

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2019649  
by Sensible Limited to register a trade mark in Class 9**

**AND IN THE MATTER OF Opposition thereto by  
Canon Kabushiki Kaisha under No 46353**

### **Background**

1. On 5 May 1995, Sensible Limited made an application to register the trade mark CANNON FODDER in Class 9 in respect of 'computer software and computer hardware; all for use in playing games'.
2. On 30 January 1997, Canon Kabushiki Kaisha (CKK) filed notice of opposition. The grounds of opposition were originally based on Sections 5(2), 5(3), 5(4) and 3(6) of the Trade Marks Act 1994. Only the ground of opposition based upon Section 5(2) of the Act is now pursued. The opponent has twenty one registrations in the UK containing or consisting of the word CANON. Of the eight most relevant registrations, seven are in Class 9 and the remaining one is in Class 28. All of these registrations predate the application in suit. The specifications of goods are set out in Annex A to this decision. All bar one of the registrations (No 900641, which is CANON in block capitals) consist of the word CANON in the slightly stylised form shown below.



3. The applicant filed a counterstatement denying the grounds of opposition.
4. Both sides ask for a contribution towards their costs.
5. The matter came to be heard on 6 April 2001 when the applicant was represented by Mr J Graham of Counsel instructed by Marks & Clark, and the opponent was represented by Mr T Moody-Stuart of Counsel instructed by R G C Jenkins & Co.

### **The Law**

6. Section 5(2) of the Trade Marks Act 1994 provides:

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.

7. The correct approach to the matter has been set out in a number of decisions of the European Court of Justice (ECJ), in particular, *Sabel BV v Puma AG* (1998) RPC 199, *Canon v MGM* (1998 ETMR 1) and *Lloyd Schufabrik Meyer & Co GmbH the Klijsen Handel BV* (1999 ETMR 690) and *Marca Mode CV v Adidas AG and others* (2000 ETMR 723). The guidance of the court can be summarised as follows:

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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;
- c) the average consumer normally conceives a mark as a whole and does not proceed to analyse its various details;
- 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;
- e) a lesser degree of similarity between the marks maybe off set by a greater degree of similarity between the goods, and vice versa;
- f) there is a greater likelihood of confusion where the earlier marks are highly distinctive character, either *per se* or because of the use that has been made of it;
- 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);
- h) but if the association between the marks results in a likelihood that the average consumer will 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;
- i) a positive finding of a likelihood of confusion is required; even where one of the earlier marks enjoys a reputation with the public, it is not sufficient to find that confusion cannot be ruled out because of a likelihood of association.

### **The Distinctiveness of the Earlier Mark**

8. With this guidance in mind I turn first to consider the strength of the earlier trade mark. I

note that some of the opponent's trade marks proceeded to registration only on the basis of evidence of acquired distinctiveness. It is not clear why. The word CANON does not appear to be descriptive of any of the goods covered by the opponent's registrations. In my view it is a distinctive mark, but it is unremarkable in the sense that it does not have an exceptionally strong inherently distinctive character. The opponent relies upon evidence, which I will come to shortly, to support its claim that its mark has acquired an exceptionally distinctive character as a result of the use made of it.

9. The applicant does not dispute that the opponent's mark has a substantial reputation in respect of cameras, lenses, binoculars, photocopies and computer printers. The nature and extent of the opponent's reputation under its trade mark is set out in a declaration of Giichi Marushima dated 12 December 1997. The main points that emerge from Mr Marushima's declaration are as follows:

- a) The trade mark CANON was first used in the UK by the opponent in 1955 in respect of cameras;
- b) According to Exhibit GM 1 to Mr Marushima's declaration the mark has subsequently been used in the UK in respect of various types of optical apparatus, printers for computers and photocopiers;
- c) The mark CANON was first used by the opponent in respect of computer software in the UK in 1981;
- d) Although Mr Marushima is vague as to the precise software in relation to which the mark CANON was used prior to the relevant date, it seems likely to have been driver software for the opponent's photocopiers and the like;
- e) Turnover and promotion figures are provided for the opponent's trade in the UK under the mark CANON; In 1994, turnover under the mark in the UK amounted to £435M and a figure of £40M was spent promoting the mark in the five years between 1993 and 1997.

10. The opponent has not provided any breakdown of this activity by product or product class. It is not therefore possible to say whether any significant amount of this turnover was in relation to a trade in computer software. On the basis of what I have seen in evidence, I think that unlikely.

11. The opponent also claims to have used the mark CANON in relation to CD ROMs containing information about its other products. It is not clear when this activity started or the extent of it, so this claim adds nothing to the opponent's case.

12. Mr Marushima says that a company called Criterion Software was incorporated in 1993 to develop computer games. The company does not use the trade mark CANON to identify the source of its products but it is said that the company identifies itself as a "Canon company." Mr Marushima provides no further details of any trade in computer software before the relevant date in these proceedings. Everything in Exhibit GM 4 to Mr Marushima's declaration, which is intended to support the claim, in fact post dates the application under opposition. I do not therefore consider that this claim adds anything to the opponent's case

either.

13. I find that the opponent has a substantial reputation under the mark CANON in respect of optical apparatus such as cameras, lenses, binoculars, and in respect of copiers and computer printers.

14. Mr Moody-Stuart submitted that the opponent's substantial reputation for other electrical goods spilled over to other goods, such as computers and computer software. Mr Graham urged me to reject that submission, although he accepted that I was entitled to assume "normal and fair" use of the opponent's mark in relation to the full range of computers and computer software, there being no attack on the validity of the opponent's earlier registration of its mark for these goods. A similar point arose in the case of Premier Brands UK v Typhoon Europe 2000 FSR 757. In that case the claimant argued that the distinctive character of its TY.PHOO trade mark, which was registered for kitchenware, had been significantly enhanced by the reputation that the mark acquired in relation to a trade in tea. The defendant resisted this line of argument pointing out that there had been very little use of the mark in relation to kitchenware whilst conceding there had been substantially more use in relation to tea. Neuberger J dealt with this (at page 70) like this.

"In my judgement the dispute between the parties in this connection is more apparent than real. I except that the three decisions of the ECJ to which I have referred support the proposition advanced by Mr Arnold on behalf of Premier. However, it seems to me that they do not detract from what may fairly be said to be the fundamental point made by Mr Bloch on behalf of TEL on this aspect, namely that, in connection with a particular registered mark, the less use it has had in connection with the goods for which it is registered, the less distinctiveness it is likely to have acquired, and, therefore, the more protection claimed for it has to be limited to its inherent distinctiveness. To my mind, that proposition is really no more than the corollary of the principle (excepted by both parties) that the greater the exposure and use of a particular registered mark, the greater its reputation is likely to be, and therefore the greater the protection likely to be afforded to it."

15. The position therefore seems to me to be as follows. The opponent can ask for the substantial reputation of its CANON mark for goods, such as computer printers, for which the mark is both registered and acknowledged to have a substantial reputation, to be taken into account in determining the likelihood of confusion. However, the reputation that the mark enjoys for other goods should not be elided with its registration for computers and computer software in such a way as to produce the artificial result that the mark is deemed to have a reputation with the public for these goods also.

### **Similarity of Goods**

16. With these points in mind I turn to the similarity of the respective goods. Mr Moody-Stuart relied primarily on the following three registrations of the mark CANON. Registration No 1355456 covers, inter alia, computer software. Registration 1197302 covers, inter alia, computers. Mr Moody-Stuart also relied upon a further registration of the same mark in Class 28 under No 2005525 in respect of games. Mr Moody-Stuart submitted that the goods specified in the application fell within the descriptions of goods listed above with the result that the respective goods should be considered to be identical. Mr Graham was

constrained to accept that the opponent's registration for 'computer software' included the specific software in his clients' application. He did not accept that the second item within the applicant's specification, namely 'computer hardware for playing games', fell within the description 'computers' in the opponent's registration No 1197302; nor did he accept that the applicant's goods fell within the description of 'games' in Class 28 covered by the opponent's registration No 2005525. He is clearly right as regards the opponent's registration in Class 28 which does not cover computer software. However, I am less persuaded that the term 'computer hardware for playing games' does not fall within the broader description 'computers'. It seems to me that the former term would include goods such as a games consoles, which is simply a computer adapted for playing games. I therefore take the view that these goods are also identical. If the respective goods are not identical then they are virtually so.

### **Similarity of Marks**

17. I turn next to the similarity of the respective trade marks. The opponent's CANON trade mark is, in the case of the three registrations upon which the opponent primarily relies, registered in the slightly stylised form shown above. The stylisation seems to me to be slight and I do not therefore believe that this has any significant effect on the likelihood of confusion between the respective marks. More significantly, the applicant's mark consists of two words CANNON FODDER whereas the opponent's mark consists simply of the word CANON. The marks are slightly more similar to the ear than to the eye in that the stylisation present in the opponent's mark is not apparent to the ear, and nor is the different spellings of the word CAN(N)ON. Conceptually the marks appear to me to be quite different. The word CANON describes a principle or a priest. The words CANNON FODDER on the other hand have an entirely different meaning ie an expendable resource, usually in a military context.

18. Mr Moody-Stuart submitted that the meaning of CANNON FODDER was not well known, or at least there was no evidence that it was. He further submitted that the applicant's specification of goods was not limited to hardware and software for use in relation to military games and, therefore, even if the meaning of CANNON FODDER was well known, there was no reason to suppose that the applicant's mark would always be used in relation to goods which would bring the meaning of the words to mind. He suggested that idioms were, as he put it, "context dependant." I reject those submissions. It seems to me that the meaning of CANNON FODDER is so well known that there is no need for evidence. Nor do I accept that a military prompt would be necessary in order to bring the meaning of CANNON FODDER into the mind of the average consumer.

19. Mr Moody-Stuart contended that the word "CANNON" was the dominant feature of the applicant's mark. In adopting the word CANNON as part of its trade mark, the applicant had taken the whole of the earlier mark. He further submitted that the addition of the "subordinate" word FODDER did not negate the overall similarity between the respective trade marks. I do not agree. Where two words have, in combination, a well known meaning, it is artificial to dissect the words and label one as the dominant component. The addition of the word "FODDER" to the word "CANNON" gives the applicant's mark a distinctly different character to the opponent's trade mark CANON. Because of this the applicant's trade mark does not capture the distinctive character of the earlier trade mark even though the first word of the applicant's mark does take all five letters of the opponent's earlier mark.

## Likelihood of Confusion

20. It is difficult to see any likelihood of direct confusion between the marks either to the ear or to the eye. The applicant's mark consists of two words against the opponent's one. Even allowing for successive (as opposed to side by side) exposure to the respective marks and a degree of imperfect recollection, I do not believe that the average consumer of these goods is likely to mistake the applicant's marks for that of the opponent. Further, because the words in the applicant's mark 'hang together' as a known term, there is no reason for the average consumer of software and hardware for use in playing games - who is likely to be as knowledgeable and circumspect as most consumers - to believe that the word CANNON in the mark CANNON FODDER signals an economic connection with the opponent.

Mr Moody-Stuart did suggest that the word FODDER might be seen by consumers as an informal way of describing consumable products for use with the opponent's goods, such as digital film cartridges. Mr Graham pointed out that this was not a natural use of the word FODDER. I agree. Further, I believe that Mr Moody-Stuart's submission suffers from the defect that it again depends upon the average consumer mentally dissecting the applicant's mark and attributing purposes to the individual components when, in practice, the applicant's mark is unlikely to be dissected in this way. In any event, it is very doubtful that the applicant's specification of goods includes any items which could be described as "consumables" for any of the opponent's goods.

21. For the reasons given above I have come to the conclusion that there is no likelihood of confusion between the respective trade marks and goods whether considered on the basis of the opponent's registrations of CANON for identical goods and/or the registrations for similar goods, such as computer printers, for which the mark CANON enjoys a substantial reputation. The opposition under Section 5(2)(b) therefore fails.

22. I am fortified in this view by the decision of Neuberger J in the case of Premier Brands UK v Typhoon Europe (cited above) in which the learned judge decided that the marks TY.PHOO and TYPHOON were not likely to be confused even if both marks were used in respect of kitchenware, and despite the reputation of TY.PHOO for related goods such as tea. As in this case the later mark took all six letters of the earlier mark and differed by just one letter. Nevertheless, the conceptual dissimilarity of the later mark was sufficient to avoid confusion.

23. I have also borne in mind that the applicant has filed evidence of use of its mark in relation to computer games software dating back to November 1993. The use is described in a statutory declaration of Jonathan Hare dated 16 December 1998. Mr Hare is a Director of Sensible Limited. He describes how the applicant marketed a game in the UK under the name CANNON FODDER. The game appears to have been quite successful. For example, in 1994 the applicant sold around 60,000 copies of this computer game in the UK. The computer software game was voted fourth favourite game of all time in May 1995 by Amiga Power Magazine. Mr Hare says that despite the use there has been no confusion with the opponent or its goods. The opponent does not suggest otherwise but points out that the applicant has not used its mark in relation to computer hardware and further, that the use in relation to computer software is limited to games with a military theme. This, the opponent says, is more likely to have brought the meaning of CANNON FODDER to mind than would be the case if the applicant was to use its mark in relation to other types of computer game. I accept that the applicant has not so far used its mark across the full breadth of the goods listed in the

specification of the application. However, I still take some comfort from the fact that the applicant's reasonably extensive use of its mark in the computer games market has not been shown to have resulted in any confusion with the opponent. However, I regard this as no more than confirmation of the correctness of the decision I have already come to. I would have come to the same decision even if the applicant's mark had not been used at all.

### **Costs**

24. The opposition having failed the applicants is entitled to a contribution towards his costs. I therefore order the opponent to pay the applicant the sum of £1,200. This sum to be paid within seven days of the end of the period allowed for appeal or, in the event of an unsuccessful appeal, within seven days of the final determination of the matter.

**Dated this 23 Day of April 2001**

**Allan James  
For the Registrar  
The Comptroller General**

**DETAILS OF OPPONENT'S RELEVANT EARLIER REGISTRATIONS FOR  
CANON MARKS**

<u>No.</u>	<u>Date</u>	<u>Specification</u>
741219	7 April 1955	Cameras and parts thereof included in Class 9.
900641	19 October 1966	Cameras for copying and reproduction purposes; apparatus and machines, all for copying or recording images by photographic means; photographic developing, duplicating, printing and processing apparatus; photographic projection screens; photographic projectors and enlargers; microfilm readers; combined microfilm readers and photographic printers; photographic optical apparatus and instruments; and parts and fittings included in Class 9 for all the aforesaid goods.
1015107	30 July 1973	Photographic apparatus and instruments, electrophotographic apparatus and instruments, apparatus and machines, all included in Class 9, all for copying or recording images by electrostatic means, electric and electronic calculators and calculating machines.
1059873	8 March 1976	Apparatus and instruments, all included in Class 9 for copying or recording images by electrostatic means; photographic slide projectors; electric calculators and electric calculating machines; cinematographic cameras and parts thereof included in Class 9; and photographic optical apparatus and instruments and parts and fittings included in Class 9 for such apparatus and instruments.
1197302	5 November 1999	Facsimile telegraphy apparatus, electronic word processors, video apparatus, computers, apparatus included in Class 9 for use in the manufacture of semiconductors; magnetic heads



(transducers).

1355456	19 August 1988	Lenses; electronic flashes; camera straps, cases and bags; lens caps and hoods; camera body caps; filters; pan and tilt heads; film advancing winders; video cameras, still video cameras, video recorders, still video recorders, video printers, still video printers, video transmitters/receivers, still video transmitters/receivers, photoelectric image producing cartridges; paper feeders and paper sorters for copying machines; stands for copying machines; telephones and telephone cords; computer software; magnetic discs and magnetic disc drives; word processors; electronic dictionaries and electronic notebooks; electronic printers; communication apparatus for the handicapped; rotary encoders; linear encoders, all included in Class 9.
1482876	18 November 1991	Audio, visual and audiovisual apparatus and instruments; loudspeakers and apparatus for use therewith; parts and fittings for all the aforesaid goods; all included in Class 9.
2005525	15 December 1994	Toys, games and playthings; decorations for Christmas trees.