

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2157042
BY NATIONAL AUSTRALIA TRUSTEES LIMITED
TO REGISTER A TRADE MARK IN CLASS 39

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50869
BY SEA WORLD INC.

BACKGROUND

1) On 2 February 1998 National Australia Trustees Limited of 255 Adelaide Street, Brisbane, Queensland, Australia, 4000 applied under the Trade Marks Act 1994 for registration of the following mark:



2) In respect of the following goods:

In Class 39: "Travel services in the nature of providing information to travellers and vouchers for tours, all to Australia, and inclusive of entry into amusement parks in Australia."

3) On the 5 April 2000 Sea World Inc. of One Busch Place, St. Louis, Missouri, 63118-1852, United States of America filed notice of opposition to the application, subsequently amended. The amended grounds of opposition, are in summary:

- a) The opponent is the proprietor of Trade Marks (detailed at annex A). The mark applied for is similar to the opponent's marks and therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.
- b) The applicant knew of the opponent's mark and earlier rights in the SEA WORLD marks and the application therefore offends against Section 3(6) of the Trade Marks Act 1994.
- c) The opponent's claim that their marks are well known and entitled to protection under the Paris Convention and Section 56(1) of the Trade Marks Act 1994.
- d) The applicant's mark is not capable of distinguishing the applicant's services from those of other traders and the evidence of acquired distinctiveness through use is inadequate and fails to demonstrate sufficient trade mark recognition amongst customers or prospective customers for these services. The mark therefore offends

against Section 3(1)(b) and (c) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent's claims. They claim that there is no likelihood of confusion as the two parties have been co-existing for seven years in the UK market without confusion occurring.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 19 June 2002 when the applicant was represented by Mr Edenborough of counsel instructed by Messrs David Keltie Associates and the opponent by Mr Mitcheson of counsel instructed by Messrs D Young & Co.

OPPONENT'S EVIDENCE

6) The opponent filed three declarations. The first, dated 23 February 2001, is by Angela Claire Thornton who is employed as a Technical Assistant by the opponent's Trade Mark Agency.

7) Ms Thornton describes how she phoned three travel agencies, Going Places, Lunn Poly and Thomas Cook, and enquired about package holidays including tickets to Sea World (without specifying the destination, whether it would be possible to buy tickets to Sea World independently of a package holiday and, if so, how this would be advertised, for example, would it be sold through brochures etc.

8) Ms Thornton describes how each company responded:

- *Going Places*: Could offer a package holiday including tickets to Sea World, and they could sell such tickets independently. They advised that such tickets would be via a separate company called Seligo Attractions and that they had separate brochures for such attractions. The agent did not seek to clarify if Ms Thornton was discussing Sea World USA, or Sea World Australia.
- *Lunn Poly*: Do not offer complete packages but could sell tickets independently of a holiday package. Again they did not seek to clarify which Sea World she was referring to but sent a brochure for Sea World Parks in the United States of America. This brochure is at exhibit ACT1 and shows the mark a device mark above the word "SeaWorld" in large text, with "Adventure Park" below in smaller text, and beneath that the word "Orlando".
- *Thomas Cook*: Do not offer package holidays which include tickets to Sea World but could offer such tickets independently of the package holiday. They did not have a brochure but advised that Virgin Holidays could assist with same. Again no clarification was sought as to which Sea World was under discussion. Ms Thornton rang Virgin Holidays and asked for details of Sea World and was sent a brochure for holidays in the USA. The brochure is at exhibit ACT2 and has the same mark as in exhibit ACT1.

9) Ms Thornton states that she viewed the video tape, exhibit GEM5, submitted in support of

the application in suit. She claims that at no point was the mark in suit used solus. It appeared in the first seconds of the tape with the words GOLD COAST AUSTRALIA underneath it.

10) Ms Thornton states that on 18 August 2000 she visited a Lunn Poly shop in High Holborn. Selecting a brochure on Florida holidays she found the opponent's trade mark 2058199. This was shown to a sales assistant and a manager who both confirmed that they recognised the opponent's dolphin and wave mark, and were aware of Sea World Gold Coast Australia. She states that the manager believed them to be under common ownership. She then states that, on the same date, she went to a Thomas Cook shop also in High Holborn. When shown the opponent's trade mark 2058199 the consultant in the shop stated that she recognised it but had never heard of Sea World Gold Coast Australia. At exhibit ACT3 is a brochure which is said to contain a representation of the opponent's trade mark 2058199, although this is not the actual brochure shown to the sales representatives mentioned above. In fact the brochure shows a photograph of what appears to be the entrance to the park, with the word SEAWORLD where the letter "O" is replaced by the logo shown in trade mark 2058199 depicting a killer whale.

11) Ms Thornton states that she selected two agents from the list provided by the applicant in the statutory declaration of Graham McHugh as being UK travel agents who offer tickets to Sea World Nara and Sea World Gold Coast Australia. The first company contacted, Travelbag, connected her to the USA department. Once she had explained that she wanted information regarding Sea World Gold Coast Australia, she was transferred to the correct department. They provided a brochure shown at exhibit ACT4 which features the trade mark applied for with the words "Gold Coast Australia" in very small print underneath. The second company contacted, Bridge the World, also sent a brochure, at exhibit ACT5 which makes reference to "Sea World" and "Sea World Nara".

12) Ms Thornton states that on the basis of her investigations she believes that, in the trade, the term Sea World solus denotes the opponent whilst it is necessary to qualify the term Sea World with the words Gold Coast Australia in order to distinguish between the two parties. She also states that there is still believed to be a connection between the two.

13) The second declaration, dated 19 July 2001, is by Victor G Abbey the President of Busch Entertainment Corporation (BEC) and its wholly owned subsidiary Sea World Inc. He has held his position since 1 March 2000 and has been employed by BEC since 1978. He states that Sea World Inc. was acquired by BEC in 1989. Mr Abbey confirms that he has access to the records of the opponent.

14) Mr Abbey states that the opponent's first marine amusement park at San Diego, California opened in 1964 under the name SEA WORLD. He states that "The theme and object of this amusement park was to entertain, inform and educate members of the public with marine and aquatic life forms and displays of various aquatic skill by entertainers and marine animals". In 1970 the opponent opened another Sea World theme park in Ohio, USA. The opponent opened further Sea World theme parks in Florida in 1973 and in San Antonio, Texas in 1988.

15) Mr Abbey claims that in late 1971 or early 1972 Mr Keith Williams, Managing Director of Ski-Land of Australia Pty. Ltd., visited the San Diego theme park. Mr Abbey claims that Mr

Williams collected literature about the park and discussed, with officers of the opponent's predecessor company, the operation of a similar theme park on the Gold Coast in Australia. Mr Abbey states that he has been unable to locate any documentation indicating that any right was given to Mr Williams to use the Sea World trade mark or logo in Australia. He claims that in January 1973 Ski-Land of Australia changed its name to Sea World.

16) Mr Abbey states that since 1964 the opponent's SEA WORLD marine theme parks have been extensively advertised both in the USA and elsewhere including the UK. Since 1964 over two hundred and seventy million people have visited the parks. Examples of the advertising are provided at exhibit A. Included are several leaflets which show use of the words "Sea World", the "dolphin logo" include in mark B1038357, and the words SEA WORLD where the "O" in World is replaced by the "dolphin logo". None of the leaflets are dated.

17) Mr Abbey states that in 1969 the opponent began using the "dolphin logo" later incorporated into trade mark B1038357. At exhibit B is a copy of the 1970 Annual report which shows the logo in use. In 1980 the opponent commenced use of the "whale logo" which is part of trade mark 2058199. Mr Abbey claims that the opponent, and its predecessors, have, through extensive use, acquired a substantial reputation in both the logos and the SEA WORLD trade mark in the USA and elsewhere in the world including the UK.

18) The opponent also filed a declaration dated 23 February 2001, by Penelope Ann Nicholls the opponent's Trade Mark Attorney. She claims the applicant has shown no use of the trade mark in suit solus, it usually appears with other words such as "Gold Coast Australia". She points out that much of the evidence does not show use of the trade mark in the UK, and that much of the applicant's evidence refers to the promotion of SEA WORLD GOLD COAST or SEA WORLD NARA. Indeed she points out that Mr McHugh, at paragraph 11 of his statutory declaration, claims reputation in SEA WORLD GOLD COAST and SEA WORLD NARA not the mark in suit. She states that the two parties marks are similar and likely to be confused, and also that the average consumer will assume that the two parties are associated or connected.

19) Ms Nicholls states that the applicant claims that their theme park in Australia has become renowned for its "ski spectacular show". She states that the applicant had no reason for adopting the name SEA WORLD other than to take advantage of the opponent's reputation.

20) Ms Nicholls disputes the claim of co-existence in the UK market place, claiming that the applicant has traded under the name of SEA WORLD GOLD COAST AUSTRALIA or SEA WORLD NARA GOLD COAST AUSTRALIA whereas the opponent has used the name SEA WORLD. She claims that the services of the two parties are similar, all falling within the broad scope of leisure industry services. She also claims that Class 39 services are covered by the opponent's Community Trade Mark application number 1065325.

APPLICANT'S EVIDENCE

21) The applicant filed a declaration, dated 29 August 2001, by Alastair Robertson Gay the applicant's Trade Mark Attorney. He confirms that his evidence is "of my own knowledge or derived from records that I identify and believe to be true and accurate".

22) Mr Gay states that the applicant relies upon the evidence of acquired distinctiveness and honest concurrent use provided at the ex-parte stage. The declaration provided by Graham Edward McHugh, dated 16 March 1999, and the supporting exhibits are provided at exhibit ARG1. I will detail the contents of this exhibit later.

23) Mr Gay states that the evidence at exhibit ARG1 was accepted as demonstrating use of the mark only in respect of an Australian marine park. He accepts that much of the evidence shows use of the words “Gold Coast Australia” but states that it is generally in smaller text and is effectively a “strapline” and that it is utterly descriptive, non-trade mark matter that does not affect the distinctive character of the mark.

24) Mr Gay states that the specification of the application is such as to assist in distinguishing the marks of the two parties, limited as it is to amusement parks in Australia. He then goes on to comment on the opponent’s evidence. He points out that the brochure shown to the various travel agents has not been submitted in evidence and could have contained matter other than the opponent’s logo solus which would have assisted the travel agents in identifying the logo as that of the opponent. The names of these travel agents are not provided and no details of their experience, or lack thereof, is provided. Nor are exact details of the conversations between the travel agents and Ms Thornton provided.

25) Mr Gay states that the brochure provided at exhibit ACT4 of Ms Thornton’s evidence does show use of trade mark “SEA WORLD” per se by the applicant. The relevant extract from that brochure is provided by Mr Gay at exhibit ARG4. This shows the mark in suit with, underneath it, the additional words “Gold Coast Australia” in smaller print.

26) Regarding the comments of Ms Nicholls, Mr Gay states that the evidence of Mr McHugh shows use of the mark in suit along with the descriptive wording “Gold Coast Australia”. He denies that the marks are similar. He comments that the opponent has not shown that their marks are well known in the UK. On the issue of bad faith he denies the claims made by Ms Nicholls and at exhibit ARG5 he provides a declaration by John Stuart Menzies which details the adoption of the trade mark SEA WORLD. I will deal with this exhibit in detail later.

27) Mr Gay denies that the two parties are operating in the same field of activity. He states the “provision of marine amusement park services in the UK and/or EU is clearly different from offering travel/holiday services to Australia”. He also claims that the Community Trade Mark application number 1065325 mentioned by Ms Nicholls is not relevant as it was filed after the filing date of the application in suit.

28) Exhibit ARG1 consists of a statutory declaration and exhibits, dated 16 March 1999, by Graham Edward McHugh the Chief Financial Officer and Secretary of Sea World Management Limited. This company is the manager of the Sea World Property Trust of which the trustee is National Australia Trustees Limited. He is also the Chief Financial Officer of Sea World Enterprises which operate the Sea World amusement park in Australia. He confirms that he has full access to the books and papers of all these companies.

29) Mr McHugh states that:

“Sea World Gold Coast is an amusement and theme park which originally opened in 1971 and became internationally renowned for its ski spectacular show. Sea World Gold Coast was acquired by the Trust from its former owner, Sea World Pty Limited in 1984 and since this time has offered an extensive range of leisure activities. In addition to the famous ski spectacular show with ski pyramid finale, the activities currently include amusement rides, shows, animal and marine displays, restaurant, snack and shopping activities, swimming and water sports facilities and helicopter rides. Sea World Gold Coast also boasts a hotel with its own private beach known as the Sea World Nara Resort.”

30) Mr McHugh states that the trade mark SEA WORLD was first used in relation to Sea World Gold Coast in Australia in 1971 and has been in continuous use since this date. The logo included in the mark in suit was first used, he claims, in 1993 in Australia and has been in continuous use since. He states that both the trade marks are used on a range of merchandising as well as advertising. At exhibit GEM1 he provides a copy of a brochure, for use in Australia, which shows use of the mark with the strap line “Gold Coast Australia” underneath in smaller text. The term Sea World is used solus in relation to the Sea World monorail, Sea World helicopters and also as a reference to the theme park.

31) Mr McHugh states that the logo mark was first used in the UK in 1993 and has been used continuously since. He provides a list of companies who provide package deals including accommodation, flights and entry to Sea World. These package deals are sold to the public through retail outlets throughout the UK. At exhibit GEM2 is the travel schedule of the International Marketing Manager, Peter Doggett, in 1998 which shows numerous meetings in the UK with a variety of companies involved in the tourist industry.

32) As holidays and tours are sold indirectly to the UK via travel companies and agencies turnover figures in respect of services supplied under the Sea World logo in the UK are not available. Instead Mr McHugh provides figures for the number of UK visitors to Sea World Gold Coast. These show that in the years 1993-1997 on average approximately 12,000 UK visitors visited Sea World Gold Coast. Again due to the services being provided by third parties Mr McHugh states that he cannot provide figures for promotion in the UK. He is able to state that the applicant has spent approximately £27,000 in the years 1995-1998 inclusive on sales trips to the UK. Fact sheets have been provided for the UK market by the applicant at a cost of approximately £1,500 since 1994. A copy of the fact sheet and brochure are provided at exhibit GEM4 and show use of the mark in suit with the words “Gold Coast Australia” in smaller text underneath. At exhibit GEM5 is a copy of a video produced in partnership with Warner Brothers in 1997 at a cost of £27,000. This has been shown at approximately 200 Warner Village cinemas throughout England since September 1998. The video lasts approximately 60 seconds and features the mark in suit with the words “Gold Coast Australia” at the very start of the video. Mr McHugh states that in February 1999 the video was updated.

33) Mr McHugh states that to the best of his knowledge there has not been any instances of confusion between the two parties marks.

34) Exhibit ARG5 consists of a statutory declaration, dated 15 May 2001, by John Stuart Menzies who states that “I have been associated with the predecessors of the Australian Sea

World theme park from early 1971". He confirms that the park opened in 1971 when steps were taken to secure the name Sea World for the park. He states that:

“The popular name for this type of activity at the time was “Marineland”, “Marine World” and the such like. These names were not available and this led to the choice of Sea World, which although not the preferred name, was the next best choice to describe the activities of the theme park. Marineland was the name being used by the park located virtually next door to our new theme park operations.”

35) Mr Menzies states that in 1973 a Mr George Millay the President of Sea World Inc. of San Diego visited the Australian theme park and was impressed with the park and its future plans. Discussions were held regarding merchandising, and the parties parted on goods terms. He states that from this time the Australian and American theme parks have co-existed and co-operated with one another in research and other activities.

36) Exhibit ARG6 consists of a declaration, dated 29 October 1999, by Francis Thomas Moore. Mr Moore states that he has been involved in the tourism industry for over twenty years and holds a number of positions in companies and bodies connected with tourism. He has also been awarded honours by the Australian Government in recognition of his contribution to the tourism industry. He states that throughout Australia the theme park is known as SEA WORLD solus, he states that the mark is also used to promote a large hotel complex located on the Sea World theme park site which is advertised as the Sea World Nara Resort.

37) Exhibit ARG7 is a declaration, dated 16 August 2001, by Andros Chrysiliou a solicitor and Trade Mark Attorney with the firm Chrysiliou Law. Mr Chrysiliou states that he has “acted for many years for an amusement park located on the Gold Coast known as Sea World”. He provides, at exhibit AC1, a copy of a decision by the Australian Patent Office where the applicant was also opposed by the opponent in the instant case. Further, he states that the same parties were involved in a similar opposition in Japan, the result of the Japanese Patent Office is provided at exhibit AC2. In both instances the applicant in the instant case won. At exhibit AC3 he provides a list of trade mark registrations in Australia, Japan and Taiwan held by the applicant for the marks Sea World and Sea World plus various logos.

OPPONENT’S EVIDENCE IN REPLY

38) The opponent filed two witness statements by Ms Nicholls who has provided a declaration earlier in these proceedings. These statements are dated 14 January 2002 and 26 February 2002.

39) Ms Nicholls points out that the term “Gold Coast Australia” is an indication of origin not a generic term for a product such as “Yorkshire Bitter”. She claims that therefore these words perform a trade mark function in serving to distinguish from a Sea World mark with another origin. She notes that in relation to the sales promotions undertaken in the UK the applicant does not state specifically that the mark in suit was used rather than the mark with the strapline “Gold Coast Australia”.

40) At exhibit PAN1 Ms Nicholls provides a statutory declaration, dated 19 February 2002, by George Millay the former President and Chief Executive Officer of Sea World Inc during the period 1962-1974. Mr Millay states that:

“In the 1970's certain sales and advertising material appeared in the United States expounding an aquatic park in Australia named “Sea World” and as I recall using Sea World Inc.’s exact logo. Sea World Inc. was not happy with this use of the Sea World name in Australia, but Sea World Inc. was very busy at the time with its own affairs in the United States.”

41) Mr Millay goes on to state that these concerns were raised with Mr John Menzies, during the course of a visit to the USA, and later during a visit by Mr Millay to Australia when in conversation with Keith Williams. On both occasions the representatives of the Australian concern stated that they did not recognise United States trade marks unless registered in Australia.

42) Both parties made reference to the similarity of the marks and referred to various cases, particularly those from the European Court of Justice. I have not recorded these comments as I have not found them particularly helpful.

43) That concludes my review of the evidence. I now turn to the decision.

DECISION

44) At the hearing Mr Mitcheson withdrew the grounds of opposition under Sections 3(1)(b), 3(1)(c) and 56.

45) The first ground of opposition is under Section 3(6) which states:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

46) The opponent has claimed that the applicant knew of its (the opponent’s) mark and deliberately chose to use a similar mark in order to “muscle in on the reputation and goodwill of the opponent”.

47) It is well established that in an opposition under Section 3(6) of the Act the onus is on the opponent, reflecting the usual approach under English law that he who asserts must prove. A claim that an application was made in bad faith implies some deliberate action by the applicant which a reasonable person would consider to be unacceptable behaviour, or as put by Lindsay J. in the *Gromax* trade mark case [1999]RPC 10:

“includes some dealings which fall short of the standards of acceptable commercial behaviour.”

48) The applicant in this case has denied the allegation and the opponent on whom the onus rests has provided no or insufficient evidence. Therefore the ground of opposition based on Section 3(6) is dismissed.

49) The remaining ground of opposition is under Section 5(2)(b) of the Act which states:-

“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.”

50) An earlier right is defined in Section 6, of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

51) In determining the question under section 5(2), I take into account the guidance provided

by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

52) In essence the test under Section 5(2) is whether there are similarities in marks and goods

and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

53) Mr Mitcheson restricted his comments to trade marks B1038357 and CTM103523 which provide the opponent with its strongest case. For ease of reference the marks are reproduced below:

Applicant's Mark	Opponent's marks
	B1038357 
	103523 SEA WORLD

54) It was common ground at the hearing that both the opponent's marks were similar to the applicant's mark. I shall first compare the applicant's mark to the opponent's mark B1038357. Aurally the marks are identical. Visually they both contain the words "SEA WORLD". The applicant's mark has a dolphin leaping above waves as does the opponent's mark. Although there are minor variations in the depiction of the mammal and the waves, and despite the opponent's logo being in a circle, to my mind the mark in suit and the opponent's mark B1038357 are virtually identical visually. Conceptually both marks conjure up the same image as the words included in each of the marks provides an indication of what is on offer and this is emphasised by the dolphin logos. Overall the opponent's mark B1038357 is in my opinion almost identical to the mark in suit.

55) Clearly the opponent's mark 103523 is identical aurally to the mark in suit. Visually the marks differ as the opponent's mark does not have a logo. Conceptually the marks conjure similar images. Whilst not identical the marks are very similar.

56) I turn now to compare the specifications of the marks above. The European Court of Justice held in *Canon* in relation to the assessment of the similarity of goods and/or services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are

complementary. I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

57) The application is in respect of the following specification in Class 39: “Travel services in the nature of providing information to travellers and vouchers for tours, all to Australia, and inclusive of entry into amusement parks in Australia.”

58) In his submissions Mr Mitcheson referred only to the following specifications:

- B1038357: Class 16: Prints, printed publications, books, pamphlets, advertising literature and photographs, all relating to the display of fish and marine life in amusement parks.
- 103523: Class 41: Education; providing of training; entertainment; sporting and cultural activities; marine amusement park services.

59) Mr Mitcheson stated that both enterprises are competing to attract consumers in the UK to visit their parks. He contended that “The most usual way of ‘providing information to travellers and vouchers for tours’ [the applicant’s specification] is via ‘printed publications, books pamphlets, advertising literature and photographs’ [the opponent’s class 16 specification] especially where both are in relation to amusement parks”. He further contended that the Class 41 specification of providing “marine amusement park services” would involve promoting these services by the provision of information, including the provision of entry vouchers and travel information.

60) I reject the first part of his contention relating to the Class 16 goods. Clearly when using the factors identified by the ECJ, at paragraph 57, the opponent’s goods could not be deemed similar to the applicant’s services. Use of a trade mark on promotional material is not usually use “in relation to” the printed matter but rather use in relation to the goods/services promoted in the material. Where the mark is used in relation to the printed matter, the goods will usually be products obtained for their own worth e.g. books, magazines. Nor could the opponent’s goods be said to be in competition with the applicant’s services even if the two parties could be said to be competitors with regard to their theme parks.

61) With regard to the opponent’s Class 41 specification Mr Edenborough, for the applicant, contended that his client was providing information to travellers to Australia, which he summarised in the following manner: “What I am doing in the UK is channelling things from the UK to Australia. I am not doing anything in the UK. I am not providing in the UK marine amusement park services. That service is not being provided here.” In short his client is advertising in the UK its Australian marine park.

62) I agree with Mr Edenborough that holidays to far flung locations such as the USA or

Australia are not chosen without some consideration. The average consumer would, in my opinion, exercise some care in the selection of their holiday location. However, this is not the issue at stake in this case.

63) For the purposes of this Section I must consider the applicant's specification against the opponent's UK protection for the provision of "marine amusement park services". The evidence provided appears to indicate that the opponent appears to be carrying out a similar promotional activity as the applicant, the only difference being the location of the marine theme park. Simply promoting in the UK an entertainment service being provided in Australia or the USA may not be use of the mark in the UK. However, where the services are specifically directed at customers and promoted/sold in the UK directly under the mark, the use does constitute use in the UK. The applicant's specification covers the promotion and ticketing aspects of such a service. This is plainly very similar to the opponent's Class 41 "Marine park amusement services".

64) Ordinarily I would also consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed of advertising expenditure in the UK or the number of UK travellers visiting the opponent's various marine parks in the USA. The evidence by the opponent's trade mark agents regarding the views of various travel companies is such that it cannot be relied upon. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date. I must also take into account the dictum of imperfect recollection.

65) Taking all of the above factors into account I believe that use of the mark in suit on the services in the specification sought to be registered would cause the average consumer in the UK to believe that the services offered by the applicant were those of the opponent or that the undertakings were economically linked. I therefore find that the opposition under section 5(2) in relation to the opponent's mark 103523 succeeds.

66) The opposition having succeeded the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £1535. This sum 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 10TH day of September 2002

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Mark	Number	Effective Date	Class	Specification
	B1038357	15.11.74	16	Prints, printed publications, books, pamphlets, advertising literature and photographs, all relating to the display of fish and marine life in amusement parks.
SEA WORLD	1539682	31.10.94	41	Marine amusement park services.
	2058199	26.2.96	41	Marine amusement park services
SEA WORLD	103523	1.4.96	16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery, adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching materials for packaging (not included in other classes); playing cards; printing blocks; publications, educational books on marine subjects, posters, postcards, children's colouring books, decals, letter openers, panes and bases for pens, and paperweights.
			28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys-namely , fabric "plush" animals.
			41	Education; providing of training; entertainment; sporting and cultural activities; marine amusement park services.