

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2172971
BY H SINGH SANGER TO REGISTER THE
MARK BOFF IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 49408 BY OH TRADING CO INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2172971
by H Singh Sanger to register the mark BOFF
in Class 25**

and

**IN THE MATTER OF Opposition thereto under
No 49408 by OH Trading Co Inc**

DECISION

On 24 July 1998 H Singh Sanger applied to register the mark BOFF for “jackets, sweat-shirts, T-shirts, boys and children’s clothing, caps, jeans, tops, underwear” in Class 25. The application is numbered 2172971.

On 28 January 1999 OH Trading Co, Inc of New York filed notice of opposition to this application. They refer to two pending applications of their own but as these have later filing dates they do not have the capacity to be ‘earlier trade marks’ within the meaning of Section 6 of the Act and so cannot form the basis of an objection under Section 5. However the opponents says that they have used their ‘various trade marks including the word BOFF in the UK’ and have a substantial reputation therein. As a result objection is said to arise under Section 5(4)(a) by virtue of the law of passing-off. The opponents also say that ‘the applicant must have been aware of the existence of the opponents’ reputation in marks containing the word BOFF’. On that basis it is said that the mark was applied for in bad faith and would be contrary to Section 3(6).

The applicant filed a counterstatement denying the above grounds.

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

Both sides filed evidence. Both sides indicated that they were content to have a decision issued on the basis of the papers filed and without recourse to a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision. In doing so I have also had regard to the submissions contained in letters received from the trade mark attorneys acting on behalf of the parties. That is to say Langner Parry’s letter of 24 January and 20 February 2001 on behalf of the applicant and Boulton Wade Tennant’s letter of 31 January 2001 on behalf of the opponents.

I do not propose to provide a full summary of the evidence but will instead draw on the statutory declarations supplied by the parties in dealing with the grounds of objection. For the record the material before me is as follows:-

Opponents' Evidence in chief:

Statutory Declaration by Julius Stobbs and Exhibits JS1-JS5

Applicant's Evidence in chief:

Statutory Declaration by Darshan Singh Sanger and Exhibit DSS.1

Statutory Declaration by Darshan Singh Sanger and Exhibits DSS.2 and DSS.3

Opponents' Evidence in reply:

Statutory Declaration by Julius Stobbs

Mr Stobbs describes himself as a part qualified Trade Mark Agent with Boulton Wade Tennant. Mr Singh Sanger is the father of the applicant. He trades under the style of Sanger Textiles & Co. His son joined him in the business in April 1988 and took over the running of one of Mr Darshan Singh Sanger's two shops.

I now turn to the ground of opposition under Section 5(4)(a). This reads:

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

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

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

The conventional test for determining whether the opponents have succeeded under this section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person, in WILD CHILD Trade Mark [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

The very full guidance given in the WILD CHILD case by Mr Hobbs by reference also to Halsbury's Laws of England can be found at pages 460 and 461 of that decision.

In view of the fact that both parties lay claim to the mark BOFF in respect of identical and closely similar goods it is clear that establishing their claim to goodwill is going to be critical to the opponents' case. I, therefore turn to the opponents' evidence in this respect. I should, however, preface what follows by expressing some unease about this evidence. The opponents have not filed evidence themselves but have left that task to their UK Trade Mark agent. Save where it is evident from supporting exhibits Mr Stobbs does not indicate the source of his information or confirm that he was given access to the books and records of the opponent company. I infer that some of the material must have come from the opponents or was authorised by them to be released to the UK agents (the Sportstar figures on turnover, for instance, referred to below). However this is not an altogether satisfactory basis on which to approach the evidence. Against this I do not understand the applicant to take any point in relation to this aspect of the evidence concentrating his attack instead on the substance of what has been provided. I therefore proceed on the basis that the evidence is not challenged in this respect.

Mr Stobbs firstly gives evidence as to the opponents' background. The company was established in 1988 and BOFF was founded as a wholly owned subsidiary in 1996. The BOFF trade mark has been used for "an urban inspired young mens active apparel product line." It is said, for example, that BOFF products are sported by famous rappers in the United States and has been promoted in magazines such as Fiba, Sportswear International and Rap Pages. The first of these is distributed in the UK.

Turning specifically to the UK Mr Stobbs says:

"The opponent has built up an extensive reputation in the BOFF trade mark both in the United States and worldwide. The nature of the youth market is that it is a global market, and trends begun in the United States do not take long to filter through to other Western countries such as the United Kingdom. This is reinforced by the growth of satellite television, the internet and the increase in scheduling of US television programmes in UK schedules, which has created a global entertainment industry.

Sales of BOFF products by the opponent in the UK first began in 1997. It has been very difficult to obtain full details of sales figures. The nature of this brand means that it is directed mainly through a number of small street retailers who do not tend to keep extensive records of individual sales. However, I have contacted Sportstar USA, Inc (one of the opponents' wholesale distributors in the United States), and the president of that company confirmed that the approximate sales (in wholesale terms) of BOFF products to the UK since 1997 has been \$50,000. There is now produced and shown to me as Exhibit JS4 a copy of a letter from the president of Sportstar USA, Inc confirming these details.

I have also contacted various London clothing traders to seek details of their sales of BOFF products manufactured by the opponent. In particular, I spoke to Mr Ismail of Styles Clothing on 22 August 1999 over the telephone, who informed me that he had

sold BOFF products through his shop, and that the first sales occurred late in 1997. On 7 February 2000 I spoke to Mr Asmal of Denim World Limited. He was unwilling to provide extensive details of his sales, but did inform me that he does stock BOFF products, and has done so for about two years. On 7 February 2000 I also contacted a sole trader named Derek Williams over the telephone, and he informed me that he had made sales of the BOFF products, and that the earliest such sales dated from 1997.”

There are in addition Exhibits showing a page from Sportswear International Who’s Who for 1999 (JS1), magazine advertisements (JS2), and pages showing use of the BOFF mark at fashion shows (JS3).

Having given careful consideration to this material and bearing in mind the material date of 24 July 1998 I find that:

- most of the exhibited material relates to US magazines and events or at least cannot clearly be identified as being relevant to the UK. Much of the material is also either undated or after the relevant date.
- the only attempt at quantifying UK trade is a faxed handwritten letter dated 5 August 1999 from Sportstar USA Inc, the opponents’ US wholesale distributor (JS4). The figure quoted for approximate sales to the UK is \$50,000 since 15 September 1997. What proportion of that figure fell within the period before 24 July 1998 is not stated.
- there is little information on sales methods (other than that they are through small retailers), geographical coverage, promotional support etc.
- one of the few items that can be said to be directed towards the UK market is the advertisement in the FIBA basketball magazine (JS2). It has a sterling price as well as comparable prices in dollars and francs. But the magazine is dated July 1998, that is to say at or about the date the application was filed.
- the claim as to the speed at which market trends spread from the US to the UK is too general to be of assistance.
- Mr Stobbs’ report of contacts at various London clothing traders to seek details of sales of BOFF products is hearsay and too vague to enable me to draw any meaningful conclusion.

The opponents are asking me to come to a finding in their favour on the issue of goodwill on the basis of just ten months use prior to the material date and what is by any standard a low level of sales even if it was possible to properly quantify the value of sales up to July 1998. Furthermore the evidence in substantiation of the opponents’ claim is in my view weak. As a result I am unable to say what impact the opponents’ activities have had on the UK market. Their claim to goodwill in the mark BOFF at the material date is thus not made out. The opposition under Section 5(4)(a) fails.

I turn now to the Section 3(6) ground that the applied for mark was adopted and filed in bad faith. The particular objection that the applicant has been asked to respond to is that “the applicant must have been aware of the existence of the opponent’s reputation in marks containing the word BOFF”.

I have some difficulty with that claim as the basis for an objection under this Section without further particularisation of the opponents’ reasons for having this view. On the basis of my finding as to reputation/goodwill for Section 5(4)(a) purposes it seems to me that it would not be unreasonable to conclude that the objection as framed does not get off the ground. However of rather more concern is the suggestion implicit in the objection that awareness of the existence of a mark with a reputation in itself renders an application made in bad faith. Whilst I accept that circumstances may arise where such will be the case, as a general proposition I regard it as flawed.

In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 Lindsay J said:

“Bad faith includes dishonesty and also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.”

I regard the opponents’ evidence as being largely directed towards supporting the Section 5(4)(a) ground. They did, however, commission an investigation report “into the use made in the UK of the trade mark BOFF” by the applicant. The results are exhibited in the report at JS5. I note firstly that the investigation was not primarily directed towards the issue of the applicant’s bona fides. The investigator, who does not appear to be named, records in relation to his or her visit that:

“During this conversation we made reference to the brand name BOFF and Mr Sanger said “that is our trade mark”. He went on to tell us that he had applied to register trade mark BOFF in July 1998 and one month later an American company had applied to register the same mark. Mr Sanger said that until that point he had no idea that anyone else had an interest in this name or that anything had been marketed under it. When asked, he claimed that the name had been used by his company on clothing. He then said that he would be talking to his son with regard to the registration of this mark.”

I assume that, in accordance with the normal nature of such enquiries, the investigator did not reveal the true purpose of the visit. There is no reason to suppose, therefore, that the comments attributed to Mr Sanger represent anything other than a spontaneous and honest statement of his position. Thus it appears that he neither knew nor had any reason to think that another trader had an interest in the mark BOFF. If that was not the position it required evidence and/or some other explanation from the opponents to support their objection.

In the light of the above I have not needed to consider in detail the applicant’s own evidence. Suffice to say that Mr Sanger has supplied documentation showing use of the mark BOFF over a number of years and copies of clothing labels bearing the mark. The latter are not

dated. Some of the other material is in the form of “To whom it may concern” letters confirming purchases of BOFF brand goods. I can give little weight to these letters the contents of which should in my view have been in proper evidential form if they were to be given proper consideration.

There is nonetheless a small amount of residual material which suggest the applicant’s trade under the mark has been of some duration (preceding the opponents’ claimed use) and suggests the opponents’ claim in relation to bad faith is not well founded.

The opposition as a whole has failed. The applicant is entitled to a contribution towards his costs. I order the opponents to pay the applicant the sum of £500. The 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 13th Day of June 2001

**M Reynolds
for the Registrar
The Comptroller General**