

O-222-09

TRADE MARKS ACT 1994

**SUPPLEMENTARY DECISION IN THE MATTER OF
APPLICATION No. 2261559 BY KIDZ WORLD LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS
CONSISTING OF THE WORDS SMILEE FACES AND SMILEE FACE
IN CLASSES 21, 25, 41 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 90354
BY MR FRANKLIN LOUFRANI**

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by Kidz World Limited to register a series of two Trade Marks
consisting of the words SMILEE FACES and SMILEE FACE
in Classes 21, 25, 41 and 42**

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**IN THE MATTER OF OPPOSITION thereto under No. 90354
by Mr Franklin Loufrani**

Background

1. On 17 February 2001, Kidz World Limited applied to register SMILEE FACES and SMILEE FACE as a series of two marks. The application, which is numbered 2261559, specifies the following goods and services:

- Class: 21** Ceramic articles; mugs, plates; ornaments.
- Class: 25** Articles of clothing; footwear; headgear.
- Class: 41** Entertainment services; provision of children's play areas.
- Class: 42** Restaurant services; preparation of foodstuffs or meals for consumption off the premises; childminding services.

2. On 16 August 2001, Mr Franklin Loufrani filed notice of opposition to this application. He is the proprietor of UK trade mark number 2269521 for the trade mark SMILEY and CTM No. 731711, full details of which appear in the Annex to the provisional decision issued on 2 July 2003. The opponent's objected under Section 5(2)(b) on the basis that the application in suit is for a similar mark and identical or similar goods such that there exists a likelihood of confusion on the part of the public. The applicants filed a counterstatement denying the ground of opposition.

3. Neither side filed any evidence and the Registrar's Hearing Officer went on to determine the matter on the basis of the information available in the Statement of Grounds and Counterstatement and the law and legal authorities referred to in his decision.

4. The Hearing Officer concluded that taking into account of all of the relevant factors, in particular, that identical and similar goods and services are involved and that the conceptual similarities between the marks create a single idea, he concluded that there is a likelihood of confusion and the opponent succeeded under Section 5(2)(b).

5. In paragraph 23 of his decision the Hearing Officer noted that although the opposition had been successful, under the provisions of Section 6(2) the final outcome was dependent upon the fate of the UK and CTM applications relied upon by the opponent. The decision was therefore to be regarded as provisional with the requirement that the opponent inform the Registry once the applications in question had been determined. Thereafter, a supplementary, final decision would be issued with the period for appeal beginning from the date of that final decision.

6. The earlier marks have now both been registered and in accordance with the Hearing Officer's decision I will issue a supplementary decision to finalise these proceedings.

7. After taking into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, the Hearing Officer went on to conduct an assessment of the similarity of the respective marks taking into account any visual, aural and conceptual similarities, particularly in respect of any distinctive or dominant elements, judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23. In this case the average consumer was taken to be the public at large, who is deemed to be reasonably well informed, circumspect and observant, and on the basis that they will rarely have the chance to make direct comparisons between marks, and as such, imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik v Klijsen Handel*, paragraph 27.

8. Reaching the conclusion that the mark SMILEY, had a moderate degree of distinctive character, the Hearing Officer determined that the respective marks were visually similar, aurally the same in respect of SMILEY/SMILEE, and possessed a strong conceptual similarity converging on a single idea. Although the Hearing Officer did not go on to actually say so, it is clear that he determined the marks SMILEY and SMILEE FACES/SMILEE FACE to be similar.

9. In respect of the goods and services the Hearing Officer did not "undertake a full-scale comparison of each and every item against the applied for specification" deeming it suffice "to indicate a few specific examples of overlap and/or broad areas of identity or similarity." The Hearing Officer was guided in this process, as will I, by the ECJ's observations in the *Canon* case to the effect that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary."

10. Given the Hearing Officer's statement that he was only giving "examples" of overlap and/or "broad areas" of identity or similarity, I feel at liberty to add a comment of my own, which in any event do not change the Hearing Officer's findings.

11. The Hearing Officer concluded that the term 'ceramic articles' in the Class 21 specification of the application includes any article made from fired clay, and that "numerous items in the Class 21 specification of the earlier mark No. 731711 could also be ceramic." He also noted this earlier mark covered earthenware and pottery, stating that the "mugs", "plates" and "ornaments" covered by the application have "very close parallels in table plates, beer glasses, goblets and works of art of porcelain, terra cotta or glass" covered by the earlier mark. There are, in my view, other terms listed in the earlier CTM that should be taken as being the same or similar, for example, "coffee services" can contain mugs, "crystal (glassware)" can include glasses for beer and also ornaments. This position remains with the registered specification of the earlier mark. Accordingly, all of the goods covered by Class 21 of the application are notionally the same or similar to the goods covered by the registered earlier mark.

12. In respect of Class 25 of the application the Hearing Officer determined the "Articles of clothing, footwear and headgear" are identical to the goods "Clothing, footwear and the specific

types of headgear (caps, hats etc)” listed in the opponent’s earlier mark No. 2269521. The specification of the earlier mark did not change on registration, so all of the goods covered by Class 25 are the same to those covered by the opponent’s earlier mark.

13. Class 41 of the application covers “Entertainment services’ which the Hearing Officer noted is expressly mentioned in both of the earlier marks relied upon by the opponents. The situation did not change on registration so self-evidently the clash here is in respect of identical services. The Hearing Officer mentioned that whilst the specific service of ‘provision of children’s play areas’ in the application did not have any direct equivalent in the opponent’s specifications, this is likely to be contained within the general terms “entertainment” and “amusement parks”, or at least to share a lower degree of similarity with such services. The services of “entertainment” and “amusement parks” at large remain within the registered specification of the earlier marks so the position of all of the services of Class 41 of the application being identical and/or similar services to those covered by the earlier marks remains.

14. The final specification of the application is for services in Class 42, including “restaurant services” and the “preparation of foodstuffs and or meals for consumption off the premises’. The Hearing Officer deemed these to be “identical or very closely similar to the café-restaurants, cafeterias, self service restaurants, snackbars and catering services” listed in the opponent’s earlier mark No.731711, and providing of food and drink in No. 2269521. The services within the earlier marks found to be in conflict with the application remain within the registered specifications of the earlier marks so the finding holds good.

15. This leaves ‘childminding services’ in Class 42 of the application. The Hearing Officer considered these to share “some similarities with day-nurseries” and although concluding that “some distinction can be drawn between the two”. I take the view that “child care services” listed within the specification of the opponent’s earlier mark No. 731711 are an even closer, if not identical service to “childminding”.

16. The result is that the Hearing Officer’s findings based on the unregistered earlier marks have not changed on registration of those marks, and consequently, the opposition succeeds in respect of all goods and all services of the application.

Costs

17. The Hearing Officer did not make an order on costs, stating that he was leaving this to be dealt with in the light of the eventual outcome of the case. The opposition having been wholly successful, the opponent is entitled to a contribution towards his costs. I therefore order that the applicants pay the opponent the sum of £1,400. This sum to be paid within seven days of the end of the appeal period, or within seven days of the final determination of this case in the event of an appeal being unsuccessful.

Dated this 29th day of July 2009

**Mike Foley
For the Registrar
the Comptroller-General**