

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION m 2049216  
BY MIRROR TELEVISION LIMITED  
TO REGISTER THE TRADE MARK  
**NEWS BUNNY**

AND

IN THE MATTER OF OPPOSITION  
THERE TO UNDER OPPOSITION m 45785 BY  
HENRI FETTER FASHION B.V.

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by Mirror Television Limited  
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5 **NEWS BUNNY**

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Henri Fetter Fashion B.V.

10 **DECISION**

Mirror Television Limited (MTL) applied on 21 December 1995 to register a series of three  
marks 'NEWS BUNNY', 'NEWSBUNNY' and 'NEWS-BUNNY' in classes 03, 09,16, 18,  
21, 24, 25, 28 and 41. On 13 August 1997 MTL applied to divide the application so that the  
mark could proceed for classes 03, 09,16, 18, 21, 24, 28 and 41; that is, excluding class 25,  
15 which consists of:

“Articles of underclothing; coats, jackets, suits, skirts, dresses, jumpers, pullovers,  
blouses, trousers, slacks, shorts, dungarees, shirts, t-shirts, sweat-shirts, sweaters,  
smocks, hats, stockings, neck-ties, scarves, headsquares, aprons, slippers, shoes and  
20 footwear; jeans, caps, berets, tights, belts, socks, swim-wear and beach-wear, pyjamas,  
nightdresses, bathing and shower caps, bath robes, bath sandals and bath slippers,  
clothing for babies and for toddlers, bibs, babies napkins of textile; overalls, visors and  
shades ”.

The application is opposed by Henri Fetter Fashion B.V.

Their grounds of opposition are:

25 **Ž** The mark applied for does not fulfil the requirements of section 1(1) of the Act  
and, therefore, falls within the prohibitions on registration in section 3(1)(a) of the  
Act as it is a sign which is not capable of distinguishing the goods of one  
undertaking from those of another.

30 **Ž** Section 5(2)(a), in that the Opponents have similar marks registered for identical or  
similar goods such that there exists a likelihood of confusion on the part of the  
public, which includes the likelihood of association with these earlier marks.

**Ž** Section 5(4)(a), insofar that use of the mark applied for is liable to be prevented by  
any rule of law protecting an unregistered trade mark or any other sign used in the  
course of trade.

35 **Ž** Registration of the mark should be refused in the exercise of the Registrar's  
judgement.

The Opponents have registered the mark:

	<b>MARK</b>	<b>m .</b>	<b>CLASS</b>	<b>GOODS</b>	<b>STATUS</b>
5	NEWS FLASH & Device	1256552	25	Articles of outer clothing, but not including footwear.	Registered 16.12.1985

And have applied for the following:

	<b>MARK</b>	<b>m .</b>	<b>CLASS</b>	<b>GOODS</b>	<b>STATUS</b>
10	NEWS CLOTHING & Device	1501851	25	Articles of outer clothing.	Filed on 22.5.1992. Examined.
	NEWS <sup>D</sup> COLLECTION & Device	1507748	25	Articles of outer clothing.	Filed on 20.7.1992. Advertised 3.11.1993. Opposed.
	NEWS (word)	1569844	25	Articles of outer clothing for men and women.	Filed on 22.4.1994. Advertised 13.11.1996. Opposed.

15 The Applicants responded denying each of the grounds pleaded. Both parties ask for an award of costs in their favour.

Neither party has requested a hearing, accepting instead that the Registrar should make his decision on the basis of the submitted written evidence. Acting on the Registrar's behalf and after a careful study of all the papers, I now give this decision.

## The Evidence

The Opponents' evidence takes the form of a Statutory Declaration dated 22 April 1997 by Peter H van der Meché, who is the Financial Director of Henri Fetter Fashion B.V., the Opponents in these proceedings.

- 5 Mr van der Meché explains that his company sells clothing and has a current turn over of £12M. This includes the home market in the Netherlands and export to other countries, which includes the UK.

Approximate annual turnover figures 'for goods sold under the trade mark NEWS' in the UK since 1985 are:

10	Year	Approximate Sales Value (£ Sterling)
	1985	145,440
	1986	446,357
	1987	506,647
	1988	180,557
15	1989	91,558
	1990	41,052
	1991	28,748
	1992	16,789
	1993	87,352
20	1994	250,824
	1995	245,261
	1996	243,852

- 25 Mr van der Meché states that Henri Fetter Fashion B.V. sold its products 'under the NEWS trade mark' through distributors in the UK, with the number of garments sold since 1993 being:

	Year	Number of garments
	1993	8,340
	1994	23,700
	1995	23,072
5	1996	22,426

Evidence is produced said to indicate promotion of goods sold in the UK. This consists of several catalogues, depicting leisure wear, and covering the period between 1988 to 1996. Most of the catalogues contain a reference to the Company's current sole distributor in the UK, the Holywell Trading Company Limited, based in West Yorkshire.

10 Mr van der Meché claims that the current and previous distributors have regularly promoted the goods sold under the NEWS trade mark in the UK by participating in National Exhibitions. Two documents are produced in evidence to support this contention. The first is a copy of letter dated 6 February 1989 from the Company's then distributors and an invoice dated 18 February 1989 both relating to an exhibition held at the Olympia Trade Exhibition Centre,  
15 Kensington, London 1989. The second is a photograph, claimed to be of the current distributors stand at the Premier Menswear Exhibition 20 - 24 February 1994.

Finally, Mr van der Meché concludes his evidence by referring to the four trade marks listed above, reproduced in evidence. He states that his company has used the NEWS CLOTHING trade mark in various formats since 1988, and also the trade mark NEWS<sup>D</sup> COLLECTION &  
20 Device (as applied for under 1507748). He completes his declaration by stating 'that use of the mark opposed...would cause deception and confusion in the marketplace'.

The Applicants' evidence consists of a statutory declaration by Richard John Horwood who is the Deputy Managing Director of MTL. Mr Horwood states that MTL own 90% of Live TV, which he describes as 'a 24 hour cable exclusive entertainment channel' which is received 'by  
25 over 4 million adult cable viewers. Live TV is renowned for its innovative programming'. This apparently includes the weather in Norwegian, Topless Darts and News Bunny.

The latter is a brown and white rabbit (played by an actor in a bunny suit), which stands behind the presenters during Live TV news programmes, and provides a silent commentary on news stories (e.g. 'thumbs up' for good news). Mr Horwood states that News Bunny has  
30 received immense publicity since it first appeared on Live TV in January 1996.

A large number of press cuttings are provided in evidence of this. (In passing, Mr Horwood refers to this evidence as being in exhibit RJH1; in fact it is at RJH2). The cuttings cover all sections of the press, including all the 'broad sheets' and tabloids. A number of local papers and more specialist publications are also included.

35 Mr Horwood refers to a further publicity stunt in which a Live TV reporter changed his name by deed poll to News Bunny and stood for Parliament in the South East Staffordshire by-election. This apparently was widely reported on both television and radio.

Mr Horwood states that ‘over 4 million people are able to view News Bunny on a daily basis’ and because of the notoriety achieved through publicity stunts and the extensive media coverage ‘..the majority of the UK population are aware of News Bunny, and also that News Bunny is connected with the Applicant’. He adds that the ‘..UK public will immediately  
5 associate any use of the Mark in respect of Class 25 goods, which would be considered by the public as a likely merchandising spin off, with the Applicant. I consider it highly unlikely that any member of the public would be confused as to the origin of any Class 25 goods..’.

He adds that the Applicants have invested approximately £80,0000 each year in promoting News Bunny and that ‘there is a very real concern that third parties may seek to commercially  
10 exploit the Mark in relation to Class 25 goods and its is imperative that the Applicants should be able to protect its considerable investment and goodwill.’.

Though the Applicants has not yet used the mark in relation to Class 25 goods, Mr Horwood states that it has an intention to do so, citing a sponsorship agreement with Millwall Football Club.

Mr Horwood refers to printouts from an on line trade mark facility that lists the Opponents’ marks NEWS CLOTHING & Device, NEWS FLASH & Device and NEWS<sup>D</sup> COLLECTION & Device. (In passing, Mr Horwood refers to this evidence as being in exhibit RJH2; in fact it is at RJH1). He also refers to the following trade marks that include the word ‘NEWS’, all either registered or applied for in Class 25.

	<b>Application m</b>	<b>Mark</b>
20	1166210	News
	1339716	News
	1414281	News
	1416472	Country News
25	1416474	City News
	1416478	Foreign News
	1416479	Sports News
	1416533	Good News
	1416534	World News
30	1416539	Evening News
	1416541	International News
	1446401	BBC Breakfast News

	<b>Application m</b>	<b>Mark</b>
	1499280	Worldwide Entertainment News
	1507748	News D Collection
	1501851	News Clothing
5	1256552	Newsflash
	1569844	News

Mr Horwood states that the extensive use of NEWS in Class 25 has lead to a substantial dilution of the distinctiveness of this word. Furthermore, the ‘Bunny’ element of the mark ‘NEWS BUNNY’ is of greater relative significance and this makes it clearly distinguishable from the Opponents’ mark. Added to this, he does not believe there is a likelihood of confusion between the Opponents’ mark and NEWS BUNNY because there are significant visual and aural differences between them, making it more distinctive than others that have received registration listed above.

Mr Horwood concludes: ‘For the above reasons I do not believe that there is a possibility of confusion between the Opponents’ marks and this Application. Due to the number of marks already registered in Class 25 incorporating the word “News” it is apparent that the word “News” has lost its distinctiveness to a certain extent in relation to Class 25 goods. The Mark is distinctive due to the “Bunny” element. Therefore, on a “mark for mark” comparison with the Opponents’ Marks the marks are distinguishable. Furthermore, the distinction between the marks will be reinforced as News Bunny will be immediately recognised by the public as being the News Bunny featured on Live TV.’

Also received as evidence in reply from the Opponents’ is a statutory declaration from Ms Sarah Orchard, a Trade Mark Attorney and Registered Trade Mark Agent for D Young and Co., the agents for the Opponents in this matter. Ms Orchard states that, on the evidence of Mr Horwood, ‘NEWS BUNNY’ is a concept (a brown and white rabbit played by an actor) and not a trade mark within the meaning of the Act.

Ms Orchard strongly denies that the majority of the UK population, as claimed by Mr Horwood, are aware of News Bunny, as no specific evidence is provided to support this statement. She disputes the numbers of homes which can receive Live TV, pointing to an article in the Financial Times that gives this figure as 1.1 million cable users.

Ms Orchard also states that there is no specific evidence that MTL have actively promoted their mark, nor is there evidence to support the statement that, as a result of the notoriety of the News Bunny character, there is a concern that third parties may seek to commercially exploit the mark in relation to Class 25 good. Further, no evidence is provided as to the sponsorship deal with Millwall Football Club.

In referring to the number of existing trade mark applications listed by Mr Horwood (and reproduced above), which include the word ‘news’, Ms Orchard states that registration Nos.

1256552, 1507748 and 1569844 are owned by the Opponents. She adds that 'Registration Nos. 1166210 and 1339716 are the subject of rectification actions by the Opponents. Application Nos. 1414281, 1416472, 1416474, 1416478, 1416479, 1416533, 1416534, 1416539, 1416541 and 1501851 are the subject of opposition actions by the Opponents. Ms Orchid contends that '...the existence of these pending applications and registrations does not support the assertion that there has been "extensive" use of NEWS in Class 25 and no evidence has been filed to support the further assertion that such alleged use has led to a substantial dilution of distinctiveness in the word "news" in Class 25.'

The Opponents, says Ms Orchid, do not deny that the character known as News Bunny, defined as 'a brown and white bunny ... played by an actor' is distinguishable from their marks and cites a copy of a letter in evidence sent by a colleague Dawn Moodie dated 13 March 1997 which attempted to settle this matter by suggesting that the Applicants limit their use and registration of NEWS BUNNY in Class 25 to a combined mark comprising of a prominent device of the rabbit character with the words NEWS BUNNY in lesser prominence in relation to the device. This letter apparently met with a negative response.

Ms Orchid closes her evidence in reply by stating that the '...very ambiguity in the definition of the "Mark" and the subsequent reference to "News Bunny" as a "brown and white rabbit ... played by an actor" illustrates that the words "News Bunny" are merely descriptive of the character which has featured in Mirror TV's programming. By reason of the statements made above, the Opponents submit that the Applicants have not proved that they have a *bona fide* intention to use the Mark applied for in relation to goods and that accordingly such application should be refused.'

### The Decision

That concludes my review of the evidence, and I turn to consider the respective grounds upon which this opposition has been brought.

The first ground of opposition refers to section 3(1) which states: section 1(1) of the Act, the definition of a trade mark:

'The following shall not be registered-

(a) signs which do not satisfy the requirements of section 1(1),'

where section 1(1) gives the definition of a trade mark as:

'...any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.'

Taking these sections together, for registration of a 'sign' to be lawful it must be representable graphically and be capable of distinguishing goods or services of one undertaking from those of other undertakings.

It is clear that the 'NEWS BUNNY' series are signs and can be represented graphically. There is no doubt about the nature, or the representation, of these signs as they appear in the



application and anyone reading the Trade Marks Journal (or inspecting the Register assuming they are registered) would not fail to understand from their appearance what they are. This fulfills the requirements for graphical representation.

5 However, Ms Orchard does raise the issue that NEWS BUNNY is a concept, merely descriptive of the character which has featured in Mirror TV's programming, and not a trade mark within the meaning of the Act. The first point to make is that MTL have not tried to register a concept. Their application is for a series of three word marks and nowhere refers to the concept behind these marks. This concept - that of a brown rabbit - is only introduced in the Applicants' evidence to support their case for registration.

10 The second point is that the mark is descriptive of a character is rather a red herring. It is certainly not descriptive of clothing. The fact that a sign is also an 'appellation' that carries with it a strong, even abstract idea, should not stop its registration as a trade mark *per se*; it is only where that sign may be related to products for which the registration is sort such that it may become '.. a name which is apt and appropriate to describe a produce rather than a  
15 manufacturer..' [McCAIN OVEN CHIPS] 1981, 5, 72 and, if so, unregistrable.

No evidence has been provided by the Opponents in support of the contention that the sign NEWS BUNNY is unable to distinguish goods or services of one undertaking from those of other undertakings. In view of this NEWS BUNNY fulfills the requirements of section 1(1) of the Act and is not in breach of section 3(1)(a). I therefore dismiss the objections raised to  
20 registration on these grounds.

Turning to the next ground for objection of opposition, section 5(2) of the Act reads:

'(2) A trade mark shall not be registered if because -

- 25 (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier mark is protected, or  
(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.'

30 The Opponents' only refer to Section 5(2)(a) in their statement of grounds, but state that the mark applied for is similar to trade marks in their name (see page 2) and 'is to be registered for goods which are identical with or similar to those for which the earlier Trade Marks are protected, so that their exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier Trade Marks'. In the light of this, I am sure the reference to section 5(2)(a) is a mistake, and section 5(2)(b) was intended. I will  
35 therefore consider the application of this section next. However, before I consider the similarity of the respective marks there are four points I should like to make clear.

First, the Applicants have not denied that the goods at issue are identical, and given that both specifications include outer clothing I am satisfied that the they are identical or at least similar. Consequently I do not need to apply the test for similarity of goods as laid down in TREAT.<sup>1</sup>

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<sup>1</sup>(1996) RPC 9, page 296, line 35ff

Second, the definition of an earlier mark in section 6 of the Act includes a registered mark (section 6(1)(a)) and ‘... a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered’ (section 6(2)). Thus the Opponents’ NEWS FLASH mark is an ‘earlier mark’ under section 6(1)(a) and their three applications 1501851, 1507748 and 1569844 have similar protection under section 6(2).

Third, in the evidence (pages 5 and 6) Mr Horwood makes much of the fact that there has been extensive use of NEWS in Class 25 by different proprietors and this has led to a substantial dilution of the distinctiveness of this word when used in connection with clothing products. However, no evidence has been put before me, as Ms Orchard points out, that indicates ‘fairly extensive use’. I am therefore unable to conclude anything about ‘dilution’ of the distinctiveness of the word NEWS.

Finally, the Applicants’ prior use of the NEWS BUNNY character is largely irrelevant to the objection under Section 5(2)(b). I need to consider all normal and fair use of the Applicants’ mark and I do not believe the evidence I have seen indicates NEWS BUNNY is a household name so strongly associated with them that, if it were used on clothing, there could be no likelihood of confusion.

I therefore intend to compare the marks on a prima facie basis. They Opponents’ marks are reproduced below:



20

NEWS

NEWS BUNNY

The Applicants’ marks are the words ‘News Bunny’ presented as separate words, conjoined and hyphenated. In deciding the question of similarity I take account of the guidance set down by the ECJ in PUMA V SABEL C251/95:

‘The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.’

All the marks contain the word NEWS and it may be argued that the public will make an association as to the origin of products so marked as a result of this, that is, they will consider the products have the same source because of the common NEWS element. This seems to me least likely with the NEWS FLASH mark because, besides the device element and the significant visual aural differences between it and NEWS BUNNY, there is a strong conceptual dissimilarity, in that a 'news flash' describes an event consumers will recognise as a short news announcement containing novel information. Of the remaining marks owned by the Opponents, NEWS CLOTHING, NEWS D COLLECTION and NEWS are, in my view, very closely related to each other; they are all essentially 'NEWS' trade marks. The words CLOTHING and COLLECTION are descriptive and merely serve to emphasise the significance of NEWS, that is, the articles in questions are NEWS clothing or part of the NEWS collection. In other words, the word NEWS is the dominant feature of these two marks.

If confusion is to occur it is most likely between NEWS and NEWS BUNNY - in my view this represents the Opponents' best case. While I admit the matter is finely balanced, I conclude that confusion is unlikely for the following reasons:

(1) The juxtaposition of the word BUNNY with NEWS is an unexpected combination of words that is 'conceptually' different to the mark NEWS. It is a phrase that principally conjures up the image that is somehow associated with news. BUNNY is not a house name and it is not a word like 'flash', 'clothing' or 'collection' that sits logically with NEWS.

(2) It seems to me that this conceptual difference is a stronger factor than any similarities between the two marks engendered by the common element NEWS.

(3) The two marks are clearly sound different and their visual difference does not stop at the simple observation that one consists of two words and the other of one. In my view the word NEWS is not so strong when used in the Applicants' mark that it becomes the dominant element. It appears to me that the word BUNNY is of greatest relative significance and it is to this word that the eye is drawn when viewing the mark for the first time.

(4) The Opponents have provided no evidence to suggest the public is liable to confuse the NEWS BUNNY mark with the NEWS mark to the extent they may consider products so labelled are from the same originator.

(5) There is no evidence that the Opponents' NEWS mark has a strong reputation in the UK.

(6) Finally, the word NEWS is not, in itself, an especially strong mark which has the inherent distinctiveness that may come with a less common used, novel or fanciful word.

For these reasons I dismiss the grounds of objection under section 5(2)(b).

The final ground for objection is given as Section 5(4)(a), which is:

‘(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-

5 (a) by virtue of any rule of law (in particular, the law of passing off) protecting a unregistered trade mark or other sign used in the course of trade..’

No rule of law which could prevent the use of the Applicants’ trade mark has been brought to my attention. I therefore propose to consider whether, at the date of application, use of the Applicants’s mark was liable to have been prevented by the law of passing off, since this is particularly mentioned in section 5(4)(a).

10 A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

15 ‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- 20 (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

25 The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of ‘passing off’, and in particular should not be used to  
30 exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’

This can be summarised under the headings ‘Reputation’ (Goodwill), ‘Deception’ and ‘Damage’. Taking the first of these, I find the evidence provided by Mr van der Meché on behalf of Henri Fetter Fashion B.V. in relation to an established reputation in this class of  
35 goods less than convincing. The sales figures given for the UK are tiny compared to overall clothing retail sales in the UK.

The assertion that promotion has taken place in the UK is also inconclusive. It appears from the copies of the catalogues provided that some advertising took place in the UK, though judging from the addresses of suppliers listed on these documents, they were circulated to other EU countries as well. I find the documents referring to trade fairs rather weak. The  
5 photograph in particular, is undated. It appears to me that, at the relevant date, the Opponents were the proprietors of a relatively modest goodwill and reputation in the UK.

Turning to the issue of deception there does not appear to be any indication that the Applicants' mark is a misrepresentation that will mislead the public. For misrepresentation to occur one trader must use its mark in such a manner as to represent falsely to customers that  
10 its goods are those of another trader. There can be confusion without misrepresentation, but the converse is not true. In my decision under the section 5(2)(b) grounds given above I dismissed the likelihood of confusion; in view of this the proposition that use by the Applicants of their mark would amount to a misrepresentation is untenable.

Finally, since it has not been proved that the Opponents have established sufficient goodwill, or that deception has, or is likely, to occur there is no prospect of them suffering damage as a  
15 result. Thus the grounds under section 5(4) also fail, and the Opponents are unsuccessful in their opposition to this application.

The Applicants, having been successful in these proceedings, is entitled to a contribution towards the costs of defending the application. I therefore order the Opponents to pay to the  
20 Applicants the sum of £450.

**Dated this day of 26 November 1998**

**Dr W J Trott  
Principal Hearing Officer  
For the Registrar, the Comptroller-General**