

O-199-11

**REDACTED VERSION TO REMOVE MATERIAL SUBJECT TO  
CONFIDENTIALITY DIRECTION**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2522502  
BY DAWN WALDRON LTD TO REGISTER THE TRADE MARK**



**IN CLASS 42**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 99843  
BY BIG FISH DESIGN LTD**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2522502  
By Dawn Waldron Ltd to register the trade mark**



**And**

**IN THE MATTER OF opposition thereto under No 99843 by Big Fish Design Ltd**

**BACKGROUND AND PLEADINGS**

1. On 31<sup>st</sup> July 2009, Dawn Waldron Ltd of 20 Tolland Lane, Hale, Altrincham, Cheshire WA15 0LD (hereafter 'Waldron') applied to register the mark as above in Class 42. The services are as follows:

Packaging design services; advisory and consultation services in respect of packaging design.

2. The application was allocated number 2522502 and was published in the Trade Marks Journal on 2<sup>nd</sup> October 2009. On 2<sup>nd</sup> December 2009 Big Fish Design Ltd of 11 Chelsea Wharf, 15 Lois Road, London SW10 0QJ (hereafter 'Big') lodged an opposition against the services specified above.
3. Big has opposed on the sole basis of section 5(2)(b), citing the following earlier marks:

Marks. Filing and registration dates	Services relied upon under section 5(2)(b)
<p>UK 2103876 ('876)</p> <p>Big fish big fish BIG FISH BIGFISH Bigfish bigfish</p> <p>28<sup>th</sup> June 1996</p> <p>7<sup>th</sup> March 1997</p>	<p>Class 42</p> <p>Graphic arts design; packaging design; designs relating to publications and brochures; consultancy services relating to graphic design; all included in Class 42.</p>
<p>UK 2404020 ('020)</p> <p>Big fish big fish BIG FISH BIGFISH Bigfish Bigfish</p> <p>14<sup>th</sup> October 2005</p> <p>11<sup>th</sup> May 2007</p>	<p>Class 9</p> <p>Computer software; data recorded electronically from the Internet; computer software downloaded from the Internet; all such goods relating to marketing and design services for clients; company magazines downloaded via the Internet.</p> <p><b>Class 16:</b></p> <p>Paper, cardboard and goods made from these materials relating to marketing and design services for clients; printed matter relating to marketing and design services for clients; photographs; plastic materials for packaging (not included in other classes); brochures, leaflets, and circulars, catalogues, printed guides, research surveys, folders, point of sale material, all relating to marketing and design services for clients.</p> <p><b>Class 35:</b></p> <p>Advertising, marketing, promotional, publicity, public relations and sales promotion services;</p>

	<p>business management, administration, organisation and information services; production, placing and dissemination of advertising, sponsorship and marketing matter; provision of space on web-sites for the advertising of goods and services and the compilation of such advertisements; market research, analysis, assessment and forecasting; buying and planning of media, advertising and sponsorship space; business promotion services provided by audio/visual means; consultancy, information, research and advisory services relating to all the aforesaid.</p> <p><b>Class 41:</b> Publishing; photography.</p> <p><b>Class 42:</b> Graphic arts design; commercial and packaging design; designs relating to publications, corporate identity, brochures, web-sites and other marketing materials; computer programming; computer software design; industrial design; consultancy, information, research and advisory services relating to all the aforesaid.</p>
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4. In its pleadings, Big say the respective marks are very similar with the second, very distinctive word, 'fish', being common to both. The respective marks are conceptually very similar as 'big' and 'little' are simply adjectives, relating only to size, albeit opposites. Big say the services are identical and consumers will think that the applicant's business is related to, perhaps a small subsidiary of, the opponent.
5. Waldron filed a counterstatement denying, in particular, that the words are conceptually similar; indeed, it says the concept of the two words is quite different. It admitted the services are identical. Overall, it denied any likelihood of confusion. It did not put Big to proof of its use of its '876 mark.
6. Evidence was filed by both parties which, insofar as it is factually relevant, I shall summarise below. Written submissions were received from the applicant and the opponent which I shall take into account. No hearing was requested by either party and so I give my decision based upon a careful reading of the papers.

## Opponent's evidence

7. This takes the form of a witness statement, dated 18<sup>th</sup> April 2010, by Peregrine Haydn Taylor, founder, creative director and principal shareholder of Big. His evidence is in the main directed to recognition in the market place of BIG FISH, amongst the relevant consumer as well as third parties.
8. The company was incorporated in 1994 but started trading under the name 'BIG FISH' in 1993. The company has worked on a wide range of projects, from pan-European branding work for: Fanta, Coca Cola and Mothercare, to concept and development of brands like Gü, Deliverance, Brora, Dorset Cereals, Cornishware, to name a few. It advises clients on brand strategy, design and new product development and, says Mr Taylor, its expertise spans a wide range of disciplines from digital media channels to print, packaging and moving image.
9. Since it started in 1993, it has created: over 60 brand identities, over 1,000 items of literature, written 27 brand strategies, designed and built over 1,000 websites, art directed over 1,000 photoshoots, shot thousands of HD images in its studio, written designed and produced 140 press ads and produced its first cinema commercial.
10. It has won a number of industry awards such as, eg: 2007 Design Week Awards for Gü, 2007 DBA (Design Business Association), Design Effectiveness Award (Gold) for Dorset Cereals and others. The DBA is the trade association for the UK design industry and its awards are said to use commercial data as a key judging criteria. Design Week claims to be the magazine of choice for over 35,000 design professionals and those that commission and supply products to them. It presents annually in 23 categories and was judged by a panel of 26 industry experts in 2009. Other awards include the Natural and Organic Awards, given by the Soil Association and The Pentawards, specifically awarded to packaging.
11. Big advertises primarily through its website at [www.bigfish.co.uk](http://www.bigfish.co.uk), and through its design 'credits', as well as word of mouth. Over the last 15 years it has relied entirely on referral for new business via people seeing its credit on the things it does. The nature of the credit is discussed below. The website traffic (sourced from Google Analytics) for the year to 28<sup>th</sup> March 2010 was 18,900 visits and 50,000 page views, ie an average of 1,500 visitors per month.
12. Mr Taylor provides turnover figures which are the subject of a confidentiality direction. [These figures are as follows: Figures redacted]

13. Big always insists on and makes it a contractual condition that all packaging and designed items include an express design credit (either with the words, “design:www.bigfish.co.uk”, or “site:bigfish@” ). These feature in relatively small lettering on each piece of packaging, other printed material and on the websites it designs. Based on its work for Dorset Cereals and Gü puds alone, the design credit appears on tens of millions of packs and printed matter each year. Exhibit PHT4-1-3 shows the design credits on 3 current brands (Dorset Cereals, Gü and Clipper Tea) as well as on the respective websites of these products. The design credit appears in the same way now as it did on 31<sup>st</sup> July 2009.
14. Some of the clients’ products are available in larger supermarkets and others through smaller specialist outlets or over the internet. Big has worked with Waitrose for over 5 years, for Boden Clothing for over 10 years and for Peter Gabriel as a brand consultancy for Real World and Womad. A full list of clients over the last 14 years appears at Exhibit PHT1-8.
15. Mr Taylor then refers to the websites which bear his company’s credit and in some cases, such as Gü Puds, the founder provides a testimonial to BIG FISH. Similarly, Dorset Cereals also acknowledge the role of BIG FISH in its packaging. Based on the various websites where credit to BIG FISH has been given, it is estimated that there have been over 3,750,000 page views displaying the BIG FISH name in the last 12 months. As Mr Taylor says, these websites will have been viewed not just by consumers but also those in the design industry and they would be able to identify the source of the design input.
16. Mr Taylor says there would be third party recognition by competitors of its clients. The website [www.lovelypackage.com](http://www.lovelypackage.com) featured BIG FISH’s design for Dorset Cereals, acknowledging the source in a posting in April 2009. Likewise, the website [www.thedieline.com](http://www.thedieline.com) featured Gü puds packaging.
17. On a personal level, Mr Taylor is regularly invited to appear on behalf of BIG FISH at award ceremonies and on the television and radio.
18. There have also been a number of references to BIG FISH in the general and specialist press, which Mr Taylor recounts. Publications include the Daily Telegraph, the trade publication ‘Packaging News’, ‘Marketing’ and ‘New Media Age’. In summary, Mr Taylor believes a great deal of awareness of BIG FISH has built up amongst the design community as a result of his company’s successful projects.

## **Applicant's evidence**

19. This takes the form of a witness statement, dated 31<sup>st</sup> August 2010, from Dawn Waldron, the Managing Director of Waldron. Her evidence is directed, in the main, to the question whether the term 'Big fish' can be said to be unique or distinctive in the relevant field. She starts by saying the term 'Big fish' is a widely used idiomatic expression, used to refer to persons or organisations which are considered important. She notes the existence of a significant number of companies in the UK trading under the name 'BIG FISH' in the marketing/advertising/media/communications sectors.
  
20. Exhibit DW1 comprises the results of a GOOGLE search on the words 'big fish design'. The search was conducted on 12<sup>th</sup> August 2010 and shows the first 10 hits. The first two relate to the opponent. Thereafter, the hits relate to: an advertising company based in Derry called Big Fish Design ([www.bigfishdesign-ad.com](http://www.bigfishdesign-ad.com)), a company called Big Fish Internet ([www.bfinternet.com](http://www.bfinternet.com)), a London based design agency called Big Fish ([www.hautstyle.co.uk/big-fish-design/](http://www.hautstyle.co.uk/big-fish-design/)), a web design company called Big Fish in Torbay ([www.bigfishtorbay.co.uk](http://www.bigfishtorbay.co.uk)) and a print management company called Big Fish Creative ([www.bigfishcreative.co.uk](http://www.bigfishcreative.co.uk)).
  
21. She has also obtained more detailed information on various 'Big Fish' companies and the following are mentioned specifically:
  - Big Fish Media Ltd ([www.bigfishmedia.co.uk](http://www.bigfishmedia.co.uk)) specialising in voiceover talent. Exhibit DW2 comprises extracts from the company's website;
  
  - Big Fish Recruitment ([www.bigfishrecruitment.com](http://www.bigfishrecruitment.com)) is a recruitment agency specialising in the creative design sector. Exhibit DW3 is information from the company's website;
  
  - Big Fish Public Relations Ltd ([www.bigfishpublicrelations.co.uk](http://www.bigfishpublicrelations.co.uk)) specialising in PR for the health, leisure and fitness industries. Exhibit DW4 comprises details from this company's website and domain name registration;
  
  - Big Fish (UK) Ltd ([www.bigfishcoaching.co.uk](http://www.bigfishcoaching.co.uk)) specialising in executive and business coaching. Exhibit DW5 comprises details from this company's website together with company registration information;
  
  - Big Fish Telecom (<http://bigfishtelecom.com/index.html>) providing telecom solutions. Exhibit DW6 comprises copies of the company's website and domain name registration;

Big Fish Creative Ltd (<http://www.bigfishcreative.co.uk>) offering brand design, development and promotion. Exhibit DW7 comprises extracts from the company's website together with domain name registration;

Big Fish Events Ltd, ([www.bigfishevents.co.uk](http://www.bigfishevents.co.uk)) being a provider of branding solutions for music industry consumers. Exhibit DW8 provides details from this company's website and company registration;

Big Fish Design and Advertising ([www.bigfishdesign-ad.com](http://www.bigfishdesign-ad.com)) specialising in design and advertising. Exhibit DW8 comprises pages from this company's website;

Big Fish International Ltd ([www.bigfishinternational.com](http://www.bigfishinternational.com)) specialising in healthcare research. Exhibit DW10 comprises pages from the company's website and company registration.

22. Ms Waldron also notes that the term 'Big Fish' is used in a number of press articles and publications. Exhibit DW11-DW13 are pages from the Bank of Scotland's 'BigFish Magazine' for women in business and copies of online articles from the websites of 'Personnel Today' and 'GDS Infocentre'.

### **Opponent's evidence in reply**

23. This takes the form of a witness statement dated 12<sup>th</sup> November 2010 by Anthony Medd, partner and head of strategy of a firm called Mother Advertising Ltd. This was established in 1996 and Mr Medd was one of its founding partners. This company is one of the UK's largest independent advertising agencies with 400 employees spread across offices in London, New York and Buenos Aires, and it works for clients such as Boots, Coca-Cola, Schweppes, Stella Artois, IKEA and the Post Office.
24. He says the company has experience of developing new products and packaging designs and because of this he is aware of the leading players in the UK in the field of such design activity. He has known of Big Fish Design Ltd since its early days of business in the mid 1990's and considers it to be one of the leading and best known graphic design businesses.
25. He is not aware of anyone other than Big Fish Design that uses the name BIG FISH in the field of graphic design, including package design, or other brand advisory services, such as marketing and promotional activity. If there are such businesses trading, he assumes they are local and relatively small operations.
26. As a result, if he hears the name BIG FISH, in relation to design generally, and the design of packaging specifically, he immediately and without question assumes it to refer to Big Fish Design Ltd. Finally, he says that if he heard



mention of the name 'Littlefish', he would automatically assume this to be somehow connected with Big Fish Design Ltd, perhaps being a sister company or specialist division of Big Fish Design Ltd.

27. There is also a witness statement dated 15<sup>th</sup> November 2010 from William Robert Barlow, who is commercial director of Big Fish Design Ltd. His evidence is directed towards the efforts made by the company to protect its brand, as well as providing a critique of the various companies sharing the name BIG FISH identified by Dawn Waldron.
28. He says his company keeps an eye open for new companies that either share their name, or that in his view may seek to trade or register a name that may conflict with theirs. Lawyers have resolved a number of conflicts in this regard and 11 examples are listed in his evidence. He notes however, that his company would only seek to engage or take action where he feels the 'core area' of his company's business is involved.
29. Of the companies listed by Ms Waldron, he says the majority of them are not in the same field or sufficiently close to warrant legal action. One use cited was known to him but he has not known of it long and the matter is under review. Two of the uses are new to him. Those companies that operate in his core area are, in his view, tiny, working only on a local scale. His clients or potential clients would not have heard of them.
30. Specifically, he says Big Fish Creative Ltd do seem to operate in his company's core area but appear to be local to Worthing or Letchworth. He was not aware of Big Fish Design and Advertising but this is based in Northern Ireland. The remainder of the companies listed do not, in his view, operate in his company's core area.
31. He then observes, concerning Exhibits DW11 – 13, that some of the hits show use of 'big fish' as part of a larger expression, as in, "big fish in a small pond". None of the articles show use as a brand.
32. He concludes by saying that a new player coming into his company's core area with the name LITTLE FISH would be perceived as somehow being connected with BIG FISH. His company already has a number of spin off ventures, and the name LITTLE FISH is just the sort of 'play' on his company's name he could well want to use. Moreover, it is also the sort of play that his clients would probably expect his company to come up with, eg focussing on some niche aspect of his company's overall business, such as packaging design.

## DECISION

### Section 5(2)(b)

33. The opposition is founded upon Section 5(2) (b) of the Act. This reads:

“(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.”

34. The ‘876 earlier trade mark in this case has a filing date of 28<sup>th</sup> June 1996 and a date of registration of 7<sup>th</sup> March 1997. It is therefore an earlier trade mark in accordance with section 6(1) of the Act, and given that its registration date is over five years prior to the date of publication of the application in suit (being 2<sup>nd</sup> October 2009), it is subject to proof of use requirements under section 6A of the Act. However, Waldron has expressly *not* put Big to proof of its use in relation to this mark.

35. In addition, the earlier trade mark ‘020, which is the same as ‘876 but with a broader specification, and with a filing date of 14<sup>th</sup> October 2005 and a registration date of 11<sup>th</sup> May 2007, also plainly qualifies as an earlier trade mark. But, given its registration date, is not subject to proof of use in any event. In the circumstances there is no need for me to consider proof of use in relation to either mark.

36. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (“CJEU”) 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;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **The average consumer and nature of the purchase**

37. The parties are in agreement that the average consumer for both parties' services will be "professional brand managers, marketing managers, new product development managers and designs-conscious entrepreneurs" who "take a particular interest and pride in having high quality design used for their products".

38. The level of attention paid in the purchasing process by this type of consumer will be at a high level.

39. These observations will be factored into my overall consideration of likelihood of confusion below, as and when appropriate.

### **Comparison of the services**

40. It is not disputed that the services in question are identical

### **Comparison of marks**

41. The case law makes it clear I must undertake a full comparison (taking account of visual, phonetic and conceptual similarities and dissimilarities), from the perspective of the average consumer. Both marks need to be considered in their totalities and overall impression (see authority (k) above in para 37), taking account of distinctive and dominant elements.

#### ***Visual comparison***

42. As I have said there is no difference between Big's '876 and its '020 mark. Both comprise a series of six variants of the dictionary words, 'Big' and 'Fish' The variants are presented in upper and lower case script, as well as conjoined versions and versions where the words are separated.

43. Waldron's mark comprises the words 'Littlefish Packaging Solutions', together with the device of a shoal of blue and grey/silver coloured fish. The words 'Packaging Solutions' are in much smaller script and below (to the right) of the

main word, 'Littlefish'. The word 'Littlefish' is in blue and formed as a single word, but with the 'f' of the word constructed in an exaggerated and elongated fashion by a blending in of the shoal of fish, but with a clear bar used to form the 'f'. There is no question that the average consumer would see the word 'Littlefish', as it is only the letter 'f' that contains some measure of disguise, and this measure of disguise is not such to create any ambiguity that it is an 'f'. Noting the similarities and dissimilarities between the respective marks, in particular the additional matter in Waldron's mark, being the device and descriptive words and the forming of the single word, 'Littlefish', I find that the respective marks are visually similar to a low degree.

### **Phonetic comparison**

44. Big's marks will be pronounced as it is written, 'BIG FISH'. Waldron's mark will be pronounced as 'LITTLE FISH'. In aural use it is unlikely that the descriptive words 'Packaging Solutions' will be enunciated at all; they are plainly subsidiary to the main word 'Littlefish'. Taking the similarities and dissimilarities into account I find that the respective marks are phonetically similar to a low degree.

### **Conceptual comparison**

45. By conceptual similarity, it is meant 'semantic' conceptual similarity and it is under this head that the parties' positions most obviously diverge. Waldron say the term 'big fish' comprises an idiomatic expression, as defined in the Oxford English Dictionary as "an important or influential person or thing", this meaning having been derived from the expression "big fish in a small pond".
46. I have not been able to find this dictionary reference but nevertheless accept that the term 'big fish' may not just convey the obvious meaning to the average consumer, namely that it is fish that is big. But that, given its usage within the well known phrase, 'big fish in a small pond', for many consumers, this longer, idiomatic expression may be brought to mind.
47. The same idiomatic expression will not be brought to mind in Waldron's mark, comprising as it does the words, "Littlefish Packaging Solutions", together with a device element of a shoal of fish. The word 'Littlefish' would be seen as evoking the simple concept of fish that are little. The words 'packaging solutions' are simply descriptive in the context of their usage and thus, overall, the concept evoked will be one of a packaging solutions company which has derived its name literally from the word 'Littlefish'. As I have said, the device element will simply reinforce the derivation of the word 'Littlefish'.
48. Insofar as the respective marks may be said to share a concept, it will be that both are related to fish, but of different sizes. Even though I have accepted that the term 'big fish' may well be seem as belonging to, or having been

derived from, the longer phrase, 'big fish in a little pond', this, emphatically, does not take away or otherwise detract from the shared 'fish' reference or 'concept' because words can carry more than one meaning. On that basis, I find that the respective marks share a moderate degree of conceptual similarity.

### **Overall similarity of the marks**

49. At this point I need to make a finding in respect to 'overall impression' of the respective marks, having regard to any distinctive, dominant elements.
50. Big's is a simple, word only mark. The word 'big' in 'big fish' is an adjective, describing the size of fish. Waldron's mark is more complex, having other elements but there is no doubt that the distinctive, dominant element of the mark is the word 'Littlefish' which occupies a dominantly central position and is relatively large compared to other elements. The other elements are descriptive, as in 'packaging solutions', or otherwise simply reinforce the word 'Littlefish', as in the shoal of fish device.
51. In all the circumstances, taking the visual, aural and conceptual assessments *overall*, I find the respective marks share moderate degree of similarity.

### **Likelihood of confusion**

52. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK of course being the prime example.
53. The earlier mark comprises the dictionary words 'big fish', which will be understood by the average consumer. Viewed purely on an *inherently distinctive* level, although the words, as I have said, may be seen to be derived from the phrase 'big fish in a small pond', such a term is normally applied to, or about, a person. On that basis, the earlier mark can be said to be at least averagely distinctive. In other words, in the context of the name of a design company, it does not have the most immediate and obvious relevance or meaning. Plainly though, I need to also consider carefully the impact of the evidence of both parties, insofar as it may enhance the distinctiveness of the earlier mark or, as far as Waldron are concerned, undermine it.
54. Big's position is that it is a well-known and established design company with, especially through its contractual credits, a high level of exposure amongst the design community in particular. Big's evidence suffers slightly from an absence of context; in other words, it is not clear what the overall size of the

relevant market is in the UK. Without this, the turnover figures are hard to evaluate, in and of themselves. That said, Big makes a good case for having a high level of exposure amongst the relevant community; the insistence on credits on products such as Dorset Cereals and Gü Puds, as well as on their respective websites, ensures that those in the design business will be able to identify the company responsible for the packaging design. This profile has been enhanced through the company's awards and the personal activities of its founder. Added to which, I have the evidence of Mr Medd and his large advertising agency.

55. At this point I need also to address Waldron's argument that the term 'big fish' is used by many operators, which in turn and in the context of actual market place conditions, serves to undermine any claim to inherent or enhanced distinctiveness. In this regard, I think the criticisms of this evidence made by Big are, at least to a large extent, valid. That is to say, the companies chosen by Waldron are, for the most part, not engaged in Big's core activity, or alternatively operating on a small or localised scale. Big has demonstrated it has taken action to police its own core area of activity against those who, from its perspective, get 'too close'. In all the circumstances, I do not believe Waldron's evidence undermines the claim to enhanced distinctiveness through use, or my finding of the inherent level of distinctiveness of the earlier mark.
56. In all the circumstances, I find that the mark BIG FISH (as two separate words rather than conjoined) has established a measure of enhanced distinctiveness with the average consumer in the course of its use. Taking this into account I find that the earlier mark has a high level of distinctiveness overall, and as a result of the use made of it.
57. So, I have found that the respective goods are identical. I have found the earlier mark to be distinctive to a average level and that this level of distinctiveness is enhanced through use. I have made observations on the respective average consumers, namely that they are also identical and I have found the purchasing process to involve considered purchasing. Finally, I have found the respective marks to share a moderate degree of similarity. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in Big's favour, it wins. All factors must be weighed in the evaluation of likelihood of confusion.
58. At this point I need to reflect on the nature and meaning of the word 'confusion' as the word has been interpreted in relation to the section 5(2)(b). Case law recognises that confusion may be 'direct' or 'indirect'. Direct confusion involves the consumer in mistaking one mark for another. Indirect confusion arises where the consumer has recognised that the later mark is different from the earlier mark but nonetheless believes, taking the common

element between the respective marks into account, that the later mark is another brand of the owner of the earlier mark.<sup>1</sup>

59. In this case, the case for direct confusion between the respective marks may not be the strongest, but it is the argument for indirect confusion that has some force. In other words, the average consumer may believe that services operated under the later mark are economically connected to those of the earlier mark. In this regard, the adjectives 'big' and 'little', although at the opposite ends of a spectrum, solely act to qualify the operative word, 'fish'. Notwithstanding the idiomatic longer phrase, 'big fish in a small pond', it seems entirely plausible that the average consumer will see the 'LITTLEFISH' mark as referring, eg to a niche activity of the proprietor of the earlier mark, such as solely packaging design. In saying this, I must of course be cautious with the evidence of Mr Barlow and Mr Medd, insofar as they may purport to express an opinion of the question of likelihood of confusion, which is for me to decide. Despite this note of caution, as I have said, it nevertheless seems to me likely that an economic connection will be made, especially given that I have found the earlier mark to benefit from a measure of enhanced distinctiveness.

[  
60. Taking *all* the relevant factors into account, and finally also noting of course the interdependency principle, whereby a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa, I find there will be likelihood of confusion in this case.

61. The opposition accordingly succeeds in its entirety.

## **COSTS**

62. Big Fish Design Ltd has been totally successful in its opposition. Accordingly, it is entitled to a contribution towards its costs and neither party sought costs off the normal scale. In the circumstances I award Big Fish Design Ltd the sum of £1400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

1. Filing opposition and considering counterstatement - £400
2. Filing evidence and considering other parties' evidence- £ 500
3. Filing submissions - £500

Total £1400

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<sup>1</sup> See eg, *LA Sugar* BL O-375-10 paras 16 and 17, a decision of the Appointed Person.



63. I order Dawn Waldron Ltd to pay Big Fish Design Ltd the sum of £1400. The sum should 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 09 day of June 2011**

**Edward Smith  
For the Registrar,  
the Comptroller-General**