

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2224081
BY HIT ENTERTAINMENT PLC
TO REGISTER THE TRADE MARK:**



IN CLASSES 9, 16, 25, 28, 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 52003
BY STEVENS HEWLETT & PERKINS
BASED UPON THE EARLIER TRADE MARK:**



TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2224081
by Hit Entertainment Plc
to register a trade mark:
in classes 9, 16, 25, 28 and 41
and
IN THE MATTER OF Opposition thereto under No 52003
by Stevens Hewlett & Perkins

Background

1) On 1 March 2000 Hit Entertainment Plc applied to register the trade mark:



for goods and services in classes 9, 16, 25, 28 and 41. The application was published on 18 October 2000.

2) On 12 January 2001 Stevens, Hewlett and Perkins filed notice of opposition to this application.

3) The opponent states that the trade mark in suit is similar to Community trade mark registration no 929406:



which is registered in respect of goods and services in classes 9, 16, 25, 28 and 41. This trade mark was applied for on 7 June 1999 and registered on 17 December 1999. It is registered in the name of The Fairies Development Pty Ltd. The opponent states that all the goods of the

application in suit and the above registration are similar or identical with the exception of *sunglasses and spectacle frames* (of the application in suit). Consequently there exists a likelihood of confusion and registration of the trade mark in suit would be contrary to section 5(2)(b) of the Act.

4) The applicant filed a counterstatement. He states that the respective trade marks are not similar. He states that many trade marks which contain the word FAIRY coexist. He states that the earlier registration was considered by the Registry but was not considered to be a bar to registration.

5) The applicant states that the opponent is a firm of patent and trade mark agents with no direct interest in the proceedings. The applicant denies that all the goods of the respective trade marks are similar as computer software and computer software concerned with children's education and/or entertainment of the application in suit is neither identical nor similar to the goods encompassed by class 9 of the earlier registration.

6) Both parties filed evidence and both parties seek an award of costs

7) The parties were advised that it was considered that a decision in relation to this case could be made from the papers filed. It was not considered necessary for a hearing to take place. The parties were allowed a period of time in which they could request a hearing or file written submissions, if they so wished. Neither party requested a hearing, nor did they file written submissions. Consequently a decision will be taken from a careful study of the papers. Acting on behalf of the registrar I duly give the following decision.

Opponent's evidence

8) The opponent's evidence consists of a statutory declaration by Peter William Cornford. Mr Cornford is a registered trade mark attorney who works for Stevens Hewlett & Perkins.

9) Mr Cornford refers to the statute and case law in respect of the issue of likelihood of confusion. The relevant law will be found in the body of my decision and so I will say no more about it here.

10) Mr Cornford states that the earlier registration conveys "an overwhelming conceptual identity of fairies and of paraphernalia associated with them". He states that the trade mark in suit consists predominantly of the word FAERIES, a variant spelling of FAIRIES. He exhibits at PWC1 two dictionary references to demonstrate the faerie is an archaic or alternative spelling of fairy. Mr Cornford states that the trade mark in suit also includes a device of a fairy.

11) Mr Cornford states that neither trade mark "makes an extraordinary visual impact beyond the subject matter of fairies". He considers that this highlights the visual similarity between the trade marks. He expects the spelling FAERIES to be instantly recognisable as an alternative to FAIRIES and even recollected imperfectly as such. Mr Cornford submits that a good proportion of the consumers of the goods of the application in suit will be children who are less likely to differentiate visually between FAIRIES and FAERIES.

12) Mr Cornford states that the words FAIRIES and FAERIES sound identical.

13) Mr Cornford goes on to give a list of those goods and services which he considers identical and those he considers similar. He states that there is no similarity between *sunglasses* and *spectacle frames* and the goods and services of the earlier registration save for such goods being toys and playthings. He refers to the test for similarity of goods given by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281.

14) Mr Cornford believes that the Registry was correct in its initial judgement to raise registration no 929406 as a citation. He notes that there is no need for an opponent to have a direct interest in the proceedings.

Applicant's evidence

15) The applicant's evidence consists of a witness statement by Roberto Calamita. Mr Calamita is a registered trade mark attorney and chartered patent attorney.

16) Mr Calamita states that the United Kingdom and Community Trade Mark registers contain numerous registrations and accepted applications in the classes relevant to the trade mark in suit for trade marks incorporating the words FAIRIES, FAIRY, FAERIE or FAERIES and that these are in the names of different proprietors. Mr Calamita exhibits at RC1 printouts in relation to such registrations and applications – they will be found at paragraph 35 of this decision.

17) Mr Calamita goes on to comment on the waiving of the original objections against the trade mark in suit at the ex parte stage and the observations filed by the opponent.

Decision

Preliminary issues

18) The applicant commented upon the opponent not having a direct interest in the opposition. Section 38 (2) of the Act states:

“Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.”

Any person may oppose. There is no requirement for an opponent to have a direct interest in the case. The opponent's lack of a direct interest in no way affects the case and its merits.

19) The parties have referred to actions at the ex parte stage. I must consider the matter afresh based upon the facts before me. What happened at the ex parte stage has no bearing upon my deliberations.

Grounds of opposition

20) The ground of opposition pursued by the opponent is under sections 5(2)(b) of the Trade Marks Act 1994. The relevant provisions read as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

21) The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

“(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.”

Section 5(2)(b) objection – likelihood of confusion

22) 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] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] FSR 77 and *Marca Mode CV v. Adidas AG* [2000] ETMR 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 224.

Comparison of goods and services

23) The goods and services of the respective trade marks are as follows:

Goods and services of earlier registration	Goods and services of application
<p>class 9 compact discs, video and audio tapes, video discs, sound recordings, device for the reproduction of sound and/or visual images</p>	<p>class 9 cameras; animated cartoons; films; pre-recorded media; video cassettes; CD Roms; video tapes; compact discs; audio cassette tapes; video game cartridges; computer discs; computer software; computer software concerned with children's education and/or entertainment; sunglasses; spectacle frames; electronic publications</p>
<p>class 16 books, cards, greeting cards, magazines, newsletters, posters, printed matter, playing cards, paper goods in this class, stationery, artists' supplies in this class</p>	<p>class 16 printed publications; printed matter; stationery; teaching materials; books; book markers; calendars; cards; playing cards; greeting cards; glue; ink; document files; boxes for stationery and papers; folders for stationery and papers; albums; binders; writing pads and paper; drawing books, pads, pens and sets; note books and pads; magazines; newsletters; modelling clay; pens, paint boxes, paintbrushes, pastels, crayons, pencils; cases, holders and stands for pens, pencils, pastels and crayons; pencil sharpeners; erasers; rulers; printed pictures and posters; post cards; scrap books; stencils; stickers and transfers; tablecloths, mats, napkins, plates, bowls and cups of paper; wrapping paper</p>
<p>class 25 clothing, footwear, headwear</p>	<p>class 25 clothing, footwear, headgear</p>
<p>class 28 toys, games and playthings, jigsaws, stuffed toys, sporting goods</p>	<p>class 28 toys; games; playthings; sporting articles; dolls; toy vehicles; model vehicles; toy building blocks; building games; mobiles; masks; plush toys; puppets; soap bubbles; kites; puppets; balloons; articles for use with games; novelties for parties; soft toys; clothes for dolls or soft toys</p>
<p>class 41 production of films and television programs, production of video and audio tapes and compact discs, production and presentation of stage and theatrical events, publication of books; entertainment services; educational</p>	<p>class 41 film production; production of radio and television programmes; publication services; TV entertainment services; film production; entertainment and education services; organisation of competitions; provision of</p>

services	education and/or entertainment relating to entertainment and/or education information; amusement services; club services; provision of information on-line; electronic games provided via the Internet; provision of on-line electronic publications; electronic publication services
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24) In the counterstatement the applicant only denies that *computer software and computer software concerned with children's education and/or entertainment* are similar to the goods encompassed by class 9 of the specification of the earlier registration. The opponent does not claim that *sunglasses and spectacle frames* are similar to the goods of the earlier registration in his statement of case. I will, therefore, only consider whether *computer software and computer software concerned with children's education and/or entertainment* are similar to the goods or services of the earlier registration.

25) Mr Cornford referred to the test formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 282 in relation to the comparison of goods and services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

26) Since that decision the European Court of Justice have ruled on this issue in *Canon* where it held that in the assessment of the similarity of goods and/or services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. There is no great discrepancy between the two sets of tests, however, the United Kingdom judgement does not cover the issue of goods and/or services being complementary.

27) In his declaration Mr Cornford claims that *computer software* is similar to *computer discs and video and audio tapes*. I presume that Mr Cornford chose these goods as representing in his view the closest match. In considering the rest of the specification of the earlier registration I cannot see that he would fare better with other goods or services. I will consider the issue of similarity of the goods in question on the basis of this claim of the opponent.

28) The specification of the earlier registration does not include the term *computer discs*. I presume by this term Mr Cornford means *compact discs*, which are in the specification. There is no limitation to this term. Therefore, it will include CD Roms. CD Roms are a standard medium for carrying computer software. The *compact discs* of the earlier registration will, therefore, encompass CD Roms that bear software. Consequently, I must

find that *computer software and computer software concerned with children's education and/or entertainment* if encoded on a CD Rom are identical to *compact discs* in the earlier registration. If the software is carried by another medium it will be similar to *compact discs*, such goods being potentially encoded with software, in all respects except the medium. In such a circumstance the respective goods would be similar to a high degree.

29) I have found the only goods which the applicant has contested are not similar or identical to be either identical or similar. The similarity or identity of the other goods in question has not been contested. In relation to these goods I consider that where they are not identical they are similar to a high degree.

Comparison of trade marks

30) The trade marks to be compared are as follows:

Earlier registration:



Application in suit:



31) In oral use the words FAIRIES and FAERIES will be pronounced identically. The definite article is unlikely to have any impact. Aurally I consider the two trade marks similar, and to a high degree.

32) Both trade marks relate to fairies. I consider that they have an identical conceptual association.

33) Visually there are differences between the respective trade marks. However, owing to the prominence of the word elements I consider that the main visual recognition will be the word FAIRIES or FAERIES. I do not consider that anything turns greatly upon the different spelling of the trade mark in suit. I consider that the respective trade marks are visually similar.

Conclusion

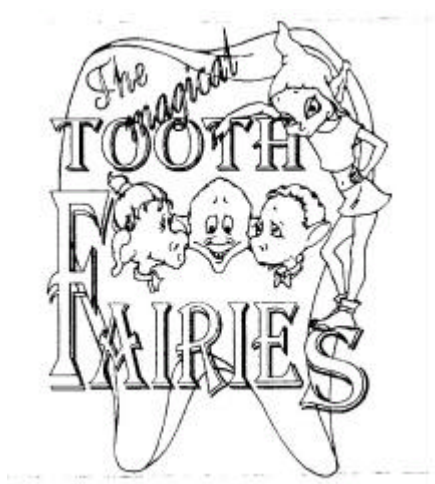
34) The applicant has to a great extent based his rebuttal of the opposition on state of the register evidence. State of the register evidence tells nothing about what is happening in the market place (*Treat* [1996] RPC 281 and *Madame Trade Mark* [1966] RPC 541). The applicant has put in no evidence to show that there are various FAIRY trade marks in use in the market place. Without such evidence I cannot tell if the public will be well used to distinguishing between trade marks containing this common element.

35) The applicant's claim in relation to state of the register evidence relies upon the following trade marks:



FLOWER FAIRIES

FIELD FAIRIES



FAIRIES LAND

RAINBOW FAIRIES

THE TOOTH FAIRY/THE TOOTH FARIES

FAIRY PRINCES

toothairy



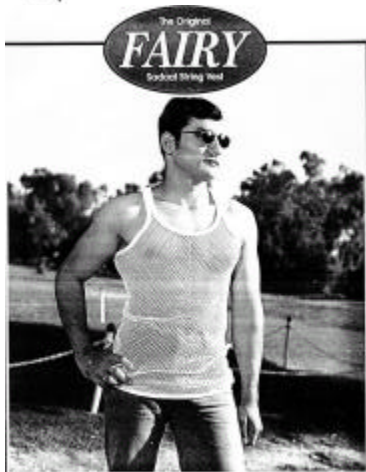
FAIRY MAGIC

FAIRY TALE PONY FARM

BUBBLY FAIRY

FAIRY FIND ME'S

FAIRY PRETTIES





The
Secret Fairy

WORLD OF FAIRY TALES

FLOWER FAIRIES

FAERIE FOLK



The above registrations and accepted applications all have other matter which distinguishes them from the trade marks in this case. So even if the state of the register evidence was relevant it would not assist the applicant.

36) The respective trade marks are similar to a high degree. They encompass identical or highly similar goods. In relation to goods that relate to fairies the earlier trade mark cannot be considered to enjoy a great deal of distinctiveness. However, the specifications of neither trade mark are limited to such goods and in relation to “non-fairy” goods the earlier registration enjoys a good deal of inherent distinctiveness. Consumers rarely have the chance to compare trade marks directly. They are also prone to the vagaries of imperfect recollection. In this case in normal and fair use I find it difficult to see how confusion would not take place. **I find that there is a likelihood of confusion in respect of all the goods and services of the application in suit which have been the subject of this opposition. The application may proceed for sunglasses and spectacle frames.**

37) Consequent upon the above decision the applicant should file within one month of the expiry of the appeal period from the decision a form TM21 to restrict the specification to *sunglasses* and *spectacle frames*. If no form TM21 is filed within the period set the application will be refused in its entirety.

38) The opponent is entitled to a contribution towards his costs and I therefore order the applicant to pay him the sum of £1000 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 04 day of July 2002

**David Landau
For the Registrar
the Comptroller-General**