

O/654/18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003244921 BY
SHENZHEN DO2DO NETWORK TECHNOLOGY CO., LTD
TO REGISTER:**

Mitoys

AS A TRADE MARK IN CLASS 28

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 410820 BY
MYTOYS.DE GMBH**

BACKGROUND AND PLEADINGS

1. On 20 July 2017, ShenZhen DO2DO Network Technology Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 18 August 2017.

2. The application was opposed by myToys.de GmbH (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is based on the earlier EU Trade Mark registration no. 13052899 for the following mark:



3. The opponent’s mark has an application date of 2 July 2014 and a registration date of 12 November 2014. It claims the colours red, blue, yellow, orange and green. The following goods are relied upon in this opposition:

Class 28 Games and playthings

4. The opponent argues that the respective goods are identical or similar and that the marks are similar.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by A. A. Thornton & Co. No hearing was requested and the opponent filed submissions in lieu. No written submissions were filed by the applicant. This decision is taken following a careful perusal of the papers.

DECISION

7. Section 5(2)(b) of the Act reads as follows:

“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.”

8. An earlier trade mark is defined in section 6 of the Act, 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 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

9. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

10. 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.

The principles:

(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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 28</u> Games and playthings	<u>Class 28</u> Car toys namely, toy vehicles and toy models

12. When making the comparison, all relevant factors relating to the goods in the specifications 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 of its judgment 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 intended purpose and their method of use and whether they are in competition with each other or are complementary.”

13. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

14. 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.”

15. 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.”

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

17. In its Notice of Opposition, the opponent stated: “The Contested Goods fall within the Earlier Goods and so are identical”. In its counterstatement, the applicant stated:

“The goods at stake are not identical. The opponent EUTM covers “Games and playthings; Gymnastic and sporting articles, not included in other classes; Decorations for Christmas trees; Playing cards” in class 28. The contested TM covers “Car toys namely, toy vehicles and toy models”. According to the Nice Classification, the general heading of class 28 is “Games, toys and playthings; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees” (enclosed hereby). Therefore, the goods of the challenged mark are not included within the goods claimed by the opponent registration.”

18. In its submissions dated 18 July 2018, the opponent provided further lengthy submissions on the similarity or identity of the goods in issue. I do not propose to reproduce those submissions here, but I have taken them into account in reaching my decision.

19. It is clear from the Trade Marks Manual that specifications which include the word “namely” should be interpreted as including only those named goods¹. However, in this case, the named goods in the applicant’s specification (toy vehicles and toy models) are broader terms than the initial category identified (Car toys). “Toy vehicles” are, of course, not limited to toy cars and could cover any number of vehicles such as toy boats or toy planes. Similarly, “toy models” could cover any number of models from buildings to vehicles. In my view, the applicant’s specification should therefore be interpreted as being limited to “car toys”. “Car toys” in the applicant’s specification falls within the broader category of “games and playthings” in the opponent’s specification. Such goods can, therefore, be considered identical on the principle outlined in *Meric*. Even if the applicant’s specification is to be interpreted to include “toy vehicles and toy models” these would still fall within the broader category of “games and playthings” in the opponent’s specification and would consequently be considered identical on the principle outlined in *Meric*. If I am wrong in my finding that the goods are identical then, taking into account the users, methods of use, distribution channels and nature of the goods, they will be highly similar.

¹ <https://www.gov.uk/guidance/trade-marks-manual/the-classification-addendum>

The average consumer and the nature of the purchasing act

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

21. I have no submissions from either party on the average consumer or the purchasing process for the goods in issue. The average consumer for the goods will be a member of the general public. The level of attention paid by the average consumer is likely to be average as a number of factors will be given consideration (for example, the target age group for the product). These purchases are likely to vary from fairly frequent to infrequent, depending on the nature of the goods being purchased.

22. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that advice may be sought from a sales assistant.


Comparison of trade marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

24. It would be wrong, therefore, to artificially dissect the trade 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.

25. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
 The logo for 'myToys' features the word 'myToys' in a stylized, rounded font. 'my' is in red, 'Toys' is in blue, and the 'y' is in green.	Mitoys

26. In its Notice of Opposition, the opponent stated:

“3. The Earlier Mark is comprised of the word myToys represented in coloured letters and in a font. The stylisation of the Earlier Mark is minor and does not

materially affect the distinctiveness of the Earlier Mark overall. The distinctive component of the Earlier Mark is therefore the word myToys.

4. The Earlier Mark would be understood by consumers as the two words 'my' and 'toys'.

5. The Contested Mark is a plain word mark comprised of the word Mitoys. The Contested Mark therefore is almost identical to the verbal component of the Earlier Mark, save for the second letter which instead of 'y' as in the Earlier Mark, is the phonetic equivalent 'i'.

6. The Contested Mark could be understood as a variation on the spelling of 'my toys'.

7. The Earlier and Contested Marks are therefore phonetically and conceptually identical and visually highly similar. Overall therefore the Earlier and Contested Marks are highly similar.”

27. In its counterstatement, the applicant stated:

“-The marks are not phonetically and conceptually identical, as the opponent states, because the opponent EUTM will be pronounced MAI TO IS whereas the contested application will be pronounced MI TO IS. Also, the contested TM will be perceived by consumers as a fantasy word devoid of meaning.

-The colours and representation of the opponent sign are not weak, as the opponent claims, because without this figurative element, the opponent TM would not have been registered because of descriptive and devoid of distinctive character for goods in class 28.”

28. In its submissions dated 18 July 2018, the opponent provided further lengthy submissions on the similarity of the marks. I do not propose to reproduce those submissions here, but I have taken them into account in reaching my decision.

29. The applicant's mark consists of 6 letters, presented in lower case but with the first letter capitalised. The applicant's mark is made up of the letters "MI" conjoined with the ordinary dictionary word "TOYS". I consider that the overall impression of the mark is as a unit (as opposed to two separate and unrelated words). The opponent's mark consists of six letters, presented in lower case but with the third letter capitalised. Although conjoined, the opponent's mark will be viewed as the two ordinary dictionary words "MY" and "TOYS". I consider that the overall impression of the mark is as a unit (as opposed to two separate and unrelated words), with neither word dominating.

30. Visually, the first letter of both marks is "M" and the last four letters of both marks make up the ordinary dictionary word "TOYS". The difference between the marks is created by the differing second letter ("y" in the opponent's mark and "i" in the applicant's mark). As notional and fair use means that the applicant's mark could be used in any standard typeface the difference created by the capitalisation is not relevant. The use of colour in the opponent's trade mark does also not create a significant visual difference between the marks. The Court of Appeal has stated on two occasions following the CJEU's judgment in *Specsavers*² (see paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc* [2015] EWCA Civ 290 at paragraph 47) that registration of a trade mark in black and white covers use of the mark in colour. Consequently, the applicant's mark should be considered on the basis that it could be used in any colour. It is, of course, not appropriate to apply complex colour arrangements to a mark registered in black and white and so it would be inappropriate to apply the colour combination used in the opponent's mark to the applicant's mark. Notwithstanding this, I consider that there is a high degree of visual similarity between the marks.

31. Aurally, the word "TOYS" in both marks will be pronounced identically. The word "MY" in the opponent's mark will be given its ordinary English pronunciation. In my view, the letters "MI" in the applicant's mark are likely to be pronounced in the same way as the ordinary dictionary word MY (that is, to rhyme with FLY). I therefore consider the marks to be aurally identical.

² *Specsavers International Healthcare Limited & Others v Asda Stores Limited*, Case C-252/12

32. Conceptually, the word “TOYS” will be recognised in both marks and given its ordinary dictionary meaning. This is particularly the case in light of the goods covered by the specifications for each mark. The word “MY” in the opponent’s mark will also be given its ordinary dictionary meaning. In combination, the opponent’s mark creates the conceptual image of ownership of toys. The letters “MI”, when used in combination with the word “TOYS” in the applicant’s mark will, in my view, appear as a misspelling of the ordinary dictionary word MY. If not, then the letters will be attributed no particular meaning by the consumer. If the former is correct, then the marks will be conceptually identical. If the latter is correct, they will be conceptually similar to a high degree.

Distinctive character of the earlier trade mark

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. 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-2779, paragraph 49).

23. 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).”

34. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

35. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. Neither the opponent nor the applicant have made any submissions about the distinctiveness of the earlier mark, save for the applicant's comments set out at paragraph 27 above.

36. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. Both words used in the opponent's mark are ordinary dictionary words. The use of the word TOYS in the opponent's mark is descriptive of the goods offered. As previously noted, the applicant has argued that the distinctiveness of the earlier mark lies in its use of colour as it states that without this it would be devoid of distinctive character. In my view, whilst the consumer will recall that the opponent's mark is presented in colour, I do not consider that they will recall the precise colour combination used in the opponent's mark. I do not consider that this increases the inherent distinctiveness of the opponent's mark. It is not in issue in these proceedings as to whether the opponent's mark should have been registered and I must assume that all registered trade marks have some degree of distinctive character³. I find that the mark has a low degree of inherent distinctive character.

Likelihood of confusion

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods or services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment

³ *Formula One Licensing BV v OHIM*, Case C-196/11P

where 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 trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

38. I have found the parties' marks to be visually similar to a high degree, aurally identical and conceptually identical or highly similar. I have identified the average consumer to be a member of the general public who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that the average consumer will pay an average degree of attention when selecting the goods. I have found the parties' goods to be identical. Bearing all of these factors in mind, I am satisfied that the similarities between the marks will lead to a likelihood of direct confusion between them i.e. the average consumer will mistake one mark for another.

CONCLUSION

39. The opposition is successful.

COSTS

40. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £600 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement	£200
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Official Fee	£100
Preparing written submissions in lieu of a hearing	£300
TOTAL	£600

41. I therefore order ShenZhen DO2DO Network Technology Co., Ltd to pay myToys.de GmbH the sum of £600. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 16th day of October 2018

S WILSON
For the Registrar