

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2114794
by Wayne Brown to register a Trade Mark
in Class 16, 25, 35, 40, 42**

and

**IN THE MATTER OF Opposition thereto under No 47063
by Turner Entertainment Co.**

BACKGROUND

1. On 6 November 1996, Wayne Brown (“the applicant”) applied to register a series of two trade marks under application No. 2114794 in Classes 16, 25, 35, 40 and 42. The marks are reproduced below. The second of the two marks is limited to the colours red, black, white, pink, purple, light blue, dark blue and brown:



2. The application was accepted and published in the Trade Marks Journal on the 19 March 1997 in respect of the following specification of goods and services:

Class 16: Paper, printed matter, printed publications, leaflets, brochures, catalogues, cards, stationery, calendars, labels, pictures, posters, photographs.

Class 25: Articles of clothing, headgear, footwear.

Class 35: Photocopying and document reproduction services; data processing and word processing services; business consultancy and information services.

Class 40: Binding and laminating services.

Class 42: Printing services, design services; consultancy and information services in relation to these services.

3. On 18 June 1997, Turner Entertainment Co (“the opponent”) filed a notice of opposition and statement of grounds for the opposition.. The opponent says that it is the owner of the rights, including the merchandising rights, in the well-known series of Tom & Jerry cinematographic films and television series which have been released and broadcast in the United Kingdom over a long period of time. They state the pictorial representation of the cartoon character Tom (the cat) is well-known throughout the United Kingdom and indeed the world. The opponent claims that it possesses a valuable reputation and goodwill in the United Kingdom in representations of the cartoon character Tom in numerous positions and perspectives, which are also protected by copyright.

4. The opponent gives details of four registrations Nos. 1527444/5, 1529118 and 1527446 in Classes 16, 25, 28 and 41 respectively of a mark consisting of a representation of the cartoon characters Tom and Jerry.

5. On the basis of these earlier trade marks and earlier right, the opponent alleges that the mark applied for offends against the provisions of Section 3 and 5 of the Act. Specifically, the opponent states that use of the applicant’s trade mark in the United Kingdom is liable to be prevented by the laws of passing-off and copyright. These objections go to Section 5(4) (a) and (b) of the Act. The opponent further alleges that the application covers similar goods in classes 16 and 25 to those for which the earlier trade mark is protected and that there exists a likelihood of confusion. The application is therefore said to be contrary to section 5(2)(b) of the Act. Further, to the extent that the respective goods and services are dissimilar, the opponent alleges that use of the applicant’s mark in respect of such goods or services would, without due cause, take unfair advantage of, or be detrimental to, the repute and distinctive character of the earlier mark. This objection goes to section 5(3) of the Act. The opponent further alleges that, because the applicant’s mark is an obvious copy of the cartoon character Tom, the application is made in bad faith and should be refused under section 3(6) of the Act.

6. There is a still further objection under Sections 32(3) and 3(6) because the opponent claims, the applicant has no bona fide intention to use the mark in relation to the goods listed in classes 16 and 25 of the application.

7. There were originally further objections but these are no longer pursued.

8. The applicant filed a counterstatement admitting the existence of the Tom & Jerry cartoon series, but denying all of the opponent’s grounds of opposition. On the Section 32(3) ground, the applicant say they have made extensive use of their trade mark on a wide range of goods and services for a number of years.

9. Both sides seek an award of costs

OPPONENT'S EVIDENCE

10. The opponent filed an affidavit dated 5th December 1997 by **Reta J. Peery**, the Assistant Secretary of Turner Entertainment Co, the opponent. Ms Peery states that the opponent owns the trade marks and copyrights to Tom & Jerry. She gives a potted history of how these rights were obtained, which I summarise thus:

- In 1940 the Tom & Jerry characters were created by William Hanna & Joseph Barbera whilst employed by Loew's Incorporated (later Metro-Goldwyn-Mayer Inc). Exhibit 1 (copies of 1952 telegrams between a magazine and Metro-Goldwyn-Mayer Inc) is said to verify this.
- Loew's Incorporated was the original copyright owner of all Tom & Jerry rights. Exhibit 2 provides copies of registrations of two films featuring Tom and Jerry, "The Midnight Snack" and "Puss gets the Boot", with the US Copyright Office in 1940/41.
- 1960 Loew's Incorporated changed its name to Metro-Goldwyn-Mayer Inc.
- Metro-Goldwyn-Mayer Inc assigned copyright to the pictures in the "MGM Library" (which it is said included the Tom and Jerry cartoons) to the opponent in 1986. Verification of the transfer is at Exhibit 4. Exhibit 5 consists of a certificate from the US Copyright Office confirming the renewal of a copyright in the Tom and Jerry cartoon "Buddies Thicker than Water" in the opponent's name in 1990.

11. Ms Peery states that entertainment services relating to Tom & Jerry have been provided in the United Kingdom for at least forty years. Due to the popularity of the Tom & Jerry characters, the opponent is said to have created new cartoon series featuring Tom & Jerry and three such series entitled "Tom & Jerry Kids" are said (Exhibit 7) to have been broadcast in the United Kingdom on "Free TV" from 1st June 1993 to 31st May 1997.

12. Ms Peery goes on to say that Tom & Jerry have been licensed for use in connection with several different types of goods and lists them. In every example (save the "View-Master reels, which is world-wide) the licence agreement is with non-United Kingdom licensees, for use on goods outside the United Kingdom, and so is of no relevance in these proceedings.]

13. Ms Peery goes on to describe how the opponent's investigations had shown use by the applicant of a cat logo (with the words "Copy Cats") prior to its use of the series of two marks in this opposition (described as the "square cat logo"). The earlier cat logo is shown in the Affidavit and is said by Ms Peery to be clearly the opponent's Tom character.

14. The opponent also filed a statutory declaration dated 8th December 1997 from **Karin Visser**, the Director of Legal Affairs of Warner Bros.Consumer Products (United Kingdom) Limited. Ms Visser says she has full access to her company's records. On 10th October 1996, Time Warner (Warner Bros holding company) acquired exclusive representation rights for merchandising purposes from Turner Entertainment Co., the

opponent. She says the first exhibition of a Tom & Jerry film in the United Kingdom took place in the 1940s in cinemas. The first viewing of a Tom & Jerry film on television in the United Kingdom was on BBC television in 1967 and films have continued to be broadcast since that date.

15. Ms Visser gives a figure of approximately £88,000 in 1966 (subsequently corrected to 1996) being the revenue received by the opponent from licensing the Tom & Jerry characters in the United Kingdom in relation to articles of clothing, footwear and accessories. Exhibited at KV2 is a list of the names of companies and organisations within the United Kingdom who have been licensed to use the Tom & Jerry characters in relation to the goods listed above. No further details are provided.

APPLICANT'S EVIDENCE

16. The applicant **Wayne Brown** filed a statutory declaration dated 2nd September 1998. He says that since 1990 he has been involved in the photocopying and printing bureau business through a number of retail outlets and through an extensive direct client base. He says that the goods and services he provides include photocopying and document reproduction services; data processing and word processing services, printing and design services, binding and laminating services, consultancy and information services on all such matters, together with the supply of goods bearing the printing or designs developed, including paper, printed matter, printed publications, leaflets, brochures, catalogues, cards, stationery, calendars, labels, pictures, posters, photographs, office requisites and articles of clothing.

17. Mr Brown says that during all this time the photocopying and printing bureau business has operated under the name of COPYCATS and in January 1996 the Square Cat device mark (the subject of the application in suit) was adopted for use in connection with all the different goods and services in relation to the COPYCATS business.

18. Exhibit WB2 shows use of the Square Cat device on the outside of one of the businesses retail establishments and on photographs of promotional tee-shirts, a booklet advertising personalised Christmas cards, envelopes, headed paper and other goods relating to the business.

19. With regard to the origin of the Square Cat logo, Mr Brown states that:

“The Square Cat logo was quite independently devised and designed towards the end of 1995 to complement the COPYCATS name and there is no question of the mark being devised to look like or otherwise have similarity with the Opponents Tom & Jerry cartoon devices.”

20. Mr Brown further says that his business has acquired and established a considerable goodwill since 1996, both in the name COPYCATS and in the Square Cat logo and at no time has there ever been drawn to his attention any instance of confusion or any other complaint in relation to the use of the Square Cat logo in relation to any element of his business.

21. Mr Brown comments on various aspects of the affidavit of Ms Reta J. Peery and Statutory Declaration of Karen Visser. The most relevant points are:

- Tom & Jerry are always mentioned together, never as Tom alone.
- The history of the Tom & Jerry cartoons is not disputed, but the opponent has not established an earlier licensing trade in the UK.
- The opponent's merchandising guidelines (Exhibit 19 to Peery 1) states that the Tom & Jerry characters should "always be portrayed together".
- A comparison of the marks shows that they are quite different.
- The details of the opponent's licences in the United Kingdom, shows no evidence that such items have been sold in the United Kingdom
- The merchandising use claimed in the United Kingdom appears to be minimal at £88,000 in 1966 (or 1996).
- The Tom & Jerry characters are never used in a format of a close-up face in a small square/rectangular frame.

22. With regard to Ms Peery's evidence of the applicant's use of an earlier cat logo, Mr Brown says:

"In paragraph 13 of the declaration there appears a representation of a mark which is described to be my logo. It is not denied that prior to 1996 my business used a logo which was different to the SQUARE CAT device, but I totally deny that the first logo represented in Paragraph 13 is the Opponent's TOM character. It is simply a cartoon cat device. In any event, the present application is not for the logo depicted in paragraph 13, so I believe that comparison between that mark and the Opponent's mark is therefore misleading and irrelevant to the present matter."

OPPONENT'S EVIDENCE IN REPLY

23. The opponent filed a further affidavit from **Reta J Peery**, dated 5th April 1999. In this she comments on Mr Brown's assertion that the Square Cat logo was independently devised and designed noting that he does not reveal who the author of the work was, nor the materials that person had about them when they produced the artwork. She goes on to suggest that although she does not know whether the author of Mr Brown's cat slavishly copied the Tom character, it is clear that the author has used the result of the labours of the opponent's authors of the Tom character. Any slight differences are, in her view, likely to be accidental or a poor attempt to disguise the act of copying.

24. The opponent also filed a statutory declaration dated 5th September 1999 from **Richard Cooke**, Marketing Director of Calypso Soft Drinks Limited. His company has been a licensee of Warner Bros. Consumer Products (United Kingdom) Limited for seven years. The licences

granted entitle Mr Cooke's firm to reproduce on its packaging and in its advertising, reproductions of the Tom & Jerry characters. The company do so on various "Tom & Jerry" drinks. Mr Cooke exhibits at RC3 copies of advertisements for "Tom and Jerry" drinks placed in publications called "The Grocer"(from February 1993) and "Checkout" (April 1996). He states that turnover for the Tom & Jerry products vary from year to year. The only figure he provides relates to a period after the relevant date in these proceedings. Finally, Mr Cooke says that if he saw the Square Cat device in relation to a company offering photocopying services, he would think that that company would have obtained permission from Warner Bros. Consumer Products (United Kingdom) Limited to use a device he has no doubt is the picture of Tom from the Tom & Jerry cartoons.

25. Another statutory declaration was filed by the opponent dated 4 September 1999 by **David Bryan Aykroyd**, a Director of Aykroyd & Sons, a company who manufactures pyjamas, dressing gowns and other items of leisure wear. He says his company have a licence from Warner Bros. Consumer Products (United Kingdom) Limited, which permits it to reproduce the famous cartoon characters of Tom & Jerry on a range of children's nightwear. DBA1 exhibits the relevant artwork. His company has been selling these products for the previous five years exclusively to British Home Stores, a chain of United Kingdom-wide retail outlets. The numbers of such Tom & Jerry products is said to vary between 4,000 and 10,000 per annum. He too declares that he immediately recognised the Square Cat device as the Tom character from the Tom & Jerry cartoons. If he were to see that picture displayed on business premises, he would assume that the owners of the business had obtained a licence to use the picture, in the same way that his company has.

OPPONENT'S FURTHER EVIDENCE UNDER RULE 13(8)

26. The opponent filed two further pieces of evidence under the provisions of Rule 13(8). The first is a statutory declaration dated 22nd October 1999 was filed by **David Walker**, the Marketing Operations Manager of Kellogg Marketing and Sales (United Kingdom) Limited. Mr Walker gives evidence of his company becoming a licensee of Warner Bros. Consumer Products (United Kingdom) Limited in 1998. This is after the relevant date and therefore irrelevant. He makes similar assertions to Richard Cook and David Aykroyd as to the resemblance of the cat in the application in suit to that of the Tom character.

27. The second piece of evidence is a statutory declaration of **Becky Crane** dated 26th October 1999. Ms Crane is a Legal Advisor for Warner Bros. Consumer Products (United Kingdom) Limited. Ms Crane exhibits as BC1 a copy of a "Contracts List" which provides very basic details of over one hundred companies with a UK office licensed in the United Kingdom and the Republic of Ireland to display Tom & Jerry characters in relation to the product range which her company describes as "accessories, apparel and footwear". The licences cover a wide range of goods, particularly clothing, such as pyjamas, boxer shorts and T-shirts, and also stationery, including greetings cards. The list dates back to 1990 and most of the licences commenced (and in some cases ended) before the relevant date.

28. Exhibit BC2 is a still larger "Contracts List" covering the same licences as BC1 and details of some additional licences in relation to other goods such as food, beverages, games, activity books, audio cassettes etc. Most of these licences pre-date the relevant date in these

proceedings, many going back to the early 1990s. All the licences cover the United Kingdom. Many cover other jurisdictions as well, mainly the Republic of Ireland.

29. Exhibit BC4 comprises a selection of sales reports from a number of licensees of the Tom and Jerry characters. The sales reports include two from Copywrite Limited and Peter Haddock limited in respect of royalties due as a result of substantial sales of children's stationery items in the period 1993-1997, and a report from WW Group Ltd in respect of sales of £62K worth of T-shirts in the period October 1994 - October 1996.

30. Ms Crane provides figures for of the revenue paid to the opponent as a result of licensing the Tom & Jerry characters in the United Kingdom:

- 1995 - \$764,000 (actual sales of goods in United Kingdom)
- 1996 - \$605,000 (actual sales of goods in United Kingdom)

31. At BC5, Ms Crane exhibits a copy of a "Contract List"(again relating to the United Kingdom) which is limited to the field of publishing, audio and music stationery and paper goods, which she comments is particularly relevant to what Mr Brown describes as his business. Ms Crane refers particularly to some of the licences contained in that list:

- Boxtree held licences from 1993 and sold 5000 books
- Fleet Way Editions held licences from 1993-1997. Comics were sold in newsagents such as WH Smiths. There were 37 monthly editions, selling approximately 50K-60K at the beginning of the contract to 15K at the end.
- Gemma Designs held a licence between 1991-1993 for Tom & Jerry stationery products, including cards.
- Peter Haddock Limited held a licence between 1990-1996 for books. Exhibit BC6 shows three examples of these (all dated after the relevant date).
- The Art Group had a licence from 1994-1997 and sold posters, prints, postcards and note cards to card shops and poster galleries.

32. Ms Crane exhibits at BC7 a collection of video sleeves for Tom & Jerry videos sold in the United Kingdom since 1990, along with a sheet produced by her company showing annual video sales figures in the United Kingdom. These range, by way of example, from 1170 in 1995 for a title called "Tom & Jerry - Mouse Line and Sinker" to 81,614 in 1995 for "Tom & Jerry's Special Bumper Collection" and 77069 in 1997 for "Tom & Jerry's Special Bumper Collection."

33. Ms Crane exhibits at BC8 a 1997 market research report produced for her company by Liebermann Research showing a range of character/product recognition indicators. There is no information about the way the survey was carried out or how many persons were interviewed or where. It appears that only those aged 49 or younger were included. The report indicates

that over 95% of those questioned were aware of Tom and Jerry and around 50% had seen Tom and Jerry “on a product.”

34. That concludes my review of the evidence insofar as I see it as relevant to the current proceedings.

THE HEARING

35. The matter came to be heard on 7 February 2001 when the applicant was represented by Mr Goldring of J E Evans Jackson & Co, Trade Mark Attorneys, and the opponent was represented by Mr C Morcom QC instructed by Wildbore and Gibbons, Trade Mark Attorneys.

DECISION

36. It is common ground that nothing turns upon the colours in the applicant’s second mark in the series. Consequently, although the application is for a series of two marks, I can treat it as though it were simply for the first mark in the series.

37. In my view the opponent’s first objection under section 3(6) - bad faith because of copying - stands or falls with the objection under section 5(4)(b) - that the applicant’s mark is a direct or indirect copy of the cartoon character TOM. If the objection under section 5(4)(b) succeeds the application must be refused for all the goods and services listed. Accordingly, I propose to address this objection first.

The Copyright Issue

38. Section 5(4) of the Act is as follows:

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
- b) by virtue of any earlier right other than those referred to in sub-sections (1) - (3) of paragraph (a) above, in particular by virtue of the law of copyright, design or registered design.

39. Ms Peery gives evidence that the cartoon characters Tom and Jerry were first created in the USA in 1940 by William Hanna & Joseph Barbera whilst employed by Loew’s Incorporated. Although it is clear that the opponent’s case is based upon copyright in the cartoon character TOM, the opponent has been a little vague about the precise subject matter of the copyright material (eg original drawings, films or broadcasts) which would be infringed by use of the applicant’s mark. At the hearing, Mr Morcom appeared to base his case on the drawings of Tom and Jerry as artistic works. I believe that this would indeed give the opponent its best chance of success.

40. In order for copyright to subsist in an artistic works it must be “original” - Section 1 of the Copyright, Designs and Patents Act 1988 (CDP). In Bookmakers Afternoon Greyhound Servicers v Wilf Gilbert (Staffs) Limited 1994 FSR 723, Mr Justice Aldous (as he then was) said that:

“It is settled law that the word “original” does not require original or inventive thought but only that the work should not be copied and should originate from the author.”

41. The applicant has not disputed the opponent’s evidence that William Hanna and Joseph Barbara originally created the representations of the characters of Tom & Jerry. I note that section 4 of the CDP includes within the definition of “artistic work” a “graphical work..... irrespective of artistic quality.” I conclude that those artistic works are capable of copyright protection in the UK..

42. However, as the works originated in another country it is necessary to consider whether they are indeed entitled to copyright protection in the UK. Protection in the UK of works having their origin in another country can arise a number of different ways. For example, because the artistic works were first or simultaneously published in another member of the Berne Convention when they were created in 1940. I have not been given enough evidence to determine when copyright might have commenced. However, even if they had not gained copyright protection in the UK at the time of their creation, the works should, however, have come into copyright in the UK on 8 March 1989 when the Copyright (International Conventions)(Amendment) Order 1989 (S.I. 1989 No 157) came into force in recognition of the accession by the USA to the Berne Convention.

43. Whether copyright protection existed at the time of the application (6 November 1996) depends on the duration of copyright for artistic works. At this time the term was the life of the author plus seventy years - section 12 of the CDP as amended by the Duration of Copyright and Rights in Performances Regulations 1995 S.I. 1995/3297, which came into effect on 1 January 1996. According to section 12(4) of the CDP, in the case of joint authors, the expiry of any copyright should be calculated by reference to the death of the last of them

44. Prior to 1 January 1996, artistic works were protected for the life of the authors plus fifty years. The opponent has not provided evidence as to whether either of the authors are still alive or, if not, when they died, although in fact the death of one of the authors, Joseph Barbara, was widely reported at the time of drafting this decision. It therefore seems safe to conclude that copyright would still have subsisted in the artistic works at all material times in these proceedings. This is consistent with the evidence of the opponent’s continuing licensing of its Tom & Jerry characters, the subject matter of which (judging from the exhibits in evidence) clearly goes beyond the UK trade mark registrations including the characters Tom & Jerry, and extends to goods for which no trade mark registration exists in the UK.

45. I have not seen the original artistic works of 1940 but I believe it is a proper to infer that the various representations of TOM in the opponent’s evidence are based directly or indirectly upon those original artistic works with the result that, if they had been reproduced by an unrelated undertaking, they would have infringed the copyright in the original artistic works. If any of the opponent’s later representations of the character TOM are sufficiently different

from the original drawings to be more than a mere copy thereof, those drawings would almost certainly constitute new original works which would themselves be entitled to copyright protection. For the reasons I have given above, these too should have been protected by copyright in the UK at the material time.

46. In his skeleton argument, Mr Goldring questioned whether the opponent had shown it was the owner of the copyright said to be infringed by use of the applicant's mark. In order to succeed in the opposition under section 5(4)(b), an opponent has to show that the use of the applicant's mark would be contrary to the law of copyright. It does not have to show that the opponent is the owner of the copyright. It is sufficient to show that there is a relevant copyright, that the applicant is not the owner of the copyright, and the applicant's use of the mark would infringe the copyright.

47. The correct approach to the determination of copyright infringement is well established and was set out quite recently in Designers Guild Ltd v Russell Williams (Textiles) Ltd 2001 FSR 113 at 124 where Lord Hope of Craighead stated:

“The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied upon are sufficiently close, numerous or extensive to be more likely the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are commonplace, unoriginal, or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying.”

48. It is worth pointing out that, in that case, there were substantial differences between the overall designs of the claimant and defendant's fabrics; the allegation of copying relating to only part of the defendant's overall design. It is in this context that his Lordship stated that the purpose of the enquiry is not to see whether there is similarity in the works as a whole but in the features alleged to have been copied. Nevertheless, with this caveat, I believe that the approach suggested is appropriate to the case before me.

49. The next question is which of the opponent's various representations of the character TOM I should take as the basis of the comparison. Mr Morcom submitted that it did not matter. He referred me to King Features Syndicate Inc. and Another v O & M Kleeman Ltd (the Popeye case)- 58 RPC (1941) 207 as support for the proposition that where a large number of drawings of cartoon characters are brought into existence it is not necessary, and indeed it will often be impossible to prove, which particular drawing of the character has been copied. Provided that it can be shown that the applicant's mark is a copy, or an indirect copy, of a substantial part of one or other copyright work, there is infringement. I accept that submission, but I must not forget that copyright exists in the expression of an idea rather than in the idea itself. It is not therefore sufficient merely to pose the question whether the

applicant's mark is recognisable as the character TOM - per Lord Porter in King Features Syndicate case at page 225, lines 29-36.

50. Not surprisingly, this issue appears to have arisen in other cases. In BBC Worldwide Ltd v Pally Screen Printing Ltd 1998 FSR 665, at 669, Laddie J. was faced with a claim for copyright infringement based on T-shirts bearing representations of the well known "Teletubbies" characters. He said:

"It is not possible to identify a particular artistic work created by or on behalf of the plaintiffs of which these can be said to be unlicensed reproductions. However, the plaintiffs say that this is effectively a *Popeye* type case, that the artwork on these two T-shirts must have been derived from one or other of those numerous drawings. Therefore substantial reproduction of a copyright work is made out. That is the overall structure of the claim to copyright infringement.

I must say that as far as the second group of garments is concerned, once again it seems to me clear that this artwork is derived directly or indirectly from Teletubby designs and, subject to the other defences raised by the defendants in this action, my view is that there is no reasonable defence to the plaintiff's claim that this artwork is a substantial reproduction of one or other pieces of artwork which the plaintiffs have generated in designing Teletubby programmes."

51. It is clear from section 16(3)(b) of the CDP that direct or indirect copying of a copyright work is an infringement. The opponent investigations revealed that prior to 1996 the applicant used a different cat device to the one applied for. Mr Goldring pointed out that whilst the applicant had admitted using a different cat device prior to 1996, he had not admitted that the cat device identified by the opponent was the one he used. That is strictly correct, but Mr Brown has not denied it either. The earlier cat device said to have been used by Mr Brown was set out in paragraph 13 of Ms Peery's first declaration. Mr Brown commented upon the claim in the terms set out in paragraph 22 above. Faced with this evidence, it is inconceivable that he would have admitted using a different cat device prior to the square cat device applied for, without denying that the cat device in Ms Peery's evidence was the particular cat device he had used. In these circumstances, I regard his failure to deny that this was the previous cat device he used as tantamount to an admission that it was.

52 I believe that this is relevant because a) the earlier cat device used by Mr Brown has additional similarities to some of the drawings of the character TOM in evidence compared to the square cat device for which registration is sought, and b) the square cat device has obviously been devised simply by "cropping" the earlier cat device. Accordingly, if the earlier cat device was copied from one of the opponent's drawings of TOM, the square cat device was indirectly copied from the same drawing.

53. The exhibits to the opponent's evidence include a variety of representations of TOM that have appeared on children's books, videos etc. As you would expect TOM is shown in a wide range of poses, some of which reveal much greater similarity to the applicant's mark than others. The following representation is reproduced from one of a selection of video sleeves, which Ms Crane gives evidence were sold in the UK since 1990. This particular one includes a copyright claim of 1993, although similar artwork can be found in the opponent's 1989

guidelines for its licensees (exhibit 19 to Ms Peery's first affidavit). Also reproduced below is the applicant's earlier cat device.



Opponent's artwork for TOM from 1993 video

Applicant's earlier cat device

54. Although these representations contain differences, there are also marked similarities, such as the shape of the respective cats mouths, tongues, cheeks, ears, and noses (with the same reflection of light at the tip of the noses), the suggestion of tufts of hair on top of the head of the applicant's cat device and the presence of such tufts on TOM, the presence of fur protruding into the ears of both cats, and the presence of eye-brows on both cats. The differences are mainly that a) the applicant's cat is shown from a left perspective view whereas TOM is shown from the opposite perspective, b) TOM has whiskers whereas the applicant's cat has none, and c) the applicant's cat has two stripes on its cheek whereas TOM has none.

55. I bear in mind that all cartoon cats are likely to have somewhat similar characteristics but I believe that, taken together, the similarities between these drawings combined with the extensive exposure of the TOM & JERRY characters in the UK, is sufficient to present a prima facie case that the applicant's earlier cat device was copied, either consciously or unconsciously, from some representation of TOM similar to the one shown above. If that is so it follows that there is also a prima facie case for saying that the mark applied for, being no more than a "cropped" version of the applicant's earlier mark, was also indirectly copied from one of the opponent's drawings of TOM.

56. If that is so, is the applicant's mark a substantial proportion of a copyright work? It is worth recording that 'substantial' has long been interpreted by the courts in this context as not restricted to the concept of 'large'. Relatively small but qualitatively important parts of a work can be 'substantial.' I bear in mind that the opponent's artwork shown above may have been devised from some earlier original work made by, or for, the opponent or a predecessor. I do not believe that this prevents me from concluding that the applicant's square cat mark is a substantial proportion of an original work. After all it is the face of a cartoon character which gives it much of its artistic worth, and therefore taking the face of a cartoon character inevitably takes a substantial proportion any drawing of the character TOM in the pose shown above, or in a similar pose.

57. Has the applicant discharged the burden of showing that, despite the apparent similarities, the square cat device mark was independently designed and not copied? The applicant gives evidence that the mark applied for was independently devised and designed towards the end of 1995. Mr Brown has not provided any further details, such as who the author was, or what materials he or she had in front of them when the square cat device was designed, or what instructions (if any) the author was given. Despite the opponent's criticism of these omissions in Ms Peery's second affidavit, the applicant has not sought to submit any evidence to fill in these gaps. In fact the whole question of who devised or designed the square cat device in late 1995 seems to me to be somewhat academic because, as I have already found, it was obviously devised simply by "cropping" the earlier cat device used by the applicant. The real question is whether this earlier cat device was independently designed.

58. What does Mr Brown say about this? He says that "I totally deny that the first logo represented in Paragraph 13 is the Opponent's TOM character. It is simply a cartoon cat device." The opponent has not sought to cross examine Mr Brown on this statement. However, to deny that the mark *is* the character TOM is not the same as saying that it was devised independently from it. Mr Brown's statement could be true even if the applicant's mark was copied from a drawing of TOM.. Mr Brown does not repeat the (albeit non-particularised) claim of independent creation he made in relation to the square cat device in respect of his earlier cat device. In my view the statement he has made is insufficient to discharge the burden on the applicant to show that he has not copied from one of the opponent's drawings of TOM, despite the apparent similarities and the wide availability of representations of TOM.

59. In the result I find that the opposition under Section 5(4)(b) succeeds.

Passing off

60. My decision under section 5(4)(b) effectively decides the matter, but in case I am found to be wrong in this respect I will go on and consider the other grounds of opposition, starting with section 5(4)(a). The test for passing off is set out in Wild Child 1998 RPC 455. Essentially, the requirements are a) the existence of goodwill identified by some distinctive indicia, b) misrepresentation by the defendant (or, in this case, the applicant) resulting in (or likely to result in) confusion or deception, c) leading to damage to the goodwill. Normally the goodwill will be that of the opponent, although, as I have already noted, this is not a legal requirement in an opposition. The question must be posed at the date of the application,

although where the applicant's mark was in use prior to that date, one may have to consider the position at an earlier date in order to determine what the position would have been at the relevant date. The purpose of such an enquiry is to ascertain whether the applicant has an antecedent right to the sign, or had built up a concurrent right which would have provided a defence to an action for passing off at the relevant date.

61. The opponent's evidence makes no attempt to distinguish between trade mark licences and copyright licences. I have not seen the licences themselves. None of the licensed use in the UK of TOM & JERRY (as shown in exhibits to the opponent's evidence) corresponds with the opponent's registered UK trade marks. It therefore seems likely that the effective subject matter of the UK licences is the opponent's copyright.

62. The only use shown in evidence of the character TOM being used as part of a sign which appears to serve as part of a traditional trade mark for the goods is the use of a head of TOM (together with the head of JERRY and the words TOM & JERRY) on cartons of soft drinks - see exhibit RC1 & RC2 to Ms Cooke's declaration.

63. Although the representation of TOM shown on the drinks cartons is similar to the applicant's mark, the combination of:

- a) the face of TOM being only part of the sign used to distinguish the source of the drinks;
- b) the applicant's mark being only a "cropped" version of TOM's face with an additional feature in the form of stripes;
- c) the distance between soft drinks and any of the goods and services in the application;

- is, in my view, sufficient to avoid a likelihood of trade source confusion or deception. In any event, there is no evidence that the opponent had any control over the quality of the goods concerned and it may not, therefore, be correct to consider this use as being substantially different in nature from the other uses of representations of TOM shown in evidence.

64. The other uses appear, on the face of it, to be either for the purpose of revealing the subject matter of the goods.e.g. on video sleeves and/or for character merchandising purposes, eg on children's pyjamas - as per exhibit DBA.1 to Mr Ackroyd's declaration.

65. The opponent's case under section 5(4)(a) therefore depends upon whether the opponent has shown that the applicant's use of the mark applied for would amount to passing itself off as a licensee of the opponent's copyright in numerous representations of the character TOM, as in the case of Mirage Studios v Counter-feat Clothing Co. Ltd 1991 FSR 145. In that case The Vice Chancellor, Sir Nicholas Browne-Wilkinson, was faced with claims for passing-off and copyright infringement as a result of the defendant's licensing of humanoid turtle characters for clothing. The plaintiffs "Teenage Mutant Hero Turtles" were very popular at the time and the plaintiff had licensed others to re-produce its characters on, inter alia, clothing. This resulted in some confusion between the goods of the plaintiff and those licensed

by the defendant even though the defendant's turtle characters had been designed so as to take only the concept of the plaintiff's humanoid turtles rather than their form. The Vice Chancellor, granting an interlocutory injunction, found that there was an arguable case of copyright infringement and passing off.

66. The Vice Chancellor's judgement in that case is not without controversy. In Elvis Presley Trade Marks 1997 RPC 543, Laddie J. noted that Vice Chancellor's judgement was on an interlocutory application and given *ex tempore*. Nevertheless, the Vice Chancellor's judgement found favour with Robert Walker L.J. when the Elvis Presley case came before the Court of Appeal. He said:

"Those cases (and some later cases in Australia) were the background to the Teenage Mutant Ninja Turtles case, *Mirage Studios v. Counter-Feat Clothing Co. Ltd* [1991] F.S.R. 145, a decision of Sir Nicolas Browne-Wilkinson V.-C. The Vice-Chancellor granted an interlocutory injunction to restrain the defendants from licensing the use of drawings of turtle characters which copied the concept of the Ninja Turtles cartoon characters rather than being exact or nearly exact copies. The defendants had no licence from the plaintiffs, who owned the copyright in the Ninja turtles cartoon. The plaintiffs alleged copyright infringement as well as passing-off.

The Vice-Chancellor held (at 154) that there was an arguable case of copyright infringement. He also held, after a fairly full examination of the authorities, that there was an arguable case in passing off. It is important to note that those two conclusions were closely linked. After referring to the *Abba* case the Vice-Chancellor said at 158:

"I do not find anything in that case inconsistent with the Australian cases. Again, it was concerned with licensing rights in a name as opposed to licensing rights in what is undoubtedly copyright material. It may be that different factors apply in such a case, though those cases may, given the change in trading habits, require reconsideration on a future occasion if the evidence before the court is different.

In my judgment the three English cases [*Wombles v. Womble Skips* [1977] R.P.C. 99, *Kojak* and *Abba*] do not touch on a case such as the present where the plaintiff clearly has copyright in the drawings and is in business on a large scale in this country in licensing the use of the copyright in those drawings. The defendant is misrepresenting to the public that his drawings are the drawings of the plaintiffs or are licensed by the plaintiffs. I can see no reason why, in those circumstances, the defendants should be allowed to misrepresent his goods in that way."

Laddie J. described the Vice-Chancellor's judgment as an *ex tempore* judgment on an interlocutory application, which it was, but the hearing lasted three days and the judgment is, in my respectful view, very clear and convincing. It does not give a green light to extravagant claims based on any unauthorised use of a celebrity's name, but makes clear (especially in the passage which I have just quoted) the relatively limited scope of the principle on which it proceeds."

67. It appears from this analysis of the case, that the passing-off issue turned on the contribution played by the plaintiff's copyright in drawings of the turtle characters in creating a link in the public's mind, between the goods at issue and the plaintiff.

68. Mr Morcom submitted that the effect of the applicant's use of the mark applied for would be to pass itself off as a licensee of the opponent. There is evidence, mainly to be found in the statutory declaration of Ms Crane, that the opponent had a significant merchandising business in the UK by the early 1990s based upon TOM & JERRY characters. There is evidence that licences were granted and representations of TOM & JERRY were used in trade in relation to clothing, publications and stationery items in classes 16 and 25 - the sort of goods covered by classes 16 and 25 of this application. There is, therefore, some similarity on the facts with the Mirage Studios case.

69. In one respect the evidence does not appear to be on all fours. The Vice Chancellor stated (at page 156):

"The Plaintiff's only connection with the marketing of those goods is by affixing their characters, the Turtles, onto the merchandise of others. But, crucially, the evidence shows that the public is aware that the turtle characters would not normally appear without the licence of the plaintiffs, i.e. they connect the turtles with the plaintiffs. The question is whether that link between the goods being sold and the plaintiffs is sufficient to found a case in passing off. In my judgement it should be." (Emphasis added)

70. The opponent's evidence in this case includes statements by Messrs Cooke and Aykroyd to the effect that if they saw the applicant's mark being used on business premises or in relation to a photocopying service, they would assume that the user of the mark was a licensee of the opponent - as they both are. However, because they are both licensees, their reaction cannot be taken as typical of the public's reaction to the use of the applicant's mark.

71. There is also the survey evidence exhibited as BC8 to Ms Crane's evidence, but the fact that it is so general combined with the lack of basic information about the way the survey was conducted, means that I cannot give it any weight at all.

72. In the absence of any credible evidence that the public would not expect the TOM & JERRY characters to appear except under licence, I do not believe that the "misrepresenting itself as a licensee" point can succeed.

73. Even if I am wrong about this, the opponent's case would not, in my judgement, succeed in respect of the services specified listed in classes 35, 40 and 42 of the application because the respective fields of activity are (as a factual matter - as opposed to a requirement of law) just too far away from the field of merchandising activities. There is nothing to suggest that the public have any possible reason to believe that the opponent licenses its TOM & JERRY characters in respect of these kinds of services.

74. I conclude, not without some hesitation, that the opponent's case under section 5(4)(a) fails, even in respect of classes 16 and 25 of the application.

Section 5(2)(b) and 5(3)

75. The opponent has the following mark registered in classes 16, 25, 28 and 41.



76. The goods for which the opponent's mark is registered in classes 16 & 25 are identical to the goods for which the applicant seeks registration in those classes.

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

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

- (a) -
- (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.

77. 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.

78. It is important to note that the comparison under section 5(2)(b) must be between the opponent's mark, as registered, and the applicant's mark as applied for. The subject matter of the registrations should not be confused with the reputation that the character TOM enjoys with the public as a result of the publication of numerous other drawings and films featuring the character. In short the comparison is mark for mark. It is not appropriate to compare the applicant's mark with the character TOM *per se*.

79. I believe that this observation is decisive of the case under section 5(2). For even though I have found that the applicant's mark is so close to some of the representations of TOM in evidence that it infringes the copyright in the drawings, the applicant's mark is nowhere near as similar to the representation of TOM in the opponent's registered mark. This is partly because of the pose that TOM strikes in the earlier mark, and partly because the details of the

cat character are relatively indistinct in that mark with the result that many of the similarities between the applicant's mark and some of the other drawings of TOM are not apparent.

80. Mr Morcom argued on the basis of De Cordova v Vick Chemical Co, (1951) 68 RPC 103, that the face of TOM was an essential feature of the earlier mark. I prefer to adopt the more recent guidance of the ECJ set out above, which recognises that the consumer forms an overall impression of trade marks based the dominant and distinctive components. I hesitate to say that the face of the cat in the opponent's earlier mark is a 'dominant' component of that mark. Even if it is, the overall differences between the respective marks is sufficient to avoid any likelihood of confusion between these marks.

81. If that is the case where the respective goods are identical, it follows that it is also the case where the respective goods or services are only similar.

82. Further, given that similarity of the respective marks is also a requirement for success under section 5(3) of the Act, the above finding is sufficient to also dispose of this ground of opposition. The applicant's mark is insufficiently similar to the earlier mark for its use in respect of dissimilar goods/services to take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark.

83. I have assumed for the purposes of section 5(3) that the opponent has a reputation under its mark in respect of the services for which it is registered in Class 41, namely:

Production and distribution of television, cable television and film programmes, all for entertainment and educational purposes; all included in Class 41.

84. There is some doubt in mind whether the mark can truly claim to enjoy a reputation in a trade mark sense for these services, which may not cover television entertainment services per se, but only production and distribution of TV and film programmes. However, given my finding above I see no need to finally determine this point.

85. The opponent also claims that the cartoon character TOM is entitled to protection under the Paris Convention as a well-known mark and therefore qualifies as an "earlier trade mark" pursuant to section 6(1)(c) of the Act. This seems to me to be an attempt to either separate the character TOM from JERRY so as to improve the protection available for TOM solus, and/or elevate the character TOM to trade mark status independent of any particular form of expression. For reasons which I believe are obvious, both these attempts to favourably (from the opponent's perspective) re-define the subject matter of the earlier trade mark must be rejected.

86. The grounds of opposition under sections 5(2) and 5(3) therefore fail.

Section 3(6) - No intention to use

87. The opponent's second objection under section 3(6) arises because the opponent claims that the applicant has no bona fide intention to use the mark in respect of the goods listed in classes 16 and 25 of the application.

88. Section 32(3) of the requires that an application must include a claim that the mark is in use by the applicant or with his consent, or that there is a bona fide intention to use the mark in respect of the goods and services stated. The application contain such a statement. The opponent contends that the statement was made in bad faith as far as classes 16 and 25 are concerned.

89. In Demon Ale 2000 RPC 345, Mr Geoffrey Hobbs QC acting as The Appointed Person, upheld the Registrar's refusal to register a mark under section 3(6) on the grounds that a) the applicant admitted that he had no intention of using the mark on the single item within the specification of goods, b) the application form contained a statement under section 32(3) of the Act. Mr Hobbs observed that bad faith does not depend entirely upon an applicant's view of whether what he was doing was in accordance with his own moral code. The test under section 3(6) is not therefore entirely subjective.

90. Mr Morcom put his case like this is his skeleton argument:

“The only evidence of use of the Applicant's SQUARE CAT device is that shown in Exhibit WB2. In the case of goods in Class 16, these items, an example of which is greetings cards, are not sold under the mark applied for, which is only used as a trade mark for the services. The goods in Class 25, such as T-shirts, are clearly intended as promotional items for the services and there is no evidence that the mark applied for has been or will be used as a trade mark for these goods. In all the circumstances the application in Classes 16 and 25 is prohibited by section 3(6) of the Act, on the grounds of bad faith in making the application in those Classes.”

91. The crux of the opponent's case is therefore that the applicant's mark is only used on printed materials and clothing either provided in the course of the services specified in classes 35, 40 and 42 , or intended to promote those services. In this respect Mr Morcom referred me to the Kodiak case 1990 FSR 49, a well known case under the old law where the judge found on the facts that use of a mark on T-shirts was not use in relation to the T-shirts but use on T-shirts for the purpose of promoting a service.

92. There is no rule that “T-shirt” use (emblazening a mark across the front of an item) cannot be trade mark use in relation to the goods; see paragraph 20 of Pumfrey J's judgement in Daimler Chrysler AG v Alavi 2001 All ER (D) 189 (Jan). Each case turns on its own facts and depends largely on how the mark is used in relation to the goods and whether other marks appear on, or in relation to, the product.

93. Mr Brown states:

“2) Since 1990 I have been involved in the photocopying and printing bureau business and, through a number of retail outlets and through an extensive direct client base, I have been providing goods and services in relation to this business over the last eight years. In particular the goods and services provided through my business include photocopying and document reproduction services; data processing and word processing services, printing and design services, binding and laminating services, consultancy and information services on all such matters, together with the supply of

goods bearing the printing or designs developed including paper, printed matter, printed publications, leaflets, brochures, catalogues, cards, stationery calendars, labels, pictures, posters, photographs, office requisites and articles of clothing.

3) During all this time this photocopying and printing bureau business has operated under the name COPYCATS and in January 1996 the SQUARE CAT device mark, the subject of the present application, was adopted for use in connection with all the different goods and services in relation to the COPYCATS photocopying and printing bureau business. There is now produced and shown to me marked "Exhibit WB1" a copy of the COPYCATS 'profile' setting out briefly all the goods and services offered through the business and as described in paragraph 2 above."

94. I take it from this that the scope of the applicant's business is outlined in exhibit WB1, which consists of a profile of the applicant company. From examination of this document, it appears that the applicant's business is primarily in the nature of photocopying and printing bureau. As part of its business it will provide stationery, various printed materials and clothing bearing designs printed to the customer's order. The exhibit provides me with little or no assistance as to how the mark is used in relation to goods of this sort other than (obviously) at the applicant's retail premises.

95. I do not believe that a reasonable person in this field of activity, would regard a mark used in relation to a photocopying and printing service to be a mark used in respect of the paper that bears the copy or print. On the other hand, exhibit WB2 to Mr Brown's declaration includes a copy of the applicant's promotional leaflet for its personalised Christmas cards. Although customers can choose their own designs from a range of styles, this is arguably use of the trade mark in relation to the cards as well as the printing service. At least I would be very reluctant to find that a claim that it was use in relation to the cards was made in bad faith. Then there is clothing. If the applicant supplies the clothing which he then prints to his customer's order, the applicant could claim to be trading in clothing under the mark - unless the T-shirts carried another mark.

96. Without more information I find it impossible to reach a clear finding in respect of the majority of goods within classes 16 and 25. As the burden rests on the opponent, where there is doubt in my mind, I will find for the applicant.

97. On this basis, I find that the applicant had no bona fide intention to use the mark in respect of paper, pictures, posters, photographs (all of which are just goods used in providing a printing and copying service) and (except as otherwise covered by the specification in class 16) printed matter and printed publications. The section 3(6) objection would have succeeded to this extent.

98. This finding will only be relevant if my earlier finding under section 5(4)(b) is found to be wrong.

Costs

99. The opponent having succeeded is entitled to a contribution towards its costs. I therefore

order the applicant to pay the opponent the sum of £1200. This sum to be paid within seven days of the end of the period allowed for appeal.

Dated this 23 Day of May 2001

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