

O/116/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003355822
BY THE ENTERTAINER (AMERSHAM) LIMITED
TO REGISTER THE FOLLOWING MARKS:



(SERIES OF 5)

IN CLASSES 16 AND 28

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 416209
BY JAKKS PACIFIC, INC.

BACKGROUND AND PLEADINGS

1. On 23 November 2018, The Entertainer (Amersham) Limited (“the applicant”) applied to register the series of five trade marks, shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 1 February 2019 and registration is sought for the following goods:

Class 16 Printed matter; stationery; stickers; artists' materials; drawing instruments; drawing materials; writing instruments; erasers; pens; pencils; crayons; chalks; paintbrushes; pencil sharpeners; artists' modelling materials.

Class 28 Toys; playthings; none of the aforesaid being games, balls, marbles, or playing pieces for games; board games; gymnastic and sporting articles.

2. On 1 May 2019, JAKKS Pacific, Inc. (“the opponent”) opposed the application based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade marks:

JAKKS

UKTM no. 2392072

Filing date 16 May 2005; registration date 20 April 2007

(“the First Earlier Mark”)

JAKKS PACIFIC

UKTM no. 2292303

Filing date 8 February 2002; registration date 11 October 2002

(“the Second Earlier Mark”)

JAKKS

EUTM no. 4471249¹

Filing date 3 June 2005; registration date 5 February 2009

("the Third Earlier Mark")

JAKKS PACIFIC

EUTM no. 4180915

Filing date 7 December 2004; registration date 15 May 2006

("the Fourth Earlier Mark")

4. Under section 5(2)(b), the opponent relies upon all goods for which the earlier marks are registered, as set out in Annex 1 to this decision. The opponent claims that there is a likelihood of confusion because the marks are similar and the goods are identical or similar.

5. The opponent claims a reputation in relation to some of the goods for which the marks are registered, as set out in Annex 2 to this decision.² The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier marks.

6. Under section 5(4)(a), the opponent relies upon the signs **JAKKS** and **JAKKS PACIFIC** which it claims to have used throughout the UK since 1998 in relation to:

Science and experiment kits, educational and teaching kits, apparatus for the recording, transmission and reproduction of sound, including disc jockey mixing desks, electronic guitars and guitar video games.

Computer software and computer programs, computer and video games software, electronic and video games, games adapted for use with television and computers, games consoles and controllers, portable gaming systems,

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

² I note that for some of the earlier marks, the goods identified by the opponent are broader than those covered by the specifications. I will address this point later in the decision.

hand held computer games, electronic games not adapted for use with television receivers, video games not adapted for use with television receivers; hand-held toys, batteries, night-vision goggles and binoculars, walkie talkies.

Printed matter, stickers, stationery, coloured paper, desk sets, drawing materials, including pens, pencils, markers, crayons and colouring kits, artists' materials, including colouring books, printing blocks, stencils, arts and crafts paint kits, adhesives, drawing kits, stencils and paint brushes, moulds, moulding compounds and moulding plastic, including moulding plastic for use with activity kits.

Games and playthings, plastic toys, models, toy vehicles, model vehicles, toys including plush toys, teddy bears, action figures/figurines, character dolls and miniatures, jewellery and toy jewellery, trinket and jewellery boxes, toy kitchens and kitchen play sets, tea sets, clothing and costumes for children, including fancy dress outfits and accessories, toy makeup kits for children and young adults, toy jewellery making kits for children and young adults, doll's clothing and accessories, doll's furniture, toy wands, balls, tool kits, hobby craft kits, hobby craft kits for sewing, knitting, crocheting, stitching, hobby craft kits containing beads, cosmetics, crayons, glitter glue, glue, magnets, mirrors, modelling clays and compounds, modelling tools and accessories therefor, paints, paint brushes, paper plastic jewellery settings, threading needles and/or toy jewellery.

7. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

8. The opponent is represented by Lewis Silkin LLP and the applicant is represented by Graham Coles & Co. Both parties filed evidence in chief and the opponent filed evidence in reply. Neither party requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

9. The opponent filed evidence in chief in the form of the witness statements of David Carscadden and Helen Whelbourne dated 15 January 2020 and 17 January 2020 respectively. Mr Carscadden is the Managing Director of the opponent and his statement is accompanied by 10 exhibits. Ms Whelbourne is the attorney acting on behalf of the opponent in these proceedings and her statement is accompanied by 2 exhibits.

10. The applicant filed evidence in chief in the form of the witness statement of Gary Grant dated 20 August 2020, which is accompanied by 6 exhibits. Mr Grant is the Chairman and Chief Executive of the applicant.

11. The opponent filed evidence in reply in the form of the second witness statement of Mr Carscadden dated 22 October 2020, which is accompanied by 2 exhibits.

12. Both parties filed written submissions in lieu dated 29 December 2020.

13. Whilst I do not propose to summarise it here, I have taken all of the evidence and submissions into consideration in reaching my decision and will refer to it where necessary below.

PRELIMINARY ISSUE

14. Ms Whelbourne's evidence introduces a number of letters from third parties about the opponent's alleged reputation in the UK.³ However, none of these are accompanied by a statement of truth. They are, therefore, hearsay. Section 1 of the Civil Evidence Act 1995 provides that evidence shall not be excluded from civil proceedings on the grounds that it is hearsay evidence. However, I must consider the weight to be attributed to these documents. Section 4 of the Civil Evidence Act 1995 states:

³ Exhibit HW2

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following –

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.”

15. No explanation has been provided as to why witness statements could not have been obtained from these individuals. I have considered the above factors and come to the conclusion that little weight should be placed upon the content of these letters. In any event, I do not consider that they assist the opponent. They do not confirm the way in which the earlier marks have been used (if at all) in the market.

DECISION

Section 5(2)(b)

16. 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.”

17. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had completed their registration process more than five years before the application date of the mark in issue, they are subject to proof of use pursuant to section 6A of the Act.

18. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Proof of use

19. I will begin by assessing whether there has been genuine use of the earlier marks. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade

mark in the variant form is also registered in the name of the proprietor),
and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(5A) [...]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

20. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

21. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the date of the application in issue i.e. 24 November 2013 to 23 November 2018.

22. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v*

Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns:

Ansul at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

23. As the Third and Fourth Earlier Marks are EUTMs, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope

should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)".

At paragraphs 57 and 58, the court held that:

"Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

24. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

"228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are

to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guilford, and thus a finding which still left open the possibility of conversion of the community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State." On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to

that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

25. The General Court (“GC”) restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark).

26. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them; and
- e. The geographical extent of the use shown.

27. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the marks

28. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

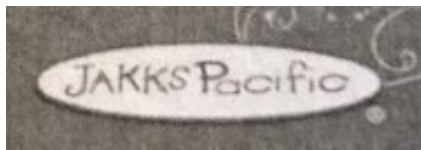
33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at

issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

29. There are examples of the earlier marks as registered throughout the evidence. Clearly, this will be use upon which the opponent can rely. There is also use in the following forms:



30. The Second and Fourth Earlier Marks are the word only JAKKS PACIFIC. The words JAKKS PACIFIC retain an independent distinctive role within the marks as used. Registration of a word only mark covers use in any standard font or typeface. Consequently, I consider these to be use of the Second and Fourth Earlier Marks as registered in accordance with *Colloseum*.

31. For the avoidance of doubt, I also consider use of the Second and Fourth Earlier Marks (and the above examples thereof) to amount to acceptable use of the First and Third Earlier Marks as registered as per *Colloseum*. This is because the First and Third Earlier Marks retain an independent distinctive role within the Second and Fourth Earlier Marks (and the above examples).

Sufficient Use

32. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁴

33. Mr Carscadden has provided print outs from Amazon showing products available for sale, specifically a chocolate egg maker, a toy magic wand, a doll, a sit-on toy

⁴ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

horse, Mario brothers figurines and an action figure.⁵ Mr Carscadden states that these products have been available since 1 August 2017, 8 August 2018, 23 October 2016, 3 June 2018, 12 December 2014 and 14 July 2015 respectively. All of the listings include the words “Jakks Pacific” or “Jakks” in the product description, the weblink or on the product.

34. Many of the photographs of product packaging are undated.⁶ There are limited examples of the earlier marks being used on product packaging within the relevant period. However, I note the following:⁷



When enlarged, it is possible to see the following:

⁵ Exhibit DC1

⁶ Exhibit DC2 and DC11

⁷ Exhibit DC2



Although the photograph itself is undated, the wording “offer ends 19/03/2014” is visible on the pricing label.

35. Mr Carscadden states that the opponent has generated the following turnover figures from sales of its products in the UK (although it is not clear whether all of this relates to products sold under the earlier marks):

Year	Annual turnover in the UK (£)	Units
2013	16,070,843	2,883,160
2014	28,292,273	4,210,801
2015	38,568,145	5,210,483
2016	33,754,345	4,577,276

2017	29,085,574	4,851,454
2018	28,038,458	4,869,559

36. Another table has been provided which lists quantities of items shipped to the UK/EU in the years 2014 to 2018, which Mr Carscadden states display the JAKKS trade mark.⁸ It is not clear what all of these items are but they include dolls, figurines, toy necklaces, journals, pencil cases, plush toys, toy video recorders and a stationary storage case. The total amount shipped for 2014 was over 120,000 units, for 2015 was over 65,000 units, for 2016 was over 120,000 units, for 2017 was over 60,000 units and for 2018 was over 120,000 units for 2018. I note that these figures are significantly less than the “units” figure provided in the above table, suggesting that the above table relates to all products sold by the opponent (not just those sold under the earlier marks). I also note that no breakdown is given as to what proportion of the shipping figures were shipped to the UK (as opposed to elsewhere in the EU).

37. I note that the opponent won Toy of the Year at the Toy Industry Awards 2014 for “Disney Frozen Snow Glow Elsa, Jakks Pacific”.⁹ Mr Carscadden has also provided a number of press articles which he states provide coverage of the earlier marks in the UK.¹⁰ Not all of the articles are dated prior to the relevant date. However, I note as follows:

- a. An article from Toy News Online (described as “The Toy Industry’s Essential Trade Website”) dated 25 July 2012 which refers to the launch of Jakks Pacific Cabbage Patch dolls launched at Harrods;
- b. An article from Dad.Info dated 4 October 2012 which refers to a give away of retro arcade games by Jakks Pacific;
- c. An article from a magazine called Toys ‘n’ Playthings dated November 2012 (described as a trade magazine) which references the launch of Cabbage Patch Dolls by Jakks Pacific at Harrods;

⁸ Exhibit DC3

⁹ Exhibit DC4

¹⁰ Exhibit DC5

d. Extracts from *Toxic Magazine* (13 November 2013), *Kraze Magazine* (December 2014) and *Beano* (11 October 2014) which advertise Jakks Pacific toy “spy gear”;

e. Extracts from Sparkle Word Magazine dated 31 August 2013 and 12 November 2014 which advertise Jakks Pacific dolls;

f. A competition that appears to have been run in *The Daily Express* to win a Jakks Pacific Elsa Doll and ski or snowboarding lessons, which confirms that the competition closes on 10 January 2017;

g. A competition via Viking FM to win a Jakks Pacific doll set, which confirms that the competition closes on 30 April 2017;

h. A competition in *Closer* to win a Jakks Pacific Disney Princess doll, which confirms that the competition closes on 30 September 2017;

38. I note that Mr Carscadden has provided “sales promotional literature” from 2012 to 2018 which he states shows use of the earlier marks in the UK.¹¹ However, the brochures provided do not appear to display the earlier marks. Mr Carscadden has also provided information about TV advertising (the content of which is confidential).¹² However, I do not consider that this information assists the opponent as no evidence is provided as to how the adverts were presented i.e. whether the earlier marks were clearly displayed. I note that in its evidence in reply, the opponent has provided examples of television commercials which display the earlier marks.¹³ However, they are dated 2019 and 2020 and are not, therefore, of use to the opponent in demonstrating the position prior to the relevant date.

39. Mr Carscadden has provided a photograph of an acceptable variant of the earlier marks in use at the Star Wars Celebration Exhibition in 2016 and the Toymaster

¹¹ Exhibit DC6

¹² Confidential Exhibit DC7

¹³ Exhibit DC12

Exhibition in 2018.¹⁴ However, no information is provided about the size of these exhibitions or the attendance levels.

40. The relevant market for assessing sufficient use for the Third and Fourth Earlier Marks is the EU market (because they are EUTMs). Consequently, the fact that a breakdown of the shipping figures between the UK and the EU has not been provided is not problematic for the opponent. Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated use of the Third and Fourth Earlier Marks in the EU in relation to dolls, figurines, toy necklaces, journals, pencil cases, plush toys, toy video recorders and stationary storage cases. In reaching this decision, I have borne in mind that there are references in the opponent's evidence to a far broader range of goods. However, there is insufficient evidence for me to conclude that these were sold under the earlier marks.

41. The position is less clear in relation to the First and Second Earlier Marks, which are UKTMs. It is use within the UK market that is relevant to my assessment for these marks. I have no way of knowing what proportion of those products described as being shipped to the UK/EU were shipped to the UK (as opposed to elsewhere in the EU). However, it is reasonable to assume that at least a proportion of them would have been shipped to the UK market. I note that Mr Carscadden has provided a list of retailers that stocked the opponent's products in the UK and Ireland during the relevant period.¹⁵ These include national retailers such as Asda, Argos, Disney Store, Smyths Toys, Wilko and Boots. However, again, he does not confirm that it is the opponent's products bearing the earlier marks which are sold through these outlets. However, the articles referred to above do reference the fact that one of the opponent's products have been sold in a well-known UK retailer (Harrods). Further, the fact that the opponent has won an award for one of its dolls indicates that there has been use in the UK. This reinforces the fact that a reasonable proportion of the shipping figures are likely to represent products shipped to the UK market. Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated genuine use in relation to the First and Second Earlier Marks.

¹⁴ Exhibits DC8 and DC9

¹⁵ Exhibit DC10

Fair Specification

42. I must now consider whether, or the extent to which, the evidence shows use of the earlier marks in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

43. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

44. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

45. As the opponent has only demonstrated genuine use in relation to a fairly narrow selection of goods covered by the earlier marks, I do not consider it appropriate to allow the opponent to retain the broad terms contained within its specification. Whilst there does appear to have been some use in relation to storage boxes for stationery, this was not included in the opponent's statement of use. I note that the use shown by the opponent does not always relate to terms specifically identified in all specifications for the earlier marks. However, even where that is the case, they represent a category

of goods covered by broader terms in those specifications (such as “stationery” or “toys”). Consequently, I consider fair specifications for the earlier marks to be:

Class 16 Journals; pencil cases.

Class 28 Dolls; figurines; toy necklaces; plush toys; toy video recorders.

46. In reaching these conclusions, I have borne in mind that the goods for which the opponent completed its statement of use are broader than those covered by its specifications for some of the earlier marks. However, as all of those goods set out in the above fair specification fall both within its statement of use and its specifications for the earlier marks, this has not impacted upon my findings.

Section 5(2)(b) – case law

47. 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 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

48. In its written submissions in lieu, the applicant made admissions in relation to the identity of the parties' respective goods as they appear in the specifications. However, given my findings above, not all of those goods covered by the opponent's specifications can be relied upon for the purposes of these proceedings. Consequently, I will carry out a full goods comparison. In light of my findings above, the competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 16</u> Journals; pen cases.	<u>Class 16</u> Printed matter; stationery; stickers; artists' materials; drawing instruments; drawing materials; writing instruments; erasers; pens; pencils; crayons; chalks; paintbrushes; pencil sharpeners; artists' modelling materials.
<u>Class 28</u> Dolls; figurines; toy necklaces; plush toys; toy video recorders.	<u>Class 28</u> Toys; playthings; none of the aforesaid being games, balls, marbles, or playing pieces for games; board games; gymnastic and sporting articles.

49. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC 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 für 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.”

50. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (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.

Class 16

51. “Journals” and “pencil cases” in the opponent’s specifications will fall within the broader category of “stationery” in the applicant’s specification. These goods will be identical on the principle outlined in *Meric*.

52. All of the applicant’s class 16 goods are likely to be sold through the same trade channels as the opponent’s “journals” and “pencil cases” i.e. stationery outlets. It is common for stationery outlets to sell both general stationery products (such as pens, pencil cases, journals, notebooks etc) and more specialised products (such as art

supplies). In more general retailers, such as supermarkets, the goods are likely to be located near each other, even if not in the same aisle. There will be overlap in user as all of the goods could be used by members of the general public or professionals. The goods will differ in nature, method of use and purpose. However, there is likely to be complementarity between at least some of the goods (such as pencil cases and pencils).¹⁶ Taking all of this into account, I consider the goods to be similar to at least a medium degree.

Class 28

53. “Dolls”, “figurines”, “toy necklaces”, “plush toys” and “toy video recorders” in the opponent’s specifications all fall within the broader categories of “Toys [...] none of the aforesaid being games, balls, marbles, or playing pieces for games” and “playthings [...] none of the aforesaid being games, balls, marbles, or playing pieces for games”. These goods will be identical on the principle outlined in *Meric*.

54. “Board games” in the applicant’s specification will be sold through the same retailers as “Dolls”, “figurines”, “toy necklaces”, “plush toys” and “toy video recorders” in the opponent’s specifications i.e. toy stores. Even where they are sold through more general retailers, such as supermarkets, they are likely to be located near each other even if not in the same aisle. There will be overlap in user and purpose. The goods will differ in nature and method of use. There may be a degree of competition between them as consumers could purchase one type of toy/game instead of another. Taking this into account, I consider the goods to be similar to between a medium and high degree.

55. That leaves “gymnastic and sporting articles” in the applicant’s specification. The opponent has filed no evidence to demonstrate that there is an overlap in trade channels in relation to these goods. However, the applicant’s evidence shows use of goods that could fall within this term being sold alongside the goods covered by the opponent’s specification on its own website. The applicant has provided print outs from

¹⁶ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

its website dated between 2014 and 2018 which show goods such as inflatable football goals, target dodgeball kits and tennis training kits sold alongside toys and games.¹⁷ Consequently, I consider that there will be an overlap in trade channels. The goods will differ in method of use and nature. I recognise that there may be an overlap in purpose at a very general level in that both could be used for the purpose of occupying/entertaining children, but their specific uses will differ. I recognise that there may be a degree of overlap in user. There is unlikely to be any meaningful competition between them and I do not consider them to be complementary. Taking all of this into account, I consider the goods to be similar to a between a low and medium degree.

Average consumer and the nature of the purchasing act

56. As the case law above indicates, it is necessary for me to determine who the average consumer is for the 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.”

57. The average consumer for the goods will be a member of the general public. The cost of purchase is likely be relatively low and the goods will be purchased reasonably frequently. However, various factors are likely to be taken into consideration. In relation to the class 16 goods, considerations such as such as suitability for particular projects or requirements, aesthetics and ease of use are likely to be taken into

¹⁷ Exhibit GG5

consideration. In relation to the class 28 goods, safety, aesthetics and suitability for particular age groups will be taken into consideration. Consequently, I consider that a medium degree of attention will be paid during the purchasing process for the goods.

58. The goods are likely to be obtained by self-selection from the shelves of a retail outlet or an online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of trade marks

59. 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.”

60. 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.

61. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade marks
<p data-bbox="252 309 735 398">JAKKS (the First and Third Earlier Marks)</p> <p data-bbox="220 472 767 562">JAKKS PACIFIC (the Second and Fourth Earlier Marks)</p>	 <p data-bbox="1008 1749 1187 1787">(Series of 5)</p>

Overall Impression

62. The First and Third Earlier Marks consist of the word JAKKS. There are no other elements to contribute to the overall impression which lies in the word itself. The Second and Fourth Earlier Marks consists of the words JAKKS PACIFIC. The overall impression of the marks lie in the combination of these words, with the word JAKKS playing the greater role due to the geographical nature of the word PACIFIC. The applicant's marks all consist of the word JACKS presented in a stylised font on an oval device with spray effect. Three of the marks in the series also have a rectangular background. It is the word JACKS which plays the greater role in the overall impression of the applicant's marks. The oval device with spray effect and stylisation (and in the case of some of the applicant's marks, the use of colour and a background) play a lesser role.

Visual Comparison

The First and Third Earlier Marks and the Applicant's Marks

63. Visually, the First and Third Earlier Marks overlap with the applicant's mark to the extent that they all contain the letters JA-KS, in the same position within words of equal lengths. In the applicant's marks the middle letter is "C" whereas in the earlier marks it is "K". This will be a point of visual difference. Further, the oval device with spray effect and (and in the case of some of the applicant's marks, the use of colour and a background) will also act as points of visual difference. The earlier marks are word only marks and so can be used in any standard font. I do not, therefore, consider that the use of stylisation in the applicant's marks acts as a significant point of difference. Taking all of this into account, I consider the marks to be visually similar to between a medium and high degree.

The Second and Fourth Earlier Marks and the Applicant's Marks

64. Visually, the same points will apply as identified in the preceding paragraph. However, there is the additional point of visual difference created by the word PACIFIC

in the earlier marks which has no counterpart in the applicant's marks. Consequently, I consider the marks to be visually similar to a medium degree.

Aural Comparison

The First and Third Earlier Marks and the Applicant's Marks

65. Aurally, the First and Third Earlier Marks will be pronounced as JAX or JAKS. The applicant's marks will also be pronounced as JAX or JAKS. The stylisation and device elements in the applicant's marks will not be articulated. Consequently, I consider the marks to be aurally identical.

The Second and Fourth Earlier Marks and the Applicant's Marks

66. Aurally, the same points will apply as identified in the preceding paragraph. However, the Second and Fourth Earlier Marks have the additional word PACIFIC which will be given its ordinary English pronunciation. This has no counterpart in the applicant's marks. Consequently, I consider the Second and Fourth Earlier Marks to be aurally similar to the applicant's marks to a medium degree.

Conceptual Comparison

The First and Third Earlier Marks and the Applicant's Marks

67. The word "JACKS" in the applicant's marks is likely to be recognised as the possessive version of a boy's name. I do not consider the absence of the apostrophe to prevent this from being the case. This is the only aspect of the applicant's mark which will convey any meaning to the average consumer. The applicant denies that the word JAKKS in the opponent's mark is likely to be viewed as a name. Whilst I recognise that it may be identified by the average consumer as an invented word, I also consider that there will be a significant proportion of average consumers who identify this as a possessive version of an alternative spelling of the boy's name Jack. For that significant proportion of average consumers, the marks will be conceptually highly similar, if not identical.

The Second and Fourth Earlier Marks and the Applicant's Marks

68. The same points apply as identified in the preceding paragraph. The Second and Fourth Earlier Marks contain the additional word PACIFIC. This will be recognised by the average consumer as the name of an ocean. It is likely to be seen as indicating a particular region at which the business is targeted or from which it originates. This will act as a point of conceptual difference between the marks. Consequently, I consider the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier trade marks

69. 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).”

70. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

71. I will begin by assessing the enhanced distinctive character of the earlier marks. The relevant market for assessing enhanced distinctiveness of all the earlier marks is the UK market. As noted above, there are issues in relation to the opponent's evidence of use in the UK market. In addition to the evidence discussed above, I note that Mr Carscadden states that the opponent has spent the following amounts on promoting its products in the UK:

Year	Annual expenditure in UK (£)
2012	1,277,859
2013	1,446,988
2014	1,518,236
2015	3,607,459
2016	5,429,711
2017	2,816,566
2018	2,932,031

72. However, again, no information is provided about what proportion of these figures relate to goods sold under the marks in issue. As noted above, it seems that the opponent overall sales relate to goods sold both under the earlier marks and other marks not relied upon in these proceedings. It seems reasonable to conclude that the same will also be true of the opponent's total advertising expenditure for the UK. Without having a breakdown of the shipping and turnover figures provided, I have no way of assessing market share or intensity of the use. Further, I have limited information about how geographically widespread use of the marks have been.

73. Taking all of the evidence into account, I am unable to conclude that the earlier marks have acquired enhanced distinctiveness through use. I have, therefore, only the

inherent position to consider. The earlier marks all consist of or contain the word JAKKS. As noted above, this will either be viewed as an invented word or an alternative possessive spelling of the boy's name "Jack". If it is viewed as an invented word, it is likely to be inherently distinctive to a relatively high degree. If it is viewed as an alternative possessive spelling of the boy's name "Jack" then it will be inherently distinctive to a medium degree. The Second and Fourth Earlier Marks also contain the word PACIFIC. The applicant submits that this "is a distinctive term in relation to all of the contested goods and is the longest element of the Opponent's two-word mark". However, as this will be seen as a geographical reference, I do not consider that this will add significantly to the distinctiveness of the mark.

Likelihood of confusion

74. 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 down to the responsible undertaking 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 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 and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, 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.

75. I have found the First and Third Earlier Marks and the applicant's marks to be visually similar to between a medium and high degree, aurally identical and (for a significant proportion of average consumers) conceptually highly similar, if not identical. I have found the Second and Fourth Earlier Marks and the applicant's marks to be visually and aurally similar to a medium degree and (for a significant proportion of average consumers) conceptually similar to a medium degree. I have found the

word “JAKKS” in the earlier marks to have either a medium or relatively high degree of inherent distinctive character depending upon how it is interpreted. I do not consider that the addition of the word PACIFIC to the Second and Fourth Earlier Marks contributes significantly to their distinctiveness as it will be seen as a geographical reference. I have found the average consumer to be a member of the general public, who will purchase the goods predominantly through visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the goods to vary from identical to similar to between a low and medium degree.

76. Mr Grant has filed evidence to show that both the applicant’s and the opponent’s products have been sold through the same retailers.¹⁸ Mr Grant goes on to state:

“11. The Applicant is not aware of any instance of any customer ever being confused between the Applicant’s Mark and any of the trade marks applied to the products supplied by the Opponent, or even making an association between the Applicant’s JACKS products and the Opponent.”

77. In its written submissions in lieu, the opponent states:

“18. [...] The lack of evidence of confusion is not itself proof that no confusion occurred and is simply an indication that consumers either were unaware that they had purchased the wrong product or did not complain.”

78. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a

¹⁸ Exhibit GG3

likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

79. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

80. As the opponent notes, it is entirely possible that confusion has occurred but customers have not realised it and/or have not reported it. Consequently, I do not find this line of argument to be particularly persuasive.

81. There are clearly similarities between the word elements of both marks. However, given that the purchasing process is predominantly visual, I recognise that the presence of the oval device with spray effect is unlikely to be overlooked. Consequently, I do not consider it likely that the marks will be misremembered or mistakenly recalled. I do not consider there to be a likelihood of direct confusion.

82. However, the words themselves are likely to be mistakenly recalled by a significant proportion of average consumers. For the significant proportion of average consumers who view the word JAKKS in the earlier marks as an alternative spelling for the name “Jack” in possessive form, they are likely to just remember the name itself, and not the slight difference in spelling. The difference in presentation created by the oval device with spray effect/stylisation and colour is likely to be seen as an alternative mark being used by the same or economically connected undertakings. I also consider that the geographical nature of the additional word PACIFIC in the Second and Fourth Earlier

Marks will lead average consumers to conclude that this is a branch of the same business which is targeting (or originating from) a different geographical region. In making this finding, I bear in mind that for the significant proportion of average consumers for which this conceptual overlap will apply, the earlier marks will be inherently distinctive to only a medium degree (as opposed to a relatively high degree). Taking all of the above factors into account, I consider there to be a likelihood of indirect confusion for all of the goods.

83. The opposition based upon section 5(2)(b) of the Act succeeds in its entirety.

Honest Concurrent Use

84. I note that in its written submission in lieu, the applicant states:

“Furthermore, or in the alternative, to the extent that the Opponent claims to have applied the Opponent’s Marks to the goods concerned, the parties have traded for many years in circumstances that (in each case) the relevant public has been exposed to both marks and have been able to differentiate between them without confusion as to trade origin.

Such honest concurrent use is one of the relevant factors that must be taken into account in the global consideration of likelihood of confusion.”

85. In reaching my conclusion above, I have borne the applicant’s submissions in this regard in mind.

86. The *Budweiser* case shows that honest concurrent use may be relevant in trade mark opposition and cancellation proceedings. Further, it also states that circumstances that give rise to this defence would have to be exceptional.¹⁹ For a defence of honest concurrent use to succeed, I would need to be satisfied that the parties have traded in circumstances that the relevant public have been exposed to both marks and have been able to differentiate between them without confusion as to

¹⁹ Paragraph 76, *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09

trade origin. I have evidence of use for a period of between 2012 and 2019 for the opponent and between 2013 and 2019 for the applicant. The evidence of use relating to the earlier marks in relation to the UK market is limited and unclear. Taking all of this into account, I do not consider the evidence in this case to amount to the 'exceptional' circumstances identified in the *Budweiser* case. Consequently, I do not consider that this line of argument assists the applicant.

Section 5(3)

87. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

88. As noted above, by virtue of their earlier filing dates, the opponent's marks qualify as earlier marks pursuant to section 6 of the Act. I have found that the opponent has satisfied the proof of use requirements pursuant to section 6A of the Act in relation to some of the goods relied upon.

89. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later

marks. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

90. The relevant date for the assessment under section 5(3) of the Act is the date of the application i.e. 23 November 2018.

Reputation

91. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

92. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its marks will be known by a

significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”

93. The Third and Fourth Earlier Marks are EUTMs and the opponent must, therefore, establish a reputation in the EU. The First and Second Earlier Marks are UKTMs and the opponent must, therefore, establish a reputation in the UK. As noted above, the evidence in the UK market is far from conclusive. The opponent does have the additional benefit of being able to rely upon full shipment figures as identified for goods bearing the marks shipped to the UK/EU. The total amount shipped for 2014 was over 120,000 units, for 2015 was over 65,000 units, for 2016 was over 120,000 units, for 2017 was over 60,000 units and for 2018 was over 120,000 units for 2018. Given what must undoubtedly be a significant market for these goods in the EU, I do not consider these sales to be particularly significant. I have no breakdown regarding what proportion of promotional expenditure relates to the marks relied upon. I recognise that the opponent has won an award and that there has been some (albeit fairly limited) coverage in the press. Taking all of the evident into account, I am not satisfied that the opponent has demonstrated a reputation in the EU.

94. The opposition based upon section 5(3) of the Act is dismissed.

Section 5(4)(a)

95. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

96. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

97. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

98. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-

410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

99. The prima facie relevant date is the date of the application i.e. 23 November 2018. However, as the applicant also claims to have used the mark prior to filing, I must consider what the position would have been at the date upon which the behaviour complained about commenced.

100. In his witness statement, Mr Grant states:

“10. Continuously since 2013, the Applicant’s “JACKS” products have been stocked and offered for sale under the Applicant’s Mark in all of the Applicant’s “bricks and mortar” stores and promoted and sold via the Applicant’s website. [...]”

101. Mr Grant goes on to state that the total sales of the applicant’s JACKS products sold under the Applicant’s Mark are as follows:

Financial Year	Applicant’s JACKS products (£)
1 February 2012 – 31 January 2013	833,502
1 February 2013 – 31 January 2014	1,229,299

1 February 2014 – 31 January 2015	6,409,442
1 February 2015 – 31 January 2016	2,576,765
1 February 2016 – 31 January 2017	2,968,318
1 February 2017 – 31 January 2018	2,716,890
1 February 2018 – 31 January 2019	6,623,147

102. These sales relate to a range of games and children’s stationary/craft products.²⁰ Printouts from the applicant’s website dated May 2014, September 2014, March 2015, October 2015, March 2016, May 2016, April 2017, September 2017 and February 2018 showing such goods available for sale have been provided.²¹

103. It seems clear to me from the evidence filed that the applicant has used its mark continuously since the beginning of 2013. I will, therefore, also consider the position at the date upon which the behaviour complained of commenced i.e. 1 January 2013.

Goodwill

104. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

105. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of

²⁰ Exhibit GG4

²¹ Exhibit GG5

reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

106. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

107. As noted above, Mr Carscadden has provided turnover figures from sales of its products in the UK. However, no breakdown of what proportion of these figures relate to products bearing the earlier signs have been provided. As noted above, the

shipment figures for products bearing the earlier signs provided relate to the UK/EU for the years 2014 to 2018. These are significantly lower than the unit figures provided for total sales by the opponent (alongside its turnover figures above). It is, therefore, a reasonable inference that only a proportion of these UK sales relate to products bearing the earlier signs. Again, I have no way of knowing what proportion of the figures for shipments to the UK/EU relate to the UK market (as opposed to elsewhere in the EU).

108. Clearly, given the sales figures set out above for the UK market, as well as the advertising expenditure identified above, it is clear that the opponent itself had goodwill prior to both relevant dates. However, very little evidence about use of the signs relied upon has been provided in relation to the period prior to the applicant's first use. I recognise that some of the press releases about the earlier signs date back to 2012.²² However, the sale figures for 2012 are not broken down to confirm what proportion were sold under the earlier signs and the shipment figures are not broken down to identify what proportion relate to the UK market. The same is also true of the figures provided for prior to the prima facie relevant date. Consequently, I am unable to find that the earlier marks were distinctive of the opponent's goodwill at both relevant dates.

109. The opposition based upon section 5(4)(a) of the Act is dismissed.

CONCLUSION

110. The opposition based upon section 5(2)(b) is successful and the application is refused.

COSTS

111. 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. Although the official fee paid by the opponent was £200 (as it pleaded section 5(3) and 5(4)(a)

²² Exhibit DC5

grounds), it has only been successful in relation to its section 5(2)(b) ground which would have attracted a fee of only £100. Consequently, I do not consider it appropriate to award the opponent the full official fee. In the circumstances, I award the opponent the sum of **£1,750**, calculated as follows:

Preparing a statement and considering the applicant's statement	£400
Filing evidence and considering the applicant's evidence	£850
Written submissions in lieu	£400
Official fee	£100
Total	£1,750

112. I therefore order The Entertainer (Amersham) Limited to pay JAKKS Pacific, Inc. the sum of £1,750. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 23rd day of February 2021

S WILSON
For the Registrar

ANNEX 1

First Earlier Mark

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; magnetic data carriers; recording discs; optical discs; sound recordings; video recordings; tapes; cassettes; compact discs; films; television programmes; animated cartoons; slides; video cassettes; video recorders; CD ROMS; DVDs; games adapted for use with televisions; portable gaming systems; electronic mats; electronic floor mats; electronic games adapted for use with television receivers; video games adapted for use with television receivers; computer games; computer game cassettes; computer game software recorded onto magnetic or optical discs; video game software; computer programs; computer software; computer hardware; electronic publications; video cameras; cameras; photographic transparencies; photographic films; batteries; encoded magnetic cards; magnetic identity cards; credit cards; debit cards; spectacles; spectacle cases; spectacle frames; sunglasses; mouse mats; karioke machines; televisions; monitors; visual display units; microphones; headphones; headsets; loud speakers; sound systems; accessories for the aforementioned goods.

Class 16 Printed matter; newspapers; periodical publications; magazines; books; photographs; pictures; prints; directories; posters; greeting cards; postcards; notepads; address books; theme books; scrapbooks; folders; catalogues; tickets; programmes; printed cartoons; comics; calendars; photograph albums; diaries; journals; booklets; postage stamps; covers for postage stamps; stamp albums; stickers; decalcomanias; cards; cardboard articles; stationery; office requisites; typewriters; pens; pencils; markers; crayons; chalk; erasers; pencil sharpeners; pencil cases; rulers; boxes for pens; desk sets; book markers; binders; drawing

materials; artists' materials; instructional and teaching materials; paper handkerchiefs; pads; labels; wrapping and packaging materials; gift bags; carrier bags; envelopes; photograph corners; blackboards; height charts; napkins; tablecloths; mats; coasters; plates; bowls; and cups of paper; flags of paper; pennants of paper; colouring books; children's activity books; printing blocks; stamps; rubber stamps; stationary; stickers; wrapping paper; children's storybooks; decals; stencils; diaries; appointment books; arts and crafts paint kits, drawing kits, colouring kits; moulds; moulding plastic; moulding plastic for use with activity kits; scrapbooks; kits for making scrapbooks and accessories; paper products including notebook paper, note pads, die cut note pads, coloured paper, construction paper; stickers; stencils; photo corners; adhesives for stationery or household purposes; paint brushes; instructional and teaching materials.

- Class 20 Articles made from plastic materials; articles made from plastics; articles of wax; sleeping bags; sleeping mats; bean bags; trinket boxes; boxes for storing toys; boxes for jewellery; action figures (decorative); mirrors.
- Class 21 Lunch boxes; action figures (decorative); applicators for cosmetics; applicators in nature of sponges; powder puffs; powder compacts; table ware (not of precious metals); storage boxes; flasks.
- Class 25 Articles of outer clothing; articles of underclothing; articles of sports and leisure clothing; articles of waterproof clothing; swimwear; footwear; headgear; scarves; football shirts; shorts; socks; sweatshirts; tracksuits; t-shirts; hats and caps; jackets; coats; pyjamas; slippers; aprons; wristbands; headbands; sun visors; belts; braces; ties; football boots; trainers; articles of clothing; footwear and headgear for babies and toddlers and children.
- Class 28 Toys; playthings; board games; games; plush toys; plush stuffed toys; teddy bears; figurines; puzzles; jigsaw puzzles; sporting articles; sporting equipment; decorations and ornaments suitable for Christmas

trees; Christmas crackers and decorations; hand-held computer games; balloons; puppets; models; character dolls and miniatures; dolls; dolls' clothing and accessories; dolls' houses; dolls' furniture; beanbags in the form of playthings; sports balls; playground balls; foam balls; shin guards; football gloves; gymnastic articles; playing cards; moulding compounds, being toys; toy action figures; toy makeup kits for children and young adults; toy jewellery making kits for children and young adults; hobby craft kits, namely, hobby craft kits for sewing, knitting, crocheting, stitching; hobby craft kits comprising beads, cosmetics, crayons, glitter, glitter glue, glue, magnets, markers, mirrors, modelling clays and compounds, modelling tools and accessories therefor, paints, paint brushes, paper, plastic jewellery settings, threading needles and/or toy jewellery; accessories for the aforementioned goods; electronic games not adapted for use with television receivers; video games not adapted for use with television receivers; hand-held toys; model aeroplanes; model cars; model figures; model vehicles; children's costumes; coin/counter operated games; electronic dance mats.

Second Earlier Mark

- | | |
|----------|---|
| Class 9 | Computer game software recorded on magnetic or optical discs; video game software. |
| Class 16 | Printed matter; stationery; pens and pencils; markers; crayons; chalk; erasers; pen cases; notebooks, journals, binders, note pads, rulers, folders; desk sets. |
| Class 20 | Sleeping bags. |
| Class 21 | Lunch boxes. |
| Class 28 | Games and playthings; hand-held toys; hobby crafts in kit-form, all being childrens' toys; craft toys sold complete or in kit-form; model aeroplanes; model cars; model figures; model toys; model vehicles; models; action |

figures; play sets; accessories for all the aforesaid goods; sporting articles; plush toys; puppets; Christmas decorations; board games; electronic toys and electronic games; childrens' costumes; toy jewellery; mechanical design toys; toys and playthings in the form of make-up kits.

Third Earlier Mark

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; magnetic data carriers; recording discs; optical discs; sound recordings; video recordings; tapes; cassettes; compact discs; films; television programmes; animated cartoons; slides; video cassettes; video recorders; CD ROMS; DVDs; games adapted for use with televisions; portable gaming systems; coin/counter-operated games; electronic mats; electronic dance mats; electronic floor mats; electronic games adapted for use with television receivers; video games adapted for use with television receivers; computer games; computer game cassettes; computer game software recorded onto magnetic or optical discs; video game software; computer programs; computer software; computer hardware; electronic publications; video cameras; cameras; photographic transparencies; photographic films; batteries; encoded magnetic cards; magnetic identity cards; credit cards; debit cards; spectacles; spectacle' cases; spectacle frames; sunglasses; mouse mats; karaoke machines; televisions; monitors; visual display units; microphones; headphones; headsets; loud speakers; sound systems; accessories for the aforementioned goods.

Class 16 Printed matter; newspapers; periodical publications; magazines; books; photographs; pictures; prints; directories; posters; greeting cards; postcards; notepads; address books; theme books; scrapbooks; folders; catalogues; tickets; programmes; printed cartoons; comics; calendars; photograph albums; diaries; journals; booklets; postage stamps; covers

for postage stamps; stamp albums; stickers; decalcomanias; cards; cardboard articles; stationery; office requisites; typewriters; pens; pencils; markers; crayons; chalk; erasers; pencil sharpeners; pencil cases; rulers; boxes for pens; desk sets; book markers; binders; drawing materials; artists' materials; instructional and teaching materials; paper handkerchiefs; pads; labels; wrapping and packaging materials; gift bags; carrier bags; envelopes; photograph corners; blackboards; height charts; napkins; tablecloths; mats; coasters; plates; bowls; and cups of paper; flags of paper; pennants of paper; colouring books; children's activity books; printing blocks; stamps; rubber stamps; stationary; stickers; wrapping paper; children's storybooks; decals; stencils; diaries; appointment books; arts and crafts paint kits, drawing kits, colouring kits; moulds; moulding plastic; moulding plastic for use with activity kits; scrapbooks; kits for making scrapbooks and accessories; paper products including notebook paper, note pads, die cut note pads, coloured paper, construction paper; stickers; stencils; photo corners; adhesives for stationery or household purposes; paint brushes; instructional and teaching materials.

Class 20 Articles made from plastic materials; articles made from plastics; articles of wax; sleeping bags; sleeping mats; bean bags; trinket boxes; boxes for storing toys; boxes for jewellery; action figures (decorative); mirrors.

Class 21 Lunch boxes; action figures (decorative); applicators for cosmetics; applicators in nature of sponges; powder puffs; powder compacts; table ware (not of precious metals); storage boxes; flasks.

Class 28 Toys; playthings; board games; games; plush toys; plush stuffed toys; teddy bears; figurines; puzzles; jigsaw puzzles; sporting articles; sporting equipment; decorations and ornaments suitable for Christmas trees; Christmas crackers and decorations; hand-held computer games; balloons; puppets; models; character dolls and miniatures; dolls; dolls' clothing and accessories; dolls' houses; dolls' furniture; beanbags in the form of playthings; sports balls; playground balls; foam balls; shin

guards; football gloves; gymnastic articles; playing cards; moulding compounds, being toys; toy action figures; toy makeup kits for children and young adults; toy jewellery making kits for children and young adults; hobby craft kits, namely, hobby craft kits for sewing, knitting, crocheting, stitching; hobby craft kits comprising beads, cosmetics, crayons, glitter, glitter glue, glue, magnets, markers, mirrors, modelling clays and compounds, modelling tools and accessories therefor, paints, paint brushes, paper, plastic jewellery settings, threading needles and/or toy jewellery; accessories for the aforementioned goods; electronic games not adapted for use with television receivers; video games not adapted for use with television receivers; hand-held toys; model aeroplanes; model cars; model figures; model vehicles; children's costumes.

Fourth Earlier Mark

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; magnetic data carriers; recording discs; optical discs; sound recordings; video recordings; tapes; cassettes; compact discs; films; television programmes; animated cartoons; slides; video cassettes; video recorders; CD ROMS; DVDs; games adapted for use with televisions; portable gaming systems; coin/counter-operated games; electronic mats; electronic dance mats; electronic floor mats; electronic games; video games; computer games; computer game cassettes; computer programs; computer software; computer hardware; electronic publications; video cameras; cameras; photographic transparencies; photographic films; batteries; encoded magnetic cards; magnetic identity cards; credit cards; debit cards; spectacles; spectacle cases; spectacle frames; sunglasses; mouse mats; karaoke machines; televisions; monitors; visual display units; microphones; headphones; headsets; loud speakers; sound systems; accessories for the aforementioned goods.

Class 16 Printed matter; newspapers; periodical publications; magazines; books; photographs; pictures; prints; directories; posters; greeting cards; postcards; notepads; address books; theme books; scrapbooks; folders; catalogues; tickets; programmes; printed cartoons; comics; calendars; photograph albums; diaries; journals; booklets; postage stamps; covers for postage stamps; stamp albums; stickers; decalcomanias; cards; cardboard articles; stationery; office requisites; typewriters; pens; pencils; markers; crayons; erasers; pencil sharpeners; pencil cases; rulers; boxes for pens; book markers; drawing materials; artists' materials; instructional and teaching materials; paper handkerchiefs; pads; labels; wrapping and packaging materials; gift bags; carrier bags; envelopes; photograph corners; blackboards; height charts; napkins; tablecloths; mats; coasters; plates; bowls; and cups of paper; flags of paper; pennants of paper; colouring books; children's activity books; printing blocks; stamps; rubber stamps; stickers; wrapping paper; children's storybooks; decals; stencils; diaries; appointment books; arts and craft paint kits, drawing kits, colouring kits; moulds; moulding plastic; moulding plastic for use with activity kits; scrapbooks; kits for making scrapbooks and accessories; paper products including notebook paper, note pads, die cut note pads, coloured paper, construction paper; stickers; stencils; photo corners; adhesives for stationery or household purposes; paint brushes; instructional and teaching materials.

Class 28 Toys; playthings; board games; games; plush toys; plush stuffed toys; teddy bears; figurines; puzzles; jigsaw puzzles; sporting articles; sporting equipment; decorations and ornaments suitable for Christmas trees; Christmas crackers and decorations; hand-held computer games; balloons; puppets; models; character dolls and miniatures; dolls; dolls' clothing and accessories; dolls' houses; dolls' furniture; beanbags in the form of playthings; sports balls; playground balls; foam balls; shin guards; football gloves; gymnastic articles; playing cards; moulding compounds, being toys; toy action figures; toy makeup kits for children and young adults; toy jewellery making kits for children and young adults; toy hobby craft kits, namely, hobby craft kits for sewing, knitting,

crocheting, stitching; toy hobby craft kits, comprising beads, cosmetics, crayons, glitter, glitter glue, glue, magnets, markers, mirrors, modelling clays and compounds, modelling tools and accessories therefor, paints, paint brushes, paper, plastic jewellery settings, threading needles and/or toy jewellery; accessories for the aforementioned goods.

ANNEX 2

- Class 9 Scientific and teaching apparatus and instruments; apparatus for recording, transmission, reproduction of sound; television programmes; games adapted for use with televisions; portable gaming systems; electronic games adapted for use with television receivers; video games adapted for use with television receivers; computer games; video game software; computer programs; computer software; computer hardware; electronic publications; batteries; accessories for the aforementioned goods.
- Class 16 Printed matter; stickers; cardboard articles; stationery; pens; pencils; markers; crayons; chalk; erasers; pencil sharpeners; pencil cases; rulers; boxes for pens; desk sets; drawing materials; artists' materials; instructional and teaching materials; colouring books; children's activity books; printing blocks; stationary; children's storybooks; stencils; arts and crafts paint kits, drawing kits, colouring kits; moulds; moulding plastic; moulding plastic for use with activity kits; paper products including notebook paper, note pads, coloured paper, construction paper; stencils; adhesives for stationery or household purposes; paint brushes.
- Class 28 Toys; playthings; board games; games; plush toys; plush stuffed toys; teddy bears; figurines; puzzles; jigsaw puzzles; sporting articles; sporting equipment; hand-held computer games; models; character dolls and miniatures; dolls; dolls' clothing and accessories; dolls' houses; dolls' furniture; foam balls; moulding compounds, being toys; toy action figures; toy makeup kits for children and young adults; toy jewellery making kits for children and young adults; hobby craft kits, namely, hobby craft kits for sewing, knitting, crocheting, stitching; hobby craft kits comprising beads, cosmetics, crayons, glitter, glitter glue, glue, magnets, markers, mirrors, modelling clays and compounds, modelling tools and accessories therefor, paints, paint brushes, paper, plastic jewellery settings, threading needles and/or toy jewellery; accessories

for the aforementioned goods; electronic games not adapted for use with television receivers; video games not adapted for use with television receivers; hand-held toys; model aeroplanes; model cars; model figures; model vehicles; children's costumes.