

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 80713
BY THE TIMBERLAND COMPANY
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF REGISTRATION No. 2269394
STANDING IN THE NAME OF TIMBERLAKE OUTDOORS LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 80713

By the Timberland Company

for a declaration of Invalidity

in respect of Registration No. 2269394

standing in the name of Timberlake Outdoors Limited

BACKGROUND

1. The following mark is registered under No. 2269394 in respect of “men’s and children’s clothing and headgear; footwear”:



It has a filing date of 5 May 2001.

2. By application dated 20 January 2002 The Timberland Company applied for this registration to be declared invalid. They are the proprietors of the following registered trade marks:

No.	Mark	Class	Specification
1209696	TIMBERLAND	25	Articles of outer clothing and T-shirts; footwear, being articles of clothing and articles of sports clothing.

Articles of outer clothing and T-shirts; footwear, being articles of clothing and articles of sports clothing.



3. On the basis of these registrations they object under Section 5(2)(b) of the Act. They give the following particulars:

- “(i) The registered mark is registered for the following goods which are identical with or similar to those for which the Applicant’s earlier trade marks are protected:-

Men’s and children’s clothing and headgear; footwear

- (ii) The registered mark TIMBERLAKE with the device of a tree and the Applicant’s earlier trade mark TIMBERLAND are similar and there is a likelihood of confusion including the likelihood of association, in view of the distinctive character of the Applicant’s mark, particularly the TIMBER element thereof, and its reputation.
- (iii) The registered mark and the Applicant’s earlier trade marks TIMBERLAND and the Tree device considered together are similar and there is a likelihood of confusion including the likelihood of association, particularly in view of the Applicant’s use of the mark TIMBERLAND in conjunction with the Tree device.”

4. On the basis of the use that has been made of the marks TIMBERLAND and the tree device objection is taken under Section 5(4)(a) (passing off). The applicants give the following particulars:

“The Applicant has sold footwear in the United Kingdom since at least 1980 and articles of clothing and headgear since 1987 under the trade marks TIMBERLAND and the Tree device and the total value of United Kingdom sales in the period 1994 to 2000 has been in excess of US\$400m. Accordingly the Applicant has a substantial goodwill in the trade marks TIMBERLAND and in the Tree device in relation to the goods in respect of which the registered proprietor’s mark is registered. The combination of the word TIMBERLAKE with the device of a tree creates an association with the Applicant’s registered marks or either of them which would

constitute a misrepresentation to the public and which would be liable to cause damage to the Applicant's business or goodwill."

5. The registered proprietors filed a counterstatement denying the grounds for invalidity and putting the applicants to proof of use of their marks. The only other point I need to record from the counterstatement is that the registered proprietors concede that 'footwear' appears in both specifications and are identical goods. They do not admit that "men's and children's clothing and headgear are similar across the whole range of meaning of those terms to the goods articles of outerclothing and t-shirts".

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

7. Only the applicants filed evidence. A Registry Hearing Officer reviewed the papers and indicated that a decision could be taken without the need for a hearing. The parties were nevertheless reminded of their right to be heard or to make written submissions. Neither side has asked to be heard. Written submissions have been received from Appleyard Lees under cover of their letter of 26 November 2002 on behalf of the registered proprietors and from Wildbore & Gibbons under cover of their letter of 19 November 2002 on behalf of the applicants for invalidity. Acting on behalf of the Registrar and with the above material in mind I give this decision.

Applicants for invalidity's evidence

8. The applicants have filed an affidavit by Danette Wineberg, Vice President, General Counsel and Secretary of The Timberland Company. Ms Wineberg's affidavit deals both with the worldwide reputation of the TIMBERLAND and Tree device brands and the position in the UK. The former is of some slight relevance in placing the UK use within the context of a broadly based international business. I bear this information in mind but will concentrate for the purposes of this evidence summary on the applicants' activities in the UK.

9. Ms Wineberg firstly sets out the applicants' corporate background along with information on ownership of trade marks in the UK. I note that reference is made to registrations other than those detailed in the statement of grounds. I intend to base my decision solely on the registrations specifically pleaded.

10. She says that Timberland sells footwear, clothing, headgear, leather goods, eyewear, watches and product care bearing the TIMBERLAND and Tree design marks ('the Timberland marks') into the United Kingdom and has done so since at least as early as 1980 for footwear and product care, and 1987 for clothing and leather goods. In support of this claim she exhibits:

- Exhibit 2 - a random selection of invoices from the years 1980 to 2001;
- Exhibit 3 - copies of the Spring 1999 Apparel catalogue, the Spring 2000 Kids' Footwear catalogue, Fall 2000 Headwear catalogue and Fall 2001 Footwear catalogue. The catalogues show how the marks are affixed to footwear and clothing;

Exhibit 4 - specimen hang-tags and a sample shoe-box cover.

11. Ms Wineberg goes on to say that Timberland footwear, clothing and accessories are available throughout the United Kingdom. They are available in Timberland “concept shops” (dedicated retail areas operated by authorized retailers) found in multiple branches of leading department store groups such as House of Fraser, Alders, and Capolito Roma, in Timberland specialty stores (stand alone TIMBERLAND retail outlets), and in franchised Timberland stores. A list of the Timberland specialty stores and retail outlets in the United Kingdom, as well as a list of authorized retailers that carried Timberland merchandise in 2001 are exhibited (Exhibit 5).

12. Turnover figures are given as follows:

Year	Net Revenue (in USD) (in excess of)
1994	\$37,673,000
1995	\$40,306,000
1996	\$50,283,000
1997	\$66,456,000
1998	\$70,023,000
1999	\$67,539,000
2000	\$77,186,000

13. Advertising expenditure incurred in promoting Timberland products in the United Kingdom is said to have been approximately US \$1,673,000 in 1996, US \$1,534,000 in 1997, US \$1,481,000 in 1998, US \$1,674,000 in 1999, and US \$1,810,000 in 2000. Sample advertising schedules and advertisements from Timberland’s Fall 1998, Spring 1999, Spring 2000, and Fall 2000 United Kingdom marketing campaigns are exhibited (Exhibit 6).

14. In addition to the above local retailers also promote the products in the UK. Examples of such promotional activity, namely 1987 and 1988 Harrods catalogues promoting TIMBERLAND, and a Harrods advertisement that was published in the December 7, 1980 Observer magazine, are exhibited (Exhibit 7).

15. Authorised Timberland retailers are also supplied with point-of-purchase advertising materials, including displays, counter cards and posters, all of which prominently feature the Timberland marks. Exhibit 16 is a portion of the Fall 1999 Trade Support Manual that was distributed to retail accounts in the United Kingdom. Ms Wineberg says that, as reflected in this manual, Timberland prominently features and painstakingly controls the use and depiction of its trade marks on in-store displays, and in co-operative advertising. The materials convey the theme of timber, woods and wilderness.

16. Further exhibits provide examples of advertising and promotion in UK publications. Exhibit 21 shows advertisements in the following:

Publication Name	Publication Date
Time Out	July 16-23, 1997
GQ	June 1997
Evening Standard	November 24, 1995
Belfast Telegraph	October 14, 1995
Trail Walker	June 1994
Marie Claire	May 1994
The Times	September 10, 1993
The Sunday Times Magazine	1988
Punch Weekly	September 23, 1987

17. Exhibit 22 contains articles from the following publications reporting on Timberland products:

Publication Name	Publication Date
For Him	Summer 1989
High & Mighty	1991
Men's Wear	April 13, 1989
Shoe and Leather News	December 1, 1988
BBC Wildlife	October 1988

18. Ms Wineberg goes on to say that a survey undertaken as part of brand research conducted for Timberland in 1999 by the Monitor Company, revealed that 77.7% of the 550 individuals in the United Kingdom interviewed over the telephone, using Computer Assisted Telephone Interviewing, indicated that they had heard of the Timberland brand. When the level of recognition of the Timberland brand was compared to the levels of recognition in respect of other well known brands, namely Nike, Caterpillar, Ralph Lauren/Polo, Salomon and Rockport, awareness of the Timberland brand was second only to Nike. In support of this Ms Wineberg exhibits (Exhibit 23) the portion of the Brand Health Analysis report prepared by the Monitor Company.

19. Similar results were achieved as a result of market research undertaken in October 2000 by Management Horizons Europe. Interviews were conducted with some 2000 people in Great Britain in respect of various categories of footwear. 69 per cent of those interviewed were aware of the Timberland brand. Part of the research report is exhibited (Exhibit 24).

20. As a result of this activity and the research undertaken Ms Wineberg considers that the Timberland marks enjoy a very substantial reputation. The remainder of her affidavit is largely submissions in relation to the registration in suit.

21. That completes my review of the evidence.

Section 47(2)(a)/Section 5(2)(b)

22. These Sections read as follows:

Section 47(2)

“47.-(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

Section 5(2)

“5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

23. Sub paragraph (b) of Section 5(2) applies here. In considering the matter I take note of the guidance from the European Court of Justice in the cases of *Sabel V v Puma AG* [1998] RPC 199; *Lloyd Schuhfabrik Meyer & Co v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

Similarity of goods

24. Both of the applicants’ registrations are earlier trade marks within the meaning of Section 6(1)(a). They have identical specifications of goods in Class 25. The registered proprietors concede that footwear appears in the specifications of the earlier trade marks and that of their own registration. They do not admit that men’s and children’s clothing and headgear appearing in their specification are similar to the applicants’ goods across the whole range of meaning of those terms. If that is the case they have neither sought to amend their specification to avoid conflict or indicated which goods they do not consider to be similar. The applicants’ articles of outer clothing must be identical to men’s and children’s clothing

and headgear. Furthermore as the applicants point out in their written submissions ‘t-shirts’ may be either outerclothing or underwear. The respective sets of goods are, therefore, identical or closely similar.

Distinctive character of the applicants’ earlier trade marks

25. In the written submissions filed on behalf of the registered proprietors it is said that:

“..... the distinctiveness of the word **TIMERLAND** and the **TREE** device is somewhat limited, because of the generally descriptive nature of the mark in relation to goods being intended for use or to have an apparent use for outdoor activities. The connection with **TIMBER** and the outdoors is obvious and applies to both marks. The connection with **LAND** is also obvious. Thus, even if the trade mark **TIMBERLAND** and the **TREE** device have a reputation, it must be narrowly construed in the light of the generally weak distinctive nature of a mark of this type.”

26. I cannot accept that submission. Whilst the applicants’ marks may have been chosen for their desirable associations with the outdoors both the word **TIMBERLAND** and the stylized tree device are entirely distinctive in relation to the goods at issue. Furthermore the evidence suggests that this distinctive character has been enhanced in the UK by the use made of the mark prior to the material date of 5 May 2001. I will comment further on the applicants’ use when I come to the objection under Section 5(4)(a). Suffice to say at this point that the applicants’ reputation was originally based on their trade in footwear but for at least ten years prior to the material date has involved the sale of a wide selection of clothing (I note, for instance, that that article from For Him magazine dated Summer 1989 refers to “the American based footwear manufacturers [Timberland] are spreading their wings by launching a clothing collection”).

Similarity of marks

27. For reasons which I will explain below I intend to concentrate on the applicants’ word only mark, No. 1209696, in making my comparison. The comparison is thus between the word **TIMBERLAND** and the composite mark of the registration under attack consisting of the word **TIMBERLAKE** and a tree device.

28. Visually the device element in the registered proprietors’ mark is unlikely to be ignored and is a feature which has no counterpart in No. 1209696. Nevertheless words talk in trade marks and I take the view that the average consumer is likely to focus his or her attention on the word **TIMBERLAKE**. I consider that word to be an important visual reference point within the body of the mark. Marks must, of course, be compared as wholes but it is necessary to have regard to the distinctive and dominant components of marks and to consider their likely impact on consumers. In that respect I find the element **TIMBER** to be a strong and prominent element in both marks. The similarity goes beyond that as the first eight letters of the words **TIMBERLAND** and **TIMBERLAKE** are the same. Making due allowance, too, for imperfect recollection I find that there is a high degree of visual similarity notwithstanding any counter-balancing effect of the device within the registered proprietors’ mark.

29. Similar considerations apply to aural similarities. It seems unlikely that the average consumer will rely on the tree device in oral references to the registered proprietors' mark given the presence of the word TIMBERLAKE. I also bear in mind that it has been held in *REACT Trade Mark* [2000] RPC 285 that, whilst aural considerations must not be ignored, the primary use of trade marks in the purchasing of clothes is a visual act.

30. The conceptual similarity between the marks is also primarily focused on the element TIMBER. However both TIMBERLAND and TIMBERLAKE are suggestive of features of natural landscape which are calculated to lend support to the image of rugged outdoor clothing fostered by the applicants. The device of a tree seems to me, in this context, to provide conceptual reinforcement of that image and the word/element TIMBER. I note a suggestion in the written submissions filed on behalf of the registered proprietors that "the presence of a lake in the lower part of the proprietors' mark reinforces the difference with the latter part of the mark TIMBERLAND". It is also suggested that the upper graphical part of the proprietors' mark has substantial visual differences from a tree, resembling more closely a cloud scene. I have difficulty with those submissions. The device is in my view unmistakably and predominantly a stylized depiction of a tree.

31. Taking all these factors into account I find that there is a marked degree of similarity between the words TIMBERLAND and TIMBERLAKE and that the device reinforces rather than displaces that similarity when the registered proprietors' mark is considered as a whole.

Likelihood of confusion

32. In coming to a global appreciation of the matter I bear in mind the following comments of Mr G Hobbs QC in *Raleigh International Trade Mark*, [2001] RPC 202:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences."

33. In the light of my above findings in relation to the respective sets of goods and the marks themselves I have little hesitation in concluding that the average consumer is likely to assume that goods sold under the respective marks come from the same trade source either as a result of direct confusion or by imperfectly recollecting the applicants' mark. The application for invalidity thus succeeds under Section 5(2)(b).

34. The second leg of the applicants' case under Section 5(2)(b) relies on their TIMBERLAND mark (No. 1209696) and tree device (No. 1209697) being 'considered together' in the context of the TIMBERLAKE and device mark. In my view it is not permissible to amalgamate earlier trade marks in this fashion. The comparison must be on a mark by mark basis. I, therefore, decline to consider this aspect of the applicants' case.

Section 47(2)/Section 5(4)(a)

35. I will for the sake of completeness deal with this ground. The relevant part of Section 47(2) is set out above. Section 5(4)(a) 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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

36. The conventional test for determining whether a party has 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 invalidity proceedings, the three elements that must be present can be summarised as follows:

- (1) that the applicants for invalidity’s 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 registered proprietors (whether or not intentional) leading or likely to lead the public to believe that goods offered by the registered proprietors are goods of the applicants for invalidity;
- (3) that the applicants for invalidity have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the registered proprietors’ 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.

37. I must return at this point to the applicants’ evidence of use which is summarised above. My findings based on that evidence are as follows:

- the applicants have a long standing trade in footwear and have expanded into the wider clothing market since the late 1980s;
- the invoice evidence (Exhibit 2) and list of retail outlets (Exhibit 5) support the above claims. I note that the latter, which consists of some 19 pages of names shows those retailers who stock ‘footwear’, ‘clothing’ and ‘other’. A

substantial number supply both footwear and clothing. The stockists' list is not dated but is said to be from 2001. It contains well over a thousand names. It is reasonable to infer that list has been built up over a period of time;

- the catalogue exhibits support the claim that by the material date a substantial trade existed in apparel as well as footwear. I note too that, whilst some of the catalogues are for the 'Fall' season, suggesting US usage, they contain a UK distributor name;
- the UK advertising also bears witness to the promotion of a wide range of clothing as well as footwear in this country;
- the brand surveys testify to the success of the TIMBERLAND brand in the UK;
- the evidence as a whole shows that the applicants have used the word TIMBERLAND, the device of a tree and a composite mark incorporating both those elements in almost equal measure;
- the target market is said to be "fashionable, outdoorsy consumers". The thrust of the advertising supports that view;
- the advertising also supports the claim that "the outdoors, often represented by depiction of trees, is a persistent theme of our advertising and corporate image".

38. The registered proprietors have filed no evidence to challenge any of the claims made. I conclude that the applicants enjoy goodwill in each of the three signs they use, that is the word TIMBERLAND, the stylized tree device (essentially the one shown in No. 1209697) and those marks used in combination. It is also evident from Exhibit 16 that the opponents regulate the use of their marks very carefully.

39. In considering the issue of misrepresentation the applicants are entitled to rely on the goodwill associated with their composite mark TIMBERLAND and tree device. That combination of features seems to me to place them in an even stronger position than they were in under Section 5(2)(b) based on the word TIMBERLAND alone. I have already given my views on the word elements of the respective marks. It is true that the tree devices are stylized to a greater or lesser extent. But it has long been held that the eye is not an accurate recorder of detail (*De Cordova v Vick* [1951] RPC 103) and that marks are remembered by general impressions. The devices are clearly of trees. There are other elements, particularly the rising sun device in the proprietors' mark, but I have little doubt that the abiding impression left in the recollection of consumers will be of representations of trees.

40. It is noted in a passage from Halsbury's referred to in Mr Hobbs' decision in *WILD CHILD* that:

"To establish a likelihood of deception or confusion in an action for passing off where

there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.”

41. Having regard particularly to the extent of the reputation relied on by the applicants, the closeness of the respective fields of activity and the cumulative effect of similarities between the marks, I find that there is a misrepresentation likely to lead the public to believe that goods offered by the registered proprietors are goods of the applicants. As the registered proprietors will be able to operate in precisely the same goods' area as the applicants the potential for damage to the latter's sign is obvious both in terms of diversion of trade or possible damage to the brand image they have carefully built up. In short I find that the Section 5(4)(a) case is also made out.

42. The application for invalidity has been successful. In accordance with Section 47(6) the registration shall be deemed never to have been made.

43. The applicants are entitled to a contribution towards their costs. I order the registered proprietors to pay them the sum of £1500. 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 13th day of December 2002

M REYNOLDS
For the Registrar
the Comptroller-General