

O-042-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2354865  
BY PHIL MOORE TO REGISTER A TRADE MARK  
IN CLASSES 10 AND 21**

**AND**

**IN THE MATTER OF OPPOSITION No. 92586  
BY MERCIS B.V.**

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## **BACKGROUND**

1. On 2 February 2004 Phil Moore applied to register the following mark:



The published application indicates that the applicant claims the colours red and blue as an element of the mark.

2. The goods specified are as follows:

- |          |   |  |
|----------|---|--|
| Class 10 | - | Baby bottles, dummies, teething soothers |
| Class 21 | - | Feeding cups                             |

3. The application was published for opposition purposes on 19 March 2004 and has been opposed by Mercis B.V. (hereafter Mercis)

4. Mercis is the proprietor of registration No. 2068800 for the mark MIFFY. The mark has a filing date of 15 April 1996 and a registration date of 3 January 1997. As it had been on the register for more than five years by the date of publication of Mr Moore's mark, Mercis was required to state on which goods the mark had been used or to say why it had not been used. (Rule 13(2)(c) of the Trade Marks Rules 2000 as amended).

5. The registration covers goods in Classes 3, 6, 9, 14, 15, 16, 18, 21, 24, 25, 26, 27 and 28. Mercis indicated in its notice of opposition that:

“Insofar as goods relevant to the present proceedings are concerned, the earlier mark has been used on children's and baby's [sic] clothing toys, feeding and drinking articles and other miscellaneous children's and baby products.  
No admission is made to the use or otherwise of other goods in the registration.”

6. Use is claimed from at least as early as 1996. Objections have been raised under Section 5(2)(b), 5(3) and 5(4)(a) of the Act.

7. Mr Moore filed a counterstatement which:

- denies the grounds of objection;
- denies similarity of marks;
- explains that MIPI is an acronym for Moore Infant Product Import;
- says that MIPI is pronounced 'my-pea';
- claims that MIFFY is the name of a cartoon character and says the applicant has not chosen a character to compete with this brand;
- claims that with 30 years of experience of the baby products market there is no need or intention to conflict with another mark.

8. In response to question 5 on the Form TM8 (Notice of defence and counterstatement) Mr Moore indicated that he did not accept the opponent's statement of use of its earlier trade mark. Question 6 invited Mr Moore to say whether he wanted Mercis to provide proof of use. He left this box blank. That state of affairs may have left the opponent in some doubt as to what it was required to do. In the event the opponent filed evidence (but whether with the proof of use requirement in mind is not clear) as, subsequently, did Mr Moore.

9. Neither side has asked to be heard. Both sides have filed written submissions. Acting on behalf of the Registrar I give this decision.

### **Opponent's evidence**

10. The opponent has filed two statutory declarations.

11. The first is by Ms M.A.M. Kerkhof, the Managing Director of Mercis B.V. She exhibits the following:

- MAMK1 - a list of licensees of the trade mark MIFFY.
- MAMK2 - copies of two newsletters dated Autumn 1999 and Autumn 2000 relating to use of the trade mark. Attention is drawn to two items which are said to relate to sales of items in the UK (both are apparel ranges).
- MAMK3 - a sample showing use of the mark on the Russimco website (Russimco is a company with an address in Bridgwater). This exhibit is particularly relied on as showing MIFFY written in script form which is said to be similar or even identical to the script form of the opposed application.

- MAMK4 - extracts from a Mothercare brochure dated Autumn/Winter 1999. The brochure displays a number of nursery items (bedding, wallpaper, glow light, bathtime products).
- MAMK5 - copies of the Mercis Times newsletter from Spring 2002 to Summer 2004 illustrating the range of MIFFY branded products that are available. The publications appear to be directed at Mercis' distributors/agents worldwide. I note the following references to the UK mainly in the new products and licensees worldwide section of the newsletter in respect of clothing, children's watches gifting lines (various products) (Spring 2002), towels (Autumn 2002), 3D animation products, duvets (Spring 2003), clothing (Summer 2003) puzzles, stitch kits (Autumn 2003), pin badges, clothing, height chart, notebook, bags (Summer 2004).
- MAMK6 - copies of Rainbow Designs brochures from 2003 and 2004 showing examples of products sold in the United Kingdom by one of Mercis' licensees. The 2003 brochure features stickers, keyrings, photo frame magnets, umbrellas, height chart, stationery items, stacking blocks, various bags, purses, wallets, cushions, plush toys, other toys featuring the MIFFY character, teether, keychain and books. A similar range of goods is shown in the 2004 brochure.
- MAMK7 - a teething ring in its original packaging. It is not clear from the packaging what market the product was intended for but the product appears to be the same as one illustrated in the Rainbow Designs 2003 brochure at MAMK6.

12. The second statutory declaration is from Anthony Temple, the Managing Director of DRI Licensing Limited, the UK agent of Mercis B.V. since 1997. He gives wholesale sales figures for products sold under the trade mark in the years 1997 to 2004 through DRI Licensing Ltd:

<b>YEAR</b>	<b>APPROXIMATE ANNUAL TURNOVER (£)</b>
1997	50,000
1998	242,230
1999	957,860
2000	1,809,407
2001	1,486,830
2002	1,500,000
2003	1,829,440
2004	2,025,000

13. He says that his company does not have exact figures for the amount spent on advertising but on a conservative view of the matter he puts it at 5% of the above wholesale turnover figures.

14. Mr Temple goes on to say that there are now (2005) more than 37 licensees covering every major category of goods. The licensees are said to be established in distribution to a wide variety of retail stores including key independents, department stores, mail order, gift, nursery and trade book stores and fashion retail chains. There is also a major television series for Miffy shown on CiTV and a publishing programme with Egmont. In eight years, MIFFY has undergone a transformation into what Mr Temple describes as a “recognised classic and relevant contemporary brand across many merchandise categories”.

15. He exhibits, at AT3, a PowerPoint presentation about the UK marketing and licensing plan. Although dated 2005 it is said to shed light on past uses of the MIFFY mark. Unfortunately, it is not easy to determine what the position would have been at the material date. I note that the ‘Miffy brand drivers & partnerships’ are said to be in the areas of television, publishing, video and plush (toys). Under the heading “The Classic Nursery Programme” are the following comments:

“New nursery programme in development ....”

“Rainbow Designs pastel nursery plush well received by trade”

“Baby book & photo album (Egmont) baby feeding (Euromark) and baby greetings (Gibson Hanson Graphics) ranges – Spring 2005 launches”

16. A side box on the slide gives a range of product areas but does not distinguish between products already on the market and those yet to be launched. The remainder of the PowerPoint presentation slides relate largely to clothing ranges. The final slide picks up on the new product categories for Spring 2005 as follows:

“• New publishing including brand new story books, colouring and teenage gift formats

- Greetings cards, gift wrap & bags – major launch across baby, pre-school and tween/teen markets. Spring Fair trade launch.

- Baby feeding, melamine & toiletries

- Baby Book, photo album, calendar

- Fashion bags & accessories – into fashion independents and high street fashion retail”

17. It would seem that the above refers to both new product launches, new developments within existing ranges and, perhaps, new outlets for existing ranges but the position is by no means clear.

18. Finally, Mr Temple exhibits, at AT4, samples of press cuttings showing use of MIFFY in the UK. The main product lines featured or referred to are clothing, books, toys, nursery items (quilts, cushions, sheets, curtains etc) and bags along with mention of the animation series for CiTV. I note that a page headed ‘Licensing Today Worldwide – Summer 2003’ records that:

“DRi Licensing has reported a surge of demand for Miffy-related licensed merchandise following the launch in January of CiTV’s new series ‘Miffy and Friends’ – which sees Dick Bruna’s classic storybook character animated in 3D for the first time in 48 years.

Miffy’s fresh new 3D look has opened the door to a whole range of new licensed products based on the animation.”

and

“The new TV series is also impacting on the demand for more ‘classic’ Miffy products. Rainbow Designs has just launched a new range of soft toys and nursery products which epitomise Miffy’s qualities of simplicity and charm.

Included in the range are soft toys – featuring Miffy in a car, or a boat, or a plane – small or large beanies, wrist and pram rattles, teethers, musical cot mobiles, keychains, and Miffy-shaped plush backpacks.”

### **Applicant’s evidence**

19. Mr Moore has filed a witness statement. It consists in the main of submissions in relation to Mercis’ evidence. I do not propose to record his comments in detail but take them into account in reaching my decision. His main criticisms seem to me to be:

- the list (in MAMK1) does not specifically identify UK licensees;
- the opponent’s exhibits in general do not disclose use in relation to products of the kind Mr Moore is interested in;
- the opponent’s word mark is often used in association with the device of a rabbit;
- there is no breakdown of the sales figures given by Mr Temple.

20. Mr Moore also reiterates points made in his counterstatement. So far as his own activities are concerned he says that the mark MIPI baby products has been used in relation to the goods of the application “at least since June 2004”. That is, of course, after the filing date of this application.

21. Finally, Mr Moore has referred me to the Preliminary Indication given in accordance with Rule 13(B)(2) of the Trade Marks Rules 2000 (as amended by the Trade Marks (Amendment) Rules 2004). I should say at this point that Preliminary Indications are given in oppositions where an opponent has pleaded Section 5(1) or 5(2) of the Act. The mechanism was introduced in order to give parties an early indication of the likely outcome under these heads of opposition before the parties are required to decide whether to enter the evidential stage of a case. The Preliminary Indication is part of an administrative process and has no legal force as such. A party need not accept the Preliminary Indication and instead can take matters forward by means of evidence if necessary and have the matter formally determined either as a result of a hearing or decision from the papers. That is what has happened here. The Hearing Officer who determines a case that has gone through the evidence rounds in this way will not be the same as the one who gave the Preliminary Indication. He is not bound by the

Preliminary Indication and will arrive at his decision independently of the Preliminary Indication. That will be my approach here.

## DECISION

### Section 5(2)(b)

22. This reads:

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

(a) .....

(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.”

23. 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] RPC 117, *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.

24. In essence, the test is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of identity/similarity of the goods and how they are marketed. In comparing the marks I must have regard to the distinctive character of each and assume normal and fair use of the marks across the full range of the goods within their respective specifications. The matter must be considered from the perspective of the average consumer who is deemed to be reasonably well informed and reasonably circumspect and observant.

25. In considering the application of these principles I also bear in mind the written submissions filed under cover of letters dated 20 January 2006 by Lloyd Wise on behalf of Mr Moore and J.E. Evans-Jackson & Co Limited on behalf of Mercis.

26. As noted above, although Mr Moore does not accept the opponent’s statement of use, he has not asked for proof of its claim. That may have been a conscious decision not to increase the costs of conducting the case or simply reflect a private litigant’s understandable lack of familiarity with the system (Mr Moore was not professionally represented at the time his counterstatement was filed). Whatever the reason for this state of affairs, it has meant that the opponent has not had to approach the matter on the basis that use would need to be shown in relation to the goods’ areas claimed to the requisite standard equivalent to what would have been needed to defend a revocation action. I do not read the written submissions filed on behalf of the applicant as taking a different position on the point.

27. I, therefore, approach the matter on the basis that the goods to be compared are as follows:

**Applicant's**

Baby bottles, dummies,  
Teething soothers  
Feeding cups

**Opponent's**

Children's and babies' clothing  
Toys  
Feeding and drinking articles  
Other miscellaneous children's and baby products.

28. The above listing of the goods relied on by the opponent has been taken from the statement of grounds. Most of the terms are self explanatory. The term 'other miscellaneous children's and baby products' is indeterminate in scope. The opponent's evidence sheds some light on the term. I note that the material exhibited to Ms Kerkhof's declaration shows a range of nursery products (bed linen, curtains, duvets etc), children's bags, watches and a teething ring. The latter item, however, would fall into Class 10 of the International Classification system. No Class 10 goods appear in the specification of the earlier trade mark so I cannot consider this term in relation to Section 5(2).

29. The position taken by the opponent in its written submissions is that 'feeding cups' (the Class 21 goods in the application in suit) must be identical to the broad description of goods in the opponent's Class 21 specification. So far as the applicant's Class 10 goods are concerned the opponent submits that its earlier trade mark is registered in respect of a wide range of baby products. In particular it is said that:

"For example, and by way of illustration, class 21 would cover "feeding articles for babies", which must be considered similar to "baby bottles" in class 10, whilst class 28 covers "toys, games and playthings" and it is often the case in shops that "dummies" and "teething soothers" are sold as toys rather than as specific baby items and thus, we believe there is room to argue that the class 10 goods of the earlier application are similar to at least, the class 21 and 28 goods of the earlier registration."

30. Although the above are said to be illustrative examples I infer that they have been chosen because they give the opponent its best chance of success.

31. Similarity of goods falls to be considered against the principles established in the *Canon* case, in particular the nature, intended purpose and method of use of the goods and whether they are in competition or complementary. The opponent's written submissions have referred me to *Jellinek Trade Mark* (1946) 63 RPC 59 which set out the 'goods of the same description' test under the preceding law. It is no longer appropriate to rely on that case albeit that certain of its key principles also find expression in *Canon*. It is also important to bear in mind that similarity is a matter of degree (see for instance the cautionary remarks about pre-emptive findings in *Merlin Trade Mark*, O-043-05 at paragraph 43 et seq).

32. So far as the Class 21 goods are concerned, the opponent's specification does not itemise 'feeding cups' and the opponent has not said which items gives rise to identity. I suppose a cup may come within the term 'household container' on a broad interpretation of the latter term though it is not an altogether natural way to describe such an item. However, 'glassware, porcelain and earthenware' would certainly embrace cups made from those materials.

33. 'Feeding cups' appears to be a term likely to be used in relation to babies or young children. For obvious reasons plastic is likely to be a more favoured material for such goods but there is no reason in principle why a feeding cup should not be an item of porcelain or earthenware. I, therefore, consider that the Class 21 goods are either identical or closely similar.

34. Turning to the applicant's Class 10 goods, the opponent's specification does not cover this Class so identity is ruled out. But if I am right in relation to the scope to be given, and construction to be placed on, the opponent's Class 21 goods, then baby bottles must be considered closely allied in trade to feeding cups. One is a natural progression from and/or complementary to the other. I find baby bottles to be similar to the opponent's Class 21 goods.

35. It is claimed in the opponent's written submissions that the remaining goods, namely dummies and teething soothers, are sold as toys rather than specific baby items. There appears to be some slight force to this submission. Exhibit MAMK7 is an example of what may almost be called a dual purpose term – a teether incorporating a soft toy in this case the MIFFY rabbit character. Nevertheless in terms of the *Canon* test the nature and intended purpose of a teether is different to a toy as is the method of use. There may be some complementarity to the extent that incorporating a toy into the teether no doubt increases the attractiveness of the teether to a baby or toddler. But overall dummies and teething soothers must be considered to be further down the similarity scale to the opponent's goods.

36. Turning to the marks themselves, the opponent's main submissions are that the element 'baby products' in the applied for mark is simply a reference to the goods; MIPI is the dominant element; in any case fair use of the opponent's mark would include 'MIFFY baby products'; MIPI and MIFFY have some similarities to one another namely the letters MI at the beginning and the I/Y sound at the end; the applicant's suggested pronunciation of its mark as 'my-pea' is rejected; the marks are said to be phonetically similar.

37. The applicant's written submissions point to the different presentations of the mark; the colour component of the applied for mark; the visual and phonetic differences between the marks; and the absence of any basis for a conceptual comparison as the marks have no meanings.

38. The clear guidance from the judgments of the European Court of Justice is that in making the necessary visual, aural and conceptual comparison regard must be had to the distinctive and dominant components of marks. I concur with the opponent that the words 'baby products' in the applied for mark will be considered to be entirely descriptive of either the goods themselves or the general area of trade in which the proprietor of the mark is engaged. For practical purposes the comparison is between MIPI and MIFFY.

39. For ease of reference in the decision I have referred to the applied for mark as MIPI but I do not lose sight of the fact that it is presented in lower case letters and in colour. The latter point does not in my view make a material difference. Goods of this kind and their packaging are normally presented in a variety of often bright colours. So far as the other presentational aspects are concerned the opponent's submissions suggest that the stylisation of the applied for mark is extremely reminiscent of that used in relation to the opponent's mark. Again I consider this to be of marginal importance. The form of lettering used in each case is not particularly remarkable and in use MIFFY is usually presented in title case.

40. MIPI and MIFFY are both short words. They clearly have the first two letters in common but lack other points of visual similarity. It is often said that small differences are more noticeable when they occur in short words. In this case the double consonant, FF, and Y ending make a markedly different impression to the second element of the applied for mark and this impacts in turn on the overall appearance of the respective marks.

41. I do not share the applicant's view that his mark will be pronounced as if it were 'my pea'. That may be one of a range of possible pronunciations but it is not in my view the most likely one. To the extent that analogies are helpful I consider that, because MIPI is not itself a known word, it will be pronounced along the lines of other similar words such as 'mini' or 'midi'. That suggests to me that the final 'i' and 'Y' sounds in the respective marks will be much the same. However, there is no obvious reason why the P and FF sounds would be confused. In addition the goods in issue are more likely to be purchased on the basis of visual approval rather than oral recommendation or ordering even though the latter should not be ruled out.

42. Conceptually, both words are invented ones. The applicant has explained the derivation of his mark but there is no reason to suppose that consumers will be aware of it. The opponent's mark MIFFY is the name of (and often used with) a rabbit character but is not restricted to use in this way. But conceptual considerations seem to me to be of somewhat lesser importance save that imperfect recollection may be a factor where there is no meaning by which to distinguish marks.

43. Accordingly, I find a modicum of similarity between the marks arising from the common first element and certain phonetic similarities but in overall terms the differences outweigh the similarities with the result that the overall degree of similarity is at a relatively low level.

44. The acquired as well as the inherent distinctive character of the earlier trade mark must be taken into account. Because, as I have indicated above, I regard MIFFY as an invented word it enjoys a relatively high degree of distinctive character being neither descriptive of the goods at issue or otherwise devoid of distinctiveness.

45. The opponent's written submissions do not suggest that the distinctiveness of MIFFY has been further improved through use though that may have been the intention in filing evidence. In my view any such claim would face difficulties for the following reasons:

- it is a fairly strong mark based purely on its inherent qualities
- the evidence suggests a broadly based trade across a range of products for babies and children.....

- but no breakdown is given of the turnover figures so it is not possible to tell whether sales in the UK have been evenly distributed over the product range
- my impression (based on the evidence) is that books, toys and clothing may be the main contributors to sales
- there is very little evidence as to the extent of trade in products that might have proved more central to the opposition (the teether incorporating a MIFFY plush toy for instance)
- because of the uncertainty over spread of sales I am unable to say that the opponent had a widespread reputation in the baby products market at the material date
- the PowerPoint presentation at AT3 suggests new product developments in key areas but comes after the relevant date.
- the collective effect of the opponent's trade based on the merchandising of the MIFFY rabbit character may have made some impact but not to the point where it may be said to have improved the distinctive character of the mark.

46. In reaching a view on the likelihood of confusion I am required to make a global appreciation of the matter taking into account the similarities and differences in the marks, the identity/close similarity of certain of the goods and the interdependency between them. I must also consider the average consumer and the nature of the purchasing process for the goods in question. In this respect baby products (to take the market at its widest) may be purchased by parents and other adults as presents. The degree of attention paid is likely to vary according to the nature and cost of the purchase. Functional items such as baby feeders etc may not be particularly expensive but may still be bought with a modicum of care so that a parent or relative can be satisfied that they are safe and convenient to use.

47. Taking all these factors into account I have come to the view that the similarities between the marks are at too low a level for there to be a likelihood of confusion. The opposition fails under Section 5(2)(b).

### **Section 5(3)**

48. As a result of regulation 7 of The Trade Marks (Proof of Use etc) Regulation 2004 Section 5(3) now reads:

“5.-(3) A trade mark which –

- (a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, 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.”

49. The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C A Sheimer (M) Sdn Bhd's Trade Mark Application (Visa)* [2000] RPC 484, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited & others* [2004] EWHC 1498 (Ch).

50. The opponent's statement of grounds identifies "similarity of marks and area of commercial activity" as being the reason for the unfair advantage or detriment. The opponent's written submissions expand on the matter as follows:

"Given that the marks are similar and given that the trading areas of the Applicant and the Opponent are the same in terms of the consumers are the same, the goods are marketed for the same purposes (namely baby products) and are likely to be sold in the same shops, clearly if the marks are similar to one another and there is a likelihood of confusion, use of the MIPI BABY PRODUCTS and design trade mark is likely to damage the Opponent in terms of both loss of sales and should there be any quality differences between the respective products, damage to the reputation of the Opponent. If the marks are similar to one another, and we assert that they are, the relevant consumer is likely to expect that the goods emanate from the same company. Thus, even if the goods are considered dissimilar, use of the mark applied for without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier registered Trade Mark MIFFY and certainly if the goods are deemed identical or similar, the likelihood that damage to reputation would occur is increased."

51. I have previously found that identical and/or similar goods are involved but that the degree of similarity between the marks is insufficient to result in a likelihood of confusion when the interdependency principle and global appreciation test are considered. It is well established that confusion is not a necessary ingredient for Section 5(3) purposes (see the *Typhoon* case) and that it may be somewhat easier to establish an association between marks than confusion.

52. Nevertheless, the opponent is likely to face great difficulty in establishing an association leading to unfair advantage or detriment in circumstances where the similarity between the marks is not particularly striking.

53. However, the opponent may have a further difficulty in overcoming the initial hurdle of establishing the necessary reputation to get its case out of the starting blocks. The ECJ has given guidance on the standard for determining whether an opponent has the requisite reputation in the *Chevy* case as follows:

"23...In so far as Article 5(2) of the Directive, unlike Article 5(1), protects trade marks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two

trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. 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.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

54. I have set out above my assessment of the opponent’s evidence. That evidence establishes a trade in the UK of modest size. It is not possible to say with sufficient certainty whether the resulting reputation is spread across the range of goods that Mercis purports to offer or whether it has been concentrated, historically at least, in certain main areas (clothing, toys and books say). It is probably best seen as a reputation deriving from the merchandising of a range of baby products based on the MIFFY character. But the nature, extent and duration of the trade in particular goods areas is not clear and hence I cannot reliably assess the collective force and scope of Mercis’ reputation. There are some pointers in the opponent’s favour. I note, for instance, that the press cutting material in AT4 refers to the wider publicity generated from e.g. the “Miffy at the library” art and book events and the availability of MIFFY products at leading retailers such as John Lewis, Daisy and Tom stores, Ottakars, Borders, Harrods and Hamleys. The reputation may, therefore, be rather greater than the turnover figures alone might suggest. But it remains a matter of conjecture rather than inference.

55. Even if that is insufficiently generous to the opponent, Mercis would still face the difficulty of establishing an association between the respective marks. For the reasons given in relation to Section 5(2)(b) I find a low level of similarity between the marks and one which is unlikely to trigger a link between them in the mind of the average consumer. It also follows that I can see no possibility of the opponent establishing unfair advantage or detriment assuming normal and fair use of the applicant’s mark. I bear in mind in this respect that it has been held that Section 5(3) is concerned with actualities not possibilities (see *Mastercard v Hitachi*). The Section 5(3) ground fails.

#### **Section 5(4)(a)**

56. Section 5(4)(a) of the Act states that a trade mark shall not be registered:

“... if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

57. The requirements to succeed in a passing off action are well established and are summarised in *Halbury's Laws of England* 4<sup>th</sup> Ed. As being:

- i) that the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- ii) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the claimant; and
- iii) that the claimant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

58. I will assume for present purposes that the opponent has established the necessary goodwill.

59. The Section 5(4)(a) ground does not appear to raise any different issues in relation to the sign relied on by the opponent or goods in relation to which it has been used. If anything the opponent's position would be weaker because the word MIFFY is often used in association with an additional distinguishing feature namely the rabbit character. In these circumstances the passing off claim appears to me to stand or fall with the case under Section 5(2)(b). I cannot see how one could find that there was a misrepresentation for Section 5(4)(a) purposes when no likelihood of confusion has been found under Section 5(2)(b). This ground also, therefore, fails.

## **COSTS**

60. The applicant has succeeded and is entitled to a contribution towards his costs. Mr Moore represented himself until shortly before the filing of his evidence. It is appropriate to reflect this in the costs award on the basis of Simon Thorley QC's observations in *Adrenalin Trade Mark*, O-040-02:

“It is correct to point out that the Registrar's practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“**48.6-(1)** This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative”.

61. I order the opponent to pay the applicant the sum of £1200. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 8<sup>th</sup> day of February 2006**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**