

O-267-16

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 1125479 IN THE NAME OF DC
COMICS INC. AND MARVEL CHARACTERS, INC. IN RESPECT OF THE TRADE
MARK**

SUPER HEROES

IN CLASS 16

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 500750 BY START UP POP UP LTD**

Background and pleadings

1) DC Comics Inc. and Marvel Characters, Inc. are the joint proprietors of the mark SUPER HEROES (“the registration”). They applied for the registration on 12 December 1979. The registration covers the following goods in Class 16:

Paper table napkins, invitation cards, stationery, pens, pencils included in Class 16, stamps (not being tools) stamp albums, photograph albums, notebooks, scrapbooks, colouring books.

2) On 18 February 2015, Start Up Pop Up Ltd (“the applicant”) applied for the registration to be declared invalid. The grounds of the application are:

- (i) The registration offends under Section 3(1)(a) of the Trade Marks Act 1994 (“the Act”) because the term SUPER HEROES is a common generic term used by the media, in entertainment and in books and because the term is not unique to the proprietor;
- (ii) The registration offends under Section 3(1)(b) because the term SUPER HEROES is not distinctive enough. It draws analogy to Marvel’s registration of the mark ZOMBIES in the mid-1970s following the success of its publication Tale of the Zombies. The applicant claims that because of the overwhelming popularity of the archetype, Marvel realised that it was impossible to enforce its rights in this mark and it went on to register Marvel Zombies together with the disclaimer “No claim is made to the exclusive right to use zombies”;
- (iii) The registration offends under Section 3(1)(c) because the mark is contrary to the “free to use” doctrine established by the EU courts and it claims that the term SUPER HERO is descriptive of a character within fiction that carries superpowers;
- (iv) The registration offends under Section 3(1)(d) of the Act because the term SUPER HERO is used in a customary way in entertainment and fiction.

3) The proprietor filed a counterstatement denying the claims made.

4) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. A Hearing took place on 19 May 2016, with the proprietors represented by Ms Angela Fox for RGC Jenkins and the applicant by its own Mr Graham Jules.

Applicant’s Evidence

5) This takes the form of a witness statement by Mr Jules, Director of the proprietor. To support the claim that the term SUPER HEROES is not unique to the proprietors, at Exhibit 1, Mr Jules provides the following copies of front covers of comics as examples of other traders also using the same term:

- a comic entitled “Archie’s SUPER HERO SPECIAL”. No date is visible but it is attributed to 1978 by Mr Jules. It is priced at 95 cents;
- a comic entitled SUPER HEROES with the mark DELL appearing in the top right of the page. It is priced at 12 cents. No date is visible but it is attributed to 1967;
- a comic entitled “Magna Man, the LAST SUPERHERO, priced at \$1.95 and attributed to 1988;
- a comic called SUPERSNIPE depicting a sleeping boy grasping a book or comic entitled SUPER HERO. It carries the date “October 1947 and is priced at 10 cents.

6) Mr Jules refers to *Webster’s Dictionary* and he claims that it dates the use of the term SUPER HERO to 17 years before the first use by DC Comics’ parent company and Marvel’s parent company by 22 years. He does not provide the dictionary extract. He contends that the term SUPER HEROES is generic and refers to *Haughton Elevator Co. v Seeberger, 85 U.S.P.Q. 80 (1950)* that considered that the word “Elevators” was generic because it had become recognized by the general public as the name for a moving stairway and not the source of the goods”.

7) Similarly, Mr Jules also refers to the more recent case *Apple, Inc v Amazon.com Inc, Case No. CV 11-01327 PJH (N.D. Cal. July 6, 2011)* in relation to the term APP STORE where it was argued that the term was generic for services for downloading of software programs from the Internet. Mr Jules states that *Apple* dropped its case, so it is not clear what finding, if any, was made by the court.

8) Mr Jules makes the same claim as in the counterstatement that the term SUPER HEROES should be treated the same way as the word ZOMBIES because it lacks any distinctive character. At Exhibit 2 he provides a copy of Marvel's latter US registration where it disclaims any exclusive right in the word.

9) When arguing that the term SUPER HEROES is customary in trade, Mr Jules refers to his Exhibit 1 and his Exhibit 3. The latter consists of examples of use of the term by other traders and includes "Kitchen Superheroes", "Superhero Studies", "Superhero Records", "resuperhero.com", "Superhero ABC", "Superhero Time" and a number of others being used in a wide spectrum of fields.

10) Exhibit 4 contains the details of UK registration 2308299 SUPER HEROES. Mr Jules provides this to support his submission that the mark is not controlled by the proprietors and strengthens his submission that the term is in customary use in trade..

Proprietors’ Evidence

11) This consists of a witness statement by Richard John Parsons, trainee solicitor with RGC Jenkins & Co, the proprietors’ representative in these proceedings. In response to the exhibits filed by Mr Jules, he provides:

Exhibit RJP1: to counter Mr Jules’ Exhibit 1 where a cover of a Dell comic is provided, Mr Parsons provides a printout from the *Wikipedia* website with information about Dell Comics. It states that Dell published comics between

1929 and 1973 i.e. did not produce any comics in the six years prior to the relevant date in these proceedings. It also states that Dell Comics was best known for its animated characters licensed to Walt Disney, Warner Bros and other animated television and film producers. Notably it does not reference any licensing in the form of merchandising;

Exhibit RJP2: a further *Wikipedia* entry, this time in respect of *Supersnipe*, a fictional comic book character published by a third party between 1942 and 1949;

Exhibit RJP4: Copies of pages from *The concise Oxford Dictionary of Current English* (6th Edition, 1976), *Longman Modern English Dictionary* (1976), *The Concise Oxford Dictionary of Current English* (5th Edition, 1964) and *The Shorter Oxford English Dictionary on Historical Principles* (3rd Edition, 1974). The terms “super hero” and “superhero” do not appear;

Exhibit RJP5: This consists of various documents illustrating that the third party use shown in Mr Jules’ evidence relates to goods or services not covered by the proprietors’ registration and often not in the UK.

Applicant’s Evidence-in-reply

12) This consists of a further witness statement by Mr Jules. He refers to the *Cambridge Advanced Learner’s Dictionary & Thesaurus* (© Cambridge University Press). He does not provide an extract but states that it defines SUPERHERO as “a character in a film or story who has special strength and uses it to do good things and help other people” and “someone who has done something very brave to help someone else”. Further, at Exhibit GJ1 Mr Jules provides an extract from the *Oxford English Dictionary – The definitive record of the English language*. This records that the word SUPERHERO originated in 1898 or earlier. The extract also includes the definition: “A person with extraordinary heroic attributes; a benevolent fictional character with superhuman powers, typically one who features in a comic strip or film. Cf. SUPERMAN n.”

13) Mr Jules reiterates that the term SUPER HERO is used generically throughout the entertainment industry and beyond, including the registered goods in question. Exhibit GJ2 consists of copies of web pages showing third parties promoting “superhero pens”, “superhero notebooks”, a colouring and activity book entitled “The Super Book for Super Heroes”, “superhero party napkins” and “superhero disposable paper napkins”.

Legislation

14) The relevant parts of the Act are:

1. - (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

3(1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

15) Section 3 of the Act is relevant in invalidation proceedings because of Section 47(1) that reads:

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

...

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.
Provided that this shall not affect transactions past and closed.

Relevant Dates

16) The language used in Section 47(1), namely, “a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3”. The

underlined words make it clear that the relevant date for assessing if the provisions of Section 3(1) apply to a registered mark must be assessed as the same relevant date that applied when it was originally assessed for registration. That relevant date was the application date of the mark, in this case 12 December 1979. Section 40((3) states that when a trade mark is registered, it shall be registered as of the date of filing of the application for registration and that this date as the date of registration. Therefore, and for convenience, I will refer to the relevant date, in the current proceedings, as the “registration date”. At the hearing, Mr Jules referred to the Registry decision BL O/214/06 *LPGA Trade Mark*, where he suggested that the hearing officer had found that there were two relevant dates, namely the date of application of the registration and the date of the hearing. This case was based upon passing off and grounds based upon relative grounds (based on Section 5 of the Act) and imported into invalidation proceedings by Section 47(2) of the Act. It is well established that in cases such as alleged passing off, there may be circumstances where more than one relevant date applies. However, the current proceedings do not involve a claim of passing off and I find that this earlier decision does not disturb my understanding that in an invalidation action based upon Section 3(1), the relevant date is the registration date of the challenged mark. I dismiss Mr Jules argument. The relevant date in the current proceedings is 12 December 1979.

Applicable Law

17) I have found that the relevant date for deciding these proceedings is 12 December 1979. At that time the Trade Marks Act 1938 was in force, however, the Trade Marks Act 1994 that replaced it includes, in its Schedule 3, transitional arrangements that are relevant for deciding these proceedings. Section 2(1) of that Schedule states:

“Existing registered marks ... shall be transferred on the commencement of this Act to the register kept under the Act and have effect, subject to the provisions of this Schedule, as it registered under this Act”

18) As a consequence of this transitional arrangement, these proceedings must be determined under Section 3 of the Trade Marks Act 1994

Section 3(1)(a)

19) In *Koninklijke Philips Electronics NV and Remington Consumer Products Ltd*, Case C-299/99, the Court of Justice of the European Union (“the CJEU”) stated that:

“30. Moreover, according to the case-law of the Court, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-349/95 *Loendersloot* [1997] ECR I-6227,

paragraphs 22 and 24, and Case C-39/97 Canon [1998] ECR I-5507, paragraph 28).”

and:

“47. First, it is clear from Article 2 of the Directive that a trade mark has distinctive character if it serves to distinguish, according to their origin, the goods or services in respect of which registration has been applied for. It is sufficient, as is clear from paragraph 30 of this judgment, for the trade mark to enable the public concerned to distinguish the product or service from others which have another commercial origin, and to conclude that all the goods or services bearing it have originated under the control of the proprietor of the trade mark to whom responsibility for their quality can be attributed.”

20) In its application the applicant states that the mark is not unique to the proprietor. Such a claim fails to render a sign objectionable under Section 3(1)(a). The aim of this provision is to prevent signs not covered by the definition of signs that may qualify as a trade mark in Section 1(1) from becoming registered. Where a sign may be represented graphically, it will fall within the broad definition contained in Section 1(1). A word mark may be graphically represented when written or printed. Therefore, with the proprietors’ mark consisting merely of two conjoined words, it is graphically represented and therefore clears the low hurdle set by Section 1(1). Consequently, I dismiss this ground of invalidation.

21) Mr Jules, in his first witness statement, also submits that because the proprietors’ mark is in joint ownership, this is not compatible with the definition of a trade mark provided in Section 1(1) of the Act. This is because the proprietors are not a single source of the goods at issue bearing the mark SUPERHEROES and never have been.

22) This point was not pleaded, rather it was introduced into the applicant’s first witness statement and written submissions. Therefore, I will comment only briefly on this point. As Ms Fox pointed out at the hearing, Section 23 of the Act recognises that trade marks may be co-owned by more than one entity. Mr Jules explained that his point is not that the contested mark is in co-ownership but that each of the proprietors has a stable of different super hero characters and the consumer will not know from which of the two proprietors any particular goods originate and, therefore, the mark is incapable of distinguishing one proprietor’s goods from the others. This argument was put forward for the first time at the hearing and there is no evidence to support Mr Jules’ contention or how the joint proprietors trade in respect of the goods at issue. This argument must therefore fail and I dismiss it.

Section 3(1)(b) and (c) – General

23) In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the CJEU stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those

grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

Section 3(1)(c)

24) I find it convenient to consider the ground based upon Section 3(1)(c) next. The case law under Section 3(1)(c) (corresponding to Article 7(1)(c) of the EUTM Regulation, formerly Article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article

7(1)(c) of Regulation No 40/94 , the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’, the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

25) Mr Jules refers to the "free to use" doctrine in EU law in relation to marks that are descriptive and contends that the term SUPER HEROES falls into this category. He relies upon the *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* case (commonly referred to as the *POSTKANTOOR* case) referred to above. This legal basis is uncontroversial, but I must consider the position from the perspective of the UK consumer in December 1979. It is important to recognise that the commercial and social landscape was very different in the late 1970s than it is today. This is a factor that I keep in mind when considering the issues before me.

26) Dictionary references are provided at Mr Jules’ Exhibit GJ1. These are contemporary publications and record that the term SUPER HERO is “in current use” to describe “...fictional characters with superhuman powers, typically one who features in a comic strip or film”. I accept these insofar as they go, but what they fail to do is enlighten me as to (a) whether the UK consumer perceived such a meaning in 1979, and (b) even if they did, whether the same meaning would have been perceived at that time when used in respect of *paper table napkins, invitation cards, stationery, pens, stamp albums* etc (as listed in the proprietors’ registration). There is nothing before me to illustrate that, in 1979, the average consumer was familiar with such goods bearing representations of fictional characters or in the form of such characters. With the vast changes in marketing techniques and strategies since that time, it is not sufficient that I make a finding that today’s average consumer would

perceive the mark as indicating solely that such goods are decorated with depictions of super heroes. In the absence of evidence, I cannot conclude that the UK average consumer in 1979 would have perceived the mark in such a way. If the consumer at that time was not familiar with *paper table napkins, invitation cards, stationery, pens, stamp albums* etc being offered with depictions of fictional characters, the term SUPER HEROES would be unlikely to have the descriptive meaning claimed by the applicant when used in respect of these goods.

27) In respect to the underlying purpose of Section 3(1)(c) that descriptive signs should remain “free to use” and not monopolised by any one trader, in the absence of evidence to the contrary, I am unable to make a finding that traders of *paper table napkins, invitation cards, stationery, pens, stamp albums* etc in 1979 should have been free to use the term SUPER HEROES. There is nothing in the evidence to show that consumers would perceive the mark as designating any particular characteristic of these goods when used upon them, at that time. Just because a term may be descriptive in one field, does not automatically prevent that term being used as a trade mark in a different field. Take for example the word POLO that describes a sport, but it functions as a trade mark for a car. If consumers were familiar with cars being decorated with designs of sportsmen taking part in their sport at the time *Volkswagen* registered its POLO mark, the impression created by the mark may have been perceived differently. There is no evidence before me that, in 1979, the term SUPER HEROES when used in respect of *paper table napkins, invitation cards, stationery, pens, stamp albums* etc would be perceived by the consumer of the time as anything other than an indicator of origin.

28) As Ms Fox observed at the hearing, the evidence provided on behalf of the applicant often relates to a period after (and often many years after) the relevant date in these proceedings and sometimes many years before the relevant date, and/or from a different jurisdiction (the USA). Mr Jules' Exhibit GJ2 showing third party use of "superhero pens" and various "superhero Notebooks" falls into this category. They are undated, but the inference is that it is a contemporary extract located at the time Mr Jules provided his witness statement (January 2016). They do not show that such goods were decorated in this way in 1979.

29) I find that the applicant has not met the evidential burden placed upon it and has not demonstrated to me that, in 1979, the term SUPERHEROS, when used in respect of the goods for which the contested mark is registered, was perceived by the average consumer at that time as anything other than a trade mark.

30) In *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, the CJEU stated that:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which

may serve, in trade, to designate characteristics of the goods or services concerned.

40 However, such a combination may not be descriptive within the meaning of Art.3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41 Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

31) Mr Jules referred to this case when he argues that SUPER HEROES consists of two descriptive terms used together and that they do not create an unusual whole. This may be so in respect of comic characters, but comics are not the goods at issue in these proceedings. In respect of the goods for which the contested mark is registered, there is nothing before me to suggest that the consumer in 1979 would have seen the term SUPER HEROES as designating a characteristic of the goods.

32) In the absence of evidence relating to that time and to the goods covered by the registration, it is not possible for me to reach a conclusion that, at that time the term was perceived as being descriptive of the goods rather than indicating their trade origin.

33) There is some specific guidance regarding the approach to take in assessing whether a trade mark is descriptive of the subject matter of the goods: *Canary Wharf Group plc v The Comptroller General of Patents, Designs and Trade Marks* [2015] EWHC 1588 (Ch) where Mr Iain Purvis QC sitting as a Deputy Judge of the High Court set out the correct approach:

“39. The general approach to be taken by a tribunal dealing with a ‘subject matter’ or ‘theme’ objection under s3(1)(c) or s3(1)(b) was recently considered by Geoffrey Hobbs QC sitting as the Appointed Person in *NMSI Trading Ltd's Trade Mark Application (Flying Scotsman)* [2012] RPC 7 by reference to a number of authorities including the General Court in *Danjaq v OHIM* (Dr No) [2009] ECR II-2097 , Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in *Linkin Park* [2006] ETMR 74 , the First Board of Appeal of OHIM in *Ferrero OHG v FIFA* [2008] ETMR 76 and Mr Allan James in *Diana Princess of Wales Trade Mark* [2001] ETMR 25 .

40 Following, in general terms, the approach of Mr Hobbs as set out in particular in paragraph 18 of *Flying Scotsman*, I believe that at least three matters need to be considered where a 'subject matter' or 'theme' objection arises under s 3(1)(c) or (b) :

(a) The nature of the goods or services for which the application is made. Are they in principle apt to provide or convey information about (or imagery relating to) the subject matter of the sign?

(b) The nature of the sign. Is it something which it is reasonable to believe would be recognised by the relevant class of persons (that is to say average consumers of the goods or services in question) as indicating a particular subject matter or theme?

(c) Is the subject matter or theme of a kind which (in the context of the goods or services in question) the average consumer would consider was controlled by a single economic undertaking, as opposed to something which was free to be used and exploited by anyone. See for example *Psytech International v OHIM* [2011] ETMR 46 at [34]-[43] and the concept of 'official merchandise' recognised in *Arsenal Football Club v Reed* [2003] RPC 9 (CJEU) and [2003] RPC 39 at [50]-[69] (Court of Appeal)."

34) The context of this case involved consideration of a contemporary sign. The context is different to the current proceedings where the relevant date is in 1979, some 37 years prior to the proceedings. Therefore, the guidance that an analysis of whether the relevant goods are apt to provide or convey information the subject matter of the sign must be considered in an amended form, namely were the relevant goods apt to provide or convey information the subject matter of the sign in 1979. Ms Fox submitted that the modern entertainment and commercial landscapes are very different to what they were in 1979. She pointed out that, in recent years there has been an explosion of comic book genre movies and related merchandising. I note this submission. It has not been supported by evidence but as an average consumer of main stream entertainment of this kind, the submission would appear to have some basis. However, the onus is upon the applicant to demonstrate that, in 1979, the average consumer would perceive the term SUPERHEROES when used in respect of the goods for which it is registered, as indicating a characteristic of those goods rather than trade origin. As I have already commented, there is no evidence before me to illustrate this. There is nothing to suggest that, at that time, the average consumer, upon encountering the contested mark being used in respect of such goods, would perceive it as anything other than an indicator of trade origin. Therefore, a finding that the ground based upon Section 3(1)(c) fails is not inconsistent with the guidance provided in *Canary Wharf*.

35) I also dismiss the applicant's submissions regarding the actions taken by the proprietor of the mark ZOMBIES and its choice not to continue with the registration, but rather to re-register it as MARVEL ZOMBIES with a disclaimer regarding the exclusive right to the word ZOMBIES. Ms Fox submitted that this is irrelevant as it relates to a different jurisdiction and to events that took place after the relevant date. I agree, and would further add that the commercial reasons for taking such action

are unknown and may have been because of reasons wholly unrelated to the scenario being contested in the current proceedings.

36) In summary, taking all of the above into account, I conclude that the applicant's evidence is insufficient to demonstrate that, in 1979, the average consumer would have perceived the proprietors' mark as designating a characteristic of the goods for which it is registered. I dismiss the ground based upon Section 3(1)(c).

Section 3(1)(b)

37) The principles to be applied under Article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to Article 3(1)(b) of the Trade Marks Directive and Section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

"29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and

C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37.”

38) I do not understand the applicant’s case to be materially different than that put forward in respect to Section 3(1)(c), namely that the term SUPER HEROES is “a description of a character in fiction” (see its continuation sheet to its Form TM26I). Its case is that because of this descriptiveness, the mark is also devoid of distinctive character. There is no separate pleading regarding this ground. I have already found that the applicant has failed to demonstrate that the mark designated a characteristic of the goods (i.e. it was not descriptive) in 1979 in respect of the goods for which it is registered. It follows, therefore, that it cannot succeed based upon its associated case relating to Section 3(1)(b).

Section 3(1)(d)

39) In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the GC summarised the case law of the CJEU under the equivalent of Section 3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking

from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

40) Mr Jules submits that the term SUPER HEROES has become customary in trade to describe a character within fiction that carries superpowers. As I have stressed in other parts of this decision, I must consider the case as of December 1979 and not the present day. In this respect there is no evidence at all that illustrates that at that time it was customary in the trade to decorate napkins, pens, notebooks etc with “super heroes” let alone illustrate that it was customary in the trade to refer to such goods by reference to the words SUPER HEROES.

41) At the hearing, Mr Jules submitted that he had tried, but failed, to find evidence from 1979 and suggested that this is because of the “perishable” nature of paper products such as napkins. It is not possible to know whether this is the reason why there is no evidence or whether it is because such products did not exist in 1979 and they were not customarily referred to be reference to the term SUPER HEROES. Either way, I am unable to make a finding in favour of the applicant in circumstances where there is no evidence to support the claim. The ground based upon Section 3(1)(d) is dismissed.

Other Arguments

42) Whilst not pleaded, in his evidence and at the hearing, Mr Jules submitted that by registering the term SUPER HEROES, the proprietors have colluded to effectively eliminate all competition within the internal market and are in breach of EU competition. He states that national law must be interpreted in accordance with EU law and that Article 101 Treaty on the Functioning of the European Union (“TFEU”) prohibits business agreements which prevent competition and he submitted that this also amounted to an abuse of the proprietors’ dominant position under Article 102 TFEU.

43) At the hearing, I informed the parties that such a claim was not within scope of the pleaded case (that was restricted to Section 3(1) of the Act). As a consequence, the applicant is not entitled to rely on such an argument. However, even if it was, my view is that it would have no prospect of success because there is nothing before me to demonstrate that in December 1979, the term SUPERHEROES could not function to indicate trade origin of the goods covered by the contested registration. Neither is there evidence that the circumstances surrounding the registration were such as to amount to unfair prevention of competition or abuse of market position.

Conclusion

44) In summary, that application for invalidation fails in its entirety on all grounds.

COSTS

45) The proprietors have been successful and are entitled to a contribution towards their costs, according to the published scale in Tribunal Practice Notice 4/2007. I

keep in mind that both sides filed evidence, but that this was light and a hearing was held. I award costs on the following basis:

Considering statement & preparing a counterstatement	£300
£	
Evidence	£800
Preparing for, and attending hearing	£800
Total:	£1900

46) I order Start Up Pop Up Ltd. to pay DC Comics Inc. and Marvel Characters, Inc. (jointly) the sum of £1900 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 26th day of May 2016

**Mark Bryant
For the Registrar,
The Comptroller-General**