

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE  
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

**THE JOHN DAVID GROUP PLC**

**Applicant**

**and**

**FL RETAIL OPERATIONS, LLC**

**Opponent**

CONCERNING

**Trade Mark Application No. 2004/00928 (229779)**

**FOOT ACTION**

**Background**

1. On 27 April, 2004, The John David Group, plc, an English company of Hollingsbrook Way, Pilsworth, Bury, Lancashire BL9 8RR, England, made application (No. 2004/00928) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the words FOOT ACTION as a trade mark in respect of a specification of goods and services in Classes 18, 25 and 35, which was amended in the course of the examination of the application to read as follows:

**Class 18:** *Bags; holdalls; backpacks; rucksacks; sports bags; sports holdalls; parts and fittings for all the aforesaid goods*

**Class 25:** *Clothing; footwear; headgear*

**Class 35:** *The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail outlet, namely bags, holdalls, backpacks, rucksacks, sports bags, sports holdalls, clothing, footwear, headgear, gymnastics and sporting articles and equipment*

*together with parts and fittings for these goods; the bringing together for the benefit of others of a variety of goods enabling customers to conveniently view and purchase those goods from a catalogue relating to bags, holdalls, backpacks, rucksacks, sports bags, sports holdalls, clothing, footwear, headgear, gymnastics and sporting articles and equipment together with parts and fittings for these goods; by mail order or by means of telecommunications; provision of information to customers and advice and assistance in the selection of goods brought together as above*

2. The application was accepted for registration and advertised accordingly under No. 229779 in Journal No. 2001 on 25 August, 2004.
3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 24 November, 2004 by FL Retail Operations, LLC, a corporation organised and existing under the laws of the State of New York, United States of America of 112 West 34<sup>th</sup> Street, New York, NY, 10120, United States of America. The Applicant filed a counter-statement on 14 December, 2004 and evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”). A hearing was then appointed for 16 April, 2008 but the parties informed the Controller that they did not intend to be represented at the hearing so that the matter went for decision on the basis only of the materials filed.
4. Acting for the Controller, I decided the opposition on 23 April, 2008. The parties were notified on that date that I had decided to dismiss the opposition and to allow the mark to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 1 May, 2008.

### **Scope of the opposition**

5. The notice of opposition lists eleven separate grounds of opposition arising under the following sections of the Act: Section 8(1)(a), Section 8(1)(b), Section 8(1)(c), Section 8(1)(d), Section 8(3)(b), Section 8(4)(a), Section 8(4)(b), Section 10(2)(b), Section 10(3), Section 10(4)(a) and Sections 37(2) and 42(3). The several grounds of opposition under Section 8 of the Act are expressed, without further

qualification or explanation, in the terms of the relevant subsections. The grounds of objection under Section 10 are based on the Opponent's claim to proprietorship of the trade mark FOOTACTION, which it claims is entitled to protection under Article 6bis of the Paris Convention as a well-known trade mark. The ground of objection under Sections 37(2) and 42(3) is based on the Opponent's claim that the Applicant does not use nor have a *bona fide* intention of using the trade mark applied for in relation to all of the goods covered by the application for registration.

### **The evidence filed and facts claimed**

6. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits MK1-MK3) dated 16 March, 2006 of Michael Thomas Kiernan, Trade Mark Agent of Tomkins & Co. and a Statutory Declaration (and Exhibits DY1 and DY2) dated 13 April, 2006 of Donald F. Yost, Vice President of the Opponent. Evidence submitted by the Applicant under Rule 21 consisted of two Statutory Declarations, one (together with Exhibits JD1-JD4) dated 5 July, 2006 and a second (together with Exhibit JD5) dated 26 September, 2006, both made by Brian Michael Small, Group Finance Director of the Applicant. Evidence in reply submitted by the Opponent under Rule 22 consisted of a sworn statement (and Exhibit GC1) made on 14 August, 2007 by Giovanna Cipriano, Vice President of the Applicant.
7. I would summarise the relevant facts averred to in the evidence as follows. The Opponent operates stores throughout the United States of America under the name FOOTACTION. There were 363 such stores in operation as of 28 January, 2006, principally in large shopping malls. It has registered FOOTACTION as a trade mark in various countries throughout the world. It maintains a website, [www.footaction.com](http://www.footaction.com), through which it sells merchandise to customers throughout the world. Such internet sales have included sales to Irish customers.
8. The Applicant is a United Kingdom high street retailer of sports and leisure goods, trading under the name JD Sports. It sells branded products such as LACOSTE, PUMA, ADIDAS and NIKE through a network of stores throughout the United

Kingdom and Ireland. It has registered the trade mark FOOT ACTION as a Community Trade Mark as of 6 July, 2001.

### **Grounds of decision**

9. The majority of the grounds of opposition set out in the notice of opposition in this case have not been supported by any evidence whatsoever. That is the case in respect of the grounds of opposition under Section 8(1)(a), Section 8(1)(b), Section 8(1)(c), Section 8(1)(d), Section 8(3)(b), Section 8(4)(a) and Sections 37(2) and 42(3). In my opinion, the only inference that can be drawn from the conduct of these proceedings by the Opponent is that it never had any basis on which to raise grounds of opposition against the present application under any of those Sections of the Act and that its inclusion of those grounds in its notice of opposition was entirely without cause. For that reason, I have decided to dismiss the opposition under those grounds without further consideration.
  
10. As regards the ground of opposition under Section 8(4)(b) of the Act, to the effect that the application for registration was made in bad faith by the Applicant, that charge was not particularised in any way in the notice of opposition and does not, therefore, fall to be dealt with by the Applicant or by the Controller. It appears to be based on the Opponent's contention that the Applicant was aware of the Opponent's proprietorship and use of the trade mark FOOTACTION and that it was "no coincidence" that the Applicant had adopted the trade mark FOOT ACTION for use in relation to similar goods. That is an entirely speculative allegation and is not a proper basis on which to make a charge of bad faith, which is a serious charge and one that should not be made lightly.
  
11. The grounds of opposition under Section 10(2)(b) and Section 10(3) of the Act are based on the Opponent's claim that its trade mark FOOTACTION qualifies under Section 11(1)(c) as an earlier trade mark as against the mark that is the subject of the present application by virtue of its entitlement to protection under the Paris Convention as a well-known trade mark. Section 61(1) of the Act provides that such a mark is a mark that is well known in the State as being the mark of a national of a Convention country or a person who is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business or has any goodwill in the State. While I accept the Opponent's direct evidence that it carries on business in the United States (a Convention country) under the trade mark FOOTACTION, there is no evidence whatsoever that, as of the relevant date, 27 April, 2004, that trade mark was well known in this jurisdiction as being the Opponent's mark. The material tendered in support of the Opponent's claim in that regard, even if given the most favourable interpretation, reflects a level of activity that is so sporadic and paltry in nature as to be incapable, in itself, of having established the Opponent's trade mark as a well-known mark in this jurisdiction, even as of the present date. It is for the Opponent to show that its trade mark is well known in the State if it wishes to pursue its opposition on that basis and it has failed completely to do so. In the circumstances, I have decided that the Opponent's trade mark does not constitute an earlier trade mark for the purposes of these proceedings and that the opposition under Sections 10(2)(b) and 10(3) must be dismissed accordingly.

12. Finally, with regard to the ground of opposition under Section 10(4)(a) of the Act, this is advanced by the Opponent on the basis that the use of the trade mark for which the Applicant seeks registration is liable to be prevented by virtue of a rule of law protecting an unregistered trade mark or other sign used in the course of trade, presumably the law of passing off. For that ground of opposition to succeed, it would have to be shown, firstly, that the Opponent's goods were known to consumers in this jurisdiction by reference to its trade mark FOOTACTION as of the relevant date, 27 April, 2004, such that the use by the Applicant of the trade mark FOOT ACTION in relation to the goods or services covered by the application might be said to constitute a misrepresentation leading to damage to the Opponent. The Opponent has not shown that its trade mark enjoyed any recognition whatsoever among consumers here as of the relevant date and the opposition based on Section 10(4)(a) must also be dismissed.

Tim Cleary  
Acting for the Controller  
13 May, 2008