

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2049253 IN THE NAME  
OF TARA JARMON**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER THE NUMBER45933 IN THE NAME OF  
GENESCO INC.**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF application no 2049253  
in the name of Tara Jarmon to register  
a trade mark in Class 25**

**and**

**IN THE MATTER Of opposition thereto under No 45933  
in the name of Genesco Inc.**

### **Decision**

1. On the 19 December 1995, Tara Jarmon of Paris, France, applied for registration of the mark TARA JARMON in Class 25 in respect of:

Bathing suits, teddies (undergarments), belts, shirts, underclothing, sashes for wear, scarfs, gabardines (clothing); vests, waterproof clothing, skirts, coats, trousers, overcoats, dressing gowns, pullovers, pyjamas, frocks; boots, esparto shoes and sandals, slippers, beach shoes; caps (headwear), hats.

2. The application claims priority under Section 35 of the Act from an earlier filing in France on 22 June 1995. The applicant subsequently filed a certified copy of the priority document which confirms the bare details of the application described above and also the application covered “Vetements, chaussures, et chapellerie”, which I believe translates as “clothing, shoes and headgear” and thus covers all the goods contained within the UK filing.
3. On 22 November 1996, notice of opposition was filed by Genesco Inc. of the USA.
4. The grounds of opposition [insofar as they were pursued before me] are that:-
  - i) The opponent has a chain of retail shoe stores throughout the USA under the name

JARMAN and there are records of sales to UK customers from these stores;

ii) Marks consisting of or containing the word JARMAN are registered in countries in Europe, South America, the Far East and in the USA [but not the UK] and the mark is well known in the UK;

iii) Registration of the mark applied for in respect of “boots, esparto shoes, sandals, slippers, beach shoes, belts, underclothing in the nature of hosiery and socks” would therefore be contrary to Sections 5(2) and 5(4)(a) of the Trade Marks Act 1994.

5. The applicant denies these grounds.
6. The matter came to be heard on 20 August 1999 when the opponent was represented by Mr K Farwell of Phillips and Leigh, assisted by Mr Robert Weston of the same firm of Trade Mark Attorneys. The applicant was not represented.
7. The opponent’s evidence is set out in an affidavit dated 12 May 1997 by H Glenn Bolton of Genesco Inc. This does no more than introduce an earlier affidavit Mr Bolton made on 22 January 1997 in relation to other proceedings. It is apparent from the earlier affidavit that Mr Bolton is President of Jarman Shoe Company, which is a division of Genesco Inc.
8. The core of the opponent’s case is set out in paragraphs 6 and 12 of Mr Bolton’s affidavit of 22 January 1997, which are reproduced below:

“ 6. I further state on oath that in my considered opinion and belief, based on my knowledge of the history of Genesco, the JARMAN trade mark, the JARMAN script, and trade marks containing the trade mark JARMAN became extremely famous worldwide beginning in the 1930's and continuing into the 1980's. The trade marks were used in the course of trade by being directly applied to the insoles of shoes, as well as on the point-of-sale materials and in advertising and promoting the products, on large quantities of shoes manufactured in multiple countries and exported to many parts of the

world as well as for retail shoe stores. Today, the trade mark JARMAN is still used in this way on a substantial quantity of shoes produced and sold by licensees authorised to use the trade marks in South Africa, Japan, Canada and South America, including Chile, Argentina, Paraguay, Uruguay, and Peru.

At the present time, the JARMAN mark is used primarily for retail shoe stores throughout the United States which sell both shoes bearing the JARMAN mark and related marks described in paragraph 4 above and other well-known brands of shoes in the chain of stores. Genesco, of course, desires to protect and enhance the goodwill which it has enjoyed for many years under the trade mark JARMAN, and therefore carefully supervises and selects the character and quality of any goods sold in JARMAN shoe stores. It should be clearly noted that the trade mark JARMAN, the JARMAN script and marks containing the trade mark JARMAN continue to be used in the course of trade applied to the insoles of products as evidenced herein above and sold in JARMAN shoe stores. The JARMAN mark is also used for retail shoes in Japan and Chile.

In its JARMAN shoe stores, Genesco sells the full range of products that would be expected to be seen in a retail shoe store including shoes and boots of all types, leather and imitation leather goods, hosiery and socks, shoe creams and polishes.”

“ 12. It is my general knowledge that Florida is a favoured location for British tourists coming to the United States of America. It is also my general knowledge that retail shopping is a popular recreational activity when on holiday. I therefore considered how best to establish that British nationals knew of and had purchased shoes from a JARMAN shoe store. Genesco has analyzed [sic] VISA sales (purchases made using a VISA card) made by nine JARMAN shoe stores in Florida for the period 30<sup>th</sup> June 1995 to 7<sup>th</sup> December 1995 by reviewing individual VISA receipt slips and noting those VISA cards which could be identified as being issued by banks in the United Kingdom. The total of these sales is \$3,388.91. From this number, I believe that we can reasonably state that the JARMAN stores in Florida generate annually at least \$11,500.00 in credit card sales to VISA credit cards issued in the United Kingdom. These figures are derived from the following analysis:

VISA sales for 23 weeks \$3,388.91

Sales derived from nine (9) Florida JARMAN stores:

(Numbers refer to store numbers in Exhibit 6 previously  
produced and shown to me)

Store# 367	\$724.25
392	408.68
400	581.48
401	308.80
653	193.63
658	259.62
663	244.92
682	320.96
1 162	.346.57
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	\$3,388.91
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The 23 weeks represent 43.9% of our annual sales

Annualized VISA sales.  $\$3,388.91 / .439 = \$7,719.61$

VISA sales represent 2/3 of all VISA sales

Estimated annual sales in Florida JARMAN

stores to VISA cards issued in UK.  $\$719.61 / .667 = \$11,573.62$ [sic]

Exhibit.....7 now produced and shown to me and forming part of this Affidavit comprises a copy of the figures from which the above analysis is derived. In view of the actual sales evidenced to citizens of the United Kingdom by the aforesaid analysis, using Florida as a sample, I considered whether any reasonable extrapolation of these figures could be made to cover sales in JARMAN stores to citizens of the United Kingdom throughout the whole of the whole [sic] of the United States of America. In conducting this enquiry, I have taken into account the obvious limiting factor that, to my general knowledge, not all towns and cities containing a JARMAN shoe store are equally likely to be visited by British tourists. Nevertheless, to my general knowledge, New Orleans is visited by tourists for Mardi Gras, the historic French Quarter and the Jazz Festival; New York and Boston for their Museums and Galleries , California for Hollywood, Phoenix AZ for the Grand Canyon and so on. I am prepared to state on oath that I verily

believe U.S. sales to citizens of the United Kingdom from the range of JARMAN stores may be of the order of \$75,000 per annum. British visitors to South Africa, Japan and Canada are also likely to encounter the shoes of the Corporation's licensees.

9. Exhibit 7 to Mr Bolton's affidavit consists of what appears to be a computer print containing a code designating the location of JARMAN shoe stores in the USA, against which are logged a number of accounts and units (presumably of sale) and a value in US dollars. All these details are in turn grouped against locations which include "England", "London", "Britain" and "United Kingdom". There is no other information, such as names or addresses of customers or even the names of the UK financial companies which are said to have issued the VISA cards that gave rise to the claimed sales. Further, the sales listed do not accord with the figure of \$3388 mentioned in Mr Bolton's affidavit. In fact the sales in the exhibit appear to represent a larger sum.
10. The opponent also filed supporting Statutory Declarations dated 28 April 1998 & 27 May 1998 by Frederick Hitchens, who is a partner of Information Research Network, and Robert Dale Weston, who is a Trade Mark Attorney acting for the opponent in the UK.
11. Mr Hitchens' evidence consists of tabulations generated from an International Passenger Survey showing the number of UK residents who visited the USA by air in 1995-1997. This suggests that Florida received over 600k UK visitors in 1995, which is around one third of all UK visitors to the USA in that year.
12. Mr Weston gives evidence of his own trips to the USA, which have included shopping in US retail outlets, and of his experience of other British visitors shopping in the USA whilst there.
13. He also provides evidence of a visit to a JARMAN shoe store in Arlington, Virginia in December 1995. This includes a photograph of the frontage of the store. I understand that this was taken during a trip to the USA connected to these proceedings.

Paragraph 4 of Mr Weston's evidence is as follows:

“On personal observation the JARMAN SHOE STORE outlets sell a whole range of popular and fashionable shoes including Timberland, Cat, Doc Martens and including slippers, sandals, trainers (runners) tennis shoes (sneakers) as well as socks, hose, shoe shining equipment.”

14. On behalf of the applicant, Helen Griffith of the British Footwear Association says that, although she has been employed in that capacity since 1980 and has attended the British Footwear Fair in London, she has never heard of JARMAN or Genesco Ltd. She says they are not listed in the trade directories she checked. Julie Hindle gives similar evidence. She says she is the Head of the Information Centre at SATRA, an organisation for companies in the footwear industry with an international membership.
15. Barry Walker, who is in the travel industry, also gives evidence on the applicant's behalf. The only point worth mentioning is that he says that, in his experience, mid-July to early September represents the peak period for travel to Florida. The significance of this is, of course, that the opponent's review of VISA credit card sales included this period.
16. Celine Baillet is a Trade Mark Attorney of Cabinet Weinstein, Paris. She exhibits a copy of an Expatriate Guide obtained from Barclays Bank in Paris offering customers VISA cards. She says that a person who is not resident in the UK can obtain a VISA card issued by a British bank.
17. The opponent responded to this evidence with a Declaration dated 21 April 1998 by John E Nylander, who is the vice president of Genesco International, a division of the opponent. The relevant paragraphs of his evidence [3-6 and 8] are reproduced below:

“ 3. My duties include promotion of Genesco's products and brands to potential licensees and wholesale and retail customers at International trade shows. One of the leading footwear trade shows in the world is the GDS Show held twice each year (in

March and September) in Dusseldorf, Germany at which Genesco regularly displays and promotes its products and brands.

4. The GDS Show is the leading European footwear trade show and is attended by thousands of footwear manufacturers, distributors, buyers, wholesalers, retailers, purchasing agents, sales persons, licensors, licensees, designers and others in the industry including large number of attendees from the UK. Examples of publicity regarding the most recent GDS show from the leading international trade publications of the industry, *Footwear News*, are marked as Exhibit A annexed hereto.

5. Genesco regularly uses the GDS Show as an opportunity to meet with current and potential licensees and to promote the JARMAN retail concept and JARMAN products.

6. An example of the Brand Positioning Presentation materials and advertising prototypes for the JARMAN brand which I and my colleagues used in promoting the JARMAN brand at the most recent GDS Show in March, 1998, are marked as Exhibits B and C annexed hereto. JARMAN footwear was also exhibited to current and potential licensees who visited the Genesco stand during the GDS show.”

“ 8. The JARMAN brand receives regular publicity in *Footwear News*, the leading industry trade publication, which is distributed internationally. Examples of such publicity are marked as Exhibit E annexed hereto. I can only surmise that Ms Helen Sarah Griffith and Ms Julie Patricia Hindle, who have given affidavits stating that they are associated with the British footwear industry and that they are unaware of the JARMAN brand, must not read the leading industry trade publications or attend the GDS show or other international trade shows”.

18. There is nothing in the exhibits to Mr Nylander’s Declaration which establishes that the JARMAN mark was promoted at a GDS show *before the date of the application under opposition*.

19. That concludes my review of the evidence and I now turn to the decision.

20. The necessary conditions to succeed under Section 5(4)(a) of the Act were described

by Geoffrey Hobbs QC acting as the Appointed Person in AD2000 trade mark 1998 RPC 455. In brief the opponent needs to show that:

- i) it has goodwill in the UK under a sign;
- ii) normal and fair use of the mark applied for would amount to be likely to cause confusion or deception and would amount to a misrepresentation (whether or not intentional);
- iii) that such a misrepresentation would damage the opponent's goodwill.

21. In *Jian Tools for Sales Inc. v Roderick Manhattan Group Ltd and another* [1995 FSR 924], Mr Justice Knox reviewed the authorities and concluded that:

- i) in order to succeed in a passing-off action a foreign plaintiff who had no place of business in the UK has to show at the least that he has customers here;
- ii) the nature of the goods or services had to be taken into account in determining whether the customer base in the UK was sufficient to support a goodwill locally situated within the jurisdiction;
- iii) sales to UK customers generated by foreign sources such as foreign magazine inspired purchases or recommendations by foreign residents or purchasers made abroad should not be disregarded unless they were purchases no member of the general public could make.
- iv) one customer in the UK may not suffice but a substantial number may.

22. The above is essentially a summary of the headnotes on page 925 of the report of the case and further comments of the judge reported in the second paragraph on page 957.

23. This was an application for an interlocutory injunction. Before deciding whether it should be granted, Knox J had to decide exactly what the law was. Applying Knox J's interpretation of the law to the facts of this case, it does not seem to me that the opponent's case under Section 5(4)(a) can be dismissed merely because they cannot point to any trade at all under the mark in the UK.
24. The evidence of sales in Florida to customers using VISA cards issued by British banks is the only specific evidence that the opponent's can rely upon to make good its claim to have customers within the UK.
25. I find this evidence inadequate for the following reasons:
- i) the evidence does not reveal the names of any UK customers;
  - ii) it does not even reveal the names of the British banks who are claimed to have issued the VISA cards used in Florida;
  - iii) there is no indication of the goods purchased with the credit cards [bearing in mind the opponent's claim to also sell leather goods such as hand bags which are not covered by the application under opposition];
  - iv) the amounts shown in exhibit 7 to Mr Bolton's affidavit do not correspond with the figure used by him in the body of the affidavit and there is no explanation for this discrepancy.
26. The applicant has pointed out that it is possible for non-UK residents to obtain a VISA card from a British bank. Not too much should be made of this point but it does reveal the frailty of the opponent's evidence. The best that can be said of it is that it gives rise to an inference that UK residents visited JARMAN stores in Florida between 30 June 1995 and 7 December 1995 and bought some goods.

27. There are further difficulties in accepting this evidence as establishing a relevant goodwill under the mark JARMAN in the UK.
28. Although it is not entirely clear from Section 5(4)(a) of the Act, it is clear from Article 4(4)(b) of Directive 89/104/EEC - which Section 5(4)(a) is intended to implement - that the right to prohibit use of the later mark must have existed at the earlier of the date of the application or the date of priority. In this case that means that the opponent must be able to establish that it had a passing-off right at 22 June 1995 (the date of the applicant's priority claim).
29. However, the whole of the period within which the opponent conducted an analysis of its credit card sales falls after this date. Accordingly, not only is there no solid evidence of any UK customers, but one has to make an assumption that sales inferred to have taken place after the relevant date are indicative of similar trade that took place before the relevant date. This I decline to do. As for Mr Bolton's attempt to give evidence of sales to UK customers throughout the USA by a process of extrapolation of the credit card sales analysis undertaken in Florida, I can only say that if such an extrapolation can ever be regarded as credible evidence, it can only be where the base figures are shown to be from a relevant period and robust. The opponent's evidence is neither.
30. The deficiencies in the opponent's evidence would, in my view, make it very unlikely that they would succeed on the same evidence in a passing-off action. This is sufficient reason by itself to reject the opposition under Section 5(4)(a).
31. However, I have a further difficulty in accepting this evidence as establishing sufficient goodwill in the UK to support a passing off action. It arises from the nature of the opponent's business and use of the mark JARMAN.
32. Mr Bolton says that the JARMAN mark [or marks including the word JARMAN] became extremely famous world wide beginning in the 1930s and continuing into the 1980s. He then says that the trade marks were applied to shoes and that the mark is

still used this way in South America, South Africa, Japan and Canada. Mr Bolton continues:

“At the present time, the JARMAN mark is used primarily for retail shoe stores throughout the United States which sell both shoes bearing the JARMAN mark and related marks described in paragraph 4 above and other well-known brands of shoes in the chain of stores”.

33. The “present time” is January 1997 when the affidavit was sworn. He does not say that the mark was applied to shoes sold in Florida in the period leading up to the material date or during the period of the analysis of the VISA card sales. And although Mr Weston gives evidence [paragraph 4 of this Statutory Declaration] of the brands he saw in a JARMAN shoe shop in Virginia in December 1995, the ‘JARMAN’ mark is not mentioned.
34. The significance of this is that retailing activity is normally local in nature whereas trade in goods which travel under a mark is more likely to create goodwill elsewhere.
35. I do not rely on this particular defect in the opponent’s evidence to any significant extent. For even if some of the goods which are said to have been sold to UK residents from the opponent’s US stores did bear the JARMAN mark, the opponent’s US business is clearly primarily a retail store chain. Knox J. pointed out that it is necessary to consider the nature of the goods or services concerned. In my view the nature of the opponent’s trade in those goods is equally relevant.
36. The reason for this is obvious. UK residents travel all around the world and use some of the shopping facilities of the countries they visit. If the result of this is that every overseas retail outlet visited by a number of UK residents acquires goodwill in the UK with associated passing-off rights in respect of the same or similar names, it would soon become hard to find a mark which could be lawfully used in this jurisdiction, at least for consumer goods.

37. It is notable that in the Jian Tools case mentioned above, the plaintiff did not only rely on sales made in the USA. There was also evidence of a small number of purchases made from the UK and evidence of use of the mark in US magazines which were circulated in the UK. Although Knox J. held that sales made in the USA were not to be discounted in the overall assessment of the existence of goodwill in the UK, it is doubtful whether sales made to UK customers outside the jurisdiction will, in isolation, be sufficient to create sufficient goodwill in the UK to support a passing off action. This observation echoes a point made by Walton J. in the *Athletes Foot Marketing Associates Inc. v Cobra Sports Ltd and Another*, 1980 RPC 343, at 357, lines 33-35, when he said:

“Whether such an instance by itself [of a transaction made in the U.S.A. by one of the plaintiff’s franchisees ] would be of any assistance to the plaintiffs may well be a moot point on several different grounds; but there is not even one such offered.”

38. Mr Farwell also drew my attention to the cases of *La Societe Anonyme des Anciens Etablissements Panhard et Levassor v Panhard Levassor Motor Company*, (1901) 2 Ch 513, *Poiret v Jules Poiret Ltd* (1920) 37 RPC 177, *Sheraton Corporation of America v Sheraton Motels Ltd* 1964 RPC 202 and *Globelegance B.V. v Sarkissian* 1974 RPC 603. All these cases can be distinguished from the facts of the case before me. In each case there was some evidence of sales under the plaintiff’s mark in or from the UK. That is not so in this case. Further, in these cases there was evidence that the claimant enjoyed a reputation in the UK which (once the claimant had shown it had some goodwill here) made it much more likely that the use of the same or confusingly similar mark would be regarded as a misrepresentation.

39. For all the reasons set out above, I have come to the conclusion that the opponent has not established that it had a goodwill in the UK at the relevant date and the Section 5(4)(a) ground of opposition therefore fails.

40. The opposition under Section 5(2) of the Act on the basis of the opponent’s claim that its mark qualifies as a well known trade mark under Section 56 of the Act must also be

rejected. Section 56(1) of the Act requires the earlier mark to be “well known in the United Kingdom”. The opponent’s evidence comes nowhere near supporting such a claim.

41. The opposition having failed, the applicant is entitled to a contribution towards its costs. The applicant did not attend the hearing. However, it is entitled to a contribution towards its costs for the earlier stages of the procedure. Accordingly, I order the opponent to pay the applicant the sum of £500.

**Dated this 7 Day of September 1999**

**Allan James**

**For the Registrar**

**The Comptroller General**