

O-030-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3106624

BY TRENDS UK LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9 & 28:

SCIENCE MAD

AND

OPPOSITION THERETO (NO. 405394) BY MAD SCIENCE LICENSING INC.

Background and pleadings

1. This dispute concerns whether the following trade mark should be registered:

SCIENCE MAD

Class 9: Sound recording, reproduction and transmitting devices, apparatus and instruments; optical apparatus and instruments; binoculars, telescopes and microscopes; planetariums; projectors and planetarium projectors; movement detectors; display and video devices; walkie-talkies; movement detectors; door alarms; protective eyewear; goggles; children's education and/or activity kits consisting of electronics; helmets; metal detectors; cameras; remote controls; computers; computer programs and applications (including downloadable); electronic diaries; headphones; batteries; mobile phones; electronic games; parts and fittings for the aforesaid goods.

Class 28: Toys, games, playthings; toy torches; toy rockets; toy planetariums; children's play cosmetics including make-up and tattoos; make-up sets; model vehicles; model cars, planes and parts there of; dolls and figures; action toys and figures; toy crystal growing sets; toy rock tumblers; toy walkie-talkies; toy nail art kits; robots; dinosaurs; colouring sets; toy alarms; children's chemistry kits; educational and/or activity kits; sports equipment and apparatus; toy vehicles; motorised ride-on vehicles; play costumes; board games; gymnastic and sporting articles not included in other classes; apparatus for performing magic tricks; cards for use in magic tricks; playing cards; toy trading cards; toy tools; toy guns; toy spy kits; parts and fittings for the aforesaid goods

2. The mark was filed on 30 April 2015 by Trends UK Ltd ("the applicant") and was published for opposition purposes on 7 August 2015.

3. Mad Science Licensing Inc. ("the opponent") opposes the registration of the mark on grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). The opponent relies on three earlier marks, as follows:

- i) European Union trade mark (“EUTM”) registration 643171 for the mark **MAD SCIENCE** which was filed on 17 September 1997 and registered on 11 May 1999 in respect of:

Class 41: Entertainment and educational services, including live theatrical performances, television and multimedia programs and presentations, and hands-on educational programs, each with a science theme, in international class 41.



- ii) EUTM 4178372 for the mark  which was filed on 1 December 2004 and registered on 9 February 2006 in respect of the same services as above.

- iii) UK Registration 2622977 for the mark **MAD SCIENTIST** which was filed on 7 October 2010 and registered on 18 March 2011 in respect of:

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; 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; educational books, science activity books, story books, colouring books, children's magazines, science magazines, workshop manuals, lesson plans, teaching guides, teachers' manuals.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys and games with a science theme, and board games.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; entertainment and educational services, namely live theatre and multi-media performances and programmes, television programmes, and hands-on educational and entertainment programmes with a science theme; production, publication and distribution of programmes for television, radio, cinema, film, video, and audio delivery systems; entertainment and educational clubs for children

4. Earlier marks i) and ii) had been registered for more than five years as of the publication date of the applicant's mark, so meaning that they are subject to the requirement to show genuine use (see section 6A of the Act). The opponent made a statement of use in which it claims that these marks have been genuinely used for all the services for which they are registered. Mark iii) had been registered for less than five years, so meaning that it may be relied upon without having to establish genuine use. The main points of the opponent's pleaded case are that:

- i) Its MAD SCIENCE marks are highly similar to the applied for mark as they comprise the same words, albeit transposed. The MAD SCIENTIIST mark is said to be confusingly similar.
- ii) The specifications of the MAD SCIENCE marks are similar to the applicant's goods because of a complementary relationship, given that the applicant's goods could be science themed. The specification of the MAD SCIENTIST mark is said to be closely similar to the applied for specification.
- iii) The opponent's mark have a reputation.
- iv) The opponent states that the applicant's business model is to sell products under licence from the owners of brands in the field of education and television programmes. It is claimed that retailers would assume that there is a link between such goods and the services of the opponent which would, therefore, take unfair advantage of, or be detrimental to, the reputation and distinctive character of the earlier mark.

5. The applicant filed a counterstatement denying the claims. It put the opponent to proof of use in respect of marks i) and ii). A summary of the main points of the applicant's defence are that:

- The repositioning of the words MAD and SCIENCE has a significant impact on the marks themselves.
- In relation to the MAD SCIENCE marks, the goods/services are not similar.
- In relation to the MAD SCIENTIST earlier mark, whilst there is some overlap in the specifications (although the class 41 is dissimilar), the marks are not visually and aurally similar and there is a conceptual difference, with MAD SCIENTIST bringing to mind a crazy professor.
- The 5(3) claims are denied and the opponent is put to proof of the claims made.

6. Both sides are represented, the opponent by ip21 Ltd, the applicant by Brookes Batchellor LLP. Both sides filed evidence. Neither side requested a hearing, both opting to file written submissions instead.

The evidence

The opponent's evidence

7. This comes from Ms Shafik Mina, the opponent's President. She begins by providing (in Exhibit SM2) details of the opponent's earlier marks. I need not summarise this further because I have already done so above. It is explained that the opponent licenses its MAD SCIENCE marks and what is described as its "Mad Science System" to Mad Science Group Inc. This includes a license to grant franchises to operate a Mad Science business. The opponent specialises in science education "in a fun and entertaining style", predominantly for children aged 3-12. Workshops for older children are sometimes run. It has 155 franchisees and operates in 23 countries. The opponent has, it is claimed, 9 current franchisees covering most of the UK. Exhibit SM2 contains a map showing regions of the UK where the opponent has a franchisee.

None are in Northern Ireland or Scotland. The first UK franchisee was appointed in 2005. Ms Mina states that the opponent supports its franchisees by providing tools and equipment and with marketing advice and strategies. Sales figures (in US dollars) are given in the UK as follows:

2005	523k
2006	1.52 million
2007	2.45 million
2008	2.72 million
2009	2.79 million
2010	3.16 million
2011	3.68 million
2012	3.79 million
2013	4.06 million
2014	3.87 million

8. Franchisees provide workshops and afterschool activities at which, Ms Mina states, products supplied by the opponent are used, some of which are taken home by the participating children. Exhibit SM4 contains a list of such products, most of which are science type games and kits, although, as all that is provided is the name of the product, one cannot get a true feel for the product's exact nature.

9. Ms Mina explains that the services are provided through local authorities and primary schools, as well as through other groups and individuals. Exhibit SM4 contains invoices dated between 2010 and 2015. All bar one have the MAD SCIENCE logo at the top of the invoice. Some additionally have the name MAD SCIENCE (often as a trading name) on the invoice also. In terms of the services (there are no goods) invoiced, it is most often the case that the service invoiced is a descriptor of the event or workshop (e.g. Secret Agent Day, Bespoke Shows, Summers Workshop) although some (9 out of the 33 invoices) use the words MAD SCIENCE in some way in the description of what is being provided. The invoices are from various franchisees of the opponent.

10. The services are marketed through leafleting (e.g. at schools and leisure centres) and through social networking. Exhibit SM5 contains examples of such leaflets distributed between 2010 and 2015 together with advertisements placed in publications, one of which is called Primary Times. Most of the leaflets and advertisements feature the MAD SCIENCE logo prominently. However, around 6 do not. Some use the words MAD SCIENCE CAMP(S) at the top of the page. However, two do not even do this and the only reference to Mad Science comes at the bottom of the page in fairly small print as part of the contact details.

11. Exhibits SM 6-13 contain archive web prints from eight of the opponent's regional franchisees as follows:

- SM6 – East of England franchisee. The web pages feature the MAD SCIENCE logo and the words MAD SCIENCE used in various ways. The events offered include after-school programmes, birthday parties, corporate events (although children are depicted), school workshops and science days, holiday camps and pre-school and nursery programmes.
- SM7 – East Midlands franchisee. The web pages are similar looking to those in SM6, The events offered include after school clubs, birthday parties, large scale events (“corporate clients”), school workshops, school holiday clubs, pre-school classes.
- SM8 – Norfolk franchisee. Again, the web pages look similar. The events include after-school programmes, birthday parties, special events, in-class workshops, summer and vacation camps, preschool programmes.
- SM9 – North West and North East franchisee. Again, the web pages look similar. The events include after-school programmes, fun science parties, special events, in-school workshops, school holiday camps.
- SM10 – South East England franchisee. Again, the web pages look similar. The events include after-school programs, birthday parties, special events, in-class workshops, summer and vacation camps, pre-school programs.

- SM11 – South Wales franchisee. Again, the web pages look similar. The events include after school programmes, birthday parties, special events, in-class workshops, holiday camps and corporate events (albeit with a child depicted).
- SM12 – South Wales and Bristol franchisee. Again, the web pages look similar. The events include summer holiday camps, after school programmes, workshops, birthday parties, special events and corporate.
- SM13 – West Midlands franchisee. Again, the web pages look similar. The events include after-school programmes, birthday parties, special events, workshops, holiday camps and preschool programs.

12. Exhibits SM14–SM20 contain invoices relating to the sale of products (as per SM3) by the opponent to its franchisees for use in the workshops and programmes they run. The invoices are issued by the Mad Science Group, with the MAD SCIENCE logo appearing at the top of the invoices. A wide range of products are invoiced, although it is not possible to clearly understand what most of them are. Some products are more evident in their nature e.g. lab coats, science equipment, puzzles. I do not consider it necessary to summarise the invoices in any greater detail.

13. Ms Mina completes her evidence by stating that the opponent has “a reputation throughout the world for the provision of high quality science education presented in an entertaining way”. Her final exhibit is SM21 which is an extract from the opponent’s website setting out its history and some of its world-wide achievements.

The applicant’s evidence

14. This comes from Mr Lee Clowes, the applicant’s managing director. He states that the applicant was formed in 2002 by a number of toy industry professionals with the aim of rescuing an old British toy company that had gone into liquidation. The backbone of its business is said to be related to a range of science and nature toys. It designs and develops its own range whilst also assisting with the local sale and marketing of products of international companies.

15. Mr Clowes states that the SCIENCE MAD trade mark was first used in 2005 in relation to a range of educational toys designed to educate and excite young minds “providing fun whilst learning”. Exhibit LC1 contains a print from its website about its SCIENCE MAD range. A stylised version of the words is the most prominent form of use, although there is reference to its “Science Mad range”. This is not an archive print. There is also an extract from its 2015 catalogue showing four of its products: Chemistry Lab, Rocket Science, Crystal Growing Kit and Explorer Globe. They all have the stylised logo on the packaging and the logo is also used on the top of the catalogue page. The words Science Mad are also used as reference to the range of products.

16. Mr Clowes provides some sales figures. In the first year (2005) sales were £31k. This grew to £439k in 2013. The forecast for 2016 is £400k (although this, of course, is just a forecast and is also after the relevant date). These figures are sales to the trade so the value of subsequent retail sale [assuming all of the goods are sold on in the UK] would, according to Mr Clowes, be double. Although some sales are made direct to the public, sales are predominantly made to “leading retailers”. Examples are given as Amazon, Argos, Debenhams, Entertainer, Harrods, Smyths, Toymaster and Toys R Us. The number of outlets that these retailers have is also given, there are many hundred overall. Exhibit LC2 contains a print from the Amazon website showing one of the applicant’s products for sale. Although this is not an archive print, some of the reviews of the product date from before the relevant date, the earliest being December 2013. The print also states that the product has been available on Amazon.co.uk since March 2013. The MAD SCIENCE logo is used on the packaging.

17. Exhibit LC3 contains the applicant’s 2008 product catalogue. The cover page highlights 6 ranges that it sells, one of which is SCIENCE MAD. The words are presented in logo form, albeit a different logo to that shown in the earlier exhibits. The contents of the catalogues are provided, but there is no further detail of the products sold under the SCIENCE MAD range.

18. Given that the applicant’s main customers are the trade, Mr Clowes explains that most of its promotion is undertaken at trade shows and via press magazines. He states that it has regularly promoted the SCIENCE MAD range at the UK Toy Fair which is

held annually at the Olympia in London. It has also promoted at the world's largest toy fair in Nuremberg. Exhibit LC4 contains photographs of its displays at these trade fair showing MAD SCIENCE products (the words are used in logo form), although it is not clear when they were taken. The approximate cost of attending these trade fairs is said to be £50,000 per annum. Mr Clowes states that advertising has taken place in the publications: Toy World, Toys and Playthings and Toy News. No further details or examples of advertising is given.

19. Mr Clowes refers to a now expired UK trade mark numbered 2406690 for the mark:



which was registered for science kits in class 9 and science toys in class 28. The above logo appears to be that shown on the front of the 2008 catalogue. All of the other exhibits use a different version. It is explained that the above logo was updated hence why it was allowed to lapse. Mr Clowes adds that given the applicant's longstanding use, it elected to register the mark [the subject of these proceedings] as a plain word mark. I note at this stage that in its written submissions the applicant attempts to rely on the now expired mark as some form of defence. This is not appropriate. If there is a likelihood of confusion or whether the forms of damage underpinning section 5(3) are found, this would not be negated by the existence of a now expired earlier mark on the register.

20. Mr Clowes completes his evidence by stating that the MAD SCIENCE mark has been used for 11 years and he is not aware of any instances of confusion with any other brands in the marketplace. He is not aware of the use of the opponent's mark nor of any instances of confusion. He considers that the applicant has its own independent goodwill and should be permitted to register its trade mark.

The opponent's reply evidence

21. This comes from Ms Clare Turnbull, the opponent's trade mark attorney. Her evidence deals with two points. First, she provides photographic evidence of some of the take-home products that are available to purchase at the opponent's events. None are dated. They include:

- What appears to be a t-shirt, depicting (on the left hand side of the chest) the MAD SCIENCE logo, underneath which are the words MAD SCIENTIST.
- A lab coat with the same logo and words as above.
- A step-o-meter, the packaging of which depicts the words The Mad Scientists and the MAD SCIENCE logo. There appears to be a copyright date on the packaging. It is very unclear, but appears to read 2009.
- A Hydration Station which includes both the words The Mad Scientist and the MAD SCIENCE logo. Mad Science is also used in a domain name.
- A flyer for birthday parties which includes the MAD SCIENCE logo and the words MAD SCIENCE. No products are mentioned on this flyer. There appears to be a copyright date of 2009 on this flyer. However, given a telephone number used ((514)344-4181) this appears to be a US flyer.
- Another birthday party flyer which includes information about a goody bag which can be used to "enhance the mad science party". The goodybag includes: adhesives [stickers], a spin disk, a flip top, a Helix Flyer, polymer putty, temporary tattoos and something described as soak n' grow. The flyer has no copyright date. It is not even clear where it was distributed, although, a testimonial mentioned on the flyer is from a person in San Francisco.
- Further prints relating to the goodybag, which depicts its contents. There is a copyright date of 2009 but, again, where this was distributed is not clear. A

further print shows a close up of one part of the contents, the stickers, with a date on this print of 2010.

22. Ms Turnbull also provides evidence in relation to the MAD SCIENTIST mark as follows:

- A flyer for a 2005 summer camp which, as well as the MAD SCIENCE logo, features the words BE A MAD SCIENTIST. It is not clear where this flyer was disturbed.
- A print of part of a resource manual that includes the words MAD SCIENTIST.
- Some material used in the events headed MAD SCIENTIST REGISTRATION FORM.
- A print of the lab coat mentioned earlier.
- A certificate of achievement, a space on which allows a person to sign in his/her capacity of officiator, who is then described as MAD SCIENTIST; this has a copyright date of 2009.
- A print from a collaborative event between NASA and the opponent called Academy of Future Space Explorers, with a subsequent print listing "The Mad Scientist's Golden Rules".
- Two prints, which appear to be of US origin, for an after-school party entitled RETURN OF THE MAD SCIENTIST.
- A print from Facebook with a post headed "Some super-satisfied mini Mad Scientists". The post is on the Mad Science page although it is sharing a photograph from an overseas user.

Section 5(2)(b) – based on the MAD SCIENTIST earlier mark

23. Section 5(2)(b) of the Act states that:

“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,

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

24. The following principles are gleaned from the judgments 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:

(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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods/services

25. When making a comparison, all relevant factors relating to the goods/services in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

26. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

27. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

28. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

29. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

30. Goods/services can be considered identical if one term falls within the ambit of the other, as per the decision in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (*‘Meric’*):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

31. The goods/services of the earlier MAD SCIENTIST mark include:

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; 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; educational books, science activity books, story books, colouring books, children's magazines, science magazines, workshop manuals, lesson plans, teaching guides, teachers' manuals.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys and games with a science theme, and board games.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; entertainment and educational services, namely live theatre and multi-media performances and programmes, television programmes, and hands-on educational and entertainment programmes with a science theme; production, publication and distribution of programmes for television, radio, cinema, film, video, and audio delivery systems; entertainment and educational clubs for children

32. The applicant seeks registration in respect of:

Class 9: Sound recording, reproduction and transmitting devices, apparatus and instruments; optical apparatus and instruments; binoculars, telescopes and microscopes; planetariums; projectors and planetarium projectors; movement detectors; display and video devices; walkie-talkies; movement detectors; door alarms; protective eyewear; goggles; children's education and/or activity kits

consisting of electronics; helmets; metal detectors; cameras; remote controls; computers; computer programs and applications (including downloadable); electronic diaries; headphones; batteries; mobile phones; electronic games; parts and fittings for the aforesaid goods.

Class 28: Toys, games, playthings; toy torches; toy rockets; toy planetariums; children's play cosmetics including make-up and tattoos; make-up sets; model vehicles; model cars, planes and parts there of; dolls and figures; action toys and figures; toy crystal growing sets; toy rock tumblers; toy walkie-talkies; toy nail art kits; robots; dinosaurs; colouring sets; toy alarms; children's chemistry kits; educational and/or activity kits; sports equipment and apparatus; toy vehicles; motorised ride-on vehicles; play costumes; board games; gymnastic and sporting articles not included in other classes; apparatus for performing magic tricks; cards for use in magic tricks; playing cards; toy trading cards; toy tools; toy guns; toy spy kits; parts and fittings for the aforesaid goods

33. Given the breadth of the opponent's specification in class 28, which covers toys and playthings, it is clear that all of the applicant's goods in class 28 fall within ambit. The applied for goods in class 28 are identical. In relation to the applied for goods in class 9, notwithstanding the fact that the opponent has made a number of comments about the complementary relationship that it says exists between the applicant's class 9 goods and its educational services in class 41 (which I will come back to later) it seems to me that the closest goods in respect of this conflict are with the opponent's class 28 goods. That is because it is clear that both specifications cover science based kits or toys or comprise goods which could be contained in a kit (or toy based kit). I consider this to apply to most of the applied for class 9 goods with the exception of:

Class 9: Sound recording, reproduction and transmitting devices, apparatus and instruments; projectors and planetarium projectors; movement detectors; display and video devices; movement detectors; door alarms; remote controls; computers; electronic diaries; headphones; batteries; mobile phones; parts and fittings for the aforesaid goods.

because there is no obvious toy based counterpart and no obvious link with the earlier mark's class 41 services, nor its goods in class 16. The one remaining term is "computer programs and applications (including downloadable)". I accept that such goods could be for an educational purpose and thus has a similar purpose to the opponent's educational services in class 41. The nature and method of use is, though, very different. Whilst it could be argued that the goods and the services compete, I doubt that they do so on a significant level. It is more likely the case that programs and apps could be used to supplement the educational service. Whether this translates to a complementary relationship or not, I note that there is no evidence to show how educational programs and apps will be used and what link, if any, will be perceived to educational service providers. Therefore, whilst I do not rule out the possibility that a complementary relationship may exist, the overall similarity is, in my view, low, based essentially on the similarity of purpose.

Average consumer and the purchasing act

34. 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. 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."

35. The opponent submits that educational toys (and the like) are purchased by the general public and are low cost, casual selections. Whilst I agree that they (and the

other conflicting goods) are not highly considered purchases, they do not strike me as everyday casual purchases. I consider that an average level of care and attention will be deployed when selecting them, not materially higher or lower than the norm. The goods will most often be selected from the shelves of retailers (including online equivalents) or perused on websites or brochures. However, whilst this suggests that the visual impact of the marks takes on more importance, the aural impacts should not be ignored completely.

Comparison of marks

36. 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 CJEU 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.”

37. 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. The competing marks are:

MAD SCIENTIST v SCIENCE MAD

38. In terms of overall impression, both marks are made up of two common English words and neither has greater visual or aural impact than the other. The words in the respective marks each hang together to form a unit, MAD SCIENTIST indicating a scientist who is mad or crazy, SCIENCE MAD indicating something (such as a company) or someone who is very keen about science.

39. In terms of visual similarity, it is clear that the eye will notice that both marks contain the word MAD and the letters SCIEN-. The applicant considers that the reversal creates a significant difference. Whilst I may not have put it as highly as that, I agree that the visual similarity is reduced on account of the reversal of the words and, further, that the second word in the earlier mark is SCIENTIST not SCIENCE which creates a further difference. I consider that this equates to only a low degree of visual similarity. A similar analysis is applicable to the aural assessment, with the similarities and differences I have already noted impacting on the respective articulations; there is only a low level of aural similarity.

40. Conceptually, I agree with the applicant that there is a key conceptual difference based upon the different meanings I have already indicated above.

Distinctive character of the earlier mark

41. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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)."

42. Inherently, the mark is not highly distinctive given that it covers goods and services which could have a science theme. The concept of a mad scientist is a well-known one and the mark is suggestive of some form of role-playing where the user can become a mad scientist themselves. I consider inherent distinctiveness to be weak.

43. In terms of the use made of the mark, I am far from satisfied that the use in relation to the conflicting goods demonstrates any form of reputation. Notwithstanding the opponent's reply evidence, the use of MAD SCIENTIST is far less prominent than the MAD SCIENCE marks even in relation to the educational services. The use made does not enhance the distinctive character of the MAD SCIENTIST mark.

Likelihood of confusion

44. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for

the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he 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).”

45. I come to the clear view that the visual and aural similarity is insufficient, even when identical goods are in play, to result in a likelihood of direct confusion, particularly given the key conceptual difference that exists between the marks. The matter is not helped, of course, by the weak distinctive character that exists, although, I would have found no direct confusion even if the distinctiveness had been higher. In relation to indirect confusion, I simply cannot see how any of the examples of indirect confusion given above would be met, nor has any further illustration been given to me by the opponent beyond a claim that consumers are used to seeing words being transposed for marketing purposes. All things considered, I do not consider it likely that the average consumer would regard this as an example of some form of marketing alteration. There is no likelihood of confusion in relation to the identical goods. Given this, there can likewise be no likelihood of confusion in relation to the class 9 goods. The opposition under section 5(2) based upon the MAD SCIENTIST mark fails.

Section 5(2)(b) – based on the MAD SCIENCE earlier marks

46. These two earlier marks are subject to the proof of use provisions. I therefore begin my assessment there.

The proof of use provisions

47. The use conditions set out in section 6A of the Act, which read:

“(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered [.....]”

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [.....]

(5) “In relation to a Community trade mark [.....], any reference in subsection (3) [.....] to the United Kingdom shall be construed as a reference to the European Community”.

48. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

49. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case-law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been

persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows: (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

50. Both of the marks which are subject to the use conditions are EUTMs so meaning that the reference to use is a reference to use in the EU. The CJEU has provided

guidance on this matter in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

and

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

and

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down

(see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

51. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

52. The General Court restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of an EUTM. Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the EU corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the EU. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the EU during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

53. I also note the decision In *Jumpman* BL O/222/16, where Mr Daniel Alexander QC, as the Appointed Person, upheld the registrar's decision to reject the sale of 55k pairs of training shoes through one shop in Bulgaria over 16 months as insufficient to show genuine use of the EU trade mark in the EU within the relevant 5 year period.

54. In *Reber Holding GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-355/09, the General Court found that the sale of 40-60Kg per annum of specialist chocolate under a mark was insufficient to constitute genuine use of a national trade mark, which was registered in Germany. On further appeal in Case C-141/13 P, the CJEU stated, at paragraph 32 of its judgment, that:

“not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question”.

55. The CJEU went on to find that:

“the General Court conducted an overall assessment of that trade mark, taking into account the volume of sales of the goods protected by the trade mark, the nature and characteristics of those goods, the geographical coverage of the use of the trade mark, the advertising on the website of Paul Reber GmbH & Co. KG and the continuity of the trade mark’s use. It thus established a certain degree of interdependence between the factors capable of proving genuine use. The General Court therefore correctly applied the concept of ‘genuine use’ and did not err in law in its assessment of that use” (paragraph 34 of the judgment CJEU).

56. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark*” is therefore not genuine use.

57. As per section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five year period ending on the date of publication of the applied for mark. Consequently, in these proceedings the relevant period in which genuine use must be shown is 8 August 2010 to 7 August 2015.

58. It is clear to me that, at the very least, the opponent has used its MAD SCIENCE logo mark in relation to its core science based educational services to a reasonably extensive degree in the UK during the relevant period. The breadth of use does not cover all of the UK but a reasonably large part of it. Although the potential EU market for such services is extremely large, I come to the view that the level of use that has been made is sufficient to constitute genuine use in the EU market. I also extend this finding to the MAD SCIENCE word mark because, although it is not the most prominent form of use (as the applicant submits), it is also consistently used in the various marketing materials put forward.

59. I accept that none of the use shown in evidence is made by the opponent itself, but, instead, by its franchisees. The applicant points out that none of the franchise

agreements have been submitted in evidence, despite the fact that the opponent obtained an extension of time to file its evidence in order to do so. However, it is clear from the commentary of Ms Mina that the business is a franchised one and I accept that the use represents use with the consent of the opponent. The more difficult matter to deal with is the extent to which the mark(s) have been used and what represents a fair specification for such use. On this issue, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

60. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average

consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

61. The starting point is the specification of the marks. A fair specification cannot, of course, go wider than this. The specification of both marks reads:

Class 41: Entertainment and educational services, including live theatrical performances, television and multimedia programs and presentations, and hands-on educational programs, each with a science theme, in international class 41.

62. The specification as it stands is extremely wide, covering all forms of education and entertainment service. The further terms (after the word “including”) do not have a limiting effect. It is clear that the primary purpose of the used services is one of education in the field of science. I come to the view that whilst the services are clearly designed to capture the imagination of the children attending the workshops etc, the service itself is not an entertainment service. This is so despite the fact that there is some evidence of the provision of children’s parties. Not only does the evidence fail to break down how many of such parties have been provided, but children’s parties would not, in my view, fall naturally under the terms of the specification. Ms Mia, the opponent’s witness, puts it best when she describes the opponent’s business as being

in relation to the provision of “high quality science education presented in an entertaining way”. Neither parties submissions focus directly on the proof of use provisions and the fair specification point. I consider a fair specification to be:

Class 41: Children’s educational services in the field of science, including hands-on educational programs, each with a science theme, in international class 41.

63. The above represents in my view a fair sub category of educational services. In terms of the specifically identified services, I have not listed certain services (such as television, theatrical performances) because there is no evidence that specifically goes to their provision. The two earlier MAD SCIENCE marks will be considered on the above basis only.

64. For the purposes of my assessment under section 5(2)(b) in respect of the MAD SCIENCE marks, I will focus on the earlier word mark MAD SCIENCE as opposed to the earlier figurative mark. This is because the latter has greater visual differences to the applied for mark. If the opponent cannot succeed with its plain word mark, it is difficult to see why it would be in a better position with regard to its figurative mark.

Comparison of goods/services

65. The earlier mark is to be considered on the basis of the following services:

Class 41: Children’s educational services in the field of science, including hands-on educational programs, each with a science theme, in international class 41.

66. The applicant seeks registration in respect of:

Class 9: Sound recording, reproduction and transmitting devices, apparatus and instruments; optical apparatus and instruments; binoculars, telescopes and microscopes; planetariums; projectors and planetarium projectors; movement detectors; display and video devices; walkie-talkies; movement detectors; door

alarms; protective eyewear; goggles; children's education and/or activity kits consisting of electronics; helmets; metal detectors; cameras; remote controls; computers; computer programs and applications (including downloadable); electronic diaries; headphones; batteries; mobile phones; electronic games; parts and fittings for the aforesaid goods.

Class 28: Toys, games, playthings; toy torches; toy rockets; toy planetariums; children's play cosmetics including make-up and tattoos; make-up sets; model vehicles; model cars, planes and parts there of; dolls and figures; action toys and figures; toy crystal growing sets; toy rock tumblers; toy walkie-talkies; toy nail art kits; robots; dinosaurs; colouring sets; toy alarms; children's chemistry kits; educational and/or activity kits; sports equipment and apparatus; toy vehicles; motorised ride-on vehicles; play costumes; board games; gymnastic and sporting articles not included in other classes; apparatus for performing magic tricks; cards for use in magic tricks; playing cards; toy trading cards; toy tools; toy guns; toy spy kits; parts and fittings for the aforesaid goods

67. It is necessary to break the above specification down. Some of the goods are clearly not similar to the opponent's services, namely:

sports equipment and apparatus (class 28)

gymnastic and sporting articles not included in other classes (class 28)

mobile phones (class 9)

apparatus for performing magic tricks; cards for use in magic tricks (class 28)

electronic diaries (class 9)

children's play cosmetics including make-up and tattoos; make-up sets (class 28)

toy nail art kits (class 28)

colouring sets (class 28)

motorised ride-on vehicles

because none have any form of educational based application (let alone a science based educational application) and are different in purpose. They are not similar in nature or method of use. There is no competitive relationship as the goods would not

be used instead of the services (or vice versa). In terms of complementarity, none of these goods are important (or from what I can see have any connection) with the services. The fact that some of the goods (such as temporary tattoos) may have been provided in goody bags does not change that fact. These goods are not similar.

68. “Sound recording, reproduction and transmitting devices, apparatus and instruments; display and video devices; headphones; computers; projectors; cameras; remote controls” may be used whilst education is being provided, but that does mean that the goods and the services have a similar purpose. The nature and methods of use differ. The goods do not compete. Whilst it could be said that display equipment (etc) is important for the operation of certain types of education, for a positive finding this must be a type of relationship whereby customers may think that the responsibility for those goods lies with the same undertaking; this is not the case with the goods of interest here. These goods are not similar.

69. The same can be said in relation to “protective eyewear; goggles; helmets”. Whilst they could be used during part of science lessons and other science based educational activities, the purpose is not similar nor is the nature and method of use. There is no competitive relationship. In terms of complementarity, I again consider that whilst it is possible that these goods are important for use in lessons etc (to protect a student from injury whilst carrying out science based experiments) it is not the type of relationship whereby consumers would think that the responsibility for those goods lies with the same undertaking as the services (or vice versa). The position is even starker in relation to “play costumes” in class 28 as such goods are merely for dressing-up (for example, as a scientist) and therefore are not really important for the use of the services and the same applies regarding the second aspect of complementarity as described already. These goods are not similar.

70. In relation to microscopes, again, the same applies in respect of having a differing purpose, methods of use and nature. The goods do not compete and there is no real complementary relationship for the reasons already given. The same applies to telescopes and binoculars and, also, optical apparatus and instruments being a term which covers these goods. The goods are not similar.

71. I next consider the following goods:

Planetariums; planetarium projectors; children's education and/or activity kits consisting of electronics (class 9); children's chemistry kits (class 28); educational and/or activity kits (class 28); toy planetariums; toy crystal growing sets

72. I accept that these goods could be purchased with the aim of helping to educate children in the field of science via the use of the goods concerned. This creates some similarity of purpose, however, when the exact purposes are considered then such similarity is fairly low. The nature and methods of use are quite different. In terms of competition, this in my view is not significant. I doubt that the above goods would be purchased as an alternative to the use of an educational service. In terms of complementarity, it is possible for the goods to be used as part of the educational service but, again, not necessarily in a way in which customers may think that the responsibility for those goods lies with the same undertaking. Any similarity is low.

73. I next consider the following class 9 goods:

Movement detectors; walkie-talkies; movement detectors; door alarms; metal detectors; batteries

74. Any link with science based education is difficult to ascertain here. At best, the goods could be used to demonstrate certain aspects of physics (how electricity and other forces work) but I struggle to see how any of the goods could be said to have a similar purpose to education and they are self-evidently different in nature and methods of use. There is no competitive relationship and, for the reasons already given, there is no complementary relationship. The goods are not similar.

75. I next consider the goods:

toy torches; toy rockets; model vehicles; model cars, planes and parts there of; dolls and figures; action toys and figures; toy rock tumblers; toy walkie-talkies;

robots; dinosaurs; toy alarms; toy vehicles; board games; playing cards; toy trading cards; toy tools; toy guns; toy spy kits

76. The assessment here is similar to that in the preceding paragraph. The goods are not similar.

77. I have already assessed computer programs and applications (including downloadable) when dealing with the MAD SCIENTIST earlier mark. I found that any similarity to the class 41 services was low, a finding which I extend by analogy to electronic games.

78. The respective parts and fittings in each of the classes rests and falls with the goods themselves. No greater analysis is required. The only term left to consider is “toys, games and playthings”. To the extent that this broad terms covers some goods (such as toy activity sets) for which I have a low degree of similarity, then the same finding applies here.

Average consumer and the purchasing act

79. The services of the earlier mark are for education purposes. A range of considerations are possible, but none are of a casual level. The services will be selected via a range of media including perusal of websites, leaflets, brochures and, possibly, word of mouth. I have already dealt with the goods of the application earlier so will say no more here.

Comparison of marks

80. The competing marks are:

MAD SCIENCE v SCIENCE MAD

81. I have already dealt with the overall impression of the applied for mark, SCIENCE MAD, which comprises two words which hang together to form a unit, indicating

something or someone who is very keen about science, with neither word dominating the other. The earlier MAD SCIENCE mark also hangs together to form a unit, indicating science that is mad, that it has some form of wacky or crazy application, again with neither word dominating the other.

82. In terms of visual similarity, it is clear that the eye will notice that both marks contain the word MAD and the word SCIENCE. The opponent submits that consumers are used to seeing transpositions of words being made to marks for marketing purposes and, thus, the marks are highly similar. The applicant considers that the reversal creates a significant difference. Again, whilst I may not put it as highly as that, I agree that the visual similarity is reduced on account of the reversal of the words. There is a reasonable (but not high) level of visual similarity. A similar analysis is applicable to the aural assessment, with the similarities and differences I have already noted impacting on the respective articulations; there is a reasonable level of aural similarity.

83. Conceptually, I consider that there is a conceptual difference based upon the different meanings I have already indicated above.

Distinctive character of the earlier mark

84. Inherently, the mark is not highly distinctive given that it covers services with a science theme. Overall, the mark is suggestive of science services that are provided with an element of wackiness or craziness. I consider inherent distinctiveness to be moderate (between low and medium).

85. In terms of the use made of the mark, I accept that reasonable use has been made, although, without evidence of market share it is difficult to fully rationalise. I accept that the distinctiveness of the mark will have been enhanced to some extent, from its moderate beginning. The earlier mark should be considered reasonably (but not highly) distinctive.

Likelihood of confusion

86. Where there is similarity between the goods and services concerned, I have assessed this as low. Whilst a high degree of mark similarity has the potential to offset this, and whilst the marks have a reasonable level of aural and visual similarity, there is also a conceptual difference. I must bear in mind, though, that conceptual differences do not always overcome the other aspects of similarity (and other factors) (as per *Nokia Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-460/07*). The case before me represents the archetypal multifactorial assessment. I come to the view that there is no likelihood of confusion, be it direct or indirect. The primary factors which have influenced my decision are the low level of goods/service similarity, together with the overall level of mark similarity (the balance between the reasonable level of aural/visual similarity, against the conceptual difference). I have taken into account the concept of imperfect recollection and, also, my assessment of the distinctive character of the earlier mark, however these factors do not push my decision the other way. The average consumer will not believe that the goods come from the same or a related undertaking. The opposition based on the MAD SCIENCE marks is dismissed under section 5(2)(b).

Section 5(3) of the Act

87. Section 5(3) of the Act reads:

“5-(3) A trade mark which-

..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 Community trade mark, 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.”

88. The leading cases are the following CJEU judgments: 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 Case 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 later mark would cause an average consumer to bring 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 likelihood 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

89. The earlier marks must have a reputation. In *General Motors* the CJEU stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

90. Given my comments in relation to the MAD SCIENTIST earlier mark at paragraph 43, I consider that this earlier mark fails to establish any form of reputation and, therefore, the ground, in so far as it is based on this earlier mark, is dismissed.

91. Given my comments in relation to the MAD SCIENCE mark at paragraph 85, I come to the view that whilst the earlier mark may be regarded as having a reputation, thus meeting the requisite hurdle, it is not a strong one.

The required link

92. In addition to having a reputation, a link must be made between the subject trade mark and the earlier marks. In *Adidas-Salomon*, the CJEU stated:

“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). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

93. In *Intel* the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

94. Whether a link will be made represents another multi-factorial question. Having assessed the various factors, I come to the view that a member of the relevant public encountering the SCIENCE MAD goods in classes 9 and 28 will not bring to mind the MAD SCIENCE educational services. In my view, the lack of, or low, levels of goods/services similarity, coupled with the conceptual difference between the marks, coupled with what is not the strongest of reputations, results in a member of the relevant public just appreciating the applied for mark for what it is. A range of goods in the field of science (including activity kits and toys etc) which make use of a suggestive phrase indicating someone or something that is mad about science. The relevant public will not think of, or bring to mind, the earlier mark.

95. Even if I am wrong on the above, then any link that would be made would be inconsequential. The link would not result in any form of economic connection or an assumption that the businesses are related somehow. Absent that, in the circumstances before me, I do not see how the applicant will benefit from any reputation the opponent’s mark may possess. I do not consider that there will be any form of image transfer. The bringing to mind will just be viewed as a co-incidental use of two common words (in reverse) with a differing concept and on different goods/services. No positive benefit flows to the applicant. Neither will anything negative impact upon the opponent’s mark’s repute or distinctiveness. In terms of repute, there is nothing inherently unpleasant about the applied for goods which would impact negatively on the opponent. Neither do I see how the opponent’s mark will in any way be less capable of distinguishing its services. The opposition under section 5(3) is dismissed.

Conclusion

96. The opposition fails. Subject to appeal, the applied for mark may proceed to registration.

Costs

97. The applicant having been successful, it is entitled to a contribution towards its costs. My assessment is set out below:

Preparing a counterstatement and considering the other side's statement of case - £300

Filing evidence and considering the opponent's evidence - £700

Written submissions - £500

Total - £1500

98. I order Mad Science Licensing Inc. to pay Trends UK Ltd the sum of £1500 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 26th day of January 2017



Oliver Morris

For the Registrar,

The Comptroller-General