

O-413-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No.2429538
BY DRUMOND PARK LIMITED
TO REGISTER THE SERIES OF THREE TRADE MARKS**



IN CLASS 28

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 97628 BY
KIT FOR KIDS LIMITED**

BACKGROUND

1) On 10 August 2006 Drumond Park Limited (hereinafter the applicant), applied to register the following series of three trade marks:



2) In respect of “Toys, games and playthings; sporting articles and equipment” in Class 28.

3) The application was examined and accepted, and subsequently published for opposition purposes on 25 April 2008 in Trade Marks Journal No.6732.

4) Kit For Kids Limited (hereinafter the opponent), filed a notice of opposition, dated 24 July 2008. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Trade Mark	Number	Application Date and Registration Date	Specification
KIT FOR KIDS	CTM 3101912	23.03.03 / 02.03.07	Class 28: Children's play mats; water-filled playmats; play houses; play tunnels; nursery play equipment; bean bags; foam play equipment; PVC covered foam play equipment; ball pools; play furniture; soft play furniture; active play equipment; play parachutes and play parachute balls.

b) The opponent states that the series of three marks applied for are similar to the opponent’s earlier registration and that the goods applied for are identical and/or similar to those for which its’ mark is registered. The opponent states that the application offends against Section 5(2)(b) of the Trade Marks Act 1994.

5) On 21 July 2009, the applicant filed a counterstatement which denied the opponent’s claims.

6) Only the opponent filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 18 October 2010. At the hearing, the opponent was represented by Ms Turnbull of Messrs Brookes Batchellor LLP; the applicant was not represented but relied upon its counterstatement and the observations contained in its letter dated 21 July 2009.

OPPONENT’S EVIDENCE

7) This consists of a witness statement, dated 16 December 2009, by Jake Van Der Velde the Finance Director of the opponent. He states that the company was established in 1993 and sells a range of products through its three (nursery, education and outdoor activities) divisions. He states that the products sold by the education and outdoor activities divisions are in Class 28 and

it is these that the opponent relies upon. At exhibit JVDV1 he provides a price list dated January 2007 and a catalogue from 2009/10 which shows the range of products sold under the opponent's trade mark, CTM 3101912.

8) He provides turnover and advertising figures for the education and outdoor equipment divisions as follows:

Year	Turnover £	Advertising £
2003/04	899,000	19,778
2004/05	1,155,000	36,821
2005/06	1,247,000	23,229
2006/07	1,556,000	33,010
2007/08	1,978,000	55,056
2008/09	2,450,000	39,160

9) Mr Van Der Velde states that his company attends trade fairs to promote their products primarily the Harrogate Nursery Fair (2007-2009), the Nuremberg Toy Fair (1998-2009) and the Cologne Fair (2008-2009). At exhibit JVDV2 he provides examples of the advertising carried out including a press release produced for the Nuremberg Toy Fair which he states is attended by retailers throughout the European Union. Although the press release is undated he states that it was released in December 2007. The exhibit includes articles in magazines such as *Overseas Trade* (January 2008), *Five to Seven Educator* (March 2008), *Kent Courier* and *Kent Chronicle* (September 2008).

10) At exhibit JVDV3 Mr Van der Velde produces a sample of eight invoices showing sales under the opponent's trade mark. These are dated between 8 January 2008 and 23 March 2009. They are to customers throughout England, and relate to the goods shown in the opponent's CTM specification.

OPPONENT'S ADDITIONAL EVIDENCE

11) This consists of a witness statement, dated 30 June 2010, by Clare Victoria Turnbull the opponent's trade mark attorney. She provides, at exhibit CVT1, the following definitions taken from the Chambers Twentieth Century Dictionary New Edition and the online dictionary thefreedictionary.com. Ms Turnbull does not make any comment on this exhibit. The exhibit is lengthy and so is included as an annex to this decision, but I summarise below the relevant parts.

KIT: Equipment, a set of articles or implements used for a specific purpose. *v.t.*
(sometimes with *out*) to provide with kit.

FIT: Suitable, well trained and ready, in good condition, to adjust or alter.

12) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

13) The only ground of opposition is under section 5(2)(b) which reads:

“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.”

14) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

15) The opponent is relying upon its trade mark listed in paragraph 4 which is clearly an earlier trade mark. It was registered on 2 March 2007 and is therefore not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

16) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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*,

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; *Sabel BV v Puma AG*, 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 Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

(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-Mayer Inc.*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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-Mayer Inc.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

17) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments

mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods previously outlined.

18) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

19) To my mind the opponent has singularly failed to show that it has a significant reputation in the goods for which its mark has been used. The opponent has provided turnover figures relating to Class 28 goods but has shown no evidence of market share or any independent trade evidence. The turnover figures provided are not, in my opinion, sufficient for them to enjoy enhanced protection because of reputation. This was agreed at the hearing by the opponent. Given the type of equipment they sell, which is designed specifically for children, i.e. chairs which are reduced in size to fit a young child, the mark KIT FOR KIDS is highly allusive. However, I accept that the opponent's mark is registered and therefore has a degree of inherent distinctiveness, although the level of distinctiveness is very low.

20) I must now determine the average consumer for the goods of the parties. It seems clear from the evidence that the goods offered by the opponent are aimed primarily at schools and similar institutions. However, as there is no limitation in their specification it is entirely possible that the general public could potentially form part of the target market. It is not certain quite who the

target market is for the applicant's goods but I believe that it is safe to assume that it will be targeting the same audience. However, with regard to the goods in the instant case I do not believe that there is any difference between the business community and the general public in how they will purchase the goods or in the manner in which they will perceive the marks. I will therefore regard the general public as the average consumer. At the hearing the opponent agreed with this reasoning. To my mind items such as toys, games and playthings; sporting articles and equipment are not purchased without some degree of care as they are purchased primarily for children, and considerations such as safety assume greater importance when purchasing for children. The average consumer will therefore be reasonably circumspect and observant, although I cannot overlook the doctrine of imperfect recollection.

21) I shall first consider the goods of the two parties. For ease of reference, I set out the goods of both parties below:

Applicant's specification	Opponent's specification
Toys, games and playthings; sporting articles and equipment" in Class 28	Class 28: Children's play mats; water-filled playmats; play houses; play tunnels; nursery play equipment; bean bags; foam play equipment; PVC covered foam play equipment; ball pools; play furniture; soft play furniture; active play equipment; play parachutes and play parachute balls.

22) In carrying out the comparison I will take into account *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered, uses, users, nature, trade channels, where the items are to be found and whether they are in competition. This approach was commented on and endorsed in *Canon*.

23) I also take into account the views of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

24) To my mind, the goods of the two parties are clearly identical or very similar. I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Marks			Opponent's Trade Mark
			KIT FOR KIDS

25) The applicant has applied for a series of three marks. Each consists of an identical (save for colour and size) device element and the same three words. There are very minor differences in the font and use of upper and lower case letters and in the first mark of the series the dots above each use of the letter “i” is coloured (although there is no colour claim). However, these differences are such that the marks can be regarded as effectively identical for the purposes of the comparison test with the opponent’s mark. In making the comparison I shall therefore use the first mark in the series and refer to it in the singular. I have chosen this mark as the device element is the smallest and it offers the opponent its strongest case.

26) Both parties’ marks both contain more than one word or element and are, therefore, composite marks. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components. The applicant’s mark consists of a device and also three words, whereas the opponent’s mark is simply three words. To my mind the device element in the applicant’s mark will be viewed as a malleable human figure similar to the toys which are sold on the strength of their ability to be stretched. I do not believe that the device element will be viewed as the distinctive or dominant element of the applicant’s mark. Given the word element of the applicant’s mark the device will be seen as a caricature of a child. Therefore the word element is the most dominant feature of the applicant’s mark although the device element cannot be overlooked.

27) The marks of both parties are highly allusive for the goods on which they are used. The opponent’s mark KIT FOR KIDS when used on play equipment designed for children is highly allusive. The applicant’s mark FIT FOR KIDS when used on toys and play equipment is clearly a reference to its suitability for children perhaps in terms of robustness or in its design.

28) The opponent contends that the marks differ by a single letter. This is incontrovertible as far as the word elements are concerned. They contend that a “carelessly written ‘K’ may have the appearance of an ‘F’ and vice versa”. I do not accept this, but in any case if something is so badly written that an “F” can be viewed as a “K” then in all likelihood the rest of the mark is going to be illegible.

29) In considering the issues I also take into account the views of Mr S Thorley sitting as the Appointed Person in the *REACT* case [2000] RPC 285 where he said:

“[*Counsel*]drew my attention to the fact that in relation to clothing of the type for which the mark is to be registered, anybody using the mark aurally would be informed to some extent of the nature of the goods they were proposing to purchase; they will therefore know of a mark; and they will know what they want. I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

30) To my mind the goods of the two parties fall firmly within the category of goods which would be selected visually, whether in a store or whilst looking in a catalogue. At the hearing the opponent accepted this in part but felt that in schools and nurseries the aural aspect would be as important. No reasoning was provided and there is no evidence that such establishments would differ from the rest of society in viewing such goods in a catalogue or in a store.

31) Visually the marks share two identical words, differing only by the first letter of the initial word in each party's mark. The applicant's mark also has the device element which although not dominant cannot be overlooked. Aurally, the device element is not in play and so the sole difference is the initial letter of the first word. Conceptually the last two words of each of the marks, FOR KIDS, are identical. The only difference being the initial word. However, that difference is considerable. As I have stated earlier the opponent's mark is highly allusive of the goods, play equipment or KIT specifically designed FOR KIDS. The applicant's mark is only slightly allusive in that it is used on play equipment which is suitable or FIT FOR KIDS. The opponent contended that the word "FIT" could mean to supply that which is needed and as such you could "kit out" or "fit out" a child with toys, games or playthings. It was therefore contended that as the words were interchangeable they were similar. If the goods were bathroom appliances or kitchen cupboards one might indeed refer to fitting out a bathroom or kitchen with the requisite kit, or kitting it out. However, when used on toys and playthings the average consumer will see the obvious connection in that the applicant's goods are suitable in terms of size, quality or robustness for children, whereas the opponent's mark refers to equipment for children. The applicant's mark almost has the ring of official confirmation about it, even though in reality all playground equipment has to pass stringent safety checks. To my mind the differences both visually and conceptually outweigh the similarities.

32) I note the comments of the ECJ in *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P*, where they stated:

“45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element

and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

33) I take all of the above into account when considering the marks globally. To my mind, the differences in the marks are such that even when used on identical goods there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2) (b) therefore fails.

COSTS

Preparing a statement and considering the other side’s statement	£300
Preparing evidence and considering and commenting on the other side’s evidence	£100
TOTAL	£400

33) As the applicant has been successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £400. 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 01 day of December 2010

**George W Salthouse
For the Registrar,
the Comptroller-General**