

TRADE MARKS ACT 1994

**IN THE MATTER of Application No 2169931
by Constandinos Georgio Sideras, Andronicos
Constandinos Sideras and Marios Constandinos Sideras
a partnership**

and

**IN THE MATTER OF Opposition thereto under No 50500
by Bernard Matthews plc**

Background

1. On 18 June 1998, Constandinos Georgio Sideras, Andronicos Constandinos Sideras and Marios Constandinos Sideras a partnership applied under the Trade Marks Act 1994 to register a series of two trade marks reproduced below.



2. The application was given the number 2169931. The application was made in respect of the following specification of goods:

Class 29

Meat and meat products; prepared meals and snacks; ham and meat snacks.

3. The application was accepted and allowed to proceed to publication on the basis of honest concurrent use with various registrations including United Kingdom trade mark registration number 2138441 for the mark DINO EGGS. On 8 December 1999 Bernard Matthews plc, the proprietor of this mark, filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition set out two grounds of opposition, these can be summarised as follows:

- (a) under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application is similar to the opponents' earlier trade mark DINO EGGS, United Kingdom registration number 2138441, and that the products covered by the application are identical or similar to those for which the earlier trade mark is protected; and

- (b) under section 5(4)(a) having regard to the opponents' use of the trade mark DINOSAURS since 1993 in relation to poultry and fish products and the established goodwill and reputation in the earlier trade mark DINOSAURS, the application is liable to be prevented by the law of passing off.

4. The applicants filed a counterstatement admitting that the goods covered by the application were identical or similar to the goods for which the opponents' mark is registered but denying the grounds of opposition. Both parties seek an award of costs and both parties filed evidence in the proceedings. The matter came to be heard before me on 12 December 2001. The opponents were represented by Mr Alan Bernard of fJ Cleveland, the applicants were represented by Ms Anne Wong of Carpmaels & Ransford.

Evidence

5. As noted above, both parties filed evidence in the proceedings. The opponents' evidence consists of a witness statement by Mr David Reger dated 11 July 2000. Mr Reger is the Company Secretary at Bernard Matthews Plc. The applicants' evidence consists of three statutory declarations. The first is by Mr Gavin Hyde-Blake and is dated 26 April 2001. Mr Hyde-Blake is Manager of the Intellectual Property Division of Carratu International Group Limited. The second is by Ms Anne Wong and is dated 30 April 2001. Ms Wong is a registered Trade Mark Attorney with Carpmaels & Ransford, the applicants' representatives in this matter. The third, also dated 30 April 2001, is by Ms Rosie Tavener-Jones a trainee Trade Mark Attorney, with Carpmaels & Ransford. Finally, the opponents filed a further witness statement of Mr Reger in reply to the applicants' evidence.

Opponents' evidence

6. Mr Reger states that the opponents first decided to produce a new product under the name DINOSAURS in June 1993. The product comprised shaped pieces of turkey meat covered with crispy breadcrumbs. The pieces were made in the shape of dinosaurs and three different dinosaur shapes were included. He states that this new product was aimed at the children's market and was launched in August 1993 in the United Kingdom. He says that pre-launch publicity first took place in July 1993.

7. At DR1, Mr Reger exhibits a bundle of copies of packaging for the DINOSAURS product. Where known, Mr Reger gives dates for the packaging. These range from 1993 to the present day. Looking at these packages it seems that the overall design has remained fairly constant. The package said to have been used in 1993 shows the word DINOSAURS in 3-D as if chiselled out of rock; it tappers off into the distance. The letter O in DINOSAURS is in the shape of an egg, it is cracked and a baby dinosaur's head is sticking out to the right. Above the baby dinosaur there is, what I would describe as, the BERNARD MATTHEWS banner "house" mark with a picture of a stately home. Below, the packaging shows three smiling cartoon dinosaurs about to tuck into a plate of the DINOSAURS product. The reproduction of the packaging is not good but there is a background scene which might be described as a pre-historic landscape complete with volcano and lush vegetation.

8. As noted above, the general theme of the packaging has remained unchanged. By way of

example, the packaging said to be currently in use still shows the DINOSAURS name chiselled in the 3-D script with the O as an egg and the baby dinosaur's head sticking out. The BERNARD MATTHEWS (stately home) banner mark remains. The three cartoon dinosaurs are now larger and are both above and below the DINOSAURS mark and are featured together with examples of the product on a pre-historic landscape. One package from 1994 shows the baby dinosaur with his head to the left and a speech bubble with the words "THE ORIGINAL" inside.

9. Mr Reger goes on to state that in 1994 his company introduced a new version of the product where the dinosaurs were made from fish. At DR2, he exhibits sales figures for turkey and fish dinosaurs in the United Kingdom from 1994 - 1997. These are as follows:

TURKEY DINOSAURS

1994	£6,818,011
1995	£4,251,237
1996	£4,421,550
1997	£4,901,789

FISH DINOSAURS

1994	£395,061
1995	£406,042
1996	£308,382
1997	£101,382

10. Mr Reger states that although figures for Turkey DINOSAURS in 1993 are not given they were £2,012,433 calculated at ex-factory prices. He states that their products are sold in major retail stores throughout the UK.

11. Mr Reger says that his company also markets other products with brand names containing either the word DINO or DINOSAUR. He says that one such product is called DINO EGGS a product made with turkey meat. He gives figures for the number of FROZEN TURKEY DINO EGGS for the period 1995-2000 as 1,802,748. I note that this does not tell me how many packs were sold before the date of application, 18 June 1998. I also note that in the same period, 19,206,165 packs of Frozen Turkey DINOSAURS were sold.

12. Mr Reger states that his company also sells a product called "Cooked DINOSAUR Roll" and he states that retail sales in the same period were 19,816,428 packs. Food service trade is said to have been 392,562 packs. Mr Reger states that his company's products were also available in Europe during this period.

13. Mr Reger then goes on to refer to the DINOSAURS product having been widely advertised in the United Kingdom. This included advertising on commercial television, in-store magazines, the trade press and trade and customer display material. At DR3 he exhibits a table of their media expenditure in the United Kingdom on television and in-store magazine advertisements. He states that the television advertising campaign was shown in October and

November 1993 and May and November 1994. The in-store advertisements appeared in 1996. At DR4 he exhibits a video of the television advertisement. At DR5 he exhibits copies of the in-store advertisements from Safeway, Co-op and Asda from 1996.

14. Mr Reger states that a major part of his company's business is the supply of products to the catering industry in the United Kingdom. He states that they supply restaurants, public houses, schools and other institutions and that their products are promoted to both the commercial establishments and directly to the public. At DR6 he exhibits a collection of material taken from trade magazines etc showing use of his company's brand name DINOSAURS. Exhibits DR8 -9 relate to advertising material used in other European countries, figures are also given for sales in France, Germany and Hungary. Mr Reger concludes by stating that owing to his company's extensive use of the brand DINOSAURS they have built up a considerable reputation in the name in consumer and trade circles alike.

Applicants' Evidence

15. The declaration of Mr Hyde-Baker states that his company was approached by Carpmals & Ransford and asked to collect evidence on the use in the United Kingdom of the word DINOSAURS, similar marks and prehistoric themes in general in the meat/snack food area. At GHB/A he exhibits the letter in which he is asked to collect such evidence. Mr Hyde-Baker states that he collected such evidence and at GHB/B he exhibits his report dated 12 April 2001. This report is referred to in the evidence of Ms Wong and was also referred to at the hearing. I need not summarise it here.

16. The evidence of Ms Wong refers to the evidence filed during the prosecution of the application before the registry. At ANW1 she exhibits a statutory declaration of Andronicos Constandinos Sideras together with exhibits. The evidence of Mr Sideras sets out the history of the trade mark DINOS and that it was first used in 1966. It gives various examples which are said to show use of the trade mark DINOS. The business originally started as a butchers and use is shown in respect of various delicatessen products including cooked meats and cheese. The only examples of use of a mark close to that the subject of the application appear in ACS/6 which is described in the evidence as a "current sales brochure". This relates to a ham snack. An advertisement for this product also appears in a Greek newspaper dated 1 October 1998, after the date of application. The product in the advertisement is described as "NEW". I will comment further on the applicants' evidence of use in my decision.

17. Ms Wong refers to the report produced for her clients by Carratu International and exhibited to Mr Hyde-Baker's declaration. She refers to various aspects of the report and comments on the use that has been shown of the opponents' marks DINO EGGS and DINOSAURS which she states has been used in a very stylised form. Ms Wong goes on to suggest that the report shows that the use of dinosaurs as a theme is a common one in food marketing and merchandising. She suggests that the report shows that food-related dinosaur imagery is common. Ms Wong submits that DINOSAURS is entirely descriptive of dinosaur shaped food products and that the use shown by the opponents shows use in a descriptive not a trade mark sense.

18. Ms Wong goes on to refer to registrations in the name of the opponents. These are

United Kingdom registration number 2183586A for the mark DINOSAURS (stylised), UK registration number 2183586B for the mark DINOSAURS (stylised) and number 1541605 BERNARD MATTHEWS DINOSAURS. Ms Wong notes that all of these registrations are in the name of the opponents and the goods are in class 29 and are limited to those in the shape of dinosaurs. Ms Wong points out that the registration 1541605 disclaims the word DINOSAUR. Ms Wong refers to the application for 2183586A and 2183586B and exhibits copies at ANW7 of fJ Cleveland's letters to the registry. In the first letter it is stated that the evidence of use filed was adequate to allow the registration of the highly stylised DINOSAURS mark but was not adequate to support it as a word mark alone. The second letter states that as a result of the Hearing Officer's decision, application 2133466 DINOSAURS was to be withdrawn in favour of a new application for the highly stylised DINOSAURS mark. At ANW8 she exhibits copies of letters relating to 2183586A and B which she states indicate that an objection under section 3(1)(b) was raised against these highly stylised marks but that this objection was overcome by showing evidence of use. Ms Wong states that these two registrations were filed after her clients' application yet her clients mark was not cited against either application.

19. Ms Wong then refers to the register and notes that there are several marks on the registrar co-existing with those of the opponents. I need not summarise these. In any event, Ms Wong states her view that the marks DINOSAURS and DINO EGGS are not similar to the mark DINO'S and device.

20. Ms Tavener-Jones, gives evidence concerning the purchase of a product called "JURASSIC PORK" on 20 April 2001. The product is described on the packaging which is exhibited at RTJ1 as "dinosaur shaped pork bites".

Opponents' Evidence in reply

21. Mr Reger provides a further witness statement in reply to the applicants' evidence. He makes various comments and submissions on the evidence filed by the applicants. I need not summarise these.

22. That concludes my review of the evidence.

Decision

23. The grounds of opposition refer to sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

"5.- (1)

(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."

(3).....

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

24. The term 'earlier trade mark' is defined in section 6 of the Act as follows:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

25. I will deal first with the opponents' ground of opposition under section 5(2)(b). In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but

who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

26. Under section 5(2), the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind I proceed to consider the opponents' case under section 5(2)(b).

27. The trade mark on which the opponents seek to rely, registration 2138411 is an earlier trade mark within the definition of section 6 of the Act. For ease of reference I reproduce the applicants' and opponents' trade marks below:

Applicants' trade mark



Opponents' trade mark

DINO EGGS

Class 29

Meat and meat products; prepared meals and snacks; ham and meat snacks.

Class 29

Poultry and poultry products; meat and meat products.

Identical or Similar goods

28. There was no dispute between the parties that the goods for which the applicants seek protection are identical or similar to the goods for which the earlier mark is registered.

Inherent Distinctiveness/Reputation of the Opponents' Earlier Trade Marks

29. The opponents' trade mark is DINO EGGS. There is only limited evidence showing use of this mark prior to the relevant date in these proceedings. The evidence gives figures for the number of packets sold in the period 1995-2000. The figures are not broken down by year and so I cannot establish the extent of use prior to the date of application. The figure given of 1,802,748 packets seems low compared to the figures provided for the opponents' other products. In any event, Mr Bernard did not seek to rely on an enhanced level of recognition amongst the relevant public. However, as the case law above identifies, the inherent distinctiveness of a mark is a factor to be taken into account when assessing the likelihood of confusion. Mr Bernard contended that the opponents' mark is highly distinctive for the goods in question. Ms Wong suggests that dinosaur themes are common in this area and so the opponents' mark has inherently, a low level of distinctive character. The applicants' filed evidence, found in the Carratu International report, purporting to show use of dinosaur themes on food products. Mr Bernard subjected this evidence to close scrutiny and suggested that it was of low probative value. He noted that many of the references were to products in the United States and the evidence did not show that such use of dinosaur themes was common as at the date of application. Finally, he noted that the examples may show some use of dinosaurs and dinosaur themes on cakes and sweets but not on the products in dispute in the instant proceedings.

30. The evidence can indeed be subject to the criticisms levelled at it by Mr Bernard. However, as Ms Wong noted, the opponents' own evidence indicates that dinosaurs are "a proven ever popular children's theme fun yet educational"; see Bernard Matthews Promotional literature at exhibit DR7. It is not in my view surprising that producers seeking to market food for the younger audience, would want to produce food with a dinosaur theme,

be they dinosaur egg sweets or dinosaur shaped cakes or pieces of turkey or fish. The exhibits at DR6 show that films such as Jurassic Park and the Flintstones, continued to maintain interest in this area. As Mr Bernard noted, the mark in question is not dinosaur but DINO EGGS. Whilst the DINO element would in my view possess a higher level of inherent distinctive character than the word DINOSAURS simpliciter it still seems to allude to a dinosaur theme and is not in my view highly distinctive. I will take these considerations into account when reaching my conclusion under section 5(2)(b). My comments concerning the mark DINOSAURS will also be relevant when I turn to consider the opponents' ground under section 5(4)(a).

Comparison of the Trade Marks

31. I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their distinctive and dominant components. The question must be assessed through the eyes of the average consumer for the goods in question. This will be ordinary members of the public. I must take into account the fact that the average consumer rarely has an opportunity to make a direct comparison between the trade marks; so called imperfect recollection.

32. Visually, the opponents' earlier trade mark is DINO EGGS, the applicants' is DINO'S in a stylised form. It was accepted by both parties that the word DINO'S is presented in the form of a dinosaur's skeleton; this was not immediately apparent to me. It is set against a background scene which shows a volcano and some vegetation. Clearly, as the applicants' mark is stylised, there are visual differences between the two marks. However, I must take into account the dominant and distinctive components of both trade marks. The applicants' mark is clearly the word DINO'S albeit written in the form of a skeleton. It seems to me that the vegetation and volcano appear very much as a background scene and as such, the word DINO'S and its stylisation are the dominant elements of the mark and would be remembered by the average consumer. The opponents' mark contains two visual elements DINO and EGGS. Ms Wong suggested that the dominant and distinctive element of the opponents' mark was the word EGGS since the DINO element would be recognised by the consumer as referring to DINOSAURS. I disagree, it seems to me that both elements of the opponents' mark perform the same function. EGGS indicates that the product is in the shape of an EGG, a DINO egg.

33. As such, it seems to me that visually there is some similarity between the opponents' and applicants' mark. The applicants' mark contains an element of the opponents' mark DINO with an apostrophe S showing the possessive form of the word.

34. Aurally the two marks are DINO EGGS and DINO'S. Here there was some debate as to the way in which the mark would be pronounced. Ms Wong suggested that the applicants' mark was pronounced DEE NO'S. She suggested that this would be evident because it is derived from a Greek name and the family have been trading under the name DINOS & Sons and DINOS (stylised) for a number of years. The evidence does show that there has been trade under these names, Mr Bernard did not disagree, and in so far as it is necessary I will discuss the effect of any use by the applicants below. However, it does not in my view follow that the average consumer will pronounce the applicants' mark in this way. Mr Bernard was

of the view that this was a DI NO mark. He suggested that his view was supported by the way in which the word was stylised in the mark to look like a skeleton of a DINOSAUR. Alternatively, Mr Bernard pronounced his mark as DEE NO and said that this was how members of the public might pronounce his mark. There is no evidence as to how either mark in question is promoted to the public in the market place and therefore I must judge this matter for myself.

35. It seems to me that the way in which the applicants' mark is presented tends towards the conclusion that the mark will be seen as a DI NO'S mark. The way in which the word is written in the bones of the skeleton of a dinosaur would lean towards that conclusion and suggest that pronunciation to the average consumer. I do not discount entirely the possibility that some consumer will see this as a DEE NO'S mark. They may even make a connection with the "Flintstones' " dog DINO (pronounced Dee no). Equally, it seems to me that the opponents' mark will usually be pronounced DI NO. Again, the link with EGGS suggests to me, and I believe the average consumer, a dinosaur egg. Again, it is not possible to dismiss completely the possibility that some consumers may pronounce the opponents' mark as DEE NO.

36. To conclude on this point it seems to me that there is a high degree of aural similarity between the marks DI NO EGGS and DI NO'S. The applicants' mark is possessive form of the first element in the opponents' mark.

37. Conceptually, here again there is some similarity. As noted above, it seems to me that both marks are trying to bring to mind a pre-historic theme based on dinosaurs. As such, they are conceptually similar.

Effect of the applicants' use

38. As noted in the introduction, the applicants' trade mark proceeded to publication on the basis of honest concurrent use with two other registrations including that of the opponents. This was under the terms of section 7 of the Act. Where, as here, the owner of the earlier right opposes the application, the provisions of section 7 have no part to play in the opposition proceedings; section 7(2). However, where two marks can be shown to have co-existed in the market place, such parallel use may be one factor in the global appreciation under section 5(2); see *Codas* (SRIS 0/372/00). That said, it is not in my view a factor here. Mr Bernard took me to the evidence of the applicants and noted that it did not show use of the mark the subject of the application prior to the relevant date. I agree. The use shown in the applicants' evidence is of the name DINOS & SONS and the trade mark DINOS written across an upturned sea shell with a statue of a woman which I take to be the goddess Aphrodite. As stated in my summary of the evidence, of the two examples of use shown of a mark similar to that the subject of the application, one is undated but said to be from a "current brochure", the other is an advertisement dated after the relevant date and describes the product as new. Some of the use shown in support of the application was also on cheeses and so outwith the applicants' specification. There is therefore, no evidence of parallel use of the marks.

Conclusions under section 5(2)(b)

39. Together with my finding in relation to the inherent distinctiveness of the opponents' mark, how do my findings in respect of the similarities of the marks and the similarities/identity of the goods come together under section 5(2)(b). As noted above, the ECJ has stated that a lesser degree of similarity between the goods or services can be offset by a greater degree of similarity between the marks (or visa versa). Here the goods are identical or closely similar.

40. Mr Hobbs, Q.C., sitting as the Appointed Person *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows:

Are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the "earlier trade mark", DINO EGGS and the sign subsequently presented for registration, DINO'S (stylised), were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?

41. Having considered the various factors, I reach the view that this question must be answered in the affirmative. In so finding, I have taken account of the relatively low level of distinctiveness of the opponents' mark and the fact that the applicants seek protection for goods which are identical or very similar to those for which the opponents' marks are protected. I have also taken note of the fact that many of the goods for which registration is sought are every day low costs items to which the average consumer will not pay great attention when purchasing. They are the sort of everyday grocery product that the busy shopper will place in their shopping trolley without paying too much attention to the purchase.

42. It was accepted by the opponents that selection of the products covered by the two specification will be primarily by the eye. I agree, they are self-service items. Taking all these factors into account, it seems to me that the visual similarities between the applicants' mark and the first element of the opponents' mark are sufficient to find a likelihood of confusion. The second element in the opponents' mark EGGS is not particularly distinctive and would not in my view serve to allow the average consumer to differentiate between the goods. Equally, although the applicants' mark is stylised it too appears to be based on a common theme and would in my view be seen as a DINO'S mark. Mr Bernard invited me to consider use of DINO EGGS on a stylised pre-historic background. I think that may be going too far but the evidence does show that such themes are common and therefore in my view the stylisation in the applicants' mark would not be particularly distinctive.

43. Even if the word EGG did serve to avoid the possibility of direct confusion, taking account of notional and fair use of the mark DINO EGGS, it seems to me that the average consumer on seeing the mark DINO'S used on identical or closely similar goods, would wrongly believe that the goods came from the opponents or some economically linked undertaking. As such, I find that there is a likelihood of confusion within the meaning of section 5(2)(b) and the opposition to the application on this ground succeeds.

Section 5(4)(a)

44. The opponents also seek to rely on the ground of objection under section 5(4)(a) of the Trade Marks Act 1994. Having found for them under section 5(2)(b) there is probably no need to go on and consider this ground. However, for the sake of completeness I will express my view. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

45. Under section 5(4)(a), Mr Bernard sought to rely on his clients' use of their trade mark DINOSAURS. At the hearing I questioned him as to whether he could be in a better position vis a vis the applicants in considering the mark DINOSAURS when under section 5(2)(b) he was relying on the mark DINO EGGS. It seemed to me that on a visual, aural and conceptual basis, there was a greater degree of similarity between DINO EGGS and DINO'S than between that mark and DINOSAURS. In any event, Mr Bernard gave me full submissions on this point.

46. In my view the opponents' use does indeed show a high level of turnover and advertising etc in respect of a product sold under the name DINOSAURS. Such use is in respect of the general public and also the restaurant and food trade. The evidence shows that this name has been used on fish and turkey pieces in the shape of dinosaurs. However, it seems to me that in respect of such goods the word DINOSAURS must, by its very nature, be to some extent descriptive of the goods to which it is applied when such goods are in the shape of dinosaurs. The use that has been shown of the mark shows the word DINOSAURS. As I have described above, it is in a stylised script (chiselled out of rock) it is in three dimensions and tapers off into the distance. The O of DINOSAURS is in the shape of an egg. The egg is cracked and the head of a baby dinosaur has broken through the egg. The opponents' 'house' mark BERNARD MATTHEWS and device is also present and presented above the DINOSAURS mark.

47. Taking all this together, it seems to me reasonable to find that the opponents may well have a goodwill and reputation in their DINOSAURS brand but it seems to me that from the evidence, such goodwill rests in the form of the mark used on the packaging and not in the word DINOSAURS simpliciter. Even so, Mr Bernard also argued that the applicants' mark

contained several elements common to the way in which the opponents' mark DINOSAUR is used. Both have a background of a pre-historic landscape and contain a volcano and pre-historic vegetation.

48. In considering misrepresentation under this section I must therefore consider whether use of the applicants' mark DINO'S in the form in which registration is sought would result in a likelihood of misrepresentation when compared to the opponents' mark DINOSAURS and DINOSAURS (stylised). In my view it would not. As to the first mark DINOSAURS (simpliciter) even if I am wrong and the opponents do have a goodwill and reputation in that mark then in my view the visual, aural and conceptual differences between that mark and the mark DINO'S are sufficient to ensure that misrepresentation is not likely. As for their stylised mark DINOSAURS, it seems to me that whilst it can be argued that both seek to use themes from pre-history, volcanos and large palm trees, the degree of stylisation on both marks taken together with the fact that the applicants' mark is DINO'S are sufficient to avoid misrepresentation. I would therefore, dismiss the opponents' ground of opposition under section 5(4)(a).

Conclusions

49. I have found that the opponents' grounds of objection under section 5(2)(b) succeeds but that the objection under section 5(4)(a) should be dismissed. The opposition is successful and application is therefore refused.

Costs

50. The opponents have been successful and are entitled to a contribution towards their costs. **I order that the applicants pay the opponents the sum of £1000-00 as a contribution towards their costs.** This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19 day of March 2002

**S P Rowan
For the Registrar
the Comptroller General**