

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1558247
BY ZETA ESPACIAL SA TO REGISTER
THE MARK BIG BANG IN CLASS 30**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 42042
BY GROWSEED AKTIENGESELLSCHAFT**

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5 **IN THE MATTER OF Application No. 1558247
by Zeta Espacial SA to register
the mark BIG BANG in Class 30**

and

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**IN THE MATTER OF Opposition thereto under No. 42042
by Growseed Aktiengesellschaft**

15 **DECISION**

On 5 January 1994 Zeta Espacial SA of Barcelona, Spain applied under Section 17 of the Act to register the mark BIG BANG for a specification of goods which, after amendment, reads "Ices, ice cream; all included in Class 30".

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The application is numbered 1558247.

On 20 February 1995 Growseed Aktiengesellschaft of Liechtenstein filed notice of opposition to this application. The grounds of opposition are in summary:

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- (i) that the mark applied for is not distinctive of the applicants. This goes to Section 9 of the Act
- (ii) under Section 11 in that the mark applied for is likely to deceive or cause confusion having regard to the opponents' use of their mark BANG BANG.
- (iii) under Section 12 by reason of the opponents' registration of the mark BANG BANG (no. 1361782) in respect of "non-medicated chewing gum, bubble gum, all included in Class 30"
- (iv) under Section 17 in that the applicants cannot claim to be the proprietor of the mark at issue

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They also ask the Registrar to refuse the application in the exercise of his discretion.

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The applicants filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour. Both sides filed evidence. The matter came to be heard on 21 December 1998 when the opponents were represented by Mr S J M Kinsey of Wildbore & Gibbons, Trade Mark Attorneys and the applicants by Mr T Mitcheson of Counsel instructed by JY & GW Johnson, Trade Mark Attorneys.

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By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponents' evidence

The opponents filed a declaration dated 24 January 1996 by Antonio Friguls, a Director of Growseed Aktiengesellschaft, a position he has held since 2 October 1995. He confirms that he is authorised to make the declaration; that he has access to the books and records of his company; and that he has a good knowledge of the English language.

He says that the opponents have used their registered trade mark BANG BANG in this country continuously since May 1991 in relation to bubble gum. The following quantities have been sold through their distributors Food Brokers Ltd and through Woolworths Plc.

	<u>Year</u>	<u>Quantities Sold</u>
	1991	826,000 packets
20	1992	7,899,000 packets
	1993	3,066,500 packets
	1994	2,756,000 packets

The total volume of sales over these years is said to have been £768,000 at ex-factory prices. The following sums have been spent on advertising.

	<u>Year</u>	<u>Amount £</u>
	1992	33,000
30	1993	35,000
	1994	19,000

In support of this Mr Friguls exhibits:

AF1 a sales sheet and selection of point of sale stickers

AF2 a typical advertisement which appeared in Convenience Store magazine

The product has also been exhibited at the IFE Trade Fairs in 1992, 1993 and 1994.

He goes on to say that “it is well-known to my Company that the applicant company manufactures confectionery products which contain pieces of bubble gum and which may be said to produce a “big bang” when chewed.”

Finally, he says that the main consumers of his company's products are children who, in his view, will be less able than adults to distinguish between the marks BANG BANG and BIG

BANG or, if they can make the distinction, will wrongly assume that the products have the same source.

Applicants' evidence

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The applicants filed two Statutory Declarations. The first dated 4 April 1997 comes from Meriel Jones, Brand Manager for Birds Eye Walls Ltd (Walls), a position she has held since 1995. She says that:

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“Walls has used the trade mark BIG BANG with the licence and consent of Zeta Espacial S.A. in the United Kingdom in relation to a speciality ice cream on a substantial scale in 1995 and 1996. During those years it made 19.1 million portions of this speciality ice cream and marketed it to wholesalers, distributors and retailers throughout the United Kingdom (England, Wales, Scotland and Northern Ireland), where it was sold in individual units and multipacks of 8 to the general public through supermarkets, confectioners, general stores and variety of other outlets. Retail sales of the BIG BANG ice cream sold by Walls in 1995 and 1996 were in excess of £5.8 million based on Wall’s recommended retail prices, including VAT. There is now produced and shown to me marked “MJ1” a sample label for the product.

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The BIG BANG ice cream sold by Walls was extensively advertised and promoted. Approximately £100,000 was spent on advertising and promotion during the period of the product’s distribution. There is now produced and shown to me marked “MJ2” a small sample of advertising and promotional literature.”

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Ms Jones goes on to make a number of observations on the way that ice cream is transported, stored and sold and compares this to the way that bubble gum and chewing gum is stored and sold. She concludes by saying:

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“Walls does not manufacture products comprising solely bubble gum or chewing gum although, in common with other ice cream manufacturers, it has incorporated bubble gum pieces into novelty ice creams from time to time.”

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The second declaration comes from Stephen Geoffrey Hale, the trade mark agent responsible for the prosecution of the action on behalf of the applicants. The purpose of his declaration is to

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- confirm that the applicants have granted Walls an exclusive licence with effect from 6 February 1995 in respect of the goods at issue

- exhibit (SGH1) the results of a trade mark search carried out in September 1994 for marks in Class 30 incorporating BANG. The search revealed the marks FIZZ BANG and WHIZ BANG

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- comment on the differing circumstances surrounding the retail sale of ice cream products and chewing gum or bubble gum.

Opponents' evidence in reply

The opponents filed evidence in reply in the form of a declaration dated 23 October 1997 by Edmund Frick, a Director of Growseed Aktiengesellschaft. In summary he makes
5 three points

- that on the basis of the applicants' evidence all the licensed use took place after the effective date of these proceedings
- 10 - the fact that ice creams are sold in refrigerated cabinets and his company's goods are not is not relevant to the issue of confusion given that children are customers for the goods
- as the applicants concede that they have manufactured ice creams which
15 incorporate pieces of bubble gum in common with other ice cream manufacturers, in his view the limitation of the goods applied for (as set out at the start of this decision) does not avoid the possibility of confusion with the goods in respect of which his company's mark is registered and used.

20 That completes my review of the evidence.

I will deal firstly, and briefly, with the objection based on Section 9 of the Act. This reads

25 "9. - (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or
30 particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- 35 (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- 40 (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its
45 distinctiveness.

5 (2) For the purpose of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally, or where the trade mark is registered or proposed to be registered subject to limitations in relation to use within the extent of the registration.

10 (3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which -

(a) the trade mark is inherently adapted to distinguish as aforesaid; and

15 (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid."

20 Mr Kinsey drew my attention to the applicants' packaging which indicated that the products contained popping candy and referred to "the exploding sensation". It is suggested, therefore, that the mark indicates the nature, or a characteristic, of the goods. It may well be that the goods are intended to produce an effervescent effect when eaten but the words would in my view be seen as indirectly allusive rather than descriptive in relation to ices or ice cream. I can see no or insufficient reason for overturning the decision reached at the examination stage. The Section 9 objection fails.

25 In relation to Section 17 the opponents say in their statement of grounds that the applicants are not entitled to claim to be the proprietor of the mark. I do not understand this to be a principal ground of attack and I cannot see any justification for the objection. Certainly no evidence has been filed to explain or support the point. It is true that the use that has been made of the mark since the application was filed is said to have been under licence but no point is taken on this in the statement of grounds. This objection also fails.

30 The main grounds of opposition are Sections 11 and 12 of the Act. These read as follows:

35 "11 It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

40 12 (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

45 a. the same goods

b. the same description of goods, or

- c. services or a description of services which are associated with those goods or goods of that description.”

5 The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

10 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd’s application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

15 (Under Section 11). Having regard to the user of the mark BANG BANG is the tribunal satisfied that the mark applied for, BIG BANG, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

20 (Under Section 12). Assuming user by the opponents of their mark BANG BANG in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a substantial number of persons if the applicants use their mark BIG BANG, normally and fairly in respect of any goods covered by their proposed registration?

25 In my view Mr Mitcheson was right to say that in practice this is not a case where substantially different considerations arise as between the two tests. Therefore I will consider the matter primarily on the basis of notional use of the opponents’ mark under Section 12 followed by brief comments on the Section 11 position.

30 The applicants, both in their evidence and in submissions at the hearing, relied in part on the state of the register. In particular my attention has been drawn to the fact that the mark FIZZ BANG (No 1133065) is registered in respect of ice cream and water ices and co-exists with the mark WHIZ BANG (No 619702) for chewing gum. Mr Mitcheson argued that these marks were rather closer to one another than the marks before me and the goods themselves were precisely those at issue in this case. At first glance this state of affairs appears to lend persuasive support to the applicants’ position. However Mr Kinsey rightly reminded me of Jacob J’s cautionary remarks in the TREAT case (British Sugar plc v James Robertson & Sons Ltd 1996 RPC 281) in relation to reliance on the state of the register. Moreover I do not know what factors were considered by the Registry’s examiner (or hearing officer) before these marks were placed on the register. Nor is there any evidence before me as to whether the marks are in use in the marketplace. I think it is right, therefore, to approach the matter from first principles rather than on the basis of the state of the register.

45 I consider firstly the marks themselves. For this purpose I adopt the well known test propounded by Parker J in Pianotist Co’s application (1906) 23 RPC 774 at page 777

5 “You must take the two words. You must judge of them both by their look and by
their sound. You must consider the goods to which they are to be applied. You must
consider the nature and kind of customer who would be likely to buy those goods. In
fact, you must consider all the surrounding circumstances; and you must further
10 consider what is likely to happen if each of these trade marks is used in a normal way
as a trade mark for the goods of the respective owners of the marks. If, considering all
those circumstances, you come to the conclusion that there will be a confusion - that
is to say - not necessarily that one will be injured and the other will gain illicit benefit,
but that there will be a confusion in the mind of the public, which will lead to
15 confusion in the goods - then you may refuse the registration, or rather you must
refuse the registration in that case.”

Mr Mitcheson also referred me to the following passage from Wm Bailey (Birmingham)
Ltd’s application, 52 RPC 136 at page 153

15 “I think that the Court has to be satisfied not merely that there is a possibility of
confusion; I think that the court must be satisfied that there is a real tangible danger of
confusion if the mark which it is sought to register is put on the Register.”

20 Self evidently both marks contain the word BANG, an element which is repeated in the
opponents’ mark and in my view gives it a visual identity of its own. I do not consider there
is a real likelihood of confusion arising from the visual appearance of the marks. So far as
the sound of the marks is concerned Mr Mitcheson pointed to the onomatopoeic quality of the
opponents’ mark which in his view suggested rapid or repeated gunfire as distinct from the
25 rather different effect of the applicants’ mark. There is some force to that argument though it
perhaps gives insufficient regard to everyday usage where BIG might be understood to
indicate a large version of a BANG product. I am not entirely convinced, therefore, that there
is no scope for confusion in oral use. I must also consider the goods themselves, the type of
customer and the surrounding circumstances. There was some discussion before me as to the
30 relative prices of the respective goods. In my view no material distinction can be drawn.
Both parties’ products are relatively cheap consumer items that are likely to be bought by or
on behalf of children as well as finding an adult market. This leads me to a consideration of
how children in particular are likely to react to the applicants’ mark. For many older people
the words BIG BANG will immediately bring to mind the cosmological theory relating to the
35 formation of the universe. If that meaning always prevailed I do not think the mark would be
confused with BANG BANG. However given that children are likely to make up a
significant part of the target market for the products I am not so sure that the above
distinction will be made in which case BIG may be taken as no more than common adjectival
use rather than as part of a word combination with the specific meaning referred to above.
40 There is no evidence before me to provide further assistance on the point. Taking all the
above factors into consideration the applicants have not persuaded me that there is no real
likelihood of confusion.

45 I, therefore, go on to consider the goods. Mr Kinsey quite properly said that I should base my
consideration on the test laid down in Jellinek’s application 1963 RPC 59. That test requires
me to look at the nature and purpose of the goods and the channels of trade. I was also

referred to Colman's Trade Mark (1929) 46 RPC 126 and the HOSTESS case 1959 RPC 120. In the former case mustard and semolina were held not to be goods of the same description and in the latter a somewhat tentative view appears to have emerged that ice cream and table jellies were goods of the same description.

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I regard the nature of ice cream as being quite different to chewing gum/bubble gum. They differ in terms of their composition, physical characteristics, storage requirements etc. Their respective purposes can at a high level of categorisation be said to be the same. Both, for instance, could be termed confectionery items. The Registry's Hearing Officer and the
10 Courts grappled with a similar problem in the HOSTESS case where both jellies and ice cream could be said to be dessert items but this was found to be too broad a category which, it was said would equally have included fruit salad or a steamed suet pudding. Mr Mitcheson tried to draw a distinction between the goods before me on the basis that ice cream was a food
15 item by which I took him to mean that it would give rather greater sustenance than bubble gum. That in many ways is an attractive argument but I would be uncomfortable in relying on such a narrow point of differentiation. Both items could, it seems to me, be termed leisure confectionery products that is to say the sort of thing that could be purchased for casual and immediate enjoyment as a snack. However even that narrowing of the confectionery heading must still, I think, encompass other types of sweets which would not be considered similar to
20 either of these goods. Commonsense suggests that ice cream is purchased as a cold snack or dessert item whether for use at the dinner table or as an outdoor or indoor snack. Bubble gum or chewing gum on the other hand is, as its name suggests, for chewing rather than for full consumption. It is highly unlikely to constitute an alternative purchase to ice cream. In short I take the view that the purposes are different.

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So far as channels of trade are concerned I find it useful to record the following general guidance given in the Registry's Work Manual (Chapter 10-55):

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"Channels of trade can be broken down into three elements although not all goods will necessarily have all three.

(a) producer/manufacturer

(b) wholesaler (if any)

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(c) retailer (if any)

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The channels of trade are considered to be the same if two sets of goods meet at any point in their channels of trade. For instance if it is common for both X goods and Y goods to be made by the same firm, or retailed by the same shop the goods are said to have the same channels of trade.

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Difficulties may be encountered when dealing with goods sold in departmental stores or supermarkets. In the case of a department store the channels of trade for both X goods and Y goods would be the same if they were sold in the same department or over the same counter.

In the case of a supermarket the channels of trade of both X goods and Y goods would be the same if the two sets of goods were commonly displayed or grouped together.”

5 I am not aware, and there is no evidence to suggest, that the respective goods are commonly produced by the same manufacturers. They may conceivably pass through the same wholesale channels but then so would a wide variety of other quite different products. I accept that they can both be found in supermarkets, confectionery shops and other retail outlets. However the particular storage needs of ice cream mean that it is unlikely to be displayed together with, or in close proximity to, bubble gum or chewing gum.

10 However there is a further aspect of the matter in that it appears to be conceded that ice cream manufacturers make bubble gum flavoured ice cream and even include pieces of such gum in ice cream. I have, therefore, considered whether this affects the conclusions I have reached above. I conclude that it does not. Ice cream is commonly sold in a variety of flavours and sometimes contains pieces of, for instance, fruit or nuts. In the absence of evidence to the contrary I do not think this is likely to lead customers to assume any wider trade connections. In conclusion, therefore, I have come to the view that judged against the Jellinek criteria the applicants’ goods are not of the same description as the opponents’. The opposition, therefore, fails under Section 12.

20 I indicated above that I did not think Section 11 gave rise to significantly different considerations. The test is not of course restricted to “goods of the same description” but the evidence suggests that the opponents restrict their use to goods falling precisely within the terms of the specification of the registered mark. It was noted at the hearing that both sets of goods are offered in a similar range of flavourings and also that the applicants’ goods contain gum used as a stabiliser. I do not consider that either factor has a material bearing on the issue before me. The opposition also fails under Section 11.

30 The matter of the Registrar’s discretion was raised in the opponents’ statement of grounds but was not actively pursued as a separate issue. For the record I see no reason for exercising discretion adversely to the applicants.

35 As the opposition has failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £635.

Dated this 8 day of January 1999

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45 M REYNOLDS
For the Registrar
the Comptroller General