

O-020-05

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2273019
IN THE NAME OF GEOFFREY INC
TO REGISTER A TRADE MARK IN CLASS 28**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 90672 IN THE NAME OF
METRO SB-HANDELS AG**

Trade Marks Act 1994

**IN THE MATTER OF Application No. 2273019
in the name of Geoffrey Inc
to register a trade mark in Class 28**

And

**IN THE MATTER OF Opposition thereto
under No. 90672 in the name of
Metro SB-Handels AG**

Background

1. On 19 June 2001, Geoffrey Inc applied to register DREAM DAZZLERS as a trade mark in Class 28 in respect of the following specifications of goods:

Role play toys and playthings; children's dressing-up clothing and accessories; children's dressing-up sets; dressing-up clothing, costumes, shoes, play jewellery, purses, handbags, play cosmetics, hair accessories, vanity boxes, jewellery boxes and vanities; none of the aforesaid goods being balloons, cosques or Christmas, festive or interior decorations or ornaments.

2. On 6 June 2002, Metro SB-Handels AG filed notice of opposition based on the following grounds:

1. Under Section 5(2)(b) because the opponents are the owners of an earlier mark that is similar to the mark of the application, and is sought to be registered in respect of similar goods to those of the opponents' earlier mark.

2. Under Section 5(4)(a) by virtue of the law of passing off.

3. Details of the earlier marks relied upon can be found as an annex to this decision.

4. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Only the opponents filed evidence in these proceedings. The matter came to be heard on 2 November 2004, when the applicants were represented by Mr Charlton of Elkington & Fife, their trade mark attorneys. The opponents were represented by Mr Hill of Wilson Gunn McCaw, their trade mark attorneys

Opponents' evidence

7. This consists of a Witness Statement dated 23 May 2003, from Andrew Hennell, Finance Director and Company Secretary of Makro Self Service Wholesalers Limited, part of the same group of companies as Metro SB-Handels AG, a position he has held for seven years.

8. Mr Hennell says that from 1984 his company has used the trade mark DAZZLERS with the consent of the proprietor in respect of Angel figurines, Santa dolls, Santa trains, Santa dogs, Christmas lights, Christmas trees, Christmas wreaths, tree decorations and tinsel. In 1986 this use extended to include candles and crackers, to party products in 1990, candle holders in 1996 and from 2001 snow-globes, greetings cards and wrapping paper. He says that the mark has been used on other products but cannot say from when. Exhibit AH1 consists of a photograph of a box of Christmas tree decorations bearing the name DAZZLERS, Mr Hennell saying that it is an example of packaging of the type used for the goods sold under the mark. There is no way of determining whether this packaging originates from before the relevant date.

9. Mr Hennell goes on to give details of turnover for goods sold under the mark in the UK in the years 1996 to 2002, which are as follows:

1996	£6,317,695
1997	£4,529,750
1998	£7,738,698
1999	£9,467,610
2000	£8,990,754
2001	£8,313,032
2002	£7,677,241

10. He goes on to give an estimate of the amounts spent on direct mail advertising in the UK in the years 2000 to 2002, which are £70,445, £49,921 and £82,831 respectively. The figure relating to 2001 is in part, after the relevant date, as is the entirety of 2002.

11. Mr Hennell says that goods bearing the DAZZLERS mark are sold in the UK through the 30 MAKRO wholesale outlets. He says that the goods are advertised in the MAKRO mail, an advertisement publication that is sent to MAKRO customers each fortnight. Exhibits AH2 to AH6 consist of copies of the MAKRO mail in which DAZZLERS products have been advertised, all dating from October/November 2002, well after the relevant date.

12. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

13. The opposition is founded on Section 5(2)(b) of the Act, which reads as follows:

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

(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.”

14. An earlier trade mark is defined in Section 6 of the Act as follows:

“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,”

15. In a consideration of a likelihood of confusion or deception I must take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 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*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*;
- (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*;
- (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*;
- (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*;

- (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*;
- (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*;
- (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*;
- (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.*

16. The opponents rely on one registration for the mark DAZZLERS. Insofar as the mark applied for incorporates the word DAZZLERS it must bear a visual resemblance to the opponents' mark and will have a degree of similarity when spoken.

17. In the applicants' mark the word DAZZLERS is preceded by DREAM, a word that has a laudatory meaning as something that is the ideal, most desired or aspirational, such as "dream team" or "dream holiday". As will be seen from these examples the use is primarily in conjunction with a word that describes the object or entity that is purported to possess the "dream" characteristic. As far as I am aware there is no such item of goods as a DAZZLER (or DAZZLERS) and as in the case of the verb DAZZLE from which it is derived the consumer will most likely see it as a laudatory reference to something of quality or an impressive appearance, or that is brilliant or sparkles, but it is in my view an allusion rather than a description. Adding the word DREAM does not change the focus; the message remains on the DAZZLERS element, and in my view both of the respective marks send out a very similar conceptual message.

18. As I have said, whilst the word DAZZLERS alludes, albeit none too covertly to goods that are brilliant, shiny or sparkle such as festive decorations, the reference is not so direct as to mean that the word lacks distinctive character. The advertising and turnover figures provided by the opponents appear significant even without knowing the size of the market, and whilst this has not been broken down into the goods from which this is derived, Mr Hennell does say that prior to the relevant date the mark had been used in respect of Angel figurines, Santa dolls, Santa trains, Santa dogs, Christmas lights, Christmas trees, Christmas wreaths, tree decorations, tinsel, candles, crackers, party products and candle holders. It therefore seems reasonable to infer that the turnover relates to the sales of these goods.

19. There is nothing from prior to the relevant date that shows how the mark has been used, the only examples being later advertisements in the Makro Mail. Mr Charlton highlighted that whilst the mark DAZZLERS may appear in the publication, it is either in the form of the composite mark DAZZLERS CHRISTMAS WORLD in an oval border, or in small lettering that suggested that DAZZLERS was a subsidiary mark of Makro. The Makro Mail contains

advertisements relating to the products of many traders and I see no reason why the consumer would assume that these or the DAZZLERS products are those of Makro. The examples show consistent use of the DAZZLERS CHRISTMAS WORLD logo on or in relation to the opponents' goods, with the word DAZZLERS being used by the Makro Mail in their descriptions of the products. The use shown is in respect of decorations and products for use at Christmas.

20. Whilst they lay claim to substantial use of the DAZZLERS trade mark, there is nothing that shows how the mark has been used prior to the relevant date. The later examples shown in the Makro Mail publication illustrate that they have used the mark DAZZLERS CHRISTMAS WORLD, with the word DAZZLERS shown in connection with descriptions accompanying illustrations of the products. I do not know whether the examples of use of the mark are typical of the way in which it has been used prior to the relevant date. If the opponents seek to claim that their mark has a reputation or a highly distinctive character because of the use they have made of it, it is for them to establish this. The gaps in the evidence are such that I do not consider that I am in a position to say that either is the case.

21. Turning now to the question of whether the respective goods are either the same or similar. In determining this question I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281, the *Atreat* case and in the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The physical nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used;
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

22. The opponents' earlier mark covers Christmas and Festive decorations and ornaments; garlands, festoons; balloons Christmas trees and Christmas tree stands; crackers; cosques. The applicants have specifically excluded Christmas, festive and interior decorations and ornaments, balloons and cosques, from their specification which I consider to effectively

remove any identical goods. It does, however leave the question of whether any goods remain that would be considered to be similar to the goods for which the opponents' mark is registered.

23. Mr Hill put the question as follows:

“... In essence, what we can be said to be considering is that the applicants' mark is aimed at role play toys and playthings. When I was looking at this I was trying to decide whether the role play applied both to toys and playthings or whether it was simply role play toys and generic playthings.

The fact is that we are looking at festive Christmas decorations and ornaments as against role play toys and playthings. The question is when is a Christmas decoration a Christmas decoration and when can it be used in other ways? I think, for example, some of the Christmas decorations could be in the form of stuffed teddy bears with a hanger on it to stick on the tree. Is that a toy or a decoration? My point on that is that the borderline between Christmas and festive decorations and ornaments and what I would say are, using the generic term, playthings, is quite blurred and difficult to decide.”

24. On the first of Mr Hill's points regarding the scope of the expression “Role play toys and playthings” I would agree that the way in which these goods have been listed is open to interpretation. However, the way in which the “playthings” have been joined to “Role play toys” and separated from the remainder of the specification by use of a semi-colon leaves me with the view that the intention was that the playthings be read as also being for role play. Had the intention been otherwise, why not express the specification as “Role play toys; plaything;...”. But whatever the intention the ambiguity remains and the specification is capable of being interpreted as incorporating playthings at large.

25. This brings me to the next question of whether the descriptions toys and playthings, role play or otherwise, would encompass Christmas tree decorations because they are capable of being played with? The easiest part of the question to answer is that of the role play toys and playthings. These are very different in nature to Christmas decorations, and although capable of being used by the same consumer, would be used for very different purposes. They are neither competitive nor complementary, and although I have no evidence as to the trade, I would suspect that they are distinct areas of trade that may meet at the end of the retail chain, but perhaps other than Father Christmas outfits, will be displayed in different locations within a retail establishment.

26. Would “toys and playthings” at large include Christmas tree decorations? In the *Treat* case the approach to be taken in construing the meaning of terms was put as follows:

"When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade."

Collins English Dictionary gives, amongst others, the following meaning to the word toy:

“1. an object designed to be played with. 2.a. something that is a nonfunctioning replica of something else, esp a miniature one. B (*as a modifier*) a toy guitar. 3. any small thing of little value; trifle.”

27. The relevant meaning attributed to “plaything” is that of a toy.

28. Mr Hill may well be correct in saying that Christmas decorations may be in the form of stuffed toys and therefore are the same as such toys in physical nature. Whilst it is probably more usual for adults to purchase decorations I see no reason why a child could not also be involved, which would make the end users the same. I have no doubt that certain types of Christmas decoration could be played with, as could any number of other products. But as far as I am aware they are not designed or intended to be anything more than for decoration and in my view the consideration should be based on the purposes for which goods are made or intended rather than how a product is capable of being used if used improperly. There is nothing in the opponents’ evidence that I can see that shows them to have been involved in a trade in Christmas decorations having the dual function of a toy or plaything, that a trade in such products exists, or that the manufacturers of festive decorations are also manufacturers of toys and more specifically those for role play . These are, I believe, separate areas of trade, that are neither in competition or complementary, and although as with the role play goods may well reach the same retail outlets, they will not be displayed together or even in proximity. On my assessment the respective goods are not similar.

29. Whilst I consider the earlier trade mark and the mark applied for to be similar, taking all of the facts of this case into account and adopting the Aglobal@approach advocated, I come to the view that the differences in the respective goods are such that it is unlikely that a consumer would form an association between the mark applied for and the opponents= earlier mark, but should they do so, they will not be led into believing that the respective goods come from the same or economically linked undertakings. I do not consider that the position would have been any different had it been accepted that the opponents had a reputation in the goods for which the mark has been used. In my view there is no likelihood of confusion and the ground under Section 5(2)(b) fails accordingly.

30. This leaves the ground under Section 5(4)(a) to be determined. That section reads as follows:

“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

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.”

31. Mr Geoffrey Hobbs QC sitting as the Appointed Person in *Wild Child* [1998] RPC 455, set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

32. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

33. Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign. I have already highlighted the weakness of the opponents' claim to a reputation within the United Kingdom, and they are in no better a position with respect to goodwill. In the *Radio Taxicabs (London) Limited v. Owner Drivers Radio Taxi Services Limited* [2001] WL 1135216, Mr John Randall Q.C., sitting as a Deputy Judge of the High Court, considered a passing off claim on the basis of goodwill in the name RADIO CABS, making various comments, inter alia, that he was faced with *the total absence of evidence from members of the wider public*. The judge went on to find that the burden of proving reputation with the general public lay on the claimant, stating at paragraph 96 of his decision:

AI consider it possible that the claimant may have built up a sufficient reputation in the ways relied upon but I cannot conscientiously put it any higher in the Claimant's favour than that..... Thus one is left to speculate. Speculation is not enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name ARadio Taxis@lies on the claimant and I find that the claimant has not discharged it.@

34. In my view the opponents' evidence suggests that they may have a reputation and/or goodwill within the UK, but does not establish that this is the case in respect of the mark DAZZLERS or even DAZZLERS CHRISTMAS WORLD which is the mark used in the examples they have provided. Consequently, I do not see how I can find that they have a reputation or goodwill that will suffer damage by the applicants' use of the mark in respect of the goods that they seek to protect. The objection under Section 5(4)(a) also fails.

35. The opposition having failed on all grounds, I order the opponents to pay the applicants the sum of £2,100 as a contribution towards their costs. 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 21st day of January 2005

**Mike Foley
for the Registrar
the Comptroller-General**