

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No: 2176778
by Joe Cole to register a Trade Mark and**

**IN THE MATTER OF Opposition No: 49995 by
Andrew Cole Enterprises Limited.**

1. On 8th September 1998 Joe Cole of 6 Donnington Court, Castlehaven Road, Camden Town, London, NW1 8RT applied to register the trade mark KING COLE for:

Class 3 'Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices';
Class 8 'Razors; electrical shavers';
Class 9 'Films, pre-recorded video tapes, pre-recorded audio tapes, educational materials in the form of computer programmes relating to the game of football';
Class 16 'Photographs, pictures, posters, books and calendars; printed matter; stationery; instructional and teaching materials (except apparatus); playing cards; but not including paper patterns for use in knitting or any goods similar to these excluded goods';
Class 18 'Leather and imitations of leather, and goods made from these materials and not included in other classes: travelling bags, umbrellas';
Class 21 'Glassware, porcelain and earthenware not included in other classes';
Class 25 'Clothing, footwear, headwear, sports wear, sports leisure wear';
Class 28 'Sports equipment; games and playthings; gymnastic and other sporting articles not included in other classes';
Class 32 'Beers; mineral and aerated waters and sports drinks; but excluding fruit juices';
and
Class 41 'Provision of football instructional course, football coaching and football schools; provision of information relating to football; management services for footballers'.
2. The mark is opposed by Andrew Cole Enterprises Limited, who are applicants for the mark NET KING COLE, applied for on 26th May 1999. The cited grounds are ss. 5(2), 5(4)(a), 3(4), 3(3)(b) and 3(6).
3. A Counter Statement was provided by the applicants, in which the grounds of opposition are denied. Both parties ask for costs to be awarded in their favour.
4. The matter came to be heard on 3rd July 2001. The opponents were represented by Mr James St. Ville of Counsel, instructed by William A Shepherd & Son, and the applicants by Tom Hinchcliffe of Counsel, instructed by George Davis & Co.

THE DECISION

5. The s. 5(2) grounds were dropped before the hearing. I do not believe the s. 3(4) and s. 3(3)(b) grounds were credible: there was simply nothing to support them in the evidence and Mr St. Ville was not prepared to argue them at the hearing.
6. The only remaining grounds are under s. 5(4)(a) and s. 3(6). I will consider that under s. 5(4)(a) first. This states:

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

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

7. I think it is necessary, particularly in this case, to be very clear about the law in relation to passing off; the following citation is from the usual reference to the decision of Geoffrey Hobbs QC, sitting as the Appointed Person in the *Wild Child* case [1998] 14 RPC 455, in which he stated:

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

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

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation ”.’

8. If the opponents were to succeed in a passing off action as of 8th September 1998, the first part of this test requires them to show that their ‘goods’ or ‘services’ had acquired a goodwill under the marks KING COLE or NET KING COLE at that time. Mr St. Ville particularly referred me to this passage, and said that such a goodwill had been established. He stated the opponents’ contention under this ground as follows:

‘... what the evidence will show is that first of all Mr Andy Cole does have a very substantial goodwill trading as a professional footballer; as a person who endorses products and a person who lends his good name to things such as charities and that includes the good name “Net King Cole”.

Secondly, that as well as being known as Andy Cole he is also known as “Net King Cole” and as “King Cole”. ... you will see that from the evidence in the newspapers.

The result is that when the name “King Cole” is used people will take that as a reference to Andy Cole. That is a misrepresentation that leads to passing off’.

9. As Mr Hinchcliffe pointed out that passing off is a question of fact in every case, and I think it is essential to carefully examine the facts in this matter before proceeding.
10. The opponents' evidence is presented in the Statutory Declaration of Mr Paul Stretford, a Director of Andrew Cole Enterprises Limited. It is clear from this evidence that Mr A Cole is a very successful professional footballer: he gained national notoriety playing for Newcastle United Football Club where, in the 1994 to 1995 football season, he became the PFA (Professional Footballers' Association?) young player of the year. Mr A Cole's success continued following what appears to have been a 'high profile' transfer to Manchester United Football Club, for £7M, apparently then a record fee.
11. The evidence indicates that Mr A Cole was a very prolific scorer of goals on behalf of his football clubs, particularly when he played for Newcastle United. Mr Stretford says: '...it was at that time that reports of the local and National newspapers coined the phrase KING COLE/NET KING COLE..' and encloses a number of press cuttings (Exhibits PS1 to PS3) illustrating this. Mr Stretford adds: 'It is because of National exposure that the phrase KING COLE and/or NET KING COLE became synonymous with ANDREW COLE and the Opponent's own trading activities in the minds of the British public interested in sporting and more particularly football matters.'
12. Further evidence is submitted in Exhibit PS5, which contains 'back research' results of newspaper titles which mention 'Andy Cole'. A significant number of these include references, for which the following are typical examples:

'King Cole - Striker back in business'.

'Net King Cole: On the kid who was born to score goals'.

'Goal King Cole'.

The appellations are obviously laudatory, and also puns that incorporates allusions to the nursery rhyme 'Old King Cole' or to the singer 'Nat King Cole'. Mr Stretford also refers (paragraph 4) to various marketing activities conducted by, and on behalf of, Mr A Cole and states that this is very much in keeping with that of a number of other professional footballers.

13. Of course, this is the case, but the evidence of Mr A Cole's sponsorship and endorsement activities enclosed - some of which is after the relevant date (Exhibit PS7) - make no reference to KING COLE or NET KING COLE. As far as I am able to discover from the material submitted - and I must assume this represents the opponents' best case - there is no evidence that Mr A Cole, or his agents, have used these marks in any *trading* activity. Extracts from the various Manchester United catalogues Exhibited at PS 9 also make no reference to 'King Cole', are after the relevant date or both.
14. The only material showing that Mr A Cole has ever, himself, employed the mark is that recorded in Exhibit PS6. This consists of a Christmas card depicting a picture of Mr A Cole dressed as Santa Claus, in the 'colours' of the Newcastle United football team, with the name 'Net King Cole' on the front in red. Mr Stretford explains:

‘Whilst playing for NEWCASTLE UNITED FOOTBALL CLUB and back in 1994 ANDREW COLE through PROACTIVE SPORTS MANAGEMENT LIMITED had created some 17,000 Christmas cards and 13,000 greeting cards (birthday cards) by a company called PREMIER FOOTPRINTS and there is now produced and shown to me marked PS6 being an example of one of the Christmas cards and a photocopy of the greeting card from which you will note the phrase NET KING COLE appears prominently on the said cards. These cards were sold through CARLTON CARDS and 10p a card was donated to CHILDREN IN NEED. Some 16,662 greeting cards were sold whereas 12,828 Christmas cards were sold in relation to this exercise’.

With Mr Hinchcliffe I do not consider that this amounts to trade mark use. It is likely to be taken as a reference to Mr Cole, it identifies him, but I do not believe that those consumers who bought the cards would have thought for one minute that Mr A Cole was trading in greetings cards under the name NET KING COLE. The following device appears on the back of the cards:



This is the symbol that consumers would have taken as indicative of Mr A Cole’s trading activities. During the hearing Mr Hinchcliffe commented on Exhibit PS6:

‘The first point from Mr. Stretford’s statutory declaration is that this was a single isolated instance. It is 1994 and there were I think about 16,000 cards, about 12,000 Christmas cards sold. That is four years before the application date. The most important thing that one sees when looking at the card is that the slogan “Net King Cole” is not being used on that card in any way as an indication of origin. It is being used as a slogan. To paraphrase the words of Laddie, J in a recent Arsenal case: It is a badge of allegiance rather than a badge of origin’.

15. An analogous situation exists with the T-shirt in Exhibit PS10. There is no date on this item and suspect it is after the relevant date, but even if it is not, no purchaser of the same is likely to consider the reference to Mr A Cole on the front as GOAL KING COLE is a mark of trade. That appears in the neck-label, where there is the Manchester United Football Club crest, the name of the club, and the words ‘Official Merchandise’.
16. Mr Hinchcliffe also made a number of further comments about the evidence. First, it appears clear that when Mr A Cole trades as a professional footballer (or otherwise), he does so as ‘Andy Cole’. For example, his promotion of Reebok football boots in 1994 is under this name (Exhibit PS7). There is no mention of King Cole or variations thereof in the promotional material (though I note some (undated) newspaper reference to GOLD KING COLE this does not emanate from Mr A Cole or his representatives, or indeed, Reebok). Further, though the appellation is used often in the newspaper headlines, it is not as ubiquitous as Mr St. Ville implies. As Mr Hinchcliffe points out, of the 560 headlines in Exhibit PS5 (before the relevant date), about 42 mention variations on the KING COLE mark. This is about 7½%. And there is less actual use of KING COLE as such.

17. In summary, as a matter of fact, I do not think I can conclude that the opponents possessed a goodwill under the marks NET KING COLE or KING COLE at the relevant date. Mr Hinchcliffe referred me to *Reckitt & Colman* (the 'Jif' lemon juice case, cited above), at 499:

'First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by which the identifying "get-up" (whether it consists simply of a brand name or a trade description or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services.'

The opponents' evidence is not enough to support an identifying get-up - that of KING COLE or NET KING COLE - that allows me to find a trading goodwill in either of these names on behalf of Mr A Cole or his representatives. In my view, Mr Stretford's declaration attempted to tie together various threads of the evidence - that were not clearly related - in an attempt to construct such a goodwill. This approach is reflected in the summary of the opponents' case, as given by Mr St. Ville (see paragraph 8). First, I am required to conclude that Mr Andy Cole had a very substantial goodwill trading as a professional footballer by 1998. I think I can agree this. I am then required to believe that he possesses a goodwill as a person who endorses products, and a person who lends his name to things such as charities. On the evidence, again, it is fair for me to say that he has some goodwill under the name Andy Cole, before the relevant date, certainly for the former activity (the Reebok promotion being the only example enclosed in evidence).

18. So far so good, but I am then asked, because some newspapers have called Mr A Cole NET KING COLE and KING COLE to reach the result that 'when the name "King Cole" is used people will take that as a reference to Andy Cole' and that 'is a misrepresentation that leads to passing off'. Mr St Ville said the 'fans':

'..would see "King Cole's Football Coaching", or "King Cole Football School", as being that of Andy Cole. It follows from their understanding of the name "King Cole". That, in my submission, would be passing off. If Joe Cole had done such a thing at the age of 16 he would have been the subject of proceedings.

The other examples of the goods I have suggested are equally good examples of normal and fair use of the trademark "King Cole", "King Cole's greatest goal"; "Learn to play football with King Cole". Christmas cards, for instance: "Merry Christmas from Great King Cole".'

However, Mr St. Ville is asking me to make up for deficiencies in his evidence. There is no evidence that, first, '.. the British public interested in sporting, and more particularly football matters..' has used the name of Mr A Cole - or associate it with him, or, second, that the name has been used by him - or his agents on his behalf - in a trade mark sense.

19. Mr Hinchcliffe pointed out, between reputation and goodwill. The following is from *The Law of Passing Off* by Christopher Wadlow 2nd Ed., 1995, paragraph 2.08:

'Goodwill as a form of legal property is to be distinguished from reputation, which is a matter of fact. The two are very closely related, and a business with goodwill (at least in

the sense in which it is used in passing-off) can hardly fail to have a reputation. The converse, however, is not true, and the existence of a reputation associated with a person, product, name or mark does not necessarily imply the existence of goodwill: “[T]hat, as it seems to me, is to confuse goodwill, which cannot exist in a vacuum, with mere reputation which may, no doubt, and frequently does, exist without any supporting local business, but which does not by itself constitute a property which the law protects.” (*Collins v. Brown* (1857) 69 ER 1174).’.”

It is possible to say that Mr Cole has some reputation in being called KING, but no trading goodwill.

20. I think this point was reinforced by a reference by Mr St. Ville to the passing off case of *Hines v Winnick* [1947] 6 RPC 113. This concerned a performing group called ‘Dr Crock and his Crackpots’, for which the Defendant proposed to substitute somebody else for ‘Dr Crock’, the conductor. The following passage is relevant:

‘..I cannot for myself see that it would be fair or right for any other person to be put before the public under the name of “Dr Crock” who is not the Plaintiff, whose association with the name is the only association at the date of the Writ, which belonged to it.

I think that some guidance is given to me by the decision of Eve, J which was cited to me by Mr Aldous, in the case of *Landa v Greenberg* (24 TLR 441). That was a case of a *nom de plume*. A certain Mrs Landa contributed to a certain periodical articles under the pen-name of “Aunt Naomi”, and the learned judge said in that case:

“I am bound to hold that the plaintiff had a good cause of action in respect of the defendant’s conduct. The name - that is the name of ‘Aunt Naomi’ - constituted part of her stock-in-trade as a writer, and that it had become identified with her was the very reason the defendant put forward for dismissing her, and the defendant was not confining himself to a mere denial of her right, but was himself making use of it in a way calculated to lead to the belief that the league into which the applicants for membership were being admitted was still being conducted by her”.

Translating that into the language which would be appropriate to the present case, I have come to the conclusion that the name “Dr Crock” has become part of the Plaintiff’s stock-in-trade as an amusement, and that it has become identified with him, and it is not open to the Defendant to make use of that name in connection with any person other than the Plaintiff - of course, in connection with any such performance as that in which the Plaintiff took part. It may well be that in some wholly different subject matter, for instance, “The War Reminiscences of Dr Crock”, or some literary work, there would be no infringement of the Plaintiff’s right, but in connection with the performance of music, and particularly burlesque music, it seems to me that this fanciful name, this *nom de theatre* of the Plaintiff, has become part of his stock-in-trade and identified with him.

After all, we are not dealing here with a wholly commercial matter. We are dealing with a personal matter connected with an art, and if a man, be he musician, portrait painter, or writer of articles in newspapers, gets to be known under a particular name, that name becomes inevitably part of his stock-in-trade and, apart from some special contract or anything of that kind, he is entitled to say that it is his name, and that anyone who adopts or

causes the adoption of that name by some other person is inflicting upon him an injury. As was pointed out by Eve, J in the case to which I have referred, he was not dealing with the alleged misuse of the name of a private individual, but of an authoress and journalist, a state of things to which wholly different rules must be applied. "The name in such a connection", said Eve, J, "constitutes part of the owner's stock-in-trade, and its use without his or her authority may inflict grievous harm and result in pecuniary loss". "Aunt Naomi" was the fanciful name adopted by Mrs Landa. "Dr. Crock" is the fanciful name adopted by the Plaintiff, and I have great difficulty in seeing the difference between the facts which were before Eve, J in that case and the facts with which I have to deal in this case'.

21. Though Vaisey J states that this matter is not 'wholly commercial' I believe he was referring to the process by which someone '...gets to be known under a particular name..'. It is clear, however, that this applies to names that are not that of a private individual, but that which constitutes part of his 'stock in trade.' Mr Hines was not keen, at first, to be known as 'Dr Crock'. But he appeared under the appellation in the exercise of his profession, became identified with it, and considered it his own that no other could adopt. The facts are not the same in this matter. As I have repeatedly stated, there is no evidence that Mr A Cole has done something similar.
22. In particular, there is no association between the nickname sometimes applied to Mr A Cole and the goods specified in the application. Perhaps one might consider the closest to be some of the goods in Classes 9, 25, 28 and 41. Above, Mr St. Ville referred to football instructional material (paragraph 18). Taking this as an example, Mr A Cole may have a reputation for football services - though these are expressed as an employee of Manchester United Football Club - but there is nothing associating him and football instructional material or services that amounts to a tradable goodwill under his own name, let alone between the name KING COLE and such goods or services. The following is from the recent decision of the High Court in *South Cone Incorporated v Jack Bessant and Others* (16th may 2001; Unreported):

'There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur'.

No evidence has been presented a *prima facie* case that the opponents' reputation extends to the goods comprised in the applicants' specification of goods.

23. I think I need to make a comment about nicknames before continuing. It seems to me that they are usually chosen on the basis of some characteristic of a person, maybe a physical attribute ('Lefty' for a left handed person) or a punning association of with their given name ('Windy', for someone whose surname is 'Miller'). I note the following, from Exhibit PS5:

'Hot and Cole'
'Out in the Cole'
'Cole-den Wonder!'
'The Cole-den Boy'
'Cole Apse'
General de Cole'
'The Cole Truth'

Which all make punning references to Mr A Cole's name. Calling Mr A Cole KING COLE was always a likelihood, making a punning association between his success as a footballer and the familiarity of the nursery rhyme. But the name could equally be applied to others for the same, similar or different reasons. Arthur Scargill, the leader of the Miners Union was called 'King Coal' by certain newspapers. Mr Eric Cantona, another Manchester United football player, is also referred to as KING (see Exhibit PS8), where both Mr A Cole and Mr Cantona are referred to by their nicknames:

'NET KING COLE
We talk to Andy.
ERIC CANTONA
The King returns to the Premiership'

It is wholly likely that Mr J Cole, if he achieves success as a footballer, will also be called KING COLE. The manner of choosing such a nicknames would be no different from the process whereby some members of the media have used the same in referring to Mr A Cole (or Mr Cantona, or Mr J Cole, who is called: 'Young King Coal' in a headline (Exhibit PS11)) but is hardly indicative of a trade under the name as a trade mark, for any of these three gentlemen.

24. I do not want to labour this point, as it has implications relating to the distinctiveness of the mark which were not raised by either side at the hearing, for obvious reasons. Rather, I am merely pointing out that the process by which Mr Cole came to called KING COLE or NET KING COLE was not, of itself, unique enough to create the sort of property right which came to Mr Hines, and described in *Hines v Winnick*. The following extract, from *Pete Waterman Ltd & Others v CBS United Kingdom Ltd* [1993] EMLR 27, at 46, is relevant. Sir Nicolas Browne-Wilkinson VC commenting on the name HIT FACTORY stated:

'The first matter to be noticed is the impermanence of the name. Mr Waterman himself accepted that in five years' time (though he sincerely hoped it would not be the case) the name "The Hit Factory" might no longer be apt to apply to PWL. If the success of PWL, in what is, by any standards, a changing and fashionable field, were to be less pronounced in five years' time, it might not be an apt description of what is going on in PWL. Another witness, when the point was put to him, said: "Well, if they stop making hits, they may well be called 'The Flop Factory'". Nobody is suggesting that that is going to happen. But the truth of the matter is that it is a feature of the name that there is a possibility of it becoming inapposite and inappropriate and therefore impermanent.

Moreover, one has the factor that PWL has not itself adopted the name “The Hit Factory” as a name under which it trades. It is, as I say, an accolade or mantle conferred on it by the public. Those who give can also take away. The fact that PWL, has not itself adopted the name as its trading name is not in law in any way fatal to a claim to the name being distinctive. In the *Dolly Blue* case, *Edge & Sons Ltd v Gallon & Son* (1900) 17 RPC 557, it was the washerwomen and not the manufacturers who originally called the manufacturer’s product Dolly Blue. But in that case the product was asked for and sold in the shops under the name Dolly Blue. Here there is no sufficient evidence that the name “The Hit Factory” is used either by those in the recording industry or the eventual retail buyer for the purpose either of engaging PWL’s services or buying records. The name is a nickname used as a term of reference, not a trading name. The highest the evidence goes is that, within certain recording companies, employees refer to PWL amongst themselves as “The Hit Factory”. In the realm of retail sales there was no evidence of current trading practices. The most I have is the recollections (now, I suspect, rather dim) of Mr Waterman and Mr Howells as to their days in the trade when the next generation, or the next generation but one, would come into the record shop and, having seen something on television, ask for something by the name of what they had seen in order to buy it for their child or grandchild. I have no evidence that that is still the practice. I have no evidence that anybody has ever asked for the latest “Hit Factory” record. I certainly infer that many thousands of people have been in to ask for “The Hit Factory” album but that is because it is the name of the record not because it is the name of the organisation.

There is no doubt at all in my mind that both in the media and by individuals PWL has been referred to as “a” and on occasions “The Hit Factory”. To a substantial number of people in this country the phrase “The Hit Factory” means PWL. But those words have in the past been to other recording enterprises, all of which were or are of the same special type as PWL, that is to say, one-stop recording organisations producing a house style or sound and which have been labelled “a Hit factory”.’

25. The facts are not identical to this matter, but *Waterman* shows that a nickname created by other than the named may become a property right of the latter if it is used in trade. However, the genesis and use of such epithets require clear evidence that this has indeed become the case.
26. In summary, I have taken the following from Mr Hinchcliffe’ skeleton argument, which distills the essence of the applicants’ case:

‘The first requirement, for an action for passing off is that Andy Cole is the owner of goodwill in the mark KING COLE. Goodwill is a form of legal property that is generated as a result of trade. It cannot exist without a business. Goodwill is to be distinguished from reputation, which is merely a question of fact - see *Anheuser-Busch v Budejovicky Budar* [1984] FSR 413 at 470. A passing off action cannot be based upon mere reputation alone.

....

Reliance is placed upon newspaper articles written about Andy Cole at [Exhibits] PS 1-5. These do not establish any goodwill sufficient to found a passing off action. All they establish is that occasionally, certain tabloid headline writers use one of the several

variants on “King Cole” (e.g. “Goal King Cole” or “Net King Cole”) in the headlines of articles concerning Andy Cole. The words “King Cole” are however only occasionally used in such headlines. Of the 500 or so articles about Andy Cole listed in PS 5, only about 30 (or about 6%) use the words “King Cole” in the headline. The others use just about every other conceivable headline pun that can be made on Andy Cole’s surname. As such, “King Cole” cannot even be said to be regularly used to refer to Andy Cole. Additionally, even those articles that do refer to “King Cole” only do so in the headline. In the main body of the article they go on to refer to Andy Cole by his proper name.

The articles also do not use “King Cole” in relation to any business (save perhaps Andy Cole’s career as a footballer, although of course Andy Cole does not “trade” as a footballer under the name “King Cole”). As such, at best the articles evidence a mere reputation, rather than any goodwill. Similar comments can be made in relation to the Manchester United magazine at PS 8.

Reliance is also placed upon the greetings cards issued by Premier Footprints in 1994 at PS 7. However, the words “Net King Cole” are not being used as an indication of trade origin here. That function is performed by the Premier Footprints and Andy Cole logos on the back. “Net King Cole” is merely used as a slogan, in the same way that “Cole the Goal” is used as a slogan in the second card in PS 5 or “Happy Birthday” is used on many birthday cards. As was explained by Geoffrey Hobbs in *Wild Child* [1998] RPC 455 this type of evidence does not establish that the words “King Cole” have been used by the Opponents in a manner sufficient to cause them to be deceptive when used in relation to the goods and services for which the mark is sought to be registered’.

I think Mr Hinchcliffe is right.

27. I now wish to turn to the issue of bad faith. S. 3(6) states:

‘(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith’.

28. Mr St. Ville stated his position:

‘.. what we say really has happened here is that Joe Cole, or those running his affairs for him, made a decision when he was 16, before he started trading as a footballer, to apply for the registered trade mark “King Cole” knowing that “King Cole” was the name that Andy Cole was known by. If there were use that would be to passing off and that is an attempt to take away my client’s epithet and seal it off as a statutory monopoly.

In my submission that goes beyond dealings which are to the standard of acceptable commercial behaviour observed by reasonably experienced men in the areas of business being examined. Therefore that does fall within the definition of bad faith within the Act’.

29. I think I must conclude that Mr J Cole may have been aware that the appellation KING COLE, or variations thereon, would have been applied to Mr A Cole before he applied for the mark. It is not clear to me, however, that he would have believed that this name was distinctive of Mr A Cole, and I do not see why he should have so concluded. The evidence shows that the epithet was applied, on some occasions to Mr A Cole - by certain newspapers - in conjunction with ‘on form’ performances as a footballer - it was a laudatory nick-name

applied to him when he played well. But why should Mr J Cole come to the conclusion that it was a name Mr A Cole believed to be his alone and, more than that, a sign representative of his business affairs? There is no evidence of promotion of the name by Mr A Cole as part of his sponsorship activities, or indeed, of his profession as a footballer. The term had been applied to Mr A Cole, now and again, since 1993, yet neither he, nor his representatives, had ever sought to promote it, register it as a mark of trade or apply it to his footballing or 'extra-footballing' affairs (apart from the circulation of Christmas cards in the Newcastle area in 1994 - and there is no evidence - nor can I presume - that Mr J Cole was aware of that).

30. I think I am being asked to infer bad faith, and I am counselled to be cautious in doing so. In an recent unreported decision of the Appointed Person, it was stated:

'An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning MR in *Associated Leisure v Associated Newspapers* (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v Garrett* (1878) 7 Ch. D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under Section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.'

31. It would seem that Mr A Cole or his agents had never laid commercial claim to the sign, and thus it was open to adopt it as a mark of trade. Without any evidence to contradict this notion, I do not think that business people would consider that Mr J Cole's actions falls below the standard of acceptable commercial behaviour observed by reasonably experienced men in the business of football promotion. The applicants saw an unused opportunity and took it. If they were aware of Mr A Cole's nickname, this action might be regarded as discourteous, but I am not able to call it dishonest or less than that expected in normal commercial dealings. This ground fails, and the opposition fails.

32. On the matter of costs, Mr Hinchliffe submitted that the opponents had should not have raised the 'hopeless' ss. 5(2) and 3 grounds. There was also the matter of a 'duplication' of effort in that there had been two oppositions, two set of evidence etc. Mr Hinchliffe stated:

'It is very clear that my learned friend and his clients should know, and almost certainly do know, who is the owner of goodwill in this case and yet they have duplicated everything'.

33. Taking the s. 5(2) ground first, this should never have been pleaded - even the most inexperienced agent must have been aware that the opponents were not the possessors of any 'earlier mark' under the provisions of s. 5(2). And, in relation to the remaining absolute grounds under s 3, I think it must be obvious that these were not going to muster any serious objection to an opposition based on an earlier right. However, though these grounds may be considered to be unnecessary - even poor practice on behalf of the opponents' agents to have included them - I decline to augment the usual award of costs, because I do not consider that much effort should have been expended in dealing with them.
34. On the other matter - duplication of the oppositions, where one is in the name of Mr Andrew Cole, and the other is in the name Andrew Cole Enterprises Limited - Mr St. Ville said '..it is perfectly proper of Andy Cole to oppose the application and perfectly proper of Andrew Cole Enterprises Limited to do so..' which I agree is the case; however, two oppositions run the

risk where they fail, as here, to have two sets of costs against them. Nevertheless, in this matter, I recognise that the vast majority of the effort consumed in preparing for this and the other opposition has been identical - the same evidence and submissions have been put in both. I think there may be cases where different opponents put in different grounds and evidence, and that should be reflected in costs if they lose. This is not one of those, and I would estimate the effort involved in preparing for them is small (some marginal administration, such as photocopying etc.).

35. The applicant has been successful and is entitled to a contribution towards his costs. I order the opponent to pay them £700. A similar amount is paid in the parallel opposition. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25TH Day of October 2001

**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**