aware of the sports goods franchising context in which it is used (whether it is in use in the UK is not clear). Moreover it is a composite mark incorporating a device. More significantly the state of the register is only likely to be a persuasive argument against the risk of confusion if it is shown that a number of marks with a common element are in different ownership and are also in use (see Beck Koller 64 RPC 76). No such information is before me.

Turning to my own consideration of the marks I have no doubt that they can be distinguished visually and aurally if seen or heard together. But it is well established (see for instance

De Cordova v Vick 1951 RPC 10) that customers rarely meet marks under such conditions. I have already indicated that I regard TIMBER- as a strong and memorable element. The fact that it is also the first element of the respective marks adds weight to the opponents' concerns (see TRIPCASTROID 42 RPC 264). I take Ms Reid's point about the conceptual differences implicit in the marks but that argument is something of a two-edged sword as both marks suggest something to do with a particular subject namely timber. I am not persuaded that any conceptual difference removes any risk of confusion. However trade marks are for use in the marketplace not as subjects for abstract debate. Whilst it is sometimes necessary to rationalise and give expression to factors influencing one's views of marks it is at the end of the day the likely impact of marks on customers that must be the guiding consideration. In that respect I remain concerned that imperfect recollection of the totalities combined with the strength of the first elements may result in confusion particularly where goods are being purchased on the basis of imperfectly remembered recommendation or parents purchasing for children say. The onus is on the applicants to persuade me otherwise. In the event they have failed to do so and I am of the view that a sufficient number of persons will have cause to wonder whether the goods emanate from the same trade source and that that risk poses a real tangible danger of confusion. It also follows that I do not accept the applicants' submissions that confusion will not arise because the parties operate in different areas of the clothing trade as evidenced by the product pricing. It is both difficult to segment markets in this way and inconsistent with the notional nature of the test. The opposition, therefore, succeeds under Section 12.

My finding under Section 12 effectively decides the matter but I will deal briefly with the objection under Section 11. I emphasise that the following views assume that the content of the evidence stands (and setting aside for the moment the problems as to the form of the evidence). Clearly if it were held on appeal that the evidence should have been struck out (without giving the opponents the opportunity to address the defects) then the Section 11 case would of necessity fall away.

Both Counsel took me through what they considered to be relevant parts of the evidence in some detail. Most of the opponents' use appears to be of the mark TIMBERLAND in association with the stylised tree device (hence my formulation of the above test). I indicated at the hearing that my provisional view was that the use of the device did not greatly alter the position. Although often presented as if it were part of a composite mark it is in fact annotated to show that it, and the word, are separately registered. The opponents would say that the device reinforces the 'timber' theme. The applicants can say that it is a differentiating feature. In my view the arguments cancel each other out and the presence or otherwise of the device is not a major determining factor. Mr Morcom did, however, suggest that under Section 11 I should take into account his clients' use of their mark on footwear (a rather longer standing trade) as supporting the use on other forms of clothing.

Mr Reid offered some robust criticism of the content of the opponents' evidence. Her main points were that:

- S the declarants do not always make their own position clear or what the source of specific pieces of information is other than by the customary introductory statements that they have access to relevant books and records

S some of the material relates to the period after the relevant date (Mr Morcom acknowledged the point and did not rely on this part of the evidence)

5 S the invoice evidence provides only limited substantiation of clothing sales (other than footwear that is)

S Ms Wineberg offers estimated sales figures only for the UK based on percentage sales of apparel and accessories worldwide

10 S other aspects of the evidence amount to hearsay. Thus, for instance, Ms Wineberg can only point to her understanding as to the distribution of product catalogues.

15 I accept there are weaknesses in the opponents' evidence but in my view a sufficient amount survives for me to come to a view on the matter. Thus there are undeniably invoices in Mr Hathaway's Exhibit 2 dating from 1988 covering items such as shirts, coats, jackets, hosiery. Exhibit 20 contains copies of magazine articles from 1989 referring to the launch of a clothing collection and "last year they [Timberland] designed a collection of men's sportswear" (presumably placing it sometime in 1988). The first concept shop also appears to date from about this time. Exhibit 3 to Ms Wineberg's affidavit consists of Timberland catalogues dating 20 from 1989. I acknowledge Ms Reid's point that Ms Wineberg is only able to refer to her understanding as to the distribution of the catalogues. However the catalogues have either a list of export customers which include Atoc Industrial Ltd in the UK or refer to Timberland (UK) Ltd as a distributor. Taken together with the invoice evidence which shows goods sold 25 to or through these companies I find that the evidence is internally consistent and that sales of clothing were being made from 1988.

I share Ms Reid's concern about the 'guesstimate' nature of the UK sales figures. Nevertheless even allowing for this the figures (£3.8 million in 1991) are not insignificant and it would be 30 perverse, taken with the other evidence, to say that they should be completely discounted. Within the context of the BALI test I find that the opponents have established priority of user and that, given my views on the marks, there is a risk of confusion. Although no actual instances of confusion have been cited I cannot draw any conclusions from this in the absence of information about the applicants' use. In the circumstances I do not need to consider 35 Mr Morcom's supporting argument based on the proposition of a natural extension of trade (and therefore reputation) from footwear to clothing. In short the opponents succeed under Section 11. The only qualification I would offer to this general finding is that it appears to be a feature of the opponents' advertising that they offer quality clothing for rugged outdoor use. Whether confusion would extend to certain items in the applicants' specification, in particular 40 swimsuits and beachwear, is perhaps debatable but given my finding under Section 12 I do not propose to reach a firm conclusion on this point.

Finally two points arise under Section 17. The first is the claim that the applicants had no bona fide intention to use the mark as two words. This is based on an example of the 45 applicants' goods at Exhibit 21 to Mr Hathaway's affidavit showing TIMBERJACK as a single

word. The opponents say that such usage further aggravates the problem. This is countered by Exhibit AJA 02 to Mr Axe's declaration which shows a restyled version of the mark with TIMBER and JACK as separate words one below the other.

5 It is not said precisely when or why the change was made apart from the fact that it gives "a better appearance". There is simply insufficient information for me to reach the conclusion the opponents would have me accept.

10 Under Section 17(2) as a matter of discretion the opponents have drawn attention to the fact the applicants were at one time using the ® symbol in conjunction with their earlier mark. It was an offence under Section 60 of the Trade Marks Act 1938 to falsely represent a trade mark as registered and continues to be an offence by virtue of Section 95 of the Trade Marks Act 1994. Mr Axe in his declaration says that it was an innocent error and Ms Reid indicated at the hearing that the applicants had desisted from the practice. The symbol was not present
15 in the mark applied for. Without seeking to determine whether the applicants are at risk as a result of their past behaviour I do not think I have a sufficient basis for a finding against them in relation to the current application.

20 As the opponents have been successful they are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £835.

Dated this 5 day of July 1999

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

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ANNEX

No.	Mark	Class	Journal	Specification	
5	1564859	TIMBERLAND	03	6044/05998	Cosmetics and cosmetic preparations; soaps and shampoos; perfumery, essential oils, lotions, skin care preparations; non-medicated toilet preparations; deodorants and anti-perspirants; detergents, cleaning, scouring and polishing products and preparations; all included in Class 3.
10					
15	1379092	TIMBERLAND	14	5836/04808	Horological and chronometric apparatus and instruments; clocks and watches; cases, parts and fittings for all the aforesaid goods; watch chains, bands and straps; smokers articles, cigar boxes, cigarette holders, match boxes, boxes and containers; tie clips, tie pins, cuff links, bracelets, brooches, jewellery and jewellery charms and pins, necklaces, buckles and shoe ornaments, all being of precious metal or coated therewith; all included in Class 14.
20					
25					
30	1429425	TIMBERLAND	16	5955/09298	Paper, cardboard and goods made from these materials; printed matter; photographs; stationery; office requisites; brochures; booklets; books; manuals; periodicals; pamphlets; posters; bookbinding materials; plastic materials for packaging; boxes of cardboard or paper; calendars; loose-leaf binders; bags of paper or plastic; pens; pencils; all included in Class 16; but not including any goods relating to timberland or for use in relation to computer software.
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45					

No.	Mark	Class	Journal	Specification	
5	1346684	TIMBERLAND	18	5791/05166	Leather, imitation leather and articles made from these materials; boot liners, leather laces, leather leashes, leather thongs, leather thread, belts, purses, wallets, briefcases, attache cases, bags, haversacks, trunks, luggage; umbrellas, parasols, walking sticks, whips, harnesses, saddlery; all included in Class 18.
10	1107755	TIMBERLAND	25	5307/00913	Boots, shoes and slippers.
15	1209696	TIMBERLAND	25	5567/01210	Articles of outer clothing and T-shirts; footwear, being articles of clothing and articles of sports clothing.
20	1523812	TIMBERLAND	28	6011/00714	Discs; sporting articles; games; all included in Class 28.