

O-270-03

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2276433
BY ADAMS CHILDRENSWEAR LIMITED
TO REGISTER A TRADE MARK
IN CLASS 25
AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 80473
BY MATTEL INC.

BACKGROUND

1) On 27 July 2001, Adams Childrenswear Limited of Attleborough House, Townsend Drive, Nuneaton, Warwickshire CV11 6RU applied under the Trade Marks Act 1994 for registration of the following mark:



2) The application was in respect of the following goods in Class 25: “Clothing, footwear and headgear.”

3) On the 18 December 2001 Mattel Inc. of 333 Continental Boulevard, El Segundo, California 90245-5012, USA filed notice of opposition to the application. The grounds of opposition are, in summary:

a) The opponent is the proprietor of Community Trade Mark (CTM) No169722 LITTLE PEOPLE registered for, inter alia, “clothing; footwear; headgear.” in Class 25. As the mark in suit is identical/similar to the opponent’s mark the application offends against Sections 5(1), 5(2)(b) and 3(4) of the Trade Mark Act 1994.

4) The applicant subsequently filed a counterstatement accepting that the opponent is the proprietor of CTM 169722 but denying the opponent’s other claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs and the matter came to be heard on 18 June 2003 when the opponent was represented by Mr Cuddigan of Counsel; instructed by Messrs RGC Jenkins & Co. The applicant was represented by Mr McBray of Hallmark IP Limited.

OPPONENT’S EVIDENCE

6) The opponent filed a witness statement, dated 16 August 2002, by Timothy George Pendered the opponent’s Trade Mark Attorney. At exhibit TGP1 he provides a print out from the on-line register of the Community Trade Marks Office showing that the opponent is the registered proprietor of CTM 169722 and giving details of its specification.

APPLICANT'S EVIDENCE

7) The applicant filed a statement, dated 15 November 2002, by Alan McBray the applicant's Trade Mark Attorney. He states that the mark in suit contains a "very distinctive word ICKLE which is not found in any dictionary and is an invented word. The presence of this word within the four word phrase renders the whole mark extremely distinctive and diminishes very considerably the likelihood of any confusion".

8) Mr McBray states that the opponent's mark LITTLE PEOPLE "when used in relation to children's clothing does not have the appearance of a very strong mark. It is well established that the likelihood of confusion on comparing trade marks diminishes proportionately according to the strength of the mark."

OPPONENT'S EVIDENCE IN REPLY

9) The opponent filed a second statement by Mr Pendered, dated 21 January 2003. He disputes the applicant's claim that the word "ICKLE" is an invented word not found in any dictionary. At exhibit TGP2 he provides a copy of an extract from "A dictionary of slang and unconventional English" published by Routledge. This provides the following definition:

"Ickle. Little: child's attempt at pron., occ. 'Borrowed' by adult females, e.g., 'ickle me': in the nursery, prob. For centuries; as coll., since (?) ca.1930. (Norah March in *London Evening Standard*, 28 May 1934)."

10) Also at exhibit TGP2 Mr Pendered provides copies from an internet dictionary which states that "Ickle: Adj; small, little. A mock juvenile shortening of the word 'lickle'". In the same exhibit he also provides print outs from a search using the AltaVista search engine which produced 1859 instance of use of the term "Ickle" on internet web sites. Mr Pendered states that most of the instances show use of the term "Ickle" in its slang sense meaning "Little".

11) That concludes my review of the evidence.

DECISION

12) At the hearing the opponent withdrew the grounds of opposition under Sections 3(4) and 5(1). The only ground remaining is that under Section 5(2)(b) of the Act which states:

"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."

13) An earlier right is defined in Section 6, the relevant parts of which state:

“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,”

14) The opponent is the proprietor of CTM 169722 which was registered with effect from 1 April 1996, and as such is an “earlier mark”.

15) In determining the question under this section, 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 224;
- (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.

16) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

17) At the hearing the applicant accepted that the specification of the mark in suit was encompassed within that of the opponent's mark, and that the goods must be regarded as identical.

18) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors. For ease of reference I reproduce the marks below:

Applicant's Mark	Opponent's Mark
	LITTLE PEOPLE

19) Visually the marks share the words "Little people". However, the applicant's mark begins with the word "ickle" in white on a black rectangular background, and also has the word "for". The device of a black rectangle is not particularly unusual, but it does bring further to prominence the word "ickle". The same situation arises when considering the marks

phonetically. The marks share two words but the applicant's mark has two additional words at its beginning. It is accepted that the beginning of marks assume more importance than endings. To my mind the visual and phonetic similarities are outweighed by the differences.

20) Conceptually there is some similarity. The words "Little people" would be seen by the average consumer as a clear reference to children. Similarly the term "ickle" is, as the evidence shows, a slang term for "little" particularly when referring to babies or goods for babies.

21) Ordinarily I would also consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date, nor is it an inherently strong mark.

22) The opponent contended that the fact that "ickle" is an acknowledged synonym for "little" would lead the average consumer to believe that there is an economic link between the goods of the two parties. It was contended that, in the field of clothing, that successful brands spawn offshoots under sub-brands. I was also referred to *Decon v Fred Baker* [2001] RPC 17. Mr Cuddigan observed that in this case Pumfrey J decided that a mark which appeared within another mark was identical and that the addition did not take it outside the scope of identity. Whilst accepting that this view of identity had been overtaken by *Diffusion v Sadas* he maintained that although the marks in the instant case could no longer be considered identical they would be similar.

23) I do not accept this contention. In the *Decon* case the signs used by the defendants were comprised of the prefix "Decon" accompanied by a part more descriptive of the particular product. They were all "Decon plus suffix" marks where the suffixes could not distinguish the defendants goods from those of the claimant because of their principal function was to refer to the nature and quality of the goods themselves. In my view, the *Decon* case is not on all fours with the instant case.

24) Even allowing for the dictum of imperfect recollection, I come to the conclusion that, when all factors are considered, that there was no likelihood of confusion at 27 July 2001. Consequently, the opposition under Section 5(2)(b) fails.

25) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £2000. This sum 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 29th day of August 2003

George W Salthouse
For the Registrar
The Comptroller General