

TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE
MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION N° 1527158
BY TWENTIETH CENTURY FOX FILM CORPORATION
TO REGISTER THE MARK



AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION N° 42627
BY JO-Y-JO LTD

TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE MARKS ACT 1994

IN THE MATTER of trade mark
application N^o 1527158 by Twentieth Century Fox Film Corporation
to register the mark

5 and



IN THE MATTER of opposition
thereto under opposition N^o 42627
by JO-Y-JO Ltd

DECISION

10 Twentieth Century Fox Film Corporation applied on 17 February 1993 under section 17(1) of the Trade Marks Act 1938 to register a mark in class 25 in respect of "T-shirts; sweatshirts; tracksuits; shell suits; shirts; trousers; underwear; pyjamas; nightgowns; headwear; footwear; all included in Class 25".

The mark is represented as follows:




15 The application is opposed by JO-Y-JO Ltd, chiefly on the basis of two earlier registrations in class 25 for identical or similar goods.

I summarise the grounds of opposition as follows:-

- 20 ● The applicant's mark emphasises the word ALIENS, which is an integral part of the opponent's registered marks, and as a result it so nearly resembles the opponent's marks as to be likely to deceive or cause confusion. Registration of the applicant's mark would be contrary to Section 12(1) of the Trade Marks Act 1938.
- 25 ● By reason of the opponent's use of its 'ALIEN' marks, registration of the applicant's mark would prejudice the opponent in the conduct of its business. The application should therefore be refused under the discretionary powers conferred upon the Registrar by virtue of section 17(2).

The relevant details of the opponent's registered marks are as follows:-

<u>No</u>	<u>Mark</u>	<u>Class</u>	<u>Jrnl/Pge</u>	<u>Spec. of goods</u>
1140750	THE ALIEN	25	5373/1970	Articles of outerclothing, but not including footwear.
1299639		25	5715/710	Articles of outerclothing included in Class 25; but not including footwear.

5 In response, the applicant filed a counterstatement admitting the existence of the opponent's prior registrations, but denying each of the grounds pleaded.

Both parties seek an award of costs in their favour.

10 The matter came to be heard on 18 March 1998. At the hearing, the opponent was represented by Mr Colin Birss of Counsel, instructed by William A Shepherd & Son. The applicant was represented by Mr David Harrison of Mewburn Ellis.

Initially, only the opponent filed evidence in these proceedings. Shortly before the hearing, the applicant sought leave to file evidence under rule 52. This matter was handled as a preliminary point at the beginning of the substantive hearing, following which I admitted the evidence concerned.

15 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, and unless otherwise indicated, all references in
20 the remainder of this decision are references to the provisions of the old law.

The Evidence

I do not propose to review in detail the evidence that has been filed in these proceedings because I have not relied upon it to any extent in reaching my decision in this opposition. All that the evidence shows is that a company associated with the opponent (Sweater Team
25 Limited) purchased ten thousand (10,000) white cotton T-shirts from a manufacturer in Brazil, and a similar number of labels from a firm in Lancashire. The evidence does not describe these labels in detail, although the invoice and delivery note bear the description 'ALIEN ALIEN'.

30 There is also an exchange of correspondence (April 1994) between Sweater Team Ltd and Mr David Lake, concerning the possibility of supplying a range of men's clothing under the name ALIEN. The late evidence from the applicant confirms that Mr Lake works for an

investigation agency, and that it was in this capacity that he wrote to Sweater Team Ltd enquiring about the ALIEN brand clothing.

At the hearing before me, Mr Harrison (for the applicant) criticised many aspects of the opponent's evidence. I think it is fair to say that Mr Birss accepted much of this criticism (rightly in my view), and apart from satisfying my curiosity in a number of areas, he did not address me at any length as regards the evidence when making his submissions. Rather he concentrated on the section 12 ground of the opposition.

Section 12(1)

This section of the Act reads as follows:

10 “12(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

 a. the same goods,


 b. the same description of goods, or

15 c. services or a description of services which are associated with those goods or goods of that description.”

The reference in this section to a near resemblance is clarified by section 68(2B) of the Act which says that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

20 For the purposes of section 12(1), Mr Birss invited me to consider the question of similarity in relation to the first of the opponent's registered marks, that is, 1140750 (THE ALIEN), on the basis that if he could not succeed with the word-only mark, it was unlikely that the later word-and-device mark would fare any better.

25 The standard test for opposition under section 12 has been laid down in Smith Hayden & Co Ltd's Application [1946] 63 RPC 97 by Evershed J (later adapted by Lord Upjohn in Bali [1969] RPC 496). Applied to the facts of the present case, the test may be expressed as follows:

30 Assuming use of THE ALIEN in a normal and fair manner for any of the goods covered by the registration, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion amongst a substantial number of persons if the applicant uses the mark  normally and fairly in respect of any goods covered by the proposed registration?

Mr Harrison helpfully conceded that the goods in question overlap, and therefore to determine the question of confusion, I need only consider the two marks used for the same goods.

35 Comparing these two marks, Mr Birss submitted that the most prominent element of the applicant's mark is the word ALIENS, and that this is clearly the most (if not the only) significant part (albeit in the plural form) of his client's mark - THE ALIEN. In Mr Birss'

opinion, this would inevitably lead to confusion among a substantial number of persons. At the very least, he suggested that it gave rise to a presumption of confusion which the applicant should have countered in evidence. It is established law that in opposition proceedings under the 1938 Trade Marks Act, the applicant has the burden of proving that if his mark were to be registered, it would not result in confusion with respect to marks already on the register. Regardless of whether I were to accept his suggestion of a presumption of confusion, Mr Birss maintained that the applicant, by choosing not to file any evidence in support of the application, had failed to discharge this onus.

Mr Harrison, on the other hand, argued that the mark in suit is more than simply the word ALIENS. It includes the word OPERATION, a colon, and a border; all presented in a distinctive style. In particular he emphasised that the word ALIENS is presented in a rather distinctive form - according to Mr Harrison, the 'I' in the word ALIENS (as presented in his mark) is intended to represent the pupil of a goat's eye.

With regard to the matter of onus, Mr Harrison did not accept that the applicant must necessarily file evidence in order to discharge the burden of proof. In his submission, the Registrar had only raised the opponent's marks as late citations following observations filed by the opponent, and had then waived those citations at an ex parte hearing on condition that the applicant give notice to the opponent. Therefore in Mr Harrison's view, the Registrar had already expressed an opinion on the registrability of the mark in suit, and he urged me not to interfere with the earlier ex parte decision without proof that that decision was in some way defective.

Attractive though this argument may seem, the Registrar has traditionally taken a fresh view of the matter when section 12 is pleaded in opposition. On this occasion, and having regard to the condition of notice which was imposed ex parte, it seems likely that the hearing officer was in some doubt as to the likelihood of confusion and elected to defer the matter to opposition proceedings where the Registrar would normally have the benefit of seeing evidence from both sides before reaching a conclusion. I say normally, because on this occasion those intentions appear to have been frustrated by the lack of any relevant evidence on the point, and I am therefore only able to consider the matter in the prima facie case.

So far as I am aware, the test advanced by Parker J in *Pianotist Co's application* [1906] 23 RPC is still good law. At page 777 line 26, he says:-

"You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

Looking afresh at the applicant's mark (reproduced right), I have to agree with Mr Birss that the most striking element of it is indeed the word ALIENS. Although it is important that I consider the mark in its entirety, and thus I do not overlook the other elements of the mark,



5 nevertheless the overall combination conveys to the mind the single notion or impression that this is an ALIEN or ALIENS mark. Having regard to the opponent's registration of the mark THE ALIEN, and taking the best view I can of the matter, my impression is that there is a likelihood of deception or confusion amongst a substantial number of persons. With no evidence from the applicant to depose this impression, it follows that the opposition under
10 section 12(1) succeeds.

Registrar's Discretion

There remains the matter of the Registrar's discretion. Strictly speaking, this opposition having succeeded under section 12 (the consequences of which are mandatory), it is neither necessary nor appropriate for me to consider exercising the Registrar's discretion under
15 section 17(2). Nevertheless, in the event of a successful appeal against my decision in relation to section 12, it may be helpful if I indicate briefly how I would have exercised the Registrar's discretion.

The only basis put forward by the opponent for exercising discretion against the applicant is that registration of the mark in suit would be prejudicial to the conduct of the opponent's
20 business; that is to say, because of the opponent's use of, and reputation in, the ALIEN marks. The evidence filed by the opponent is intended to show such use. It seems to me that however compelling the evidence of use may be (and in fairness I have to say that it is far from compelling), if, on appeal, a higher court were to refute any likelihood of deception or confusion under section 12, then I cannot see how registration of the mark could be held to be
25 prejudicial to the conduct of the opponent's business. In the circumstances, I see no reason to refuse this application in the exercise of the Registrar's discretion.

The opponent, having been successful in these proceedings, is entitled to a contribution towards the costs of mounting the opposition. I therefore order the applicant to pay to the opponent the sum of **£750**.

30 **Dated this 20th day of March 1998**

S J Probert
Principal Hearing Officer
For the Registrar, the Comptroller-General