

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

**IN THE MATTER OF APPLICATION NO: 1574071 BY  
SCOTT LEATHERS INTERNATIONAL LIMITED  
TO REGISTER A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO: 43409 BY SCOTT USA INC**

**BACKGROUND**

1. On 3 June 1994, Scott Leathers International Limited applied to register the mark shown below in Class 25 of the Register:

**SCOTT LEATHERS**

2. Following examination, the application met with objections under sections 9 & 10 of the Trade Marks Act 1938 because the mark consists of the common surname “Scott” combined with the description “Leathers”. The applicant filed evidence intended to establish that the mark was adapted to distinguish its goods because of the use made of the mark. As a result the application was advertised before acceptance in Part A of the Register, under the proviso to Section 18(1) of the 1938 Act.

3. The published specification of goods is as follows:

‘Jackets, trousers, one-piece and two piece suits; anoraks, t-shirts and gloves; shirts and trousers all for motor-sports; all for men, women and children; all included in Class 25’.

4. The application is opposed by Scott USA Inc. The grounds of opposition are under:

- i) Sections 9 & 10 of the Act, as the mark applied for is neither inherently adapted to, or capable of, distinguishing the applicant's goods.
- ii) Section 11 of the Act because the mark applied for would be deceptive if used on goods not made of leather.
- iii) Section 11 of the Act on the alternative ground that the opponent is the proprietor of SCOTT mark that is well known in the UK and elsewhere in relation to a range of motorcycle and skiing accessories. As a result of this use, the opponent says that it has built up a worldwide reputation and goodwill in the mark SCOTT, and contends that use of the mark applied for would be likely to deceive or cause confusion or otherwise be disentitled to protection in a court of justice.
- iv) Section 12(1) of the Act because of the existence of three trade marks registered in the name of the opponent.
- v) Section 17(1) of the Act because the applicant cannot properly claim to be the proprietor of the mark applied for. In this connection the opponent contends that the applicant's use of the mark applied for has not been bona fide or honest.
- vi) Section 17(2) of the Act because registration of the mark applied for would interfere with the legitimate conduct of the opponent's business and ought to be refused in the exercise of the Registrar's discretion.

5. The applicant filed a counterstatement in which the existence of the opponent's registered trade marks is admitted, but all of the grounds of opposition are denied. Both sides ask the Registrar to exercise her discretion in their favour and award costs accordingly.

6. The matter came to be heard on 27 June 2000. The applicant was represented by Mr D Campbell of Counsel instructed by Urquhart Dykes & Lord. The opponent was represented by Dr H Lawrence of Counsel instructed by R G C Jenkins & Co.

7. By the time the 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 remainder of this decision are references to the provisions of the old law.

### **Opponent's Evidence-in-Chief**

8. The opponent's evidence-in-chief consists of four Statutory Declarations. The first dated 23 September 1996, is by Robert Pearson Harkins. Mr Harkins explains that he is the Director of Bert Harkins Racing Limited, who are the distributors of the opponent's goods in the UK. The main points that emerge from Mr Harkins' declaration are as follows:

- i) The business carried on by the opponent was originally founded in the USA in 1959. The company's main activity at that time was the development and sale of ski poles. The opponent entered the motorcycle accessories market in the USA in 1972, selling off-road motorcycle goggles. During the period 1972-1978, the opponents held 90% of the US off-road motorcycle goggles market.
- ii) The opponent officially entered into the UK market with their goggles and other motorcycle related products in 1979. It was at this time that Mr Harkins' company was appointed as their distributor. In the "early years" the opponent used the name SCOTT USA. Mr Harkins says that the opponent's product range, in addition to goggles, included face masks, t-shirts, baseball caps, sweat bands and wallets. Exhibit RPH1 consists of three brochures showing the mark SCOTT in use in relation to a range of goods. There is no claim that these particular brochures were circulated within the UK prior to the relevant date.
- iii) The opponent says that its use of the mark SCOTT in the USA, combined with the appearance of the mark in a range of articles in specialist motorcycling magazines (such as Motor Cycle News, Motorcycling, Dirt Bike Rider etc) meant that the mark was already well known in the UK (for motorcycle goggles) by those in the motorcycling fraternity, prior to the opponent officially entering the UK market.

iv) While sales of the opponent's goods were initially made nationwide to motorcycle shops catering particularly for motocross and other off-road riders, Mr Harkins states that, within months, the opponent's goods were being sold to more general motor cycle shops, in particular to those catering for the ordinary road going motorcyclist.

v) The opponent is also said to have supplied a range of motocross boots. These were subsequently discontinued. It is not clear when sales of these goods began or finished. The extent of any sales is also unclear. The name SCOTT is also said to have been used on a range of gloves, sold "since the early 1980's" and on casual (or "Paddock") jackets "since the late 1980's."

vi) Mr Harkins states that sales of SCOTT branded goods sold through his company has been in excess £7.4 million retail value. He says that annual UK turnover in the last five years (1991-1996) amounted to between £2.5 and £3 million. Of these sales, 50% are said to relate to goggles and lenses, 10% to face masks and body armour, and 40% to clothing merchandise such as t-shirts, baseball caps and sweat bands.

vii) The opponent subsequently expanded its range to include a range of bicycles and associated accessories. Mr Harkins says that this was a logical extension of their off road range since there is a close similarity in terms of accessories such as gloves, goggles, and handlebar grips. Approximately £20,000 per year is said to have been spent on advertising and promoting the SCOTT mark. Examples of advertisements placed in a number of motorcycle and cycle magazines, together with a range of promotional materials are shown at exhibit RPH3. The magazines concerned appear to be aimed at the off-road market. They include "Dirt Bike Rider" and "Trials Motocross News". The advertisements for 1993 include goggles, gloves, sunglasses and handlebar grips.

viii) The opponent has sponsored professional riders in the UK in various forms of off-road sport, principally, Speedway and Motocross.

9. Mr Harkins states that there is a degree of cross over between the goods used in on and off road motor cycling. He claims that, although superior "full face" helmets were introduced in the late 1960s they were

considered to be relatively expensive and some road riders continued to wear “open face” helmets with goggles. He also says that some road riders like to wear motocross boots and motocross gloves in the summer months. He adds that people who own or ride a motorcycle tend to be fairly knowledgeable and relatively well informed as to what goods are available. In view of this, Mr Harkins concludes that the vast majority of motorcyclists will at some time have come into contact with the opponent's goggles or other accessories.

10. Mr Harkins comments on the nature of the applicant’s use of their mark, which he says has always carefully shadowed the get-up and style used by Scott USA, and he refers to a range of usages which he feels supports this contention. Exhibit RPH5 contains examples of the applicant’s use of the mark. Finally, Mr Harkins states that there have been numerous instances of actual confusion, and as examples of this, he cites (unnamed) members of the public telephoning his office to ask if the applicant's products were an extension of the opponent's range of goods.

11. The second, third and fourth declarations are from Joan Sutton Waind, Vaughan Semmens and Martin Cooke, all of whom are involved in the retailing of off-road motorcycles and their associated accessories. All three individuals comment that their customers have been confused by the applicant’s and opponent’s marks. In particular, Ms Waind comments that the problem is worsened by the fact that the logos of the two companies look so alike.

### **Applicant's Evidence-in-Chief**

12. This consists of two Statutory Declarations. The first dated 12 June 1997 is by James Millar Aird who is the Managing Director of Scott Leathers International Limited, the applicant for registration. The main points emerging from Mr Aird's declaration are as follows:

i) The mark SCOTT LEATHERS was first adopted in November 1983. Prior to that, Mr Aird was a Director of TT Leathers of County Durham, which went into liquidation in 1983. When TT Leathers went into liquidation, Mr Aird says that it enjoyed a considerable reputation in the market place in connection with motorcycle leathers. Following the liquidation of TT Leathers, a new company was set up in 1983 to manufacture motorcycle leathers.

(ii) Following discussions with Tom Walker (previously of TT Leathers) and at the time of

Eurohelmets Limited (who were to distribute the new company's leathers), the name SCOTT was suggested. The name was chosen because it would remind the public that Mr Aird was a Scot. The double 'T' was adopted as a sign that the new company was linked with TT Leathers, which was still highly regarded.

(iii) Although Mr Aird was aware of Scott USA at the time the name was chosen, in his view, the opponent's reputation was limited to goggles for off-road use. Although the opponent may have distributed a range of promotional clothing, in Mr Aird's view, this was primarily fashion clothing and would not be regarded as similar clothing to leathers.

(iv) Mr Aird states that when the name SCOTT LEATHERS was adopted the opponent (via Mr Harkins) was aware of his company's activities and did not raise any objection. He adds that Mr Harkins company was a customer of the applicant. Exhibit JMA.1 is a copy of an invoice dated 20 June 1987 to Mr Harkins' company relating to the repair of a jacket by the applicant.

(v) The applicant has used the mark SCOTT LEATHERS continuously since November 1983 throughout the UK. In the ten year period prior to the filing of the application, turnover under the mark had increased from £ 110,000 in 1984, to £1m in 1993. Total turnover in the period amounted to approximately £5.6 million.

(vi) Mr Aird states that the applicant promotes the mark by way of advertisements, brochures, pamphlets and by sponsoring motorcycle riders. However, no figures are provided for promotional spend. There is no evidence of adverts being placed in magazines. Examples of promotional material are provided in exhibits JMA2, JMA4, and JMA5. At exhibit JMA3, are examples of swing tags, woven labels, stickers etc showing the manner in which the mark is used. The presentation of the letters TT varies from two single letter 'T's, to TT shown with the tops of the letters T joined. The mark is shown in a range of colour schemes, the most common being red, blue and silver, magenta on black and yellow on magenta and black.

vii) Mr Aird further states that approximately 80% of the applicant's activities relate to the on-road market. Most of the exhibits are consistent with this claim although, perhaps significantly, they include a 1994 catalogue for off-road products.

viii) Mr Aird claims that leathers are protective clothing made usually from leather, but may also be made from other materials such as nylon or kevlar. He claims that, although leathers can be worn in both on-road and off-road sectors, they are generally more appropriate to the on-road sector.

12. The second declaration, dated 5 June 1997, is by Thomas Black Walker. Mr Walker explains that he is currently employed by Hein Gericke (UK) Limited. He is the same Thomas Walker mentioned in Mr Aird's declaration above, and was previously the Sales Manager at TT Leathers before they went into liquidation. He says that he was involved in discussions with Mr Aird about the name for the new company at the time that it was chosen. He supports Mr Aird's explanation of the manner in which the name SCOTT was chosen by the applicant in 1983. He also states that:

“Leathers is the term used to describe clothing worn by motorcyclists, consisting usually of jackets and trousers of durable material (often of leather but other similar materials are often used) intended to reduce the risk of injury if a motor cyclist should, for example, fall onto the road while travelling at speed.”

He says that leathers are mainly worn in the on-road sector of the motorcycle market. In Mr Walker's opinion, the on-road and off-road sectors of the motorcycle market are “generally divided into two relatively distinct sectors.”

13. Mr Walker is of the view that on-road motorcyclists would not “for a number of reasons including reasons of style” use off-road ski-type goggles. He says they would use full face helmets or open helmets with traditional goggles.

### **Opponent's Evidence-in-Reply**

14. This consists of a further statutory declaration by Robert Harkins. The main points emerging from Mr Harkins second declaration are as follows:

i) In so far as the applicant alleges that Mr Harkins was aware of the name Scott Leathers and raised no objections, Mr Harkins says that this is not true. In addition to speaking to Mr Aird at the time, Mr Harkins explains that the matter was brought to the attention of the opponent through their European subsidiary Scott Europe. One of the reasons that the opponent took no action at that time,

was that the business of Scott Leathers was limited to selling leather jackets and suits to road going motorcyclists. This meant that “Scott Leathers were not in direct competition with Scott USA in terms of either their products of their target market.”

ii) In so far as the applicant implies that Mr Harkins used to trade in Scott Leathers, this is he says an exaggeration. His link with Scott Leather was only as a result of an existing business relationship with Eurohelmets (who took on the distribution of Scott Leathers). Mr Harkins states that he has never stocked any Scott Leathers clothing, but has obtained such goods from the applicant to meet specific requests from customers.

iii) The suggestion that the term "leathers" covers protective clothing in general is misleading. While motorcyclists do wear clothing made of other materials such as nylon, the term "leathers" would be understood as goods made predominantly of leather. Leather is preferred as it provides better abrasion resistance qualities. Nylon would be worn principally to protect from wind and rain. Mr Harkins says that Mr Aird's reference to other non-leather materials with anti-abrasive qualities, such as Kevlar, is misleading because he does not believe that the applicant was marketing such suits in June 1994.

iv) In so far as the distinct nature of the on-road and off-road markets are concerned, Mr Harkins agrees that this was the case in the 1980s. However, in Mr Harkins' opinion, this is no longer the position and the distinction between the respective markets has become increasingly blurred. He adds that there are now publications which cater for both sectors, and at exhibit RPH3, he provides examples of BIKE and MOTOR CYCLE NEWS publications (both of which are dated well after the relevant date). Page 39 of BIKE shows an off-road motorcycle rider wearing a nylon suit bearing the applicant's SCOTT LEATHERS mark and goggles and gloves bearing the opponent's SCOTT mark.

(v) Mr Harkins adds that confusion can (and has) occurred at trade shows and fairs where both the applicant and the opponent has been represented. He cites examples of his experience at the Dirt Bike Show 1996 where he personally received many comments and enquiries both from the general public and the trade, as to whether the opponent had brought out a range of off-road clothing.

(vi) Although goggles were the opponent's best known product in 1983 (when the applicant's mark



was adopted) the opponent had been selling a range of beanie hats, baseball caps, anoraks and bags in the UK under the SCOTT brand since 1978, and SCOTT t-shirts since 1980. Retail turnover in these items is claimed to have amounted to some £140,000. In addition, SCOTT gloves had been marketed in the UK since 1980 with turnover amounting to some £330,000.

15. That concludes my review of the written evidence. Mr Aird attended the hearing for cross examination, primarily because the honesty of his use had been put in issue by the opponent. Throughout the cross examination Mr Aird stuck quite closely to the position set out in his written evidence. I shall return to particular aspects of the cross examination and certain additional explanations he provided at the appropriate points in my decision.

## **DECISION**

16. At the outset of the hearing Mr Campbell asked me to consider both the original specification and, in the alternative, an amended specification of goods. He initially suggested that the latter would consist of the original specification of goods (as set out in paragraph 3 above) amended by the addition of the limitation "all for on- road use by motorcyclists as protective clothing against abrasion". However, he later suggested that the amended specification should be:

"Jackets, trousers, one piece and two piece suits; anoraks; shirts and trousers all for motor sports; all for men, women and children; all adapted for on-road use by motorcyclists as protective clothing against abrasion; all included in Class 25."

I do not understand how 'anoraks' can be adapted to fulfill the purpose indicated by the proposed limitation. However, I do not need to decide what to do about that particular point because there is, as I explained to Mr Campbell at the hearing, another more substantial difficulty with the limitation proposed.

17. Although clothing generally falls into Class 25, the Registrar's practice in June 1994 was (and still is) to classify articles of clothing for protection against accidents in Class 9. This is consistent with the Guide to International Classification of Goods and Services under the Nice Agreement. The explanatory note to Class 25 of the sixth edition of this publication (first published in 1992) explains

that whilst clothing is proper to Class 25, that class does not include, in particular, “certain clothing and footwear for special use.” These uses are listed in the alphabetical list of goods. Entry C0559 in Class 9 lists 'clothing for protection against accidents, irradiation and fire'. Protective clothing for wear by motorcyclists for protection against abrasion must fall within the term 'clothing for protection against accidents'. The Registrar classifies these goods in Class 9.

18. The applicant's specification contained a limitation 'all included in Class 25' at the time of filing. The question therefore arises whether the applicant can add a 'limitation' which has the effect of importing goods into the specification which the Registrar does not consider proper to Class 25.

19. Mr Campbell suggested that multipurpose products could be classified in all the classes that correspond to each of their functions. In putting this submission forward he no doubt had in mind paragraph 1(b) of the general remarks to this effect on page 5 of the International Classification of Goods and Services (sixth edition). However, it is clear from paragraph 1 of these guidelines that the remarks in paragraph 1(b) only applies to goods which cannot be classified in accordance with the list of classes or with the alphabetical list. The goods in question are specifically catered for in the alphabetical list of goods in the International Guide. Further, even though leather jackets (for example) can be classified in Classes 9 & 25 (depending upon whether they are primarily for protection against accidents), that does not mean that a description of the intended purpose consistent with classification of the goods in Class 9 can be added to a specification of goods which is limited by the term “all included in Class 25.”

20. The effect of the limitation “all included in Class ...” has been considered in the recent past. For example, in *British Sugar Plc v James Robertson & Sons Ltd* (1996 RPC 286 at 289, lines 13 to 44), Jacob. J had to interpret the significance of the words 'all included in Class 30' in deciding whether dessert sauces in a registration in Class 30 were identical or similar to the defendant's spread product. He decided that the goods were not identical, inter alia, because the Registrar did not classify the defendant's spread product in Class 30 at the time of registration.

21. Section 3 of the Act is as follows:

A trade mark must be registered in respect of particular goods or classes of goods, and any

question arising as to the class within which any goods fall shall be determined by the Registrar, whose decision shall be final.

The Registrar's decision on this point therefore appears to be final.

22. Mr Campbell did not ask me to consider the deletion of the words "all included in Class 25" from the applicant's specification so as to allow the application to be re-classified in Class 9. I think he was right not to do so. It is true that Section 17(7) of the Act provides that:

The Registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application on such terms as the Registrar or the Board of Trade or the Court, as the case may be, may think fit.

This appears to give the Registrar a broad discretion to allow the applicant to amend his application. However, I cannot envisage any circumstances which would persuade me to allow the amendment of an application, some six years after it was filed, which would have the effect of importing goods into the specification that were not covered at the time of filing.

23. I therefore conclude that:

- (i) Class 25 does not cover clothing adapted for use by on-road motorcyclists in protecting them from abrasion in the event of an accident;
- (ii) the application cannot therefore be amended so as to include such goods within the scope of a specification already limited by "all included in Class 25";
- (iii) the application cannot be transferred to Class 9.

24. I shall therefore consider the opponent's grounds of opposition with regard to the published specification. I first consider the grounds of opposition under Sections 9 and 10 of the Act. Sections 9 and 10 of the Act are as follows:

9.-(1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purpose of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish 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.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which -

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

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, of 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 the limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

25. The mark SCOTT LEATHERS clearly does not fall within sub paragraphs (a) to (c) or (e) of Section 9(1). Nor does it appear to fall within paragraph (d) of Section 9(1). The word SCOTT is self evidently, according to its ordinary signification, a common surname. The word LEATHERS is obviously a description of a material from which clothing can be made. In the absence of evidence of

use of the mark it is, in my view, clearly excluded from registration by Section 9(1). I see nothing in the combination of the surname SCOTT and the description LEATHERS that would enable the mark to qualify for prima facie registration under Section 10 either. Similar applications have been rejected in the past. See, for example, *Wacker-Chemie (1957 RPC 278)*, where the court held that the combination of even a foreign surname with a description of goods was not capable of distinguishing within the meaning of Section 10 of the Act. The Courts have repeatedly held upon grounds of public policy that a trader ought not to be able to get a monopoly under the Trade Marks Act 1938 (and its predecessors) in what other traders may legitimately wish to use (*per Lord Parker in the W & G case 1913 30 RPC at page 472*). Absent any common law rights, any other trader called “Scott” who trades in leather goods has a legitimate reason to use the words “Scott Leathers.”

26. The applicant faced such objections at the time the application was examined. Evidence of use of the mark was filed in order to show that the mark was in fact adapted to, or at least capable of, distinguishing the applicant's goods because of the use that had been made of it. It is clear to me from the applicant's evidence that the use that has been made of the mark is in respect of protective clothing. The amended specification is meant to reflect this. This was confirmed by Mr Aird during cross examination. It follows from this finding that there has been no use of the mark in respect of any goods that fall within the specification set out within the application.

27. Dr Lawrence initially argued the case under Sections 9 and 10 on the footing that the word 'leathers' is merely descriptive, and the word 'Scott' is not distinctive of the applicant because it distinguishes the goods of the opponent. That case was bound to fail because, as Mr Campbell rightly pointed out, it is an objection that should properly be raised under Sections 11 and/or 12 of the Act because it depends upon earlier use and/or registration of the opponent's trade mark. Once the difficulty with the applicant's specification became clear at the hearing, Dr Lawrence shifted her attack to the absence of any evidence of use of the mark in relation to the goods covered by the Class 25 application. In the light of my earlier findings that objection succeeds. The application has not yet been accepted by the Registrar, and now that it has come to light that the applicant's user does not correspond with the specification of goods applied for, there is an overwhelming case for concluding that the prima facie objections to the application should stand and that the application should be refused.

28. It could be argued that the applicant's user in respect of protective clothing that falls in Class 9 is a circumstance that should be taken into account under Sections 9(3)(b) and 10(2)(b) in assessing whether the applicant's trade mark was adapted or capable of distinguishing the clothing that is covered by the application. In my view it is not. The applicant's goods are, according to Mr Aird, highly specialised items of protective clothing. He says that leathers are not similar to fashion clothing. Use of the mark in respect of such protective clothing cannot therefore be expected to convey a distinctive character on the mark in respect of the sort of clothing that falls in Class 25. The Opponent's grounds of opposition under Sections 9 & 10 therefore succeed. Further, given that the applicant's past use has been in respect of goods that are not covered by the application, and there is no suggestion that the applicant intends to use the mark in respect of different goods in the future, there is a clear case for the refusal of this application in the exercise of the Registrar's discretion under Section 17(2) of the Act because the application does not comply with the provisions of Section 17(1). There was no use or proposed use of the mark in respect of relevant goods at the material date.

29. In the light of these findings there is no need for me to go on and address the other objections. However, given that the case has gone this far and the issue of the honesty of the applicant's use has arisen, I think it would be helpful if I were to give an indication of my likely conclusions if the application could have proceeded in the correct class for the goods of real interest to the applicant. I believe that these goods can, best be described as "suits, jackets and trousers, all being protective clothing for use by on-road motorcyclists for protection against injury from abrasion."

30. The first point to consider is whether the mark is likely to deceive or cause confusion if used in respect of goods within this description that are not made of leather. This objection goes to Section 11 of the Act which is as follows:-

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.

31. It is evident from cases such as CHINATHERM (1980 FSR page 21), to which Dr Lawrence drew my attention, that a trade mark may be deceptive if it mis-describes the material from which the goods

are made, at least where the material is likely to be of significance to the purchasing public or a significant proportion thereof. The ordinary meaning of the word 'leather' is clear and requires no further elaboration from dictionary references etc. The applicant's case is that, in the trade, the term 'leathers' describes protective clothing for motorcyclists, whether it is made from leather or not. The evidence of Mr Walker is intended to support the applicant's contention. It appears to be common ground that leather has good anti-abrasive qualities and is mainly worn for road use or road racing use. Given this and the clear ordinary meaning of the word "leather", I would require considerable persuasion that the use of the mark "Scott Leathers" in respect of articles of protective clothing for motorcyclists that are not made of leather, was not likely to lead to confusion or deception amongst the public. The closest the applicant gets to any independent evidence on this point is the evidence of Mr Aird's ex-business colleague, Mr Walker. Mr Walker says that 'leathers' are often made of leather but that other similar materials are often used. It is not clear whether his evidence reflects the position in June 1994 (which is the date at which I must decide the matter). Against this, Mr Harkins, for the opponent, says that the term 'leathers' will be understood as meaning goods made predominantly of leather. There is no evidence from ordinary users of motorcycle leathers, which might have helped to establish the ordinary consumer's view of the matter.

32. It is well established that the onus is on the applicant to show that use of his mark is not likely to result in confusion and deception. I do not believe that the applicant's evidence is sufficient to displace my provisional view that, prima facie, the mark is inherently deceptive if used on non-leather protective clothing. The result of this finding is that, even if the application had been able to proceed in Class 9, it could only have done so with an appropriate limitation to the specification of goods.

33. The opponent's remaining objections under Sections 11 and 12 are based on the opponent's earlier use and registration of the mark SCOTT in the UK. A prerequisite for success under Section 12 is that the respective goods are either the same or "of the same description." This comes from the wording of Section 12 (1) which is as follows:

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

i) the same goods

- ii) the same description of goods, or
- iii) services or a description of services which are associated with those goods or goods of that description.

34. The opponent has the mark SCOTT registered in Class 9 in respect of :

Goggles and protective face masks (other than sporting articles), all for motorcyclists; ski goggles; lenses for motorcycle and ski goggles.

35. It has the same mark registered in Class 28 in respect of:

Sporting articles (other than clothing) for use in ski-ing; ski gloves.

36. The opponent has a further registration in Class 12 in respect of bicycles and parts and fittings, but this does not seem relevant because it does not cover any goods which could even arguably be regarded as being “of the same description” as the goods covered by the sort of protective clothing for which the applicant seeks protection. The only item within the Class 28 registration which could possibly be argued to be goods of the same description as these goods is "ski gloves". The applicant’s original specification covered gloves in Class 25 but there is no evidence the applicant has ever used its mark in respect of protective gloves. These goods were not included within the final version of the amended specification put forward by Mr Campbell at the hearing.

37. In order to decide whether the respective goods are of the same description, I adopt the approach set out in *Jellinek's Application (1946 63 RPC 59)*. This requires me to consider the nature, purpose and channels of trade of the respective goods. Protective jackets, trousers and suits for on-road motorcyclists are specialist products for use by motorcyclists. Ski gloves are a sports product. Their nature is partly the same (clothing) but mainly different. Although ski gloves are, to some extent worn for protective purposes, they are primarily intended to keep the hands warm and dry whilst allowing the user to grip effectively through the glove. The channels of trade for ski gloves are likely to be different to the channels of trade for protective wear for use by on-road motorcyclists. I conclude that these goods are not of the same description.

38. The opponent’s Class 9 registration covers "goggles and protective face masks (other than sporting



articles), all for motorcyclists." Protective face masks appear to be articles that are mainly worn for off-road use. The evidence suggests that certain types of goggles can be worn on-road and off-road but that the use of goggles for on-road use has become much less common with the advent of full face motorcycle helmets. The position would not appear to have been much different in 1994. Consequently, although it is probably true to say that there is some overlap between the respective channels of trade, that overlap does not appear to be great. In this connection, I note all three of the opponent's trade witnesses testifying to instances of confusion within their knowledge are traders in off-road motorcycle accessories. The respective goods are different in nature. Motorcycle goggles and face masks are eye wear and headgear respectively, whereas the protective jackets, trousers, and suits that the applicant seek protection for are designed to cover the body. The evidence shows that such goods are generally made from leather whereas goggles and face masks are likely to be made of other materials (although goggles could have leather straps). The purpose of goggles and face masks appears to be to protect the eyes from mud, rain or articles thrown up from the ground, whereas the purpose of the applicant's goods is to protect motorcyclists bodies from abrasive injuries caused by contact with the road surface. I have therefore come to the view that the respective goods are not of the same description. Accordingly, if the application could have proceeded in Class 9, the Section 12 objection would have failed.

39. The opponent's second ground of opposition under Section 11 is based upon its earlier use and reputation under the mark SCOTT in respect of, inter alia, goggles and protective gloves. The established test is set out in *Smith Hayden's Application (1946 63 RPC 97 at page 101)* as adapted by Lord Upjohn in *Bali (1969 RPC 472 at 496)*. In this case the test is as follows:

Having regard to the use of the mark SCOTT, is the Tribunal satisfied that the mark applied for, SCOTT LEATHERS, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

40. In his evidence-in-chief, Mr Harkins says that the opponent's range of products in 1979 (when Mr Harkins was appointed UK distributor) included goggles, face masks, t-shirts, baseball caps, sweat bands and wallets. A range of SCOTT gloves was sold in the UK "from the early 1980s." Mr Harkin says that in the five years (presumably preceding the date of his declaration in 1996) annual UK

turnover for SCOTT branded goods amounted to between 2 ½ to 3 million pounds. In his first declaration he says that 40% of these sales related to clothing merchandise such as t-shirts, baseball caps and sweat bands. This is not entirely consistent with his later declaration dated 16 September 1998, wherein Mr Harkins says that the opponent sold a range of Beanie hats, baseball caps, anoraks and bags in the UK under the SCOTT brand name from around 1978, and SCOTT t-shirts since about 1980, with turnover in these items amounting to a retail value of approximately £140,000. That is a lot less than 40% of the turnover claimed in his first declaration.

41. Mr Harkins further asserts that SCOTT gloves have been marketed in the UK by the opponent since about 1980, with a turnover amounting to a retail value of approximately £330,000. Again there is little specific evidence to support this assertion. There are no invoices or details of any customers. As Mr Campbell pointed out at the hearing, there is further ambiguity surrounding this evidence because the opponent also trades in ski gloves, as reflected in their registration for those goods in Class 28. The extent to which the claimed trade in gloves represents a trade in motorcyclists gloves is not therefore clear. However, it is apparent from copies of advertisements in 'Dirt Bike Rider' and 'Trials Motor Cross News' (which appear in Exhibit RPH3 and which are all dated in 1993) that the opponent had some trade in gloves for use by off-road motorcyclists prior to the date of this application. There is no dispute that, by this date, the opponent had a reputation acquired from longstanding use in the UK of the mark SCOTT for motorcycle goggles (at least for off-road use). The question is (or rather would be if the application could proceed in the correct class) whether, in the light of this use, I am satisfied that the opponent's subsequent use of the mark SCOTT LEATHERS in respect of jackets, trousers and suits for protection of on-road motorcyclists from abrasion (motorcycle leathers) was not likely to cause confusion or deception amongst a substantial number of persons at the date of the application.

42. The test under Section 11 is not a particularly high one. In *Jellinek's Trade Mark*, Romer J. said:

"It is not necessary in order to find that a mark offends Section 11 to prove that there is an actual probability of deception leading to a passing off or I add an infringement action, it is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products came from the same source."

43. However, the likelihood of confusion must be more than just a possibility, as Romer J noted when he concluded;

“ It is enough if the ordinary person entertains a reasonable doubt, but the court has to be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the register.”

This passage was quoted with approval by Lord Upjohn in *Bali*.

44. The matter turns, in part, on whether I accept the applicant’s contention that there is little overlap between the on-road and off-road markets for motorcycle accessories, or whether the opponent is correct in saying that the distinction between the markets was blurred at the relevant date. I have already noted that the opponent’s three trade witnesses all appear to specialise in the off-road market. And as Mr Campbell pointed out at the hearing, there is no evidence to corroborate Mr Harkins’ claim that the opponent’s goggles were sold through on-road motorcycle accessory shops as he claims “within months” of the opponent entering the UK market, or at all. Indeed, in his later declaration, Mr Harkins says that one of the reasons that the opponent took no action at the time the applicant started trading under its SCOTT LEATHERS mark (in 1983) was that the applicant was selling leathers to road going users and was not therefore perceived as being in direct competition with the opponent as regards products or target market. Having regard to the opponent’s current position, it is hard to believe that it would have taken this position if the parties goods were being sold through the same outlets on a significant scale. Further, the exhibits attached to Mr Harkins’ declaration rather reinforce the impression that the opponent’s trade, at least before the relevant date, was directed overwhelmingly towards the off-road market in motorcycle accessories. The magazines featuring advertisements for the opponent’s goods, included in exhibits to Mr Harkins’ evidence (such as “Dirt Bike Rider” and “Trials Motocross News”) are obviously aimed at the off-road market.

45. It may be that there were other motorcycle magazines (such as ‘BIKE’) and motorcycle exhibitions whose appeal is not strictly limited to on-road or off-road motorcyclists. Further, Mr Aird himself says that one of the reasons he adopted the mark SCOTT was that he was well known as the “flying scot” as a result of off-road motorcycle racing. In that case he must have believed that (in 1983), his

reputation as an off-road rider would benefit his sales of motorcycle leathers for on-road use. However, my overall impression from the evidence is that the actual trade in on-road and off-road accessories was relatively distinct at the relevant date. I note that Mr Walker's view accords with this assessment.

46. Added to this relative distinction in the markets is the distinction in the goods. The goods the applicant trades in, and which I am notionally considering for registration in Class 9, are protective clothing in the nature of jackets, trousers and suits, all adapted for on -road use by motorcyclists. The most relevant goods the opponent has traded in are motorcycle goggles, face masks and gloves. Of these only "gloves" are closely similar goods to the applicant's goods. The extent of the opponent's earlier use of the mark SCOTT in relation to motorcycle gloves is not clear. Further, the limited use that has been shown appears to indicate that the opponent's gloves, like its other products, are primarily designed for off-road use.

47. There is little difference between the marks. "Leathers" is 100% descriptive of (most of) the goods for which the applicant seeks protection. The essential feature of the mark is therefore the name "Scott". This is identical to the mark the opponent used prior to the application date. Having said that, the name "Scott" is, as I have already observed, lacking in an inherently distinctive character because it is a common surname. The opponent's mark had acquired a distinctive character by the relevant date, certainly for goggles, and perhaps for some other goods, but the scope of protection must, to some extent, reflect the fact that it is not an inherently distinctive mark.

48. Taking all these factors into account I have come to the view that there was no real likelihood of confusion at the relevant date. The ground of opposition under Section 11 would, therefore, also have failed if the application could have proceeded in Class 9 with the limitation put forward at the hearing.

49. Without the limitation, the Section 11 and 12 objections would have partly succeeded. The applicant's decision to enter the market for off-road protective clothing inevitably brought the parties goods into closer proximity and created a real tangible danger of confusion. One has only to look at the article from BIKE magazine, referred to in Mr Harkins second declaration, which shows a motorcyclist riding a motorbike off-road with a nylon suit bearing the applicant's SCOTT LEATHERS mark and goggles and gloves bearing the opponent's SCOTT mark, to appreciate the likelihood of

confusion. In these circumstances the public would be bound to wonder whether the respective goods came from the same source.

50. As I indicated earlier, much of the hearing was dominated by the applicant's claim to have made honest concurrent use of his mark. This goes to Section 12(2) of the Act which is as follows:

In the case of honest concurrent use, or of other circumstances which in the opinion of the Court or the Registrar make it proper to do so, the Court or the Registrar may permit the registration by more than one proprietor in respect of:

- a) the same goods
- b) the same description of goods
- c) .....

Subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.

51. It is common ground that honest concurrent use can also overcome an objection under Section 11 of the Act. There is no dispute that the applicant has used the mark SCOTT LEATHERS in respect of protective clothing for motorcyclists in the nature of suits, jackets, trousers, since 1983. It is not clear when the applicant entered the off-road market. The only dated exhibit clearly promoting goods for the off-road market is dated 1994 (the year this application was filed). In the light of my findings under Sections 11 and 12 the applicant would not have had to rely upon honest concurrent use if the application could have proceeded for a specification in Class 9, limited as proposed at the hearing (and further limited to leather goods). If I am wrong about the objections under Sections 11 and 12, the application could, in my view, have proceeded under Section 12(2) with the same limitations.

52. The opponent has challenged the honesty of the applicant's use. I find Mr Aird's explanation for the adoption of the mark SCOTT LEATHERS somewhat unconvincing on its face. The idea that the public would connect SCOTT LEATHERS with the previous company 'TT leathers' because there are two 'T's in "Scott" seems far fetched. On the other hand there is evidence that the applicant has used the mark SCOTT LEATHERS (albeit not consistently) with the 'TT' in "Scott" joined to create a quasi-logo within the word "Scott". This may be an indication that the applicant actually held the expectation Mr Aird describes, however unlikely it may seem. Mr Aird's explanation is also supported by Mr Walker's evidence. In my view the decisive point is the limited nature of the opponent's reputation at the time the mark SCOTT LEATHERS was adopted. The evidence suggests that the

only relevant reputation that the opponent enjoyed at this time was in relation to motorcycle goggles and lenses intended primarily (at least) for off-road use. Despite the rather odd explanation for the applicant's adoption of its mark, it seems unlikely that the opponent's reputation for such goods could have made the mark SCOTT LEATHERS significantly more attractive as a trade mark for road going motorcycle leathers, which is what the applicant was selling in 1983. I am therefore prepared to accept that the mark was adopted in good faith.

53. The opponent points to the use of similar typefaces and colour schemes by the applicant as further evidence of dishonesty. In fact the respective typefaces used by the parties are not the same, although they are similar. Neither is out of the ordinary. I attach little weight to this. The use of similar colour schemes is potentially more significant, particularly as the opponent alleges that the applicant changed his own colour scheme to mirror changes to their own mark in use. At the hearing, Dr Lawrence put it to Mr Aird that he started off using red, white and blue, which were the colours used by the opponent in their advertising. Later when the opponent changed its mark to yellow letters on a black background, she suggested that the applicant followed suit. Mr Aird pointed out that much of the applicant's early use was actually red, blue and silver (although he accepted that there was one example of the applicant using red, blue and white). He denied having changed to yellow letters on a black background pointing out that the applicant's revised logo featured yellow letters on magenta against a black background. He explained that the logo had been updated because of changes to the colours in fashion in the motorcycle trade. In this respect he pointed out that the colours of logos have to co-ordinate with the colours of the garments to which they are applied. He denied that the applicant had copied the opponent's colour scheme to enhance the belief that the applicant's goods came from the same source as those of the opponent.

54. The evidence on this point is unclear. Although the opponent claims that the applicant has copied its colour schemes (as well as its word mark), there is little detailed evidence before me, such as the time the opponent used a particular colour scheme and the time the applicant is alleged to have followed suit. If the matter had turned on the honesty of the applicant's use this would have been an important omission. Both sides have filed examples of their respective marks in use, but it difficult to establish from this whether the applicant copied the principal colours the opponent was using at the time. Further, the evidence suggests that both parties have used their marks in a range of colours other than the red, blue and white (or silver) and yellow on black (or magenta with a black background)

colour schemes that form the basis of the opponent's complaint. As I have already indicated, the opponent's allegations about the copying of colours are not particularised sufficiently. This inevitably resulted in a certain level of generality in the cross examination of Mr Aird on this matter. Having listened to his answers I am prepared to accept that the applicant made honest use of its mark from 1983 in respect of road going leather garments of protective clothing for motorcyclists.

55. There is little evidence of use of the mark in respect of protective clothing for the off-road motorcycle accessories market prior to the relevant date. In view of the limitation put forward at the hearing there is no point in considering the relevance of any use in that market further. I observe however, that the claims of confusion between the marks from independent witnesses (as per Joan Sutton Waind, Vaughan Semmens, Martin Cooke) and the specific claim of confusion in Mr Harkins' evidence (arising from his personal experience at the Dirt Bike Show 1996) all appear to stem from the applicant's extension of its trade into the off-road market.

56. I conclude that:

- a) the grounds of opposition under Sections 9 and 10 succeed;
- b) the application should otherwise be refused in the exercise of the Registrar's discretion because the application has been filed in the wrong class and does not cover the goods in respect of which the applicant uses or proposes to use his mark;
- c) the application should not be transferred to the correct class because of the limitation "all included in Class 25" within the original filed specification;
- d) if the application could have proceeded in Class 9 for suits, jackets and trousers being protective clothing for use by on -road motorcyclists for protection against abrasion, the opponent's first objection under section 11 would have succeeded in the absence of a further limitation to the specification "all made wholly or predominantly of leather";
- e) the second ground of opposition under section 11 and the ground of opposition under section 12 would have failed in the light of the limitation to the specification put forward by the

applicant at the hearing;

f) if the objections had not failed on a prima facie basis, they would have been set aside because of honest concurrent use;

g) the objections would have succeeded (on either basis) to the extent that the applicant sought to register its mark for protective clothing for off-road use by motorcyclists.

57. That brings me to the question of costs. The opposition having succeeded, the opponent would normally be entitled to a contribution towards its costs. However, the circumstances of the refusal are rather unusual and arise partly because the application was filed in the wrong class with the result that the evidence upon which the applicant relied was found to be irrelevant to this application. It is unfortunate that this was not noticed earlier. The limited specification put forward by the applicant could also have been put forward earlier and before positions became entrenched. Without the limitation, the opposition would have partly succeeded, even if the application could have been transferred to Class 9. Taking all these factors into account I have decided that the applicant should pay the opponent the sum of £800 within seven days of the end of the period allowed for appeal or, in the event of an unsuccessful appeal, within seven days of the final determination of the matter. I have reduced this figure by £300 to take account of the opponent's very late request to cross examine Mr Aird which resulted in an adjournment of the hearing started on 25 May until 27 June. This resulted in the applicant incurring unnecessary costs.

**Dated this 29 Day of September 2000**

**Allan James**

**For the Registrar**

**The Comptroller General**