

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2171837
BY SWEETMASTERS LIMITED
TO REGISTER A TRADE MARK
REINDEER NOSES (RUDOLPH'S SPARES)
IN CLASS 30

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 49272
BY THE RUDOLPH COMPANY LP

BACKGROUND

1) On 11 July 1998, Sweetmasters Ltd of P.O. Box No 13, Blackpool, Lancashire, FY3 9XQ applied under the Trade Marks Act 1994 for registration of the trade mark **REINDEER NOSES (RUDOLPH'S SPARES)** in respect of the following goods in Class 30: "Confectionery and confectionery products".

2) On the 9 December 1998 the Rudolph Company LP of 901 Railroad Avenue, Novato, California 94945, USA filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of a number of UK trade mark registrations for the words "RUDOLPH THE RED-NOSED REINDEER" and variations thereof such as RUDY and RUDOLPH. The registrations are detailed at annex A.

b) The application would therefore offend against Section 5(2), 5(3) and 5(4) of the Trade Mark Act 1994.

3) The applicant subsequently filed a counterstatement denying all of the grounds of opposition. Both sides ask for an award of costs.

4) Both sides filed evidence in these proceedings and the matter came to be heard on 25 July 2001 when the applicant was represented by Mr Marsh of Messrs Wilson Gunn M'Caw, and the opponent by Mr Wallace of Messrs Boulton Wade Tennant.

OPPONENT'S EVIDENCE

5) The opponent filed a declaration, dated 19 April 1999, by David Marks the Vice President of St Nicholas Music Inc. which is one of the general partners in the opponent The Rudolph Company L.P. He has held this position for approximately twenty years.

6) Mr Marks says that:

"4. The opponent 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 registrations 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 opponent is in the process of being recorded at the various trade mark offices.

5. Since 1939, the opponent (and its predecessors-in -title, 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 jewellery, 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. These examples represent a small fraction of licensed “RUDOLPH” merchandise.”

7) Mr Marks states that the opponent owns the copyright of the song “Rudolph the Red-Nosed Reindeer” and provides a very lengthy account of its history, success and the opponent’s exploitation of it. These claims are supported by exhibits DM3 - 14.

8) The opponent claims to have used and licensed the RUDOLPH trade marks in connection with a series of animated films shown on television and released on video. 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 DM 15 - 18.

9) Mr Marks says that the opponent has 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 DM19 and 20. However, there is no claim to have licensed the mark for use on confectionery.

10) Finally, in relation to the mark applied for he says:

“20. The mark REINDEER NOSES (RUDOLPH’S SPARES) subject of application no 1271837 plainly refers to the “RUDOLPH THE RED-NOSED REINDEER” character, which character is the subject of the trade mark rights of the opponent.

The applicant’s use of, and application to register, the mark REINDEER NOSES (RUDOLPH’S SPARES) 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 mark by St. Nicholas and the opponent and their predecessors in title. Long before the applicant filed the subject application, the world knew “RUDOLPH THE RED-NOSED REINDEER” from the vast exploitation activity of St. Nicholas and the opponent.

The applicant’s use of the mark REINDEER NOSES (RUDOLPH’S SPARES) is likely to confuse consumers. Upon seeing the applicant’s mark - - with its references to “RUDOLPH” and “REINDEER NOSES” - - on a product, a consumer would naturally assume that the source of such a product is the same as the source of the “RUDOLPH THE RED-NOSED REINDEER” trade marks, namely, the opponent.”

APPLICANT'S EVIDENCE

11) The applicant filed a declaration, dated 8 February 2000, by David William Van Faraday a Director of the applicant company.

12) Mr Farady states that his company is the owner of UK trade mark number 2123467 REINDEER DROPPINGS. Products sold under this brand are confectionery items and have been particularly successful in the UK. He states that in order to take advantage of this success a variant confectionery item was developed and sold under the mark REINDEER NOSES utilising the trade mark RUDOLPH'S NOSES as a strap line.

13) Mr Farady disputes the opponent's claims to own all rights in the name of RUDOLPH THE RED-NOSED REINDEER and variants thereof and produces details from the UK register of other marks containing the words REINDEER and RED NOSED REINDEER. However, this is of little or no relevance to the case because "state of the Register" evidence is, in principle, irrelevant: TREAT 1996 RPC 281.

14) Mr Farady observes that the opponent has not provided any turnover figures or sales information and that other parties have used the likeness of a reindeer with a red nose. He provides some examples at exhibits DF4 - 7. These show, inter alia, Christmas cards with reindeer with red noses, RUDOLPH plush toys and RUDOLPH'S RED NOSE handkerchiefs. He also states that using the likeness of a reindeer with a red nose is common in the confectionery industry. At exhibits DF8 - 12 he provides copies of items such as a chocolate medallion with the words "Rudolph the Red nosed reindeer", a plush toy with "Rudi the Reindeer", and a "Rudolph the Red Nose cookie set".

OPPONENT'S EVIDENCE IN REPLY

15) The opponent filed a second declaration, dated 21 November 2000, by David Marks. Mr Marks makes a number of comments as to why the applicant would follow up the alleged success of its REINDEER DROPPINGS with the mark in suit rather than alternatives such as ELK DROPPINGS.

16) He points out that his earlier declaration referred to the sale of 400,000 copies of the video of the movie RUDOLPH THE RED-NOSED REINDEER: THE MOVIE in the UK in 1998 alone. He points out that the items which feature at exhibit DF4-7 of the applicant's evidence contain no specific details.

17) That concludes my review of the evidence. I now turn to the decision.

DECISION

18) I shall first consider the ground of opposition under Section 5(2)(b) which reads:

"5 .- (2) A trade mark shall not be registered if because -

(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 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.”

19) An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) *In this Act an ‘earlier trade mark’ means -*

(a)...a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

20) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, 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; *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, 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; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

21) As is clear from the Annex to this decision the opponents are relying on a number of registrations, half being the word only mark of “Rudolph the red-nosed reindeer” and the other half being a reindeer device. I consider that the opponent’s strongest case is under registration 1461091 for the words “Rudolph the red-nosed reindeer” which is registered for “Candy, confectionary, breakfast cereals; snack foods flavoured with salt; all included in Class 30”.

22) Clearly, in my view, the specification of the mark in suit is subsumed within the specification of the opponent’s mark 1461091. The goods of the two parties are therefore, in my opinion, to be regarded as identical for the purposes of Section 5(2). This was common ground at the hearing. It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods or services for which it is registered, and any other relevant factors.

23) When comparing the mark in suit, “REINDEER NOSES (RUDOLPH’S SPARES)”, to the opponent’s mark, “RUDOLPH THE RED-NOSED REINDEER”, visually the respective marks have the words REINDEER and RUDOLPH in common albeit that the name Rudolph takes the possessive form in the applicant’s mark. The opponent also suggested that the word NOSE appeared in both marks. I do not accept this contention. The plural form of the word appears in the applicant’s mark whereas in the opponent’s mark it is used as an adjective and is hyphenated with the word red. The words do not appear in the same order in the respective marks.

24) Aurally, the marks have common sounds, but at different places within the marks. They are therefore dissimilar.

25) Conceptually the marks have a similar theme. The opponent’s mark is very well-known as the song from which it derives is world famous. Clearly the applicant’s mark alludes to a reindeer character called Rudolph.

26) The opponent claims in their evidence that “The Rudolph Company LP 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 red-nosed reindeer.” However, little or no evidence has been supplied to support any claim in respect of RUDOLPH or RUDY solus. Neither is it clear what rights the opponent has in relation to the character RUDOLPH. Although reference is made to sales of a video titled Rudolph the Red-Nosed Reindeer, these sales took place after the relevant date. I take judicial note that reindeer, particularly those with red noses, are used on a wide range of items such as cards, paper and decorations at Christmas.

27) Confectionery items are not, I would suggest, chosen with undue consideration. The average consumer of such products would not, in my opinion, exercise great care in the selection.

28) I must also consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. The opponent's evidence is mainly directed towards establishing the fame of the song. Earlier in this decision I accepted that it is well known. The opponent provided a number of exhibits relating to sales of sheet music and records, most of which clearly did not relate to sales in the UK, having prices in US\$ or American addresses. Two items of sheet music for the song do relate to the UK. However, one had a price of two shillings, the other is priced at 20p. The latter item would appear to be quite an old document, probably dating from the late fifties or early sixties judging from its character and other dated exhibits. Those exhibits which related to sales of merchandising were all indistinct and poorly photocopied. None had visible prices or dates. They consisted of photocopies of two book covers, a card and photocopies of the wording on two T-shirts. The only visible label shows that one of the garments was made in the USA. There is no evidence that any of the goods were offered for sale in the UK, let alone when they might have been on sale. The relevance of all the exhibits provided is somewhat doubtful and it is not possible to draw any conclusions as to the extent of any sales in merchandising items.

29) The opponent has failed to provide evidence of any promotional or advertising activity. No evidence of sales either by reference to individual invoices or yearly totals have been made.

30) Whilst the evidence of merchandising activity by the opponent could be said to be thin at best, the question is whether as a result of such merchandising the name "Rudolph the Red-Nosed Reindeer" has an enhanced distinctive character in a trade mark sense. The evidence that the character is well known will, without evidence of an expectation by the average UK consumers of a single trade source, not have enhanced the trade mark character of the earlier mark.

31) Indeed, as the name of a popular children's character, the earlier mark has very limited capacity to distinguish the confectionery of one undertaking from another because confectionery is often marketed with names and images of popular children's characters. Images may be protected by copyright but there is no copyright in a name.

32) Accordingly, although "Rudolph the Red-Nosed Reindeer" must be considered to be validly registered for confectionery, the scope of protection must be considered limited. The respective marks look and sound different. The opponent's mark is the name of the character. The applicant's mark consists of the semi-descriptive words REINDEER NOSES and the humorous strapline (RUDOLPH'S SPARES). It has a significantly different "feel" and is unlikely to be mistaken for the name of the character per se.

33) There is conceptual similarity in that both marks bring the character to mind. However, that is no more than association in the strict sense rejected by the ECJ in *Marca Mode*.

34) With all of this in mind I come to the conclusion that while there are superficial similarities, they are more than counterbalanced by the differences, and when all factors are considered, that there was no likelihood of confusion at 11 July 1998. Consequently, the opposition under Section 5(2)(b) fails.


35) At the hearing Mr Wallace accepted his case under Section 5(3) & 5(4) was no stronger than that under Section 5(2).


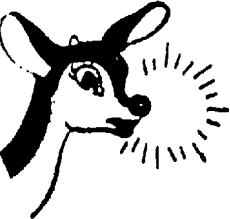



36) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1235. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 04 day of September 2001

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Mark	Number	Date Filed	Class	Specification
RUDOLPH THE RED-NOSED REINDEER	1461087	11.4.91	9	Audio and video cassettes, tapes and discs; computer software; cinematographic films and recordings; gramophone records; all included in Class 9.
RUDOLPH THE RED-NOSED REINDEER	1461088	11.4.91	16	Printed matter and publications, music publications, sheet music, folios and song books, photographs, posters, stationery, office requisites, instructional and teaching materials, paper napkins, ordinary playing cards, paper and cardboard wrapping material; all included in Class 16.
RUDOLPH THE RED-NOSED REINDEER	1461089	11.4.91	25	Underwear, sleepwear, pyjamas and robes; swimwear; rainwear, coats and hats; sweatshirts, T-shirts and overalls, all being leisurewear; fancy dress costumes; footwear; hosiery; all included in Class 25.
RUDOLPH THE RED-NOSED REINDEER	1461090	11.4.91	28	Toys, games and playthings; musical and non-musical plush toys and stuffed toys; puppets; board games; Christmas tree decorations; all included in Class 28.
RUDOLPH THE RED-NOSED REINDEER	1461091	11.4.91	30	Candy, confectionary, breakfast cereals; snack foods flavoured with salt; all included in Class 30
RUDOLPH THE RED-NOSED REINDEER	1461092	11.4.91	41	Production, distribution, exhibition and performance of live and recorded entertainment through the medium of radio, stage, concert, television and films; all included in Class 41.
	1461081	11.4.91	9	Audio and video cassettes, tapes and discs; computer software; cinematographic films and recordings; gramophone records; all included in Class 9.

	1461082	11.4.91	16	Printed matter and publications, music publications, sheet music, folios and song books, photographs, posters, stationery, office requisites, instructional and teaching materials, paper napkins, ordinary playing cards, paper and cardboard wrapping material; all included in Class 16.
	1461083	11.4.91	25	Underwear, sleepwear, pyjamas and robes; swimwear; rainwear, coats and hats; sweatshirts, T-shirts and overalls, all being leisurewear; fancy dress costumes; footwear; hosiery; all included in Class 25.
	1461084	11.4.91	28	Toys, games and playthings; musical and non-musical plush toys and stuffed toys; puppets; board games; Christmas tree decorations; all included in Class 28.
	1461085	11.4.91	30	Candy, confectionary, breakfast cereals; snack foods flavoured with salt; all included in Class 30
	1461086	11.4.91	41	Production, distribution, exhibition and performance of live and recorded entertainment through the medium of radio, stage, concert, television and films; all included in Class 41.