

O-068-17

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTERS OF TRADE MARK APPLICATIONS 2596855, 2596084,
2597073, 2597070, 2597069, 2597072 & 2597074**

**BY CLEVERCAT PRODUCTIONS LIMITED TO REGISTER THE FOLLOWING
TRADE MARKS IN CLASSES 9, 16, 24, 25, 28 & 41:**

The Babas & the babas (a series of 2)

Baba & baba (a series of 2)

Baba Mousie



Baba Bear



Baba Monkey



Baba Bun



Baba Tig



AND

**OPPOSITIONS THERETO (NOs. 102925, 102926, 102954, 102955, 102956,
103017 & 103018) BY HOHO ENTERTAINMENT LTD**

Background

1. This dispute concerns seven oppositions filed by Hoho Entertainment Ltd (Hoho) against the registration by CleverCat Productions Limited (CleverCat) of the following marks:

i) 2596855 for the marks “The Babas” and “the babas” (a series of 2) which were filed on 6 October 2011 and published on 28 October 2011;

ii) 2596084 for the marks “Baba” and “baba” (a series of 2) which were filed on 28 September 2011 and published on 28 October 2011;

Baba Mousie



iii) 2597073 for the mark which was filed on 9 October 2011 and published on 4 November 2011;

Baba Bear



iv) 2597070 for the mark with the same dates as mark iii);

Baba Monkey




v) 2597069 for the mark with the same dates as mark iii);

Baba Bun



vi) 2597072 for the mark with the same filing date as mark iii) but with a publication date of 16 December 2011;



- vii) 2597074 for the mark  with the same filing date as mark iii) but with a publication date of 9 December 2011.

2. The applied for specifications are the same for all of the marks for which registration is sought and covers a range of goods and services in classes 9, 16, 24, 25, 28 and 41¹.

3. The grounds of opposition are the same in each case, all being based on Section 5(2)(b) of the Trade Marks Act (the Act). The oppositions are directed against of all the goods and services in the applications. In each case, Hoho relies upon its European Union Trade Mark (EUTM) registration no. 10186559 for the mark BABA PINK which was filed on 9 August 2011 and registered on 9 January 2016 in respect of goods and services in classes 9, 16, 25, 28 and 41². Hoho argues that the respective goods and services are identical or similar and that the marks are similar. The oppositions were all defended by CleverCat.

4. The proceedings were consolidated. Only CleverCat filed evidence; it also filed written submissions. This will be summarised to the extent that it is considered appropriate. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

The evidence

5. CleverCat's evidence³ is given by its Managing Director and founding owner, Ms Caroline Roberts and it is accompanied by an exhibit (CR1). This is summarised to the extent that it provides a background to this dispute and an insight into the nature of the market for what seems to be the core services of interest to CleverCat.

¹ The specifications are reproduced below in the Annex to this decision.

² The specifications are reproduced below in the Annex to this decision.

³ Although the document is headed "observations" it contains a statement of truth.

6. Ms Roberts explains that CleverCat is a production company specialising in animation, writing, illustration and publishing for children. After being made redundant from her role as a children's book publisher, Ms Roberts decided to invest in a pre-school animation project called "The Baba House". The cast consisted of five toddler characters: "Baba Tig", "Baba Bun", "Baba Monkey", "Baba Mousie" and "Baba Bear", collectively "The Babas". Ms Roberts commissioned and produced a 4.5 minute animated promotional film including script, storyboard, music and associated merchandising before pitching the show to commercial third parties. In April 2006 Ms Roberts applied for the mark "The Baba House", which was registered in November 2006. Ms Roberts also refers to her attendance at a number of events for the purpose of marketing her project, namely a Cartoon Forum in Germany (2008) and a trade fair in Cannes (2007) where, she states, she pitched the show to Oliver Ellis of Hoho (then at Target Entertainment). In 2009 CleverCat signed a co-production agreement with Amberwood Entertainment in Canada who subsequently secured a development deal with the broadcaster TVO. As TVO had requested some modifications to adapt the project to the requirements of UK broadcasters, it was decided to wait until the development work was completed and the budget in place, before re-approaching the UK market. In 2011 CleverCat became aware that "a similar rival show "Cloudbabies" with Baba characters had been developed by Oliver Ellis" of Hoho and was in production with the BBC.

Preliminary issue

7. In relation to the similarity of the respective goods and services, CleverCat states in each counterstatement:

"It is acknowledged that some of the goods covered by classes 9, 16, 25, 28 and 41 of the Application may be identical or similar only to the goods covered by classes 9, 16, 25, 28 and 41 of the CTM Application. [...] It is denied that the goods covered by class 24 of the Application are similar to the goods and services in class 25 covered by the CTM Application".

8. By way of background, at the time when the present oppositions were filed, Hoho's application for the EUTM (which is the mark relied upon in these

proceedings) was subject to an opposition at the EUIPO (B1939845) brought by CleverCat on the basis of its earlier UK trade mark “The Baba House” (a series of 3) registered under number 2419214. A revocation action was simultaneously initiated by Hoho against CleverCat’s earlier UK mark and opposition B1939845 was suspended by the EUIPO pending the resolution of the UK revocation action. The outcome of the revocation was that the 2419214 mark was partially revoked in relation to a wide range of goods and services, but was permitted to remain registered for “animated cartoons for children”; this was the specification on the basis of which the opposition B1939845 was eventually decided. On 11 September 2015 the EUIPO partially upheld opposition B1939845 refusing the registration of the EUTM for the following goods and services which were found to be similar to varying degree to animated cartoons in class 9:

Class 9: Animated cartoons; audio-visual recordings; cinematographic films; computer software concerned with children's education and entertainment; interactive educational games for use with video apparatus or television receivers; interactive entertainment software for use with computers; pre-recorded media including video tapes and cassettes, laser discs, compact discs, CD ROMs, audio tapes and cassettes, DVDs, video game cartridges and computer discs; pre-recorded compact interactive discs; downloadable electronic publications; electronic colouring books; downloadable electronic publications provided on-line from databases or the Internet.

Class 16: Books, story books, drawing books, activity books, printed matter and publications.

Class 41: Education, entertainment services; TV entertainment services; entertainment activities accessible through the Internet; provision of education and entertainment for children by means of the Internet; film, radio and television entertainment; information relating to entertainment or education provided on-line from a computer database or the Internet; leasing of films, videotapes, CD-ROMs and DVDs; production, distribution, rental and exhibition of films, videos and television and radio programmes; entertainment provided by means of video game

cartridges; videotape editing; videotape, film, CD-ROM, DVD, tape and cassette production; information, advice and consultancy relating to the aforesaid services.

9. Consequently, these goods and services (which were initially relied upon by Hoho) did not proceed to registration. The EUIPO considered the remaining goods and services (as registered) to be dissimilar to animated cartoons. There does not appear to have been any appeal against that decision.

10. It is not clear in respect of which goods and services CleverCat admitted that there was similarity (or identity). As the counterstatement is not precisely worded and I am unable to say whether the goods and services in respect of which CleverCat initially accepted that there was a clash are still included in the specification (as registered), the concession will have no bearing on the outcome of the opposition.

11. In its submissions of 19 July 2016 CleverCat states (reproduced as written):

“...the Applicant contends that there is no danger of confusion in the minds of the consumer or end-user and requests that the opposition be dismissed in its entirety (sic) and that the Applicant’s mark proceed to registration not only in the goods in classes 9, 16 and 41 where the Opponent’s mark has been rejected, but in all goods and classes on the attached schedule and costs be awarded in its favour.”

12. CleverCat submits the page reproduced below:

Applicant's Goods	
<p>Class 9: Photographic; cinematographic; optical; teaching apparatus and instruments; recording discs; animated cartoons; pre-recorded cds, dvd's cd roms; sound and picture recording video cassettes; radios; video games; electronic publications; amusement apparatus; audio visual teaching apparatus; computer games apparatus; compact disc players; dvd players; mouse pads; water wings.</p>	<p>Class 28: Toys; games; playthings; gymnastic and sporting articles; toy figures, hand puppets, plush toys; soft toys, soft sculpted toy figures; jigsaw puzzles, board games; balloons; balls; dolls, doll accessories; doll's prams; clothes for dolls or soft toys; infant rattles; infant crib toys; mobiles; ride on toys; battery operated toys; toy vehicles; model vehicles; tricycles; playing cards; toy building blocks; building games; soap bubbles; bubble-making wand and solution sets; kites; Christmas tree ornaments and decorations; party favours in the nature of small toys; novelties for parties, paper party hats; masks; masquerade and Halloween masks; play costumes; action figures, action figure accessories and environments; play costumes; sandboxes, slides; pool rings, inflatable swimming pools, bath toys, pool toys, water squirting toys; toy bake ware, toy cookware; toy tools, toy tool belts, toy hard hats; amusement apparatus other than those adapted with television receivers only; hand held electronic games apparatus.</p>
<p>Class 16: Artwork; photographs and images; posters, printed pictures, photographs; artists' materials and paintings; instructional and teaching materials; books, story books, drawing books, activity books, scrapbooks, autograph books; printed matter and publications, booklets, periodicals, magazines, newsletters; stationery, notepads, folders, notebooks, binders; calendars, diaries, address books, blank journals; writing pads and paper; modelling clay; paint boxes, painting sets and paint brushes; pens, pencils, crayons, markers, pastels, felt-tipped pens, coloured pencils; erasers, pencil sharpeners, rulers; chalk and chalkboards; glue; ink; holders and stands for pens, pencils, pastels and crayons; stencils, stickers, transfers, decals, heat transfers, non-permanent skin decals; book covers, book marks; certificates and stamps; albums; wrapping and packaging materials; gift bags, gift bows; paper handkerchiefs; place mats, paper tablecloths, paper napkins; party invitations and paper party decorations; cards, greeting cards, post cards, trading cards; banners and other party articles made from paper or cardboard; paper diapers; printed patterns for costumes.</p>	<p>Class 41: Education, training and entertainment services; TV entertainment services; amusement park services; theme park services; providing coin-operated rides; arranging and conducting workshops; fan club services; entertainment activities and games accessible through the Internet; provision of education and entertainment for children by means of the Internet; film, radio and television entertainment; information relating to entertainment or education provided on-line from a computer database or the Internet; leasing of films, videotapes, CD-ROMs and DVDs; organisation of competitions; organisation of exhibitions; organisation, production and presentation of live performances and audience participation events; live performances and personal appearances by costumed characters; production, distribution, rental and exhibition of films, videos and television and radio programmes; production of stage shows; providing digital music (not downloadable) from MP3 Internet websites; entertainment provided by means of video game cartridges; electronic publication services and providing on-line electronic publications; publication of books; scriptwriting services; theatre production services; theatre services; videotape editing; videotape, film, CD-ROM, DVD, tape and cassette production; music writing services; children's adventure playground services; provision of play facilities for children; nursery, play group and kindergarten services; information, advice and consultancy relating to the aforesaid services.</p>
<p>Class 25: Clothing; footwear; headgear; children's clothing; fancy dress, masquerade and Halloween costumes; babies' napkins.</p>	

13. As it can be seen, the list of goods and services does not correspond to the applied for specifications. To the extent that the proposed list includes additional goods and services, there is no provision in the Act or rules to broaden the scope of an application after it has been published. Insofar as the proposed schedule does not reproduce some of the goods or services for which registration was initially sought, e.g. class 24, there has been no explicit request to delete any goods or services from the specifications; no doubt this has been exacerbated by CleverCat acting without legal advice. Hence, I proceed on the basis of the specifications as applied for.

DECISION

14. Section 5(2)(b) of the Act reads:

“5(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.”

15. An earlier trade mark is defined in Section 6(1) of the Act, which states:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.”

16. Given its date of filing, Hoho’s mark is an earlier mark in accordance with Section 6 of the Act. As this mark had not been registered for five years or more at the publication dates of the opposed applications, it is not subject to the proof of use provisions under section 6A of the Act. Consequently, the earlier mark may be relied upon for all goods and services for which it is registered without having to prove use.

Section 5(2)(b) - case-law

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives 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 normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) 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;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

18. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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 intended purpose and their method of use and whether they are in competition with each other or are complementary”.

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

20. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

21. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is

equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

22. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

23. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

24. It should also be noted that, as per the judgment of the GC in *Gérard Meric v OHIM*, case T-133/05, goods and services can be considered identical when the goods and services of the earlier mark are included in a more general category, included in the specification of the application and vice versa.

25. The respective goods and services are reproduced in the Annex to this decision. In making the comparison, I will do so with reference to the applied for goods and services, on a term-by-term basis, albeit grouping them together when it is reasonable to do so. I do not intend to compare each and every item within the applied for specification against that of the earlier mark, but will instead concentrate on where I consider the closest matches to be.

Class 9

26. Hoho's term "computer software" is unrestricted in scope. In *Galileo*

International Technology, LLC v European Union [2011] EWHC 35 (Ch) Floyd J stated:

“39. The unrestricted specification is of enormously wide scope. The Hearing Officer wisely reminded himself of what Laddie J had said about wide specifications for computer software in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J considered that:

“... there is a strong argument that a registration of a mark simply for “computer software ” will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls the computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

40. That was a case decided under the Trade Marks Act 1938, but, like Laddie J, I see no reason why the views there stated should not apply under the [1994] Act.”

27. In *Les Editions Albert René v OHIM*, Case T-336/03, the GC stated:

“69 Next, the Court must reject the applicant’s argument that all the goods and services covered by the Community trade mark application are linked, in one way or another, to ‘computers’ and ‘computer programs’ (Class 9)

covered by the earlier trade mark. As the defendant rightly points out, I today's high-tech society, almost no electronic or digital equipment functions without the use of computers in one form or another. To acknowledge similarity in all cases in which the earlier right covers computers and where the goods or services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark. Such a position would lead to a situation in which the registration of computer hardware or software would in practice exclude subsequent registration of any type of electronic or digital process or service exploiting that hardware or software."

28. I proceed on that basis.

29. Photographic, cinematographic, optical apparatus and instruments. The earlier mark covers the term "cameras" at large. A camera is an optical instrument for recording visual images in the form of photographs, film, or video signals; as such, it can be both a photographic and a cinematographic instrument and falls within the ambit of the applied for goods. Applying the guidance in *Meric*, the goods must be held to be identical.

30. Teaching apparatus and instruments; audio visual teaching apparatus. The goods include apparatus and instruments that instruct in a way that requires students' interaction and audio-visual aids, such as electronic white boards, slide projectors, video projectors, projection and display screens etc. The earlier mark covers "interactive graphics screens" which could be used as educational tools for interactive lessons and, as such, fall within the ambit of "audio visual teaching apparatus" and within the broader category of "teaching apparatus and instruments" in the applications. Applying the guidance in *Meric*, the goods must be held to be identical.

31. Mechanisms for coin operated apparatus. Even though the earlier mark covers "providing coin-operated rides" in class 41 I do not consider that there is any similarity here, as the goods are the mechanisms that provide activation of the machine as opposed to the service of providing coin-operated rides. Hoho has not

explained why it considers these goods to be similar to any of the earlier mark's goods and services and I see no obvious similarity. Consequently, I find that these goods are not similar to any of the earlier mark's goods and services.

32. Animated cartoons. The evidence shows that "animated cartoons" are the core goods of interest to CleverCat. Whilst the specification relied upon by Hoho initially included animated cartoons (and other goods and services which were held to be similar to animated cartoons), these goods and services did not proceed to registration; consequently, they cannot be relied upon in these proceedings. In the absence of any submission or evidence to the contrary, I see no degree of similarity with any of the registered goods and services of the earlier mark.

33. Pre-recorded cd's, dvd's, cd roms. Insofar as the goods include cd, dvd and cd rom based games, the goods are identical to "electronic computer games adapted for use with video apparatus or television receivers" in the earlier mark. Identity exists here.

34. Sound and picture recording video cassettes; recording discs. The use of "recording" suggests that the video cassettes and discs are blank. The earlier mark covers "cameras". There is a clear complementary relationship here because some video cameras need a recording video cassette or a recording disc to function. This is the type of relationship which would lead the average consumer to believe that the responsibility for the goods lies with the same undertaking. Further, the goods may be sold through the same outlets. I consider these goods to be similar to a medium level.

35. Compact disc players; dvd players. These are sound and image reproducing equipment. The earlier mark covers "cameras" which are devices for recording images (photographic) or images and sounds (video). The nature, purpose and methods of use of the respective goods are different, the goods are not complementary and there is no competition. The most that can be said is that, from a technical point of view, the goods are all electronic devices for recording and reproduction of sound and images. If there is any similarity, then I consider it is of a low degree.

36. **Radios.** These goods are one step removed from “camera” of the earlier mark. I see no similarity here.

37. **Video games.** The earlier mark covers “electric computer games adapted for use with video apparatus or television receivers”. The goods are identical.

38. **Electronic publications.** The goods includes e-books, digital periodicals, magazines, newsletters and the like. The earlier mark covers “periodicals, magazines, newsletters” in class 16. Whilst the nature and method of use are different, an electronic publication shares the same purpose and users as a printed publication. Further, goods may be available through the same channels and are competitive as one could choose between a printed and an electronic version of a periodical, magazine or newsletter. Finally, there is a degree of complementarity in the sense that consumers may believe that the responsibility for the goods lie with the same undertaking. I consider these goods to be similar to a high degree.

39. **Amusement apparatus; computer games apparatus.** The earlier mark covers “electric computer games adapted for use with video apparatus or television receivers” which are, in themselves, amusement/computer games apparatus. The goods are identical.

40. **Sunglasses.** In *Oakley Inc. v OHIM*, Case T-116/06 the GC stated:

“86 The intervener’s argument that eyewear, jewellery and watches could be similar or complementary to items of clothing cannot succeed, since, as correctly pointed out by OHIM, the relationship between those goods is too indirect to be regarded as conclusive. It must be borne in mind that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar.”

Accordingly, there is no similarity with the earlier mark’s goods in class 25. Nor can I see any other obvious similarity with any other of the earlier mark’s goods and services.

41. **Mouse pads.** The term “mouse pads” is contained in both specifications. Identity also exists here.

42. **Water wings.** The term “water wings” is contained in both specifications. Identity also exists here.

43. **Swimming belts; swimming jackets.** Whilst the methods of use are different, these goods share the same purpose, users and trade channels as “water wings” covered by the earlier mark as they are both water safety products. Further, the goods are competitive and there is a degree of complementary in the sense that consumers may believe that the responsibility for the goods lie with the same undertaking. I consider there to be a high degree of similarity between these goods.

44. **Goggles for sports.** The term “goggles for sports” includes swimming and diving goggles. Although the goods are not competitive, there is a similarity in term of users and trade channels and a degree of complementarity with Hoho’s “water wings”. I consider the degree of similarity between these goods to be medium.

45. This leaves **automatic vending machines; magnets; egg timers; eye-glass cases; helmets, protective for sports; holograms.** None of these goods appears to have any similarity with the goods and services of the earlier mark. They all have a different purpose and nature. They do not share methods of use. They are not obviously in competition or complementary in the sense defined in *Boston Scientific* and they do not obviously share trade channels. In the absence of any evidence or submissions to the contrary, I conclude that these goods are not similar to any of the goods and services of the earlier mark.

Class 16

46. **Paper, cardboard and goods made from these materials not included in other classes.** These must be taken to be identical to, inter alia, “banners and other party articles made from paper or cardboard” of the earlier mark, on the basis of *Meric*.

47. Printed matter including but not limited to books, comic books, albums, babies napkins. The earlier mark covers “instructional and teaching materials” which, in itself, covers the applied-for “books”. The earlier mark also covers “albums” and “paper napkins” which, in itself, covers “babies napkins”. The applied for “comic books” fall within the ambit of “periodicals” and “magazines” covered by the earlier mark. It should be noted that the use of the word “including” in the phrase shown above does not limit the applied for goods to only those identified, however, insofar as the phrase includes goods which are (on the *Meric* principle or otherwise) identical, identity also exists here.

48. Bookbinding material. These are goods used in making bindings for books. The earlier mark covers “book covers” and “binders”; the Oxford English dictionary defines the term “binder” as i) a cover for holding magazines or loose sheets of paper together; ii) a substance used to make other substances or materials stick or mix together; iii) a reaping machine that binds grain into sheaves and iv) a bookbinder. Applying the *Meric* principle, the goods of the earlier mark are encompassed by the broader term “bookbinding material” in the applications and goods are identical.

49. Photographs. The earlier mark covers “photographs”. The goods are identical.

50. Stationery. The earlier mark covers “stationery”. The goods are identical.

51. Adhesives for stationery or household purposes. The earlier mark covers “glue” which is an equivalent term to “adhesive”. The goods are identical.

52. Artists' materials; paintbrushes. The earlier mark covers “artists' materials and paintings” and “paint boxes, painting sets and paint brushes”. The goods are identical.

53. Typewriters. The earlier mark covers “ink”. Whilst typewriters need some sort of ink to function, they use typewriter ribbons rather than ink in a fluid form. I see no obvious similarity here and Hoho puts forward no reasons why these goods should be considered to be similar to any of its goods and services.

54. Office requisites (except furniture). The goods include office-related equipment such as, for example, staples, punches, paper cutters, folders and files, writing instruments etc. The following term “stationery” covered by the earlier mark would therefore fall within the ambit of “office requisites (except furniture)”. The goods are identical.

55. Instructional and teaching material (except apparatus). The earlier mark covers “instructional and teaching materials”. The goods are identical.

56. Plastic materials for packaging (not included in other classes). The earlier mark covers “wrapping and packaging materials” which includes the applied for goods. Applying the guidance in *Meric* the goods must be held to be identical.

57. Printers’ type; printing blocks. “Printing blocks” are hand engraved or carved blocks made of wood or metal and used in printing techniques. “Printers’ type” are pieces of wood or metal used to reproduce letters or graphics (similar to printing blocks but in the form of an individual character). These are specialist items that are not similar to any of the goods and services covered by the earlier mark.

58. Printed publications. The earlier mark also includes “periodicals, magazines, newsletters” which fall within the ambit of the applied for “printed publications”. Applying the guidance in *Meric*, the goods are identical.

Class 24

59. Textiles and textile goods, not included in other classes; bed and table covers. Hoho argues that these goods are similar to its goods in class 25 because clothing are made of textile. In relation to the applied for “bed and table covers”, the goods serves completely different purposes since clothing are meant to be worn by people whereas bed and table covers are used for household purposes. Consequently, the nature, purpose, methods of use are different, goods have different distribution channels and there is no competition or complementarity. Insofar as “textiles and textile goods, not included in other classes” are concerned, I bear in mind that being a component of a finished good does not of itself give rise to

a similarity; the issue will turn upon the particular goods. In this connection I note that in case T-8/03 *El Corte Inglés, SA v OHIM* the GC found that:

“44. Similarly, the textiles and textile goods in Class 24 and the clothing and shoes in Class 25 differ in many respects, such as their nature, intended purpose, origin and distribution channels. The Board of Appeal was therefore right to find, in paragraph 31 of the contested decision, that it is only in special cases, namely where a textile manufacturer exploits the reputation of its trade mark and decides to extend its activity to the production of clothing, that the same mark is used to designate finished goods (clothing) and semi-finished goods (textiles for clothing). It is not apparent from the file submitted by the applicant that this is the case here.

45. Therefore, far from being ‘manifestly and very closely linked’, the goods in Classes 18 and 24 and those in Classes 3 and 25 are normally not sufficiently similar for a likelihood of confusion as to their commercial origin to arise in the minds of the reference public, even where the signs are similar.”

Accordingly, there is no similarity here.

Class 25

60. **Clothing, footwear, headgear.** The earlier mark covers “clothing; footwear; headgear”. The goods are, self-evidently, identical.

Class 28

61. **Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.** The earlier mark covers “games”, “playthings”, “gymnastic and sporting articles” and “Christmas tree ornaments and decorations”. The applied for terms are identical or analogous to terms covered by the earlier mark and the goods must be held to be identical.

Class 41

62. Education; providing of training; physical education. The earlier mark covers “training” so the applied for “providing of training” services are, self-evidently, identical. Insofar as the applied for “education” and “physical education” are concerned, they also fall within the term “training”. Applying the guidance in *Meric* the services are identical. Even if training is not identical to education and physical education, they are, at least, highly similar.

63. Entertainment. The earlier mark covers various entertainment services, such as, for example, “amusement park services”, “theme park services” and “theatre services” which are all covered by the applied for “entertainment”. On the *Meric* principle, the services are identical.

64. Sporting and cultural activities including but not limited to cine films (rental of). The earlier mark covers “training” and “theatre services” which fall within the ambit of “sporting and cultural activities” respectively. Whilst the use of the word “including” in the phrase shown above does not limit the applied for services to only those identified, insofar as the phrase includes services which are (on the *Meric* principle) identical, identity also exists here.

65. Club services. The earlier mark covers “fan club services” which is encompassed by the broader term “club services” in the applications so, once again, the services are identical on the principles outlined in *Meric*.

66. Entertainer services. These services are provided by professional entertainers such as singers, dancers, or comedians, whose job is to entertain others. The average consumer for the services is the general public; the services could be offered at weddings or other functions or at venues. The earlier mark covers “amusement park services”. An amusement park is a large outdoor area with fairground rides, shows, and other entertainments. The nature of the services is therefore the same, as both relate to the provision of entertainment, the users are the same and the services are competitive, as one could choose between different forms of entertainment. Further, the applied for entertainer services could be offered

as an integral part of the services offered by the amusement park, so there is a degree of complementarity and an overlap in term of trade channels. Overall, I consider the services to be similar to a medium degree.

67. Party planning. In relation to these services, Hoho puts forward no reasons why they should be considered to be similar to its goods and services. I cannot see any obvious similarity here.

68. Film production. The Oxford English Dictionary defines “film production” as “the process or activity of producing films”. Whilst there is no direct evidence on the point, I take into account the points made by Ms Roberts in her evidence about the nature of the market. A film producer is someone who creates and realises, autonomously or upon request, a film. The consumer of film production services would usually be the funder of the film, normally a film studio, but sometimes a broadcaster. I note that the earlier mark covers “scriptwriting services” which may be provided to those in the creative industry. I can see no closer terms in the earlier mark’s specification. Whilst the respective services are different in nature, purpose and methods of use and are not competitive, they may share the same users because the scriptwriting services of the earlier mark could also be sought by film studios and broadcasters. There is also a degree of complementarity as the production of a film includes the creation of a film script. Overall, I consider the services to be similar to a low degree.

69. Game services provided online (from a computer network). The earlier mark covers “games accessible through the Internet”. The services are identical.

70. Live performances. The applied for “live performances” falls within the ambit of “theatre services” and, on the *Meric* principle, the services are identical.

71. Nursery schools. The earlier mark covers “nursery services”. The services are identical.

72. Publication of books; publication of electronic books and journals on line; publication of texts (other than publicity texts); providing online electronic publications (not downloadable). The earlier mark covers “publication of books”

“electronic publication services and providing on-line electronic publications” which are self-evidently identical to the services applied for.

73. Radio and television programmes (production of). The services cover the creation of radio and television programmes for sale and license to third parties, i.e. radio and television broadcasting companies. This includes both the technical aspect of producing radio and television programmes and the production of the artistic content of the programme. The services consist, therefore, in creating content of the radio and television programmes and not in broadcasting the programmes to final viewers and are rendered by professionals skilled in the field of radio and TV productions, who, either autonomously or upon request, create and realise new programmes meant to be sold to radio and TV broadcasters. For similar reasons given in relation to film production, there is a degree of similarity with “scriptwriting services” of the earlier mark because the respective services could potentially be utilised by the same users, i.e. radio and television broadcasting companies. Further, there is a degree of complementarity as the production of radio and television programmes includes the creation of programmes scripts. Overall, I consider the services to be similar to a low degree.

74. Recreation facilities. The earlier mark covers “provision of play facilities for children” which are encompassed by the broader term “recreation facilities” in the applications. Applying the guidance in *Meric*, the services are identical.

75. Sound recordings. These are essentially recording studio services. The users of the services will be musicians who wish to record their own music or commercial customers who wish to produce corporate music. Whilst the earlier mark covers “music writing services” there is no evidence that providers of sound recordings services could also provide music writing services to their customers or that the services have converged in a manner that the public may believe the responsibility for the services lies with the same undertaking. Consequently, I see no obvious similarity and Hoho puts forward no reasons why these services should be considered to be similar to any of its goods and services.

76. Theatre productions. The earlier mark covers “theatre productions services”. The services are identical.

In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

Having concluded that there is no meaningful degree of similarity between Hoho’s goods and services and the following:

Class 9

Automatic vending machines and mechanisms for coin operated apparatus; animated cartoons; radios; magnets; sunglasses; egg timers; eye-glass cases; helmets, protective for sports; holograms.

Class 16

Typewriters; printers’ type; printing blocks.

Class 24

Textiles and textile goods, not included in other classes; bed and table covers.

Class 41

Party planning; sound recordings.

Consequently, there can be no likelihood of confusion and the opposition to these goods and services fails accordingly.

Average consumer

77. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

78. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

79. For both parties, the average consumer of the goods in classes 9, 16, 25 and 28 will be the general public although some of the goods in classes 9 and 16, i.e. office requisites (except furniture), could also be purchased by a professional or a business user. The purchasing process will be primarily visual, with the products being selected from shop shelves, websites or catalogues. Some may place orders aurally via the telephone, so aural considerations must not be ignored. The specifications cover a range of goods which vary in price and frequency of purchase. Consequently, the level of attention is likely to vary: from lower than normal, e.g. an item of stationery selected by a member of the general public, to average, e.g. articles of clothing, to slightly higher than normal, e.g. the purchase of a camera which may be fairly expensive.

80. The parties' nursery services in class 41, will be sought by those with parental responsibilities. I have already found that the average consumer of film production

and radio and television programmes (production of) services are film studios and broadcasters. The average consumer of the remaining services is the public at large, although the parties' educational and training services could also be sought by business users with training or educational requirements. The level of care and attention will range from average, e.g. in relation to video games services, to above average, e.g. in relation to educational services, to very high, i.e. film production and radio and television programmes (production of). The purchasing process will often be visual with the services being selected from, inter alia, brochures and the like and also the online equivalents, however, I do not ignore that, for some of the services concerned, the selection may involve word-of-mouth recommendations and bookings by telephone where aural considerations will play a part.

Comparison of marks

81. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

82. It would be wrong, therefore, artificially to dissect the marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

Earlier mark	Applied for marks 2596855	Applied for marks 2596084
BABA PINK	The Babas & the babas	Baba & baba

Applied for mark 2597073	Applied for mark 2597070	Applied for mark 2597069	Applied for mark 2597072	Applied for mark 2597074
<p>Baba Mousie</p> 	<p>Baba Bear</p> 	<p>Baba Monkey</p> 	<p>Baba Bun</p> 	<p>Baba Tig</p> 

Overall impression

83. The earlier mark consists of the two words “BABA PINK” in a normal typeface and in capital letters. The Oxford English dictionary defines the word “baba” as a word of French origin meaning a small cake usually soaked in rum (rum baba). I have no submissions from the parties on how the word “BABA” may be construed but, from my experience, the term is not commonly used in the UK as signifying a cake. Rather, it is more likely to be understood by the UK average consumer as indicating, in informal language, a baby or a toddler. The word “PINK” will be readily understood as denoting a colour. The combination of the words is unusual because in the context of the use of the word “BABA” as a noun the overwhelming majority of English adjectives precede the nouns they qualify and it would be much more normal to combine the words as “PINK BABA”. Notwithstanding the unusual order of the words, some consumers may construe the mark intuitively as indicating a pink baba (i.e. a baby or toddler) in which case it forms a unit and the distinctiveness and overall impression created will rest in the mark as a whole. However, it is equally likely that for other consumers the structure of the mark may prevent its understanding as a unit, in which case it will not be clear what the combination exactly means. In those circumstances, the components will not form a unit and both are likely to retain an independent role in the mark. Less likely, in my view, is that the word “BABA” would be treated as invented (and neither party has made such an

argument). If it were, however, it is likely that, once again, the words will not form a unit and will retain an independent distinctive role. Either way, as colours rarely make for particularly distinctive marks, the word “PINK” is likely to have less distinctive character than “BABA” which is likely to make a more significant contribution to the overall impression the earlier mark conveys.

84. The marks applied for under no 2596855 consist of the word “The Babas/the babas” presented in title and lower case letters respectively. Given its nature, the definite article “The/the” has the least relative weight and although it is not negligible, it is the word “Babas/babas” that has the greatest relative weight in the overall impression of the marks.

85. The marks applied for under no 2596084 consist of the words “Baba/baba” presented in title and lower case letters respectively. The overall impression of the marks resides in the words themselves.

86. The marks applied for under nos 2597073, 2597070, 2597069, 2597072 and 2597074 consist of the following: i) the words “Baba Mousie” presented in the colour pink above the cartoon representation of an anthropomorphised creature wearing a mouse costume; ii) the words “Baba Bear” presented in the colour red above the cartoon representation of an anthropomorphised creature wearing a bear costume; iii) the words “Baba Monkey” presented in the colour green above the cartoon representation of an anthropomorphised creature wearing a monkey costume; iv) the words “Baba Bun” presented in the colour blue above the cartoon representation of an anthropomorphised creature wearing a bunny costume; v) the words “Baba Tig” presented in the colour orange above the cartoon representation of an anthropomorphised creature wearing a tiger costume. Every cartoon character is presented in a different pose and distinctively dressed in a particular colour. Given the positioning of the words above the pictures and the fact that the second word in each mark is associated with the animal costume worn by the relevant character, the word elements will be seen as signifying the names of the characters themselves. Consequently, there is a strong association in each mark between the words and the pictures as they reinforce one other. In this connection CleverCat accepts that both the words and the pictures are equally important to the brand although it submits that

the marks' dominant visual features are the images. In my view, the marks are likely to be remembered as "Baba Mousie", "Baba Bear", "Baba Monkey", "Baba Bun" and "Baba Tig" respectively and, notwithstanding the pictures are larger than the words, I consider that both the pictures and the names applied to them contribute to the overall impression of the marks.

Visual and aural similarity

87. Notional and fair use of either the earlier mark or the applied for marks could include use in upper and lower case lettering, so nothing turns on the use of different casing. The earlier mark and the mark 2596855 share the same letters "BABA/Baba/baba". However, the marks are different in that the earlier mark uses the singular word "BABA" whereas in the applied for marks the word is in the plural form, "Babas/babas". Further, in the applied for marks the words "Babas/babas" are preceded by the definite article "The/the" which has no counterpart in the earlier mark and in the earlier mark the word "BABA" is followed by the word "PINK" which is absent in the applied for marks. I consider there to be a medium degree of visual and aural similarity.

88. In respect of the mark 2596084 the only difference is the presence of the element "PINK" in the earlier mark which makes it look and sound much longer. There is a medium degree of visual and aural similarity.

89. Insofar as the figurative marks are concerned, they are visually similar to the earlier mark to the extent that they have the word "BABA/Baba" in common. Further, there is a similarity in terms of structure since the word "BABA" is followed by another word, i.e. Mousie, Bear, Monkey, Bun and Tig in the same manner as the word "BABA" is followed by the word "PINK" in the earlier mark. However, the visual significance of the device elements and the different appearance of the words which follow the element "BABA", taken together, render the respective marks visually similar to only a low degree. In term of aural similarity, the device elements will not be articulated and the marks will be referred to by the word elements alone. I find that there is a low to medium degree of aural similarity.

Conceptual similarity

90. Turning now to the conceptual comparison, even in the context of goods and services which are not children-related, the average consumer is likely to be aware of the meaning of the word “BABA”. The word “BABA” in the mark 2596084 and the combination of the word “BABA” in the phrase “BABA PINK” of the earlier mark is likely to bring to mind the concept of a baby or a toddler (pink or otherwise). The pluralisation and the presence of the article “The/the” in the 2596855 mark will have little effect on the perception of the average consumer and the concept conveyed by the mark will be of a group of “babas”. Hence, the fact that the respective marks share the word “BABA” (either in the singular or plural form) create similar mental pictures in the minds of the average consumer leading to a fairly high degree of conceptual similarity between the marks at issue. Where the meaning of the word “BABA” is not clearly understood, there will be no clear concept and the conceptual position between the respective marks is likely to be neutral.

91. In relation to the figurative marks, the presence of the cartoon characters is likely to lead consumers to perceive “Baba Mousie”, “Baba Bear”, “Baba Monkey”, “Baba Bun” and “Baba Tig” as characters with that names. This means that whatever is the meaning attributed to the element “BABA” in the earlier mark, there is no meaningful conceptual similarity. This is because the phrases “Baba Mousie”, “Baba Bear”, “Baba Monkey”, “Baba Bun” and “Baba Tig” will send a clear conceptual message of characters’ names which is absent from the earlier mark, in the context of which I see no reasons why the phrase “BABA PINK” should be perceived as the name of a cartoon character. In this connection, I note that none of the applicant’s character names include the name of a colour. Bearing these conclusions in mind, I find that, if there is any conceptual similarity this stems solely from the respective marks using the word “BABA/Baba”, but the significance of “BABA/Baba” in the respective marks does not create similar overall concepts⁴.

⁴ See by analogy BL–O- 045-17 paragraphs 11 - 20

Distinctive character of the earlier mark

92. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

93. No evidence of use has been provided by Hoho, so I have only the inherent characteristics of the earlier mark to consider. The mark “BABA PINK” is not descriptive of any of the registered goods and services. Even if the word “BABA” may be allusive in relation to, for example, nursery services and other children related services in class 41, baby napkins in class 16 and a number of goods in class 28, e.g. infants rattles, the word has only an informal meaning and, in those circumstances, it is, in my view, endowed with (at least) an average degree of distinctive character. In relation to the remaining goods and services, I find that the mark is endowed with an above average degree of distinctive character.

Likelihood of confusion

94. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind. In its submissions, CleverCat states:

“It is disingenuous of [Hoho] to suggest that someone looking for BABA PINK merchandising, would be confused by the collective Babas, especially as [Hoho] umbrella brand is Cloudbabies. It is equally the case that there is no possibility of the end user on hearing the word “Babas” would confuse it with “Baba Pink”.

95. CleverCat’s submissions are clearly misconceived. The earlier mark is “BABA PINK” and not Cloudbabies, so I need to say no more about it. Insofar as the reference to merchandising is concerned, I must assume use of the mark as indicative of trade origin, not limited merely to the context of merchandising.

96. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on

the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

97. This is not a case where one mark will be mistaken for the other. For that to happen it would require the average consumer (who is deemed to be reasonably circumspect and observant) to ignore the second element of the earlier mark or discount its impact on the basis that it is descriptive or laudatory, which is not the case. There is, in my view, more scope for indirect confusion here. In relation to the marks 2596084 consisting of the words "Baba/baba" alone, taking into account the distinctive character of the earlier mark, the medium degree of visual and aural similarity and the fairly high degree of conceptual similarity between the competing

marks, there is, in my view, a likelihood of indirect confusion in respect of the goods and services which I found to be identical or highly similar. Where I found a lesser degree of similarity between the goods and services, my conclusion is that the similarities between the marks and the distinctiveness of the common element “BABA” are as such that, even when a very high degree of attention is paid, they will still cause the consumers to believe that the respective goods and services come from the same or an economically linked undertaking. This is because irrespective of whether the average consumer is likely to treat the words “BABA PINK” in the earlier mark as a unit or as two independent components, the word “BABA” will still create the same conceptual image of a baby or a toddler (pink or otherwise) which is also conveyed by the applied for marks, leading to a likelihood of indirect confusion.

There is a likelihood of indirect confusion in respect of the marks 2596084.

98. I see no reason to reach a different conclusion in relation to the marks 2596855 consisting of the words “The Babas/the babas”. **There is a likelihood of indirect confusion in respect of the marks 2596855.**

99. For the sake of completeness, I should say that I would have come to the same conclusion even if the average consumer saw the word “BABA” as an invented word, in which case, whilst the conceptual position would be neutral, the earlier mark would be endowed with a high degree of distinctive character and Hoho’s position would be equally strong.

100. In relation to the figurative marks, they are different as regard to the figurative elements and because the element “Baba” is combined with another word to form the names of the characters. These elements do not only exclude direct confusion but create totally different overall impressions, one evoking the concept of a toddler (pink or otherwise) the others being the name of fictional characters individually identified by the figurative elements of the marks. I bear in mind that the protection resulting from the registration of the earlier mark applies to the sign “BABA PINK” and Hoho is not relying on a family of marks; whilst both the earlier mark and the applied for marks contain the word “BABA/Baba” followed by another word, the nature of the word is different and there is no pattern that can be held so characteristic of the earlier mark. Finally, whilst it is clear from the evidence that both

parties are production companies wanting to use the word “BABA/Baba” in relation to cartoon characters, I found that there is no similarity in relation to animated cartoons. This means that Hoho’s case rests on a wide range of goods and services which are unrelated to these core goods, in the context of which I must assume the sign will be used as an indicator of origin (and not as character merchandising). Assessing the matter from that perspective, it does not seem to me that the creation of animated distinctive cartoon characters is entirely logical and consistent with a brand extension.

101. Balancing all the factors, I conclude that even where identical goods are involved and a lower than normal degree of care and attention is deployed, consumers are unlikely to believe that the applied for figurative marks are somehow connected to the mark “BABA PINK”. Once again, I would have come to the same conclusion even if the average consumer saw the word “BABA” as an invented word (or a word whose meaning is unclear), in which case the clear conceptual meaning of the figurative marks will still be regarded as sufficient to avoid confusion. **There is no likelihood of indirect confusion in respect of the figurative marks.**

OVERALL CONCLUSION

102. Given my findings, the oppositions fail in relation to the figurative marks.

The oppositions succeed in relation to the marks 2596084 and 2596855 for the following:

Class 9: Photographic, cinematographic, optical, teaching apparatus and instruments; recording discs; pre-recorded cd's, dvd's, cd roms; sound and picture recording video cassettes; video games; electronic publications; amusement apparatus; audio visual teaching apparatus; computer games apparatus; compact disc players; dvd players; goggles for sports; mouse pads; swimming belts; swimming jackets; water wings.

Class 16: Paper, cardboard and goods made from these materials not included in other classes; printed matter including but not limited to books, comic books, albums,

babies napkins; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printed publications.

Class 25: Clothing, footwear, headgear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 41: Education; providing of training; entertainment; sporting and cultural activities including but not limited to cine films (rental of); club services; entertainer services; film production; game services provided online (from a computer network); live performances; nursery schools; physical education; publication of books; publication of electronic books and journals on line; publication of texts (other than publicity texts); radio and television programmes (production of); providing online electronic publications (not downloadable); recreation facilities; theatre productions.

103. The oppositions fail in relation to marks 2596084 and 2596855 for the following:

Class 9: Automatic vending machines and mechanisms for coin operated apparatus; animated cartoons; radios; magnets; sunglasses; egg timers; eye-glass cases; helmets, protective for sports; holograms.

Class 16: Typewriters; printers' type; printing blocks.

Class 24: Textiles and textile goods, not included in other classes; bed and table covers.

Class 41: Party planning; sound recordings.

COSTS

104. Although both parties have achieved a measure of success, as CleverCat has been substantially more successful than Hoho it is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (TPN) 4 of 2007. As CleverCat is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the oppositions. It was made clear that if the pro-forma was not completed “no costs will be awarded”.

105. CleverCat indicated that it spent a total of 32 hours dealing with the preparation of the evidence written submissions. Whilst this is likely to have taken CleverCat same time, a claim in respect of 32 hours is in my view excessive. In this connection, I bear in mind that most of CleverCat’s submissions consisted in a summary of the history of the case, that the evidence was on the light side and in part not pertinent and that there were no submissions of evidence submitted from the other side. I consider that, in these circumstances, an award of cost for 12 hours would be appropriate. I award costs to CleverCat in the amount of £216 i.e. 12 hrs x £18, the latter being the minimum level of compensation for litigants in person in The Litigants in Person (Costs and Expenses) Act 1975. In respect of the filing of counterstatements, I consider that CleverCat was professionally represented at the time and that the counterstatements were nearly identical. Making a “rough and ready” reduction to reflect the measure of Hoho’s success, I award costs to CleverCat on the following basis:

Preparing statements and considering the other party’s statements:	£400
Preparing evidence and written submissions:	£150
Total:	£550

106. I order Hoho Entertainment Ltd to pay CleverCat Productions Limited the sum of £550 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 15th day of February 2017

A handwritten signature in black ink, appearing to be 'TP' followed by a large, stylized flourish.

**Teresa Perks
For the Registrar
The Comptroller General**

Annex

Applied for specifications

Class 9: Photographic, cinematographic, optical, teaching apparatus and instruments; recording discs, automatic vending machines and mechanisms for coin operated apparatus; animated cartoons; pre-recorded cd's, dvd's, cd roms; sound and picture recording video cassettes; radios; video games; magnets; electronic publications; amusement apparatus; audio visual teaching apparatus; computer games apparatus; sunglasses; compact disc players; dvd players; egg timers; eye-glass cases; goggles for sports; helmets, protective for sports; holograms; mouse pads; swimming belts; swimming jackets; water wings.

Class 16: Paper, cardboard and goods made from these materials not included in other classes; printed matter including but not limited to books, comic books, albums, babies napkins; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed publications.

Class 24: Textiles and textile goods, not included in other classes; bed and table covers.

Class 25: Clothing, footwear, headgear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 41: Education; providing of training; entertainment; sporting and cultural activities including but not limited to cine films (rental of); club services; entertainer services; film production; game services provided online (from a computer network);

live performances; nursery schools; party planning; physical education; publication of books; publication of electronic books and journals on line; publication of texts (other than publicity texts); radio and television programmes (production of); providing online electronic publications (not downloadable); recreation facilities; sound recordings; theatre productions.

Earlier mark's specifications

Class 9: Computer software; electric computer games adapted for use with video apparatus or television receivers; software for hand held electronic games apparatus; interactive graphics screens; interactive video software; mouse pads; phonograph records; cameras; electronic posters; electronic greetings cards; electronic games provided by the Internet; downloadable electronic information provided on-line from databases or the Internet; digital music downloadable provided from a computer database or the Internet; digital music downloadable provided from MP3 internet websites; downloadable musical sound recordings; water wings.

Class 16: Artwork; photographs and images; posters, printed pictures, photographs; artists' materials and paintings; instructional and teaching materials; scrapbooks, autograph books; booklets, periodicals, magazines, newsletters; stationery, notepads, folders, notebooks, binders; calendars, diaries, address books, blank journals; writing pads and paper; modelling clay; paint boxes, painting sets and paint brushes; pens, pencils, crayons, markers, pastels, felt-tipped pens, coloured pencils; erasers, pencil sharpeners, rulers; chalk and chalkboards; glue; ink; holders and stands for pens, pencils, pastels and crayons; stencils, stickers, transfers, decals, heat transfers, non-permanent skin decals; book covers, book marks; certificates and stamps; albums; wrapping and packaging materials; gift bags, gift bows; paper handkerchiefs; place mats, paper tablecloths, paper napkins; party invitations and paper party decorations; cards, greeting cards, post cards, trading cards; banners and other party articles made from paper or cardboard; paper diapers; printed patterns for costumes.

Class 25: Clothing; footwear; headgear; children's clothing; fancy dress, masquerade and Halloween costumes; babies' napkins.

Class 28: Toys; games; playthings; gymnastic and sporting articles; toy figures, hand puppets, plush toys; soft toys, soft sculpted toy figures; jigsaw puzzles, board games; balloons; balls; dolls, doll accessories, doll's prams; clothes for dolls or soft toys; infant rattles; infant crib toys; mobiles; ride on toys; battery operated toys; toy vehicles; model vehicles; tricycles; playing cards; toy building blocks; building games; soap bubbles; bubble-making wand and solution sets; kites; Christmas tree ornaments and decorations; party favours in the nature of small toys; novelties for parties, paper party hats; masks; masquerade and Halloween masks; play costumes; action figures, action figure accessories and environments; play costumes; sandboxes, slides; pool rings, inflatable swimming pools, bath toys, pool toys, water squirting toys; toy bake ware, toy cookware; toy tools, toy tool belts, toy hard hats; amusement apparatus other than those adapted with television receivers only; hand held electronic games apparatus.

Class 41: Training; amusement park services; theme park services; providing coin-operated rides; arranging and conducting workshops; fan club services; games accessible through the Internet; production of stage shows; providing digital music (not downloadable) from MP3 Internet websites; electronic publication services and providing on-line electronic publications; publication of books; scriptwriting services; theatre production services; theatre services; music writing services; children's adventure playground services; provision of play facilities for children; nursery, play group and kindergarten services; information, advice and consultancy relating to the aforesaid services.