

O-046-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2412243
BY HAPPY BOX LONDON LIMITED TO REGISTER THE
TRADE MARK HAPPY BOX IN CLASS 35**

AND

**IN THE MATTER OF OPPOSITION NO 94763
BY LIGHTBULB VENTURES LTD**

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Trade Mark HAPPY BOX in Class 35**

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**IN THE MATTER OF Opposition No 94763 by
Lightbulb Ventures Ltd**

BACKGROUND

1. On 26 January 2006 Happy Box London Limited applied to register the trade mark HAPPY BOX in relation to the following services:

Class 35 - Retail services connected with the sale of antiques, works of art, bags, wallets, purses, books, maps, comics, magazines, candles, cashmere, wool, textiles, chocolate, confectionery, clocks, watches, clothing, footwear, headgear, diaries, journals, writing apparatus, food, beverages, furniture, games, toys, gardening equipment and accessories, plants, flowers, audio apparatus, audio-visual apparatus, jewellery, gemstones, kitchen equipment, leather goods, music, dvds, natural pharmaceutical products, pet supplies, photographs, pictures, frames, albums, pottery, porcelain, glassware, soap, silverware, sportswear, sports equipment, bedroom furnishings and fittings, bathroom furnishings and fittings, soft furnishings, lighting apparatus and installations, beauty products, toiletries, beauty treatments, cosmetics and hair lotions, soaps, perfumes, essential oils, holistic relaxation products, paints, paintboxes, household cleaning products, computer hardware, computer software, mouse mats, mobile phone accessories, mirrors, musical instruments, tents, camping equipment, rugs, mats, carpets, picnic equipment, tabletop partyware, yarns, threads, embroidery, lace, ribbon, artificial flowers, gambling equipment, neon lights, neon signs, greetings cards, giftwrap, bells, chimes, fancy dress, wall hangings, bicycles, motorbikes, gift vouchers, wallpaper, Christmas decorations, matches, diffusers, room sprays, baby clothing, soft toys, christening gifts, nursery furnishings, baby food, baby beverages, office furnishings, travel cushions, pillows, linen, towels, luggage, toys, games, playthings, toys, games and playthings all for babies, coasters, wine stoppers, cocktail shakers, cocktail barware, wine racks, wine fridges, dripstops, corkscrews, ice buckets, wine buckets, ice trays, ice crushers, measures, bottle openers, shawls, blankets, bicycles, calendars, planners, diaries, paper files, paper folders, adhesives, glue, tape, labels, mailing bags, paper, pads, writing equipment, presentation materials, display materials, staplers, hole punches, fasteners, toners, cartridges, envelopes, filing cabinets, index files, stamps, pads, books, clipboards, scissors, letter openers, geometry sets, pencil cases, business card holders, first aid equipment, batteries, bulbs, desk fans, bookends, coin trays, letter trays, rubber bands, pins, calculators, albums, frames, art supplies, crafts

supplies, globes, scrapbooks, shredders, briefcases, document holders, portfolio cases, correction aids, desk tidies; visitors books, waste bins, telephone books, address books, paper trays, self-stick notes, recycled paper stationery, including all the aforesaid goods being personalised or customised.

2. On 10 November 2006 Lightbulb Ventures Ltd filed a notice of opposition to the above application under the sole ground of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”); the opposition is based on the opponent’s earlier trade mark registration 2334939, the details of which are shown below:

Trade Mark	Filing date	Specification
Boxhappy	14 June 2003	Class 35 - The bringing together, for the benefit of others, of gifts, toys, confectionery, toiletries and a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise Internet website, from a general merchandise store, through a television shopping channel, from a general merchandise catalogue, by mail order or by means of telecommunications

3. The applicant filed a counterstatement denying the above ground of opposition.

4. Both sides filed evidence, this is summarised below. Neither party requested a hearing or filed formal written submissions. However, submissions on the merits of the dispute have been made by both parties at different stages of the proceedings. These will be drawn upon and taken into account in this decision, but I do not intend to summarise them separately. Acting on behalf of the Registrar, and after a careful study of the papers, I give this decision.

Applicant’s evidence

5. The only formal evidence from the applicant comes from Ms Alison Nester-Smith, the Director of the applicant company. Her evidence merely serves to introduce into the proceedings the Registrar’s preliminary indication issued in relation to this opposition. Due to the non-binding and non-persuasive status of a preliminary indication, I have not taken it into account or examined it in any way. To do otherwise would be to undermine the tribunal process and the independent decision that I am required to reach. This approach is supported by Lindsay J in *esure Insurance Limited v Direct Line Insurance Plc* [2007] EWHC 1557 (Ch) where he stated in paragraph 37:

“As a subsidiary argument, esure argues before me that the Hearing Officer was wrong to reject the Registrar's preliminary view in the way that he did. Mr Hobbs, drawing attention to the Rules to which I have referred and also to Article 6 ECHR, argues that the Hearing Officer was right in doing as he did. I have no doubt but that the Hearing Officer was right to do as he did. The Registrar's view was arrived at before there was any evidence on either side, before there was any

argument on either side and in a context in which it could not be regarded as a decision against the interests of either side without the prospective loser being given an opportunity to be heard, an opportunity which was not given. So far from it being an error of principle to fail to take the Registrar's preliminary view into account, it would, in my judgment, have been a serious error of principle for it to have been taken into account.”

Opponent’s evidence

6. The opponent’s evidence comes from Mr Neil Goldsmith, the Director of the opponent company. Various statements are made in his evidence relating to the nature and status of the preliminary indication – I have dealt with this issue above and will say no more about it. Statements are also made which are more akin to submissions in relation to the similarity between the respective trade marks and the likelihood of confusion, I will deal with these submissions later in this decision.

7. Mr Goldsmith’s evidence introduces two exhibits. Exhibit 1 is a print from the Internet search engine Google. It shows that a search term entered for “box-happy” brings back links to web-pages for what appears to be the opponent’s business (boxhappy.com) and also the applicant’s business (happyboxlondon.com). The print is dated 20 April 2007. Mr Goldsmith states that the link to the applicant’s web-page was generated by the applicant placing a paid for Google advertisement against the reverse configuration of their business name because they (the applicant) believed that people would get the name wrong. Additionally, reference is made to letters to and from Google in which Google agreed that the placing of these advertisements breached the opponent’s trade mark.

8. Exhibit 2 is an e-mail (dated 28 October 2007) from one of the opponent’s customers enquiring about the whereabouts of an ordered “happy box”. This is filed to show that people using the opponent’s “Boxhappy” service often mistakenly refer to the products supplied under the service as HAPPY BOXES.

DECISION

The law

9. The sole ground of opposition is under Section 5(2)(b) of the Act. This states:

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

(a)

(b) it is similar to an earlier trade mark and it 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.”

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or International trade mark (EC) 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.”

11. Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to the proof of use requirements. Section 6A(1) details the circumstances where these provisions apply:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

12. The trade mark relied upon by the opponent has a date of application of 14 June 2003. The applicant’s mark was applied for on 26 January 2006. Neither party has claimed any form of priority. The opponent therefore has an earlier trade mark as defined in section 6(1). Furthermore, the earlier trade mark was registered on 2 January 2004, therefore, the provisions of section 6A of the Act do not apply to this opposition.

13. When reaching my decision I have taken into account the helpful guidance provided by the European Court of Justice (“ECJ”) in a number of judgments relating to Article 7(2) of the Directive (Section 5(2) as incorporated into the Act), notably in: *Sabel BV v. Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the 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 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 + Adidas Benelux BV*, 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.

Average consumer

14. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the services at issue. Both specifications cover the retail sale of a range of products. Many of them are what could be described as gift items but others could be described simply as consumer goods. The submissions made by both sides demonstrate that the service which they both offer is a service relating to the provision of gifts. In my view, the average consumer of these items is likely to be the general public.

15. The applicant's submissions highlight that one of their main types of customer is the corporate buyer who may buy gifts for their business contacts; the opponent says that they also have customers of this nature. These types of customers will also form part of the

relevant consumer, however, in terms of the degree of attention paid in the purchasing act, I do not consider this to alter the position. Be it buying for oneself, for friends or family, or for business contacts, I consider that the act of selecting the service provider in this field will be reasonably well considered, but not of the highest degree. This is not a technical or specialist area. Neither is it an area where large sums of money are being spent (in comparison, for example, to buying a new car). Some care will nevertheless be taken as regardless of the recipient of the gift, there will be a desire on the part of the user of the service to ensure that the service provided is reliable and of a good quality in order that the recipient of the gift has a pleasurable experience upon receipt.

Similarity of trade marks

16. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective trade marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). For ease of reference, the respective trade marks are:

Applicant's trade mark

Opponent's trade mark

HAPPY BOX

Boxhappy

17. From a visual point of view, it is clear that both trade marks are constructed of the same two words albeit in a different configuration, this does not fail to strike the eye and therefore creates an obvious aspect of visual similarity. Although the different configurations reduce the degree of similarity (they would otherwise be virtually identical) this does not render them dissimilar. Neither of the elements in the respective trade marks stand out more than the other, both elements have an equal impact in the overall impressions. In their submissions, the applicant argues that the marks are distinguishable not only because the words are reversed but also because of the conjoining of the two words in the opponent's mark. I have taken this argument into account but consider this to be a factor of limited assistance as the conjoining does not disguise the fact that the mark is made up of these two words.

18. Similar considerations apply in relation to aural similarity. When spoken it will be clear that both marks are constructed of the same two words although, again, the different configuration is still a factor to consider. When spoken, neither of the elements in the respective marks have any greater dominance or impact than the other.

19. In relation to conceptual similarity, and if required to analyse the meanings behind the applicant's mark, possible meanings could range from a box that has a happy disposition or a box with happy features depicted on it, to a box that in some way provides the recipient with a sense of happiness. These are somewhat unusual and quite vague concepts. In view of this, the most likely scenario is that the average consumer will simply take the mark as a reference to something relating to happiness and boxes. In respect of the opponent's mark, the conceptual meaning is even less clear. Even upon a forensic analysis I would struggle to come up with any meaning other than that, again, it has something to do with boxes and happiness.

20. I am aware that if the respective marks have a conceptual difference then this may, in certain circumstances, off-set the visual and aural similarities between them. However, I am also conscious that for this to occur such a conceptual difference must be founded on clear and specific meanings. In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-147/03* it was stated (para 98):

“It is true that, according to case-law, a conceptual difference between the marks at issue may be such as to counteract to a large extent the visual and aural similarities between those signs (*BASS*, cited in paragraph 60 above, paragraph 54). However, for there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.”

21. Taking this into account, there does not seem to me to be a clear and obvious difference of concept underpinning the respective marks that would create a conceptual dissonance. The most likely conceptual interpretations of the two marks are that of boxes and happiness, and, happiness and boxes. This creates a conceptual similarity rather than a dissonance. Even though upon a forensic analysis of the applicant’s mark it may be possible to attribute some form of meaning to it, even this would not be enough to create a meaningful difference given that the concept behind the opponent’s mark (boxes and happiness) is not too distant from this.

22. Based on the assessments I have made in relation to the various aspects of similarity, I find that, overall, the respective marks are similar and are similar to a reasonable degree.

Similarity of services

23. The specifications of the respective marks both cover the service of the retail sale of various goods. Some of the goods sold under the two retail services are common to both specifications, for example, toys appears in both. Some of the goods retailed by the applicant are not expressly listed in the opponent’s specification. However, I note that the opponent’s specification includes the retail sale of “gifts”. In my view the term “gifts” is a broad one covering any item that could reasonably be regarded as something that may be given as a present. The opponent’s specification also covers “goods of all type”, this, again, is a broad term, albeit one that would be limited to goods of a general merchandise nature given the type of retail sale further described at the end of their specification. In view of this, it seems to me that the opponent’s earlier mark covers the retail sale not only of the specific terms mentioned in their specification (toys, confectionery, toiletries) but also the retail sale of any item that could reasonably be described as a gift or as a general merchandise item.

24. I am content that the items listed as being retailed in the applicant’s specification would fall within the ambit of either of the opponent’s broad terms. Neither party has

made any real issue in relation to whether specific items in their respective specifications are or are not similar to each other. What the submissions do focus on is what the applicant describes as the diametrically opposed packaging, services, products, and pricing between the respective services. In summary, this focuses on the fact that the applicant claims that their gifts are of a much higher quality and, as such, cost much more. They also highlight that the packaging used in relation to the gifts provided under their service is of a much higher quality. In relation to this, the opponent submits that whilst this is not strictly true (they claim to sell some expensive items also) the point is, in any event, irrelevant.

25. I take the view that the opponent is correct on this point. The fact that the respective gifts being retailed may be targeted at different ends of the market, or that they are premium rather than non-premium products, has no bearing on the assessment of similarity and subsequent confusion. Marketing strategies can be temporary and a proprietor who adopts a particular strategy at one point in time has the freedom to choose another strategy at a different point. I am re-enforced in this view by the judgment in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03* where it was stated:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.

.....

107 It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

26. In summary, the different marketing techniques of the two parties have no bearing on the degree of similarity between the respective services. I must assess the matter from the inherent properties of the descriptions. In my view, and as assessed above, I consider the applicant’s services to be encompassed by the opponent’s service. The services must therefore be considered to be identical, particularly when one bears in mind the judgment in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* where it was stated:

“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 the trade mark application....”

Distinctiveness of the earlier trade mark

27. The distinctiveness of the earlier mark is another important factor to consider because the more distinctive (based either on inherent qualities or because of the use made of it) the earlier mark, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The earlier mark has some qualities that are at least allusive to the service of providing gifts. The word “box” alluding to the type of packaging the gifts will come in and the word “happy” alluding to the state of emotion that the provision of a gift is intended to evoke. Consequently, the mark is not as distinctive as say an invented word(s) or a word(s) that has no relationship with the service at all. Nevertheless, the mark as a whole does create an unusual totality as it is not common to describe the emotional state of the inanimate packaging of products provided under a service, and, the combination itself has no real allusion or description relative to the gift service being provided. I am therefore left with the impression that, from an inherent point of view, the mark is of at least an average level of distinctiveness.

28. No real evidence of use has been provided by the opponent to enhance the distinctiveness of the earlier trade mark. Although the opponent suggests that the trade mark has been used for around 5 years, no further information is provided. Nevertheless, as a mark of at least average distinctiveness it is entitled to a reasonable degree of protection when considering the question of likelihood of confusion.

Likelihood of confusion

29. I have found that the respective trade marks are reasonably similar and that the respective services are identical. I have found that the earlier trade mark possesses at least an average degree of distinctiveness. The question I must answer is whether these factors combine to create a likelihood of confusion on the part of the average consumer?

30. The opponent’s evidence provides what is described as a “paid for” Google advertisement (Exhibit 1). This has little bearing on the likelihood of confusion. Firstly, I am unaware of the circumstances of how paid for Google advertisements operate and the circumstances in which a search term will bring forward the advertisement. Additionally, and more importantly, regardless of the manner in which such an advertisement is generated, this proves nothing as to whether the consumer would actually be confused.

31. Of greater relevance is the opponent’s submission that members of the public often interchange the words that make up the respective marks. He refers to numerous examples but has filed only one as evidence (Exhibit 2). In this example, one of his Boxhappy customers is enquiring in an e-mail about the whereabouts of an ordered “Happy Box”. The opponent does not appear to promote the concept of a Happy Box under his Boxhappy service, this is supported by the web-page prints provided in the applicant’s submissions (they feature the Boxhappy service providing what they refer to

as Boxhappy boxes). Therefore, I can only assume that the customer in this e-mail has simply interchanged the words in error or has formed his own impression that boxes sold under the Boxhappy service would naturally be called Happy Boxes. Both these reasons support the proposition that confusion may arise. Whilst this evidence has some value, I am conscious that it is only one example and does not, in itself, make the opponent's case. Nevertheless, I am required to come to my own view based not only on the evidence but also on my own opinion as to whether the marks are likely to be confused.

32. The applicant's submissions focus on what they see to be the differences between the two marks particularly the fact that the words are in a different order. I have dealt with most of this in my assessment of the similarity between the marks, but, to deal with this point further when assessing the likelihood of confusion, I highlight another factor that the ECJ has informed us to take into account when deciding on whether there exists a likelihood of confusion, namely, that although the average consumer is deemed to be reasonably well informed and circumspect and observant, they will rarely have 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).

33. This, in my view, is an important factor to bear in mind in the present case. In my experience, it is not uncommon for words to be interchanged when trying to recall something. The consumer may recall that the marks were to do with boxes and happiness or happiness and boxes, but may not recall the precise configuration. Without precise recollection, the interchanging of the words is something that could easily occur. I also bear in mind that the services are identical and that this, taken into account with the degree of similarity between the marks, and taking into account the concept of imperfect recollection, all leads me to the conclusion that the marks are likely to be confused directly (one mark being mistaken for the other).

34. I am also of the view that even if the marks were not imperfectly recalled and the alternative configurations were noticed by the average consumer, then, given the closeness and the make-up of the respective marks and bearing in mind the identical services at issue, the consumer will simply believe that the respective services were provided by the same or an economically linked undertaking¹. This would therefore lead to indirect confusion. I come to this view because a consumer seeing a happy box may simply consider this to be a product of box happy and vice versa. The combination of the two words BOX and HAPPY in either configuration could therefore create confusion.

Conclusion

35. Taking all factors into account, I find that there is a likelihood of confusion in respect of all the services applied for and, as a result, the application for registration should be refused in its entirety.

¹ A circumstance where a likelihood of confusion can still be found (see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29)

COSTS

36. The opponent has been successful and is entitled to a contribution towards its costs. I hereby order the applicant to pay the opponent the sum of £688 which is made up as follows:

Notice of opposition	£200*
Official fee	£200
Considering statement of case in reply	£133*
Preparing and filing evidence	£100*
Considering applicant's evidence	£50*
Total	£688

37. It should be noted that in this breakdown of costs, the sums I have highlighted with an asterisk represent no more than one third of what I may otherwise have awarded. This reflects the fact that the opponent has not had legal representation in these proceedings. The Civil Procedure Rules state at Part 48.6²:

“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.”

38. The applicant must pay the opponent the above sum 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 18th day of February 2008

Oliver Morris
For the Registrar
The Comptroller-General

² Mr Simon Thorley QC, sitting The Appointed Person in *Adrenalin Trade Mark* (BL 0/040/02), confirmed the applicability of this Rule to costs before the Registrar of Trade Marks.