

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2157304
BY BENDY (INTERNATIONAL) LIMITED
TO REGISTER A TRADE MARK IN CLASS 28**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 48744 BY NEWFELD LIMITED
AND ANTHONY CARL NEUFELD
TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2157304
by Bendy (International) Limited
to Register a Trade Mark in Class 28**

AND

**IN THE MATTER OF Opposition Thereto
Under No 48744 by Newfeld Limited
and Anthony Carl Neufeld**

BACKGROUND

1. On the 5th February 1998, Bendy (International) Limited ("the applicants") applied to register a trade mark under application No 2157304 in Class 28. The mark is reproduced below:



2. The application was accepted and published in Trade Marks Journal No 6219 page 03762 on the 1st April 1998 for the following specification of goods:

"Toys made wholly or principally of natural or synthetic rubber or of like elastomers."

3. On the 1st July 1998, Newfeld Limited and Anthony Carl Neufeld ("the opponents") filed a notice of opposition, accompanied by a statement of grounds for the opposition. In this, they set out in some detail the history of the trade mark BENDY for "toys made wholly or principally of natural or synthetic rubber or of like elastomers", dating back to 1947, and of the relationship between the two opponents and the applicants. For reasons which will become apparent, I do not intend to cover those points in detail. Essentially, the grounds of opposition were stated as being under Sections 3(4) and 3(6), 5(2)(a) and (b) and 5(4)(a) of the Act.

4. On the 25th September 1998, the applicants filed a counterstatement denying each of the grounds of opposition, although admitting some of the detail of the opponents' statement of grounds of opposition.

5. Both sides sought an award of costs in their favour.

6. Subsequent to the filing of the aforesaid statement of grounds and counterstatement, the opponents requested on the 13th October 1998 the suspension of these proceedings pending the

outcome of rectification proceedings against registration No's 751759 and 1085099 (Rectification No 10281 and 10282) which at that time stood on the Register in the name of the applicants in this case. This stay in the proceedings was eventually granted.

7. The eventual outcome of the rectification action against the above mentioned registrations resulted in both of them being put into the ownership of Bendy Toys Limited (ie no longer in the name of the applicants in these proceedings).

8. As a result of these rectifications the Registrar wrote to both parties in this current case on 1st October 2001, asking them how they intended to continue the proceedings? The opponents replied on the 15th October 2001, the essential elements of which were:-

- (a) The applicants should now withdraw the application for 2157304 unconditionally.
- (b) If they do not, the Registrar should refuse the application summarily under the grounds of Sections 3(4), 3(6), 5(2)(b) and 5(4)(a) of this Act., without the need to proceed through evidence stages.

9. The applicants did not respond to the Registrar's letter of 1st October. On the 14th November 2001, the Registrar wrote to both parties again, saying that the Registrar does not have the power to dispense with the evidence rounds and issue a summary judgement as requested by the opponents. Further, that it was the Registrars preliminary view that the outcome of the related rectification cases (10281 and 10292), presents a *prima facie* case for refusal of application 2157304 under Section 5(2) of the Act.

10. In that letter, the applicants were given a period of one month to indicate whether any evidence was to be filed under Rule 13(9) to rebut the opponents allegations that there is a likelihood of confusion as set out in their statement of grounds. If no response was received, it would be taken as an indication that the applicant does not wish to file evidence.

11. The opponents were told in the same letter that if they did not wish to file evidence in support of the alternative grounds set out in their statement of grounds, then the Registrar will make a decision on the basis of the Section 5(2) ground alone.

12. Neither party responded to the official letter of 14th November 2001. Consequently, I adopt the approach set out in that letter and will decide these proceedings purely on the basis of the Section 5(2) grounds.

13. No hearing was requested by either party, so on a careful study of the papers, I give the following decision.

DECISION

The Section 5(2) Ground (as pleaded)

14. The opponents case based on Section 5(2) boils down to a comparison of the two marks which were particularised in their statement of grounds as being "earlier trade marks" within the

meaning of Section 6(1) of the Act for the mark BENDY (solus). These were UK registrations 751759 and 1085099 - the same two registrations which were the subject of rectifications actions 10281 and 10282. These marks are now in the ownership of Bendy Toys Limited.

15. Section 5(2) of the Act reads as follows:

5.-(2) *A trade mark shall not be registered if because -*

- (a) *it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or*
- (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.

16. An earlier right is defined in Section 6 of the Act, the relevant part of which states:

6.-(1) *In this Act an 'earlier trade mark' means -*

(a) *a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,*

(b)

(c)

17. In deciding this case, I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

18. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

19. With this in mind, I should say at the outset that there is no question that the goods in question in all three cases at issue are identical, so the matter rests entirely on a comparison of the marks.

20. Even a cursory comparison of the three marks in question reveal that a determination under Section 5(2)(a) is not appropriate, as the marks comprising the earlier rights (751759 and 1085099) are purely word marks, whereas the application under opposition (2157304) has a globe device partially obscured by a stylised word BENDY.

21. Section 5(2)(b) then is the only one to be considered in determining whether the marks are confusingly similar. Using the "global appreciation" guidance above, I do not find it necessary to assess the visual, aural or conceptual similarities of the marks in detail. These are readily obvious. As stated above, the only significant difference between the application and the two earlier rights, is the presence of a partially obscured globe device in the application. The question is whether that element is significant enough to distinguish the identical goods covered under that mark, from both those under the registrations, given that they each contain the word BENDY? I do not consider that it is.

22. It is often said that "words talk" in trade marks. All three marks will clearly be seen as and referred to as "BENDY" marks. In the context of the goods in question in the earlier rights, this does not seem to me to be the most distinctive of words, but nevertheless both achieved registration, albeit through evidence of achieved distinctiveness in one case (1085099). The addition of what is, it seems to me, a common element in many trade indicators (ie a globe device), does not help change this view when considering the marks in totality.

23. The opposition therefore succeeds under the Section 5(2)(b) ground.

24. As such the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of **£335**. This sum is to be paid within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24 Day of January 2002

**G J Rose'Meyer
For the Registrar
The Comptroller-General**