

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2107245 BY
SILVERSURFER.UK.LTD TO REGISTER A SERIES
OF MARKS IN CLASSES 25 AND 28**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER 46295
BY MARVEL CHARACTERS INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2107245
by silversurfer.uk.ltd to register a series of
marks in Classes 25 and 28**

And

**IN THE MATTER OF Opposition thereto under
No 46295 by Marvel Characters Inc**

DECISION

1. On 9 August 1996 silversurfer.uk.ltd (previously Telecard Sales Limited) applied to register the following series of two marks:

SILVERSURFER
SILVER SURFER

for the following specification of goods:

Class 25:

Articles of outer clothing for men and women; articles of underclothing for men and women; footwear, headgear, shirts, blouses, trousers, socks, ties, scarves, jackets, coats, underwear, boots, shoes, sandals, hats and caps.

Class 28:

Toys, games and play things; gymnastic and sporting articles.

The application is numbered 2107245. It was published for opposition purposes on 23 October 1996. I should say by way of background to what follows that at the time this application was examined and published the Registry was not yet able to conduct a search for earlier Community Trade Marks (CTMs).

2. On 23 January 1997 Marvel Characters Inc filed notice of opposition to this application based on what was at the time their CTM application, No 47142, along with a UK trade mark registration, No 1516749. Full details are given in the Annex to this decision. It is relevant for present purposes to record that CTM application No. 47142 has a filing date of 1 April 1996. The opponents also claimed use of their mark SILVER SURFER. Arising from all this objections were raised under Section 5(1), 5(2)(a) and (b), 5(3), 5(4)(a) and 3(6). Refusal was also sought in the exercise of the Registrar's discretion. The only ground relevant for the purposes of this decision is that under Section 5(1).

3. The applicants put the opponents to proof of the existence and ownership of the CTM application (No 47142) and commented as follows in relation to paragraph 3 of the opponents' statement of grounds which dealt with the Section 5(1) objection:

"The allegations made or implied in paragraph 3 of the SGO are not admitted. Community Trade Mark application number 47142 is not registered hence falls to be considered under Section 6(2) of the Trade Marks Act 1994. In this connection the Opponents are put to proof with regard to any reputation of the Trade Mark SILVER SURFER particularly in Classes 25 and 28.

Further Section 6(2) can only be of significance when registration of the Community Trade Mark has occurred and the specification of goods approved. In practice this means after the full Opposition procedure throughout the Community has occurred.

The Opponents are put to proof that any use has been made prior to the Applicant's filing date of the trademark SILVER SURFER in Classes 25 and 28 as specified in the application. The Applicants are particularly interested in gymnastic articles in Class 28 and sports clothing associated therewith in Class 25. They look forward to proof of use of the mark SILVER SURFER on those goods (if available)."

4. On 2 June 1997 the opponents asked for the current proceedings to be suspended pending the outcome of their CTM application. This request was objected to by the applicants. Following an interlocutory hearing on the matter on 23 September 1997 I decided that the opposition proceedings should be suspended and the position reviewed when the outcome of the OHIM examination of No 47142 was known. In the event No 47142 was published for opposition purposes on 4 May 1998 and in turn opposed by the current applicants. The UK proceedings remained in suspension but subject to periodic review in the light of developments in the CTM proceedings.

5. By letter dated 11 November 1999 Marvel Characters Inc's UK attorneys notified the Registry that the opposition to their (Marvel's) CTM application had been rejected and that, absent an appeal, it would proceed to registration. A copy of the registration certificate for No 47142 was subsequently filed on 12 December 2000. On the basis that No 47142 now constituted an earlier trade mark Marvel asked that the current application be refused.

6. By letter dated 9 February 2001 the Registry notified the applicants that consideration was being given to whether mandatory refusal was now appropriate under Section 5(1) of the Act based on the existence of CTM No 47142. The applicants were given 14 days to comment. As no comments were forthcoming and no hearing requested the Registry wrote to the applicants once more on 2 April 2001 indicating that the papers would be passed to a Hearing Officer for a decision.

7. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

8. Section 5(1) reads:

5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

9. The prohibition on registration under Section 5(1) is thus an absolute one. The opponents' CTM registration is in respect of the words SILVER SURFER (two words), that is to say a mark identical to the second mark in the applicants' series. The first mark in the applicants' series is SILVERSURFER written as a single word. In my view that mark too is for practical purposes identical.

10. The goods of the application in suit appear to be contained within the broad terms employed in the opponents' CTM registration. If it was possible for the applicants to amend/reduce their specification in such a way that it avoided the problem of identical goods they have made no attempt to do so. In reality I doubt whether it would have been possible to resolve the problem in this way. The result is that the opponents' objection under Section 5(1) is made out and a decision can be reached without the need for evidence or consideration of the other grounds.

11. As the opposition has been successful the opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of May 2001

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

Details of opponents' earlier trade marks

No	Mark	Class	Specification
47142 (CTM)	SILVER SURFER	9	Prerecorded video, audio and audio-visual tapes, discs and cassettes; audio cassette players and recorders; radios; sunglasses; cameras; video game cartridges and software programs for video games; cartridges and software for hand-held game systems, coin-operated arcade games; computer game programs; pinball machines; bicycle helmets.
		16	Printed matter and paper goods, namely comic books and comic magazines and stories in illustrated form; books, children's books, activity books, coloring books, sticker books; stickers; bumper stickers; posters; trading cards; collector cards; collector albums; playing cards; art supplies, namely crayons, markers, colored pencils, paints, paint brushes, pre-printed sheets or posters for coloring or painting; slates; chalk and chalkboards; decals and heat transfers; school supplies, namely pens, pencils, erasers, pencil cases, pencil sharpeners, scissors, rulers, staplers, paperweights, notebooks, folders, ring binders, spiral notepads, book covers and bookmarks; door knob hangers; stationery, writing paper, envelopes, note cards, greeting cards, postcards, notepads, memo pads; appointment books; calendars; printed patterns for costumes; paper party goods namely gift wrapping paper, paper doilies, crepe paper, paper invitations, paper cake decorations, paper napkins, paper placemats, paper party hats, paper centerpieces and paper tablecloths.
		25	Clothing, namely, T-shirts, sweatshirts, shirts, tank tops, sweaters, jerseys, turtlenecks, golf shirts, shorts,

sweatpants, warm-up suits, snow suits, slacks, overalls, vests, jackets, coats, parkas, ponchos, swimwear, rainwear, sleepwear, robes, underwear, boxer shorts, hats, wool hats, visors, scarves, headbands, ear muffs, wristbands, cloth bibs, ties, socks, hosiery, shoes, boots, sneakers, beach shoes, sandals, slippers, gloves, suspenders, belts, Halloween and masquerade costumes.

28 Toys, games and playthings, namely, toy action figures and accessories, toy vehicles, action playsets (sold as a unit for creative play activities), toy environments for use with action figures; plush dolls, soft sculpture dolls, bendable figurines, puppets; balloons, water play toys, inflatable toys; target games; chess games, board games, puzzles, kites, rack toys, yo-yos, toy weapons, toy watches, toy calculators, role playing games, model kits, craft and activity sets, electronic hand-held games; gymnastic and sporting articles namely balls, sports balls, inflatable swimming pools for recreational use; roller skates, in-line skates, skateboards elbow pads, knee pads; jump ropes; snow sleds for recreational use; surf fins; swim fins; surfboards; swimboards for recreational use; Christmas tree ornaments.

1516749 (UK) SILVER SURFER 16 Printed matter, publications, comics; comic books; magazines; books, colouring books; activity books; address books; diaries; calendars, posters; trading cards; playing cards; greetings cards; wrapping papers; stationery; school supplies; office supplies; office requisites; writing and drawing materials, art supplies; artists' materials; napkins, towels, bags, tablecloths, coasters and table and placemats, all made of paper; paper party goods, tableware and decorations; decalcomanias; stickers; all included in Class 16.

