

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS. 1451403 AND 1451405
BY SECOND NATURE LIMITED TO REGISTER A SERIES OF MARKS
IN CLASSES 16 AND 25**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITION THERETO UNDER
NOS. 42338 AND 42339 BY ST NICHOLAS MUSIC INC**

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DECISION

On 27 December 1990 Second Nature Limited applied to register the following series of two marks, SANTA AND RUDY and SANTA & RUDY in Classes 16 and 25 for specifications of goods which read:

Class 16 paper, napkins, paper bags and sacks; printed matter, greetings cards, books, calendars and advent calendars; stationery, pencil cases, pencils; decalcomanias

Class 25 articles of clothing, footwear and headgear

The applications are numbered 1451403 and 1451405.

On 24 April 1995 St Nicholas Music Inc filed notice of opposition to these applications. The grounds are in summary:

- (i) under Section 11 in that the opponents are the owners of all rights in the song "RUDOLPH THE RED-NOSED REINDEER" written by Johnny Marks, the founder of St Nicholas Music Inc., and have, since as early as 1949, exploited (either directly or through licensees) the name and likeness of RUDOLPH THE RED-NOSED REINDEER in connection with a wide variety of products and services, such as inter alia, musical performances, audio recordings, sheet music and other music publications, television programmes and video cassettes
- (ii) under Section 12(3) having regard to a number of trade and service mark applications in their proprietorship
- (iii) under Section 17(1) in that the applicants are not the proprietors of the marks applied for

They also ask that the applications be refused in the exercise of the Registrar's discretion.

The applicants filed counterstatements denying the above grounds. They note that in the intervening period the opponents' applications proceeded to registration but that they have later filing dates than the opposed marks. They also say that copyright in a song does not extend to the title of the song nor to the characters therein. They, therefore, put the opponents to proof that the marks applied for are confusingly similar and that the opponents' rights extend to the goods of the applications.

Both sides ask for an award of costs in their favour.

The cases were subsequently consolidated. Only the opponents filed evidence. Neither side has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

By the time this matter came to be decided, the old Act had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the Trade Marks Act 1938 however, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the provisions of the old law, unless otherwise indicated.

Opponents' evidence

The opponents filed an affidavit by David Marks, their Vice President.

He says that:

“3. The Opponent and Robert L May Company LLC (the “May Company) of 910 Railroad Avenue, Novato, California, 94945, USA, are the general partners in The Rudolph Company, L. P. The Rudolph Company, L P owns all trade mark rights in the name “RUDOLPH THE RED-NOSED REINDEER” and variations thereof (e.g. “RUDOLPH” and “RUDY”) and in the likeness of a red-nosed reindeer (the ““RUDOLPH’ trade marks”), including trade mark registrations and applications for registration in the UK, the US and other countries around the world. There is now produced and shown to me marked Exhibit DM1, details of these various trade mark registrations and applications. The assignment of the “Rudolph” trade marks to the Rudolph Company L P is in the process of being recorded at various trade mark offices.

4. Since 1939, the Opponent and/or the May Company, the Opponent's partner in The Rudolph Company, L P, (and their predecessors-in-interest, directly and through licensees) have continuously exploited the “RUDOLPH” trade marks in connection with a vast range of merchandise including, e.g. balloons, bibs, books, candy, charms, Christmas cards, Christmas stockings, cookie jars, figurines (e.g. porcelain, resin, lighted and unlighted), clothing (e.g. sweaters, sweatshirts and t-shirts), games, jewelry, light sets, mechanical figures, mugs, ornaments, pens, plush toys, posters, slippers, teapots, wallets, watches and so forth. There is now produced and shown to me marked Exhibit DM2, examples of “RUDOLPH” merchandise in class 16 and class

25, the classes in which the Applicant has applied to register, the class 16 examples being books and Christmas cards, and the class 25 examples being sweat shirts and t-shirts. These examples represent a small fraction of licensed “RUDOLPH” merchandise.”

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Mr Marks goes on to say that the opponents own the copyright of the song Rudolph the Red-Nosed Reindeer. The applicants have challenged the relevance of copyright in a song to the opposition but have not denied that the song is extremely well known. For my part I accept the fame of the song and do not need therefore to record the opponents’ lengthy account of its history, success and their exploitation of it (supported by Exhibits DM3 to DM14).

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The opponents say that they have also used and licensed the RUDOLPH trade marks in connection with a series of animated television films. The first film was produced in approximately 1964 and is said to have been broadcast in this country in recent years on the BBC. Exhibits DM15 to 17 have been supplied in support of these claims.

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Mr Marks says that the opponents have engaged in extensive advertising and promotional efforts in connection with their exploitation of the Rudolph song and related products and services. Examples are exhibited at DM18 and 19.

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Finally in relation to the mark applied for he says:

“19. The “RUDY” in the Applicant’s mark, “SANTA & RUDY” – which pairs “RUDY” with Santa Clause – plainly refers to the “RUDOLPH THE RED-NOSED REINDEER” character, which character is the subject of the trade mark rights of the Opponent and the May Company, the Opponent’s partner in The Rudolph Company, L P. Indeed, there is now produced and shown to me marked Exhibit DM20, copies of Christmas cards which are produced by the Applicant, from which it can be seen that there is a clear intention to use the mark SANTA & RUDY as a reference to the “RUDOLPH THE RED-NOSED REINDEER” character. In fact, several of the cards refer explicitly to “RUDOLPH”.

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The Applicant’s use of, and application to register, the mark “SANTA & RUDY” constitutes an attempt by the Applicant to appropriate for itself the fruits of more than a half century of promotion and exploitation of the “RUDOLPH” trade marks by the Opponent and the May Company, the Opponent’s partner in The Rudolph Company, L P. Long before the Applicant filed the subject application, the world knew “RUDOLPH THE RED-NOSED REINDEER” from the vast exploitation activity of the Opponent and the May Company, the Opponent’s partner in The Rudolph Company, L P.

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The Applicant’s use of the mark SANTA & RUDY is likely to confuse consumers. Upon seeing the Applicant’s mark – with its reference to “RUDY” – on a product, a consumer would naturally assume that the source of such product is the same as the source of the “RUDOLPH” trade marks, namely, the Opponent and the May Company, the Opponent’s partner in The Rudolph Company, L P.”

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That concludes my review of the evidence.

5 The opponent's have asked in their statement of grounds for the matter to be determined under Section 12(3) (conflicting co-pending applications). At the time the oppositions were filed the opponents had some twelve applications of their own pending in Classes 9, 16, 25, 28, 30 and 41. In each class there were paired applications for the mark RUDOLPH THE RED-NOSED REINDEER and a reindeer device. I have not felt it necessary to record full details of these applications (now registrations) for reasons which I will briefly explain. As the applicants pointed out all the applications relied on by the opponents have later filing dates than the application in suit. As this case has not been the subject of a hearing or written submissions I have not had the benefit of the parties' views in relation to the application of the law. However, it was held in C(Device) Trade Mark, 1998 RPC 439, that the material date for Section 12 purposes was the application filing date and that a later filed application which had subsequently proceeded to registration had no retrospective status at that date. Precisely the same circumstances have arisen here. I have no reason for coming to a different view of the matter. The opposition, therefore, fails under Section 12.

Section 11 reads:

20 "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

25 The established test for an objection under this Section is set down in Smith Hayden and Company Ltd's application (volume 1946 63 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand the test may be expressed as follows:

30 Having regard to the user of the mark RUDOLPH THE RED-NOSED REINDEER is the tribunal satisfied that the marks applied for SANTA AND RUDY and SANTA & RUDY if used in a normal and fair manner in connection with any goods covered by the registrations proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

35 The opponents' case centres on their commercial exploitation of rights based on the song 'Rudolph the red-nosed reindeer'. It is said that a range of merchandise has been developed and made available under the name. In fact there is a suggestion in the opponents' evidence that the claim goes somewhat wider than that contained in the statement of grounds. It is said that "The Rudolph Company L P owns all trade mark rights in the name "RUDOLPH THE RED-NOSED REINDEER" and variations thereof (e.g. "RUDOLPH" and "RUDY") and in the likeness of a red-nosed reindeer". These marks are collectively referred to as the RUDOLPH trade marks. Two points arise from this. The statements of grounds have, so far as I can see, never been amended to reflect this broader claim covering the variant forms of the name. Secondly there is little, if any, evidence to support any claim in respect of RUDOLPH or RUDY on their own. For the record I should also say that it is not immediately apparent what claim the opponents, or anyone else for that matter, might have in relation to the

character RUDOLPH. It may be that it is a name that has passed into the language and is no longer capable of being associated with any particular trader (cf TARZAN). In the absence of any evidence directed to the point I merely flag up my own doubts about the opponents' claim without deciding the point.

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The applicants say that copyright in a song does not extend to the title of the song. I have not been referred to any authorities either for or against that proposition. In *Shetland Times Ltd v Dr Jonathan Wills*, 1997 FSR 604, a copyright infringement case, the defendant conceded that a newspaper headline could be a literary work. On that basis it is not inconceivable that a song title could also have this attribute though I note that *Cornish on Intellectual Property* (Sweet and Maxwell) takes a cautious line at 10-05 and suggests that in most cases, the titles of books - and equally of plays, films and the like - are treated as insufficiently substantial to attract copyright themselves. However, I do not need to decide the matter in quite those terms. The opponents have not expressly pleaded a copyright objection under Section 11 and I cannot, in any case, conceive that the marks applied for would be objectionable on that account. Nor, of course, does copyright in a song (or title) in itself confer trade mark rights in relation to goods or services sold under a mark based on the title.

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Nevertheless, the opponents say that they have a substantial merchandising trade under the mark RUDOLPH THE RED-NOSED REINDEER. Such a trade certainly has the capacity to form the basis for a Section 11 action.

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A good deal of the opponents' evidence is directed towards establishing the fame of the song. I have already said I accept it is extremely well known. But there is no necessary or automatic assumption that a song will give rise to a trade in merchandise. I would imagine that such a trade is relatively unusual. The opponents' main exhibit in relation to merchandising of goods in Classes 16 and 25 is DM2 (though I accept that the Section 11 test is not restricted to the same goods or goods of the same description). The exhibit consists of photocopies of what I take to be book covers and cards featuring the words RUDOLPH THE RED-NOSED REINDEER (and in one case RUDOLPH). There are also two examples of the words and a device featuring on clothing. The small print in the copy material supplied to the Registry is indistinct but insofar as it is legible appears to carry 'made in the USA' labels. That is not to say that the goods were not exported to and sold in the UK but it is simply not possible to draw any such inference from the material itself and the opponents make no explicit claim in this regard.

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So far as the remainder of the evidence is concerned (to the extent that I consider it relevant) Exhibits DM4 and 5 are copies of sheet music and an old record label featuring a Gene Autry recording. There is again no obvious indication that these items were ever available in this country. Exhibit DM11 consists of cover from a printed music publication. They all carry US addresses and/or dollar prices. DM12 is a cover of a UK edition of sheet music of the Rudolph song. It carries a price of two shillings. A similar cover at DM13 is priced at 20p but I judge from the style and referencing that it is a fairly old document. The remainder of the material is either intended for the US market, not obviously directed at the UK market or otherwise of doubtful relevance or materiality.

Quite apart from the detailed criticisms set out above the opponents have made no attempt to quantify their trade, to indicate what, if any, promotional and advertising activity was undertaken, what the geographical spread of their business has been or to provide other indicators of use in this country within a relevant time frame. On that basis alone they are in my view some way from establishing an effective basis on which to sustain a Section 11 objection.

I have not, therefore, needed to consider the marks applied for, SANTA AND RUDY/SANTA & RUDY. RUDY is, I think a somewhat uncommon abbreviation for RUDOLPH (or at least the reindeer of that name) but I accept that in the context in which it is used (Exhibit DM20) the reference to RUDOLPH would be well understood. However, for the reasons set out above it is not clearly established that the opponents have any rights in respect of RUDOLPH as opposed to RUDOLPH THE RED-NOSED REINDEER and even in relation to the latter the evidence establishes little more than ownership of copyright in the song. I, therefore, have no hesitation in concluding that for the purposes of the BALI test there is no basis for finding that use of the mark applied for in relation to the goods concerned will cause deception and confusion amongst a substantial number of persons. The opposition fails under Section 11.

Section 17(1) reads:

17. - (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.

The opponents specifically claim that “the applicants are not the proprietor of the mark applied for as the applicants do not hold any lawful ownership interest in any aspect of the RUDOLPH THE RED-NOSED REINDEER property”.

The claim has not been developed in the evidence or, rather has been elided into the Section 11 objection. Quite clearly the series of marks applied for is not RUDOLPH THE RED-NOSED REINDEER or even colourably similar thereto. The applicants are claiming proprietorship of a different mark. They say that they have met all the provisions of Section 17(1). I do not see anything in the application which leaves the applicants open to the sort of objection raised by the opponents.

Finally, there is the matter of the Registrar’s discretion. The opponents have lost on all the main grounds on which the opposition was brought. No other reason has been brought to my attention why I should exercise discretion against the applicants.

As the opposition has failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £370 in respect of these consolidated proceedings. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

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Dated this 31 day of March 2000

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**M REYNOLDS
For the Registrar
the Comptroller General**