

O-157-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 3 072 688 IN THE NAME
OF TAURUS MUSIC B.V. TO REGISTER THE TRADE MARK WOZZLE & PIP IN
CLASSES 09, 16, 24, 25, 28, 35 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 403 763 IN THE NAME
OF TATTIEMOON LIMITED**

Background and pleadings

1. Taurus Music B.V. (the applicant) applied to register the trade mark WOZZLE & PIP in the UK on 15 September 2014. It was accepted and published in the Trade Marks Journal on 5 December 2014 in respect of the following goods and services

Class 09:

Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, image and sound carriers (discs); Compact discs, DVDs and other digital recording media; Data processing equipment and computers; computer software; computer games entertainment software; electronic publications; publications in electronic form, supplied online from databases or from facilities provided on the Internet; digital recording media; Computer software applications for mobile telephones, smartphones, notebook computers, computers and media players; software applications delivered online through a web-browser or as a downloadable application or application delivered to any computing device including desktop, laptop and tablet computers as well as mobile devices.

Class 16:

Paper, cardboard; Printed matter; books; magazines; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Instructional and teaching material (except apparatus); Plastic materials for packaging (not included in other classes); Printers' type; Printing blocks.

Class 25:

Clothing, footwear, headgear.

Class 28:

Games and playthings; Gymnastic and sporting articles not included in other classes; Decorations for Christmas trees; stuffed toys; soft toys.

Class 35:

Advertising; Business management; Business administration; Office functions; Sales promotion; Writing of publicity texts; retail and wholesale services connected with the sale of toiletries, textiles, bed covers, bed linen, duvet, quilt and pillow covers and cases, valances, cushion covers, curtains, bath linen, towels, table covers, table linen, tablecloths, table mats, tea towels, serviettes, handkerchiefs, clothing, footwear, headgear, embroidery and embroidery designs, floor coverings, games and playthings, foodstuffs and non-alcoholic beverages, furnishings for children's bedrooms; party paper hats, party decorations, party novelty hats, paper party favours, paper cake decorations, paper napkins, paper party bags, paperweights, paper gift wrap bows, paper pennants, paper place mats, paper table cloths, plastic party bags, party games, party poppers, novelties for parties, crackers, pinatas, balloons, streamers; dummies and soothers for babies, bottles for babies, babies' clothing, babies' potties, babies' baskets, babies' cradles, babies' chairs, carriages for babies, babies' bottles, toys for babies, crib mobiles, crib toys, children's clothing, children's playthings, envelopes, writing implements, writing materials, pens, pencils, painting sets for children, crayons, comics, colouring books, colouring pages, activity books, colour pencils, chalks, erasers, sharpeners, rulers, pen and pencil cases and holders, posters, prints, paintings, pictures, labels, stickers, books, sticker books, height charts; puzzles, electronic toys, calendars, night lights, torches, plasters, toiletries, hair accessories, greetings cards, lunch boxes, drinking bottles & cups, watches, wall/window stickers, beds for animals, toys games and playthings for pet animals, collars for animals, harnesses for animals, leads for animals, leashes for animals, clothes for animals, combs for animals, bells for animals; car sunshades, car safety seats for babies and children, neck cushions for

children, car seat belt cushions, car chair organisers; Import and export services; Administrative processing of business orders; Compilation of statistics; Market prospecting, research and analysis; Opinion polling; Compilation of information into computer databases; Data file administration; Organization of trade fairs and exhibitions for commercial or advertising purposes; Information and consultancy relating to the aforesaid services; All the aforesaid services whether or not provided via electronic channels, including the Internet.

Class 41:

Education; Providing of training; Entertainment; Sporting and cultural activities; Arranging games and competitions; Conducting award ceremonies; Arranging, producing, presenting and carrying out concerts, festivals and other events and activities for musical, educational, cultural or entertainment purposes; Providing digital music (not downloadable) from the Internet; Concert, musical and video performances; Audio, film, video and television recording; Production of films, video films, radio and television programmes and music; Production of live entertainment; Production of theatre; Theatre entertainment; Presentation of live performances, musical performances and entertainment via television, radio and film; Providing of entertainment via film, television and music videos from interactive websites; Editing and publishing (other than printing); Providing electronic publications, non-downloadable; Compilation and providing of training, courses and workshops; Arranging and conducting of conferences, seminars, congresses, symposiums, lectures and other such educational activities; Publishing, lending and dissemination of newsletters, books, newspapers, magazines, brochures, leaflets, printed matter and other texts and publications; Writing of texts, other than publicity texts; Organization of trade fairs and exhibitions for educational purposes; Information and consultancy relating to the aforesaid services; All the aforesaid services whether or not provided via electronic channels, including the Internet; Theatre productions; Courses, providing of training, training sessions and seminars, in particular in relation to day-nurseries (crèches); Education of children in the context of day-nursery (crèche) activities.

2. Tattiemoon Ltd (the opponent) oppose the trade mark on the basis of Section 5(2) (b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark WOOLLY AND TIG. The following goods and services are relied upon in this opposition¹:

Class 09:

Audio, video, still and moving images and text and data recordings in compressed and uncompressed form; CDs, CD-ROMs, DVDs; computer software including software for use in downloading audio, video, still and moving images and text and data in compressed and uncompressed form from a computer or communication network; computer programmes and computer equipment, audio systems, cassette players, video players, CD players, DVD players, MP3 players, MP4 players, video games programmes, consoles, joysticks and memory cards for use with video games programmes; electronic instructional and teaching apparatus and instruments; downloadable electronic publications; mouse mats; parts for all the aforesaid goods.

Class 16:

Paper, cardboard and goods made from these materials; printed publications; magazines; books; pamphlets; catalogues; printed guides; photographs; stationery; adhesives for household purposes; book binding material; artists materials; paintbrushes; paint boxes for children; printing blocks; posters; cards; postcards; trading cards; greetings cards; diaries; calendars; prints; gift boxes; note pads; writing instruments and crayons; coasters; packaging materials; gift and luggage tags; ornaments of paper, card and papier-mâché; stickers; transfers; stamps; personal organisers; address books; note books;

¹ The goods and services displayed in bold is also relied upon in respect of Section 5(3) and Section 5(4)(a)

pen and pencil holders; desk mats; embroidery, sewing and knitting patterns; gift wrap.

Class 24:

Textiles and textile goods; household linen; table linen; bed linen; curtains; table mats; sheets, pillow cases, duvets and duvet covers, bedspreads; towels; face towels; handkerchiefs; cushion covers; embroidery and sewing kits; sleeping bags for children; wall hangings of textiles.

Class 25:

Clothing; footwear; headgear.

Class 27:

*Carpets, **rugs, mats** and other materials for covering existing floors; wall hangings (non-textile).*

Class 28:

Toys, games and playthings; gymnastic and sporting articles; dolls; soft toys; plush toys; cloth toys; toy and novelty face masks; toy musical boxes; toy musical instruments; toy models; floats and inflatable toys for play purposes; puzzles; kites; play balls and play balloons; puppets; plastic toys; bath toys; play sets; developmental toys; playing cards; wheeled toys, scooters, bicycles and tricycles; video games equipment being joysticks and headsets for use with video games.

Class 30:

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; coffee beverages with milk; coffee-based beverages; tea-based beverages; cocoa-based beverages; flour and preparations made from cereals, bread, pastry and confectionery, ices; ice cream; frozen yoghurt; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 35:

Retail services and online retail services connected with the sale of audio, video, still and moving images and text and data recordings in compressed and uncompressed form, CDs, CD-ROMs, DVDs, computer software including software for use in downloading audio, video, still and moving images and text and data in compressed and uncompressed form from a computer or communication network, computer and electronic and video games programmes and equipment, electronic instructional and teaching apparatus and instruments, downloadable electronic publications; retail and online retail services connected with the sale of baby bottle warmers, baby food warmers, bicycle lamps and lights, reflectors for attachments to bicycle spokes, lampshades, toilet seats and lids; retail services and online retail services connected with the sale of paper, cardboard and goods made from these materials, printed publications, photographs, prints, stationery, adhesives for household purposes, book binding material, artists materials, paintbrushes, paint boxes for children, diaries, calendars, gift boxes, note pads, writing instruments and crayons, packaging materials, gift wrap, gift and luggage tags, ornaments of paper, card and papier-mâché, personal organisers, address books, pen and pencil holders, desk mats, embroidery, sewing and knitting patterns; retail services and online retail services connected with the sale of textiles and textile goods, household linen, table linen, bed linen, curtains, table mats, pillow cases, duvets and duvet covers, bedspreads, towels, face towels, handkerchiefs, cushion covers, embroidery and sewing kits, sleeping bags for children and wall hangings of textiles; retail

services and online retail services connected with the sale of clothing, footwear and headgear; retail services and online retail services connected with the sale of carpets, rugs, mats and other materials for covering existing floors and wall hangings (non-textile); retail services and online services connected with the sale of coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, coffee beverages with milk, coffee-based beverages, tea-based beverages, cocoa-based beverages, flour and preparations made from cereals, bread, pastry and confectionery, ices, ice cream, frozen yoghurt, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, sandwiches, prepared meals, pizzas, pies and pasta dishes.

Class 38:

Telecommunications; broadcasting; radio and television broadcasting; transmission, broadcast and other dissemination of audio, video, still and moving images and text and data in real and delayed time; interactive broadcasting services; rental of radio and television broadcasting facilities; production, presentation and distribution of data and still and moving images; information and advisory services relating to the above.

Class 41:

Provision of entertainment, recreation, education, instruction and training; production, presentation and distribution of text; publishing services including electronic publishing services; non-downloadable electronic publications; production, organisation and presentation of shows, competitions, games, exhibitions, concerts and events; information and advisory services relating to the above.

3. Under Section 5(2)(b), the opponent argues that the respective goods and services are identical or similar and that the marks are similar.

4. Under Section 5(3), the opponent claims that it has a reputation and that the similarity between the marks is such that the public will believe there is an economic connection between them. Further, that the later mark will benefit from the power of attraction, reputation and prestige of the earlier trade mark; will ride on the coat tails and will gain sales and enhanced status as a result of its association with the opponent's mark. In addition, the use of the later mark will be outside of the control of the opponent; any poor quality goods and services provided under the mark will reflect negatively upon the opponent's business leading to detriment to the opponent's valuable reputation. Finally, there will be detriment to the distinctive character of the opponent's mark as it will no longer signify origin.
5. Under Section 5(4)(a), the opponent's claim to have a goodwill in its business and that use of the later mark would misrepresent the goods and services of the applicant as those of the opponent which will lead to damage to the earlier goodwill.
6. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier trade mark relied upon).
7. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
8. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Opponent's Evidence

9. This is a witness statement from Helen Doherty, a Producer at Tattimoon Limited (TL). She explains that WOOLLY AND TIG is a television programme aimed at preschool age children which airs on the BBC's CBeebies channel and which was launched in 2011. The programme is also broadcast in other countries including BBC Kids in Canada, RTE in Ireland, TV NZ in New Zealand. There have been two series of WOOLLY AND TIG on television as well as numerous online and radio episodes. The programme currently averages around 400,000 viewers per episode and is shown twice daily on CBeebies. The episodes on BBC iPlayer have an average of 1,200,000 hits per week. Exhibit HD1 is an extract from the CBeebies website listing the various programmes available to download. Further on YouTube, the number of views for particular episodes is in excess of 900,000. Exhibit HD2 contains an extract supporting this assertion. The programme has its own website (extracts of which are contained in exhibit HD3) which lists information about the programme, lists merchandise available to purchase and a list of retailers.

10. A large range of merchandise is available under the WOOLLY AND TIG brand including toys, magazines, bedding, clothing and DVDs. Exhibit HD4 is extracts from various websites offering the merchandise for sale including amazon. Ms Doherty also explains that Toys R Us, Tesco, Argos and Debenhams sell products under the WOOLLY AND TIG brand. Exhibit HD5 is a full product licensee list including Golden Bear Products (toys) and Penguin/Random House (books).

11. According to Ms Doherty, the approximate annual worldwide turnover for the WOOLLY AND TIG brand is in excess of £1,000,000 (over £1m in 2013 and close to £2m in 2014). The revenue generated from the licenses in 2013 was around £130,000 and in 2014 was £240,000. Ms Doherty claims that the audience share enjoyed by WOOLLY AND TIG is 23% of the overall market in pre-school programming.

12. Exhibit HD6 are extracts from WOOLLY AND TIG's Facebook and Twitter pages as evidence of its presence in social media. Exhibit HD7 are extracts from the iTunes store and WOOLLY AND TIG's own website offering for purchase a WOOLLY AND TIG "app".

13. A number of press articles are included in the evidence. These include:

- Exhibit HD8 is a copy of an online article titled "Woolly and Tig Triumph" dated September 2012 and published by film, TV and games music publisher Accorder music.
- Exhibit HD9 is a copy of an online article dated 6th May 2015 published by global licensing industry trade news provider Licensing.biz highlighting the expansion of the Woolly and Tig licensing programme.
- Exhibit HD10 is an article dated 1st August 2013 published by toysnews-online.biz, attesting to the expansion of the licensing programme.
- Exhibit HD11 are articles published by Toy World Magazine. These are in respect of the Golden Bear signing a three year deal for Woolly and Tig dated October 2012; the "where's Woolly" campaign launched in April 2013 and "Demand for Woolly and Tig toys mounts", dated 30th May 2013.
- Exhibit HD12 are online articles dated 2013 announcing the launches by licensees Dreamtex in respect of bedding and Random House in respect of books.

14. In respect of marketing and advertising activities, the opponent has, according to Ms Doherty, invested heavily in the WOOLLY AND TIG brand. Exhibit HD13 is a collection of advertising/sales material promoting the brand to potential partners and licensees. These are dated between 2012 and 2014. Exhibit HD14 is a collection of CBeebies advertisements for the WOOLLY AND TIG toy range, including promotional competitions for children to win toys. These are dated 2014 onwards.

15. Ms Doherty concludes her witness statement by asserting that the earlier trade mark is the subject of a reputation by virtue of its programmes

transmission throughout the UK, in Europe and beyond. She also makes comments regarding the perceived similarity between the marks in question in these proceedings. These will not be summarised here, but have been taken into account.

Applicant's evidence

16. This is a witness statement from Lucy Woesthoff, the co-owner of the Dreamchaser Company, of which the applicant is the parent company. The following relevant information is contained therein:

- The applicant makes a children's television show involving the characters WOZZLE & PIP. The show started out in the Netherlands under the name Woezel & Pip where it has been shown for a number of years. The original plan in the UK was to use the name WOOLLY & PIP but upon contact from the opponent, this was changed to WOZZLE & PIP in order to avoid a conflict.
- Doubts are raised regarding the extent of the earlier mark's reputation. Ms Woesthoff notes at Exhibit LW 5 which is an extract from the CBeebies website that WOOLLY AND TIG is one of over one hundred programmes available for the pre-school age group. Further, there are numerous other channels aimed at that age group such as Disney Channel, CITV, Channel 5, Nickleodeon. As such, Ms Woesthoff is of the view that a 23% audience share for all pre-school programming must be an overestimate.
- In response to the opponent's turnover figures, Ms Woesthoff notes the contents of Exhibit LW6. This exhibit is articles from "The Telegraph" and "The Guardian" websites regarding the value of merchandising relating to children's television. For example, in 2010 Peppa Pig had generated £100 million in retail sales with predictions that the total would rise to £150 million. Exhibit LW6 also includes an extract from Ofcom's report into the television sector dated 2015 which states that the total value of the British television industry is £13.2 billion, provided in support of the applicant's opinion that the opponent's relative level of sales are very low.

17. The remainder of the witness statement contains submissions which will not be summarised here but have been taken into account in reaching this decision.

Conclusions on the opponent's evidence

18. It is clear from the opponent's evidence that the television programme WOOLLY AND TIG is enjoying success. The viewing figures provided together with a claimed market share of 23% is notable. Though the latter was criticised by the applicant as an overestimate, no convincing evidence has been provided to refute it. It is also noted that this success has in turn led to a number of merchandising deals and licenses, most notably in respect of toys and books. These also appear to be a success. In considering whether or not a trade mark enjoys a reputation, one must consider whether or not it is known to a significant part of the public concerned. In respect of pre-school children's television programmes, this is likely to be in respect of parents of the appropriately aged children. Based upon the evidence filed, it is clear that the show WOOLLY AND TIG is popular with impressive viewing figures. It is accepted that the earlier trade mark enjoys a reputation in this regard. That said, the extent of its reputation is also limited in this respect, that is, to children's television programmes. This also applies to considerations of enhanced distinctiveness which will be discussed further below.

DECISION

Section 5(2)(b)

19. Sections 5(2)(b) of the Act is as follows:

“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 trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

21. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

22. The respective trade marks are shown below:

WOOLLY AND TIG	WOOZLE & PIP
Earlier trade mark	Contested trade mark

23. Before commencing a comparison of the signs, I must first identify the respective distinctive and dominant components contained in each. In respect of the earlier trade mark, I consider that there is no stand out dominant and distinctive component; rather, the mark will be appreciated instantly as a cohesive phrase. The same applies to the later mark.

24. Visually, it is noted that the marks coincide in respect of the first three letters – WOO. They also share a broadly similar structure: a six letter word and a three letter word divided by an “AND” or a “&”. They differ in respect of the overall look of the six and three letter words though WOOLLY/WOOZLE and TIG/PIP. Though there is a degree of visual similarity between them, this is considered overall, to be low.

25. Aurally, the marks coincide in respect of WOO and AND. They also share a rhythm and structure as a result of the same number of syllables (four in each). However, the aural differences are marked – LLY versus ZLE and TIG versus PIP which have an impact on the articulation of these marks. They are aurally similar to only a low degree.

26. Conceptually, the earlier trade mark is most likely to be seen to be describing a duo called Woolly and Tig. The later trade mark will also be understood to be a duo, called Woozle and Pip. Though in its broadest sense, this means that the marks conceptually coincide, i.e. each describe a duo, a clear conceptual gap is created by the different names which make up each duo. They each have their own distinct identity and so are not considered to be conceptually similar.

Comparison of goods and services

27. In these proceedings, we have a situation where some of the contested goods and services, i.e. provision of entertainment, which would include children's television programmes as a distinct subset are identical to the goods and services on which the opposition is based. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods and services listed above. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier trade mark. If the opposition fails, even where the goods/services are identical, it follows that the opposition will also fail where the goods/services are only similar.

Average consumer and the purchasing act

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

29. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,*

[2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

30. The opponent argues that the average consumer are young children, namely those of preschool age. However, entertainment services are not limited as such. Indeed, they are clearly aimed at the general public at large. Even in respect of programmes aimed at preschool children, the actual average consumer would still be the relevant adult, most likely a parent. It is considered that these services will be at least reasonably considered as a parent is likely to want to ensure an age appropriate program is viewed by a young child. The level of attention expected to be displayed during the purchasing process is medium. The same is likely to be true of the provision of entertainment at large, though there will likely be more of a range of levels of attention displayed (including low), dependent on the exact nature of the type of entertainment in question. .

Distinctive character of the earlier trade mark

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must

make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

32. It has already been found that the earlier trade mark enjoys a reputation in respect of children’s television programmes. However, there is nothing in the evidence beyond such programmes. To this extent, its degree of distinctiveness must be considered on a prima facie basis. In this regard, it is considered to clearly be a trade mark with above average distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

33. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-*

Goldwyn-Mayer Inc, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

34. The high point of the opponent's case appears to lie with children's television programmes for which its mark has also been found to enjoy an enhanced distinctive character. Such programmes are also included in the later specification and indeed, according to the evidence filed, is also the market the applicant is interested in. That these services are identical means that the interdependency principle is in full effect here. The marks themselves have been found to contain numerous visual and aural differences. They also have distinct concepts, each being a different duo. Though this is not relied upon in itself in reaching this decision, it is also noted that the use of duo's are hardly unique within television programmes. Having said all that, it is accepted that there are similarities in overall structure and the initial syllable of each mark does coincide.

35. In terms of the purchasing process, it has been found that the level of attention likely to be displayed will be medium. As such, this is considered likely to negate successfully against imperfect recollection. Even if a lower degree of attention was displayed, the numerous important differences between the marks remain. It is considered that these differences ensure that the relevant public will accurately be able to distinguish between these marks and will not mistake one for the other. Bearing in mind all of the aforesaid, it is considered that there is no likelihood of direct confusion.

36. Before leaving the question of confusion, the following is also borne in mind:

37. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

38. It is considered that the marks in these proceedings have no clear strikingly distinctive common feature which will lead to a consumer to conclude they emanate from the same undertaking. This is not a scenario where a later mark has merely added a non-distinctive element nor is it clearly a logical brand extension. These marks are two, quite distinct duos with their own differing identities. There is nothing to hook in the minds of the average consumer that these marks are from the same source. There is no likelihood of indirect confusion.

Section 5(3)

39. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

40. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the

relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of

the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

41. It has already been found that the opponent has established a reputation. However this is limited to in respect of children's television programmes. As such, this is considered to be a qualifying reputation.

The Link

42. In this regard, I bear in mind the following:

- a) In Case C-408/01, *Addidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them

(see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

- b) In Case C-254/09P, the CJEU rejected an appeal against a judgement of the General Court rejecting an opposition against a Community trade mark application under article 8(5) of the Community Trade Mark Regulation, which is analogous to s.5(3) of the Act. The court held that:

“68. It should be noted that, in order for Article 8(5) of Regulation No 40/94 to be applicable, the marks at issue must be identical or similar. Consequently, that provision is manifestly inapplicable where, as in the present case, the General Court ruled out any similarity between the marks at issue.”

- c) In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

43. The trade marks have already been compared earlier in this decision. However, as the case law already cited sets out, the level of similarity required for the public to make a link may be less than that required to create a likelihood of confusion. These marks have been found to be similar to a low degree visually and aurally. Conceptually, each convey the message of being a duo. However, this does not render them conceptually similar as each is clearly a different duo, with its own distinct identity. Even in respect of services which bring these into direct competition, namely children's television programmes, it is considered that these marks are sufficiently different with the result being that no link will be established between them.
44. Further, even if a link could be established, it is difficult to see how use of the later trade mark would cause injury to the earlier trade mark's reputation.

Section 5(4)(a) – Passing Off

Legislation

45. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

General principles of Section 5(4)(a)

46. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of

passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

47. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

48. The nature of the opponent’s claim under Section 5(4)(a) does not materially exceed the scope of that advanced under Section 5(2)(b). It is therefore difficult to see how there can be a misrepresentation if it has already been found to be no confusion. As such, this claim takes the opponent no further and must be set aside.

Outcome

49. The opposition fails in its entirety.

COSTS

50. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £950 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering notice of opposition and preparing a counterstatement:

£200

Preparing evidence and considering other side's evidence: £500

Preparing written submissions: £250

TOTAL: £950

51. I therefore order Tattimoon Limited to pay Taurus Music B.V the sum of £950. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of March 2016

Louise White

For the Registrar,