

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No: 2069780A
by Copy Cats Copy Limited to register a
Trade Mark and**

**IN THE MATTER OF Opposition No: 47719 by
Wayne Brown.**

On 26th April 1996 Copy Cats Copy Limited of 63 Commercial Road, Swindon, Wiltshire SN1 5NX applied to register the following trade mark:



These goods and services were specified with the mark:

Class 25: 'Clothing, footwear, headgear';

Class 35: 'Mail shotting, publication of publicity texts, facilities management, advertising and promotions, shredding documents';

Class 38: 'Fax bureau';

Class 40: 'Pattern and photographic printing, printing on clothing, collating and binding of documents, encapsulating documents, shrink wrapping, punching stapling and folding documents, scanning information on to computer disks' and

Class 42: 'Printing services, black and white digital printing, black and white laser printing; full colour digital offset printing, full colour litho printing, art work and design services.'

(The application was split from 2069780B, which includes, in Class 35: 'Black and white photocopying services, colour photocopying services, spot laser photocopying services and laser copying services').

The application is opposed by Mr Wayne Brown. The grounds of opposition are not particularly clear, but refer to ss 1, 3 and 5 of the Act. The opponent is the registered proprietor of the mark N^o: 1292719, and has applied for (after the relevant date of 26th April 1996) mark N^o: 2119120, both shown in the Annex.

A Counter Statement was provided by the applicants, in which the grounds of opposition are denied. Both parties ask for costs to be awarded in their favour.

The matter came to be heard on 8th January 2001. The applicants were represented by Ms Martha Bruce of Bevirs Solicitors, and the opponent by Mr Goldring of J E Evans Jackson & Co.

THE EVIDENCE

The applicants have enclosed no evidence of use of their mark, though they state in their Counterstatement that it has been in use in the UK since 1992; they also make the following claim:

‘The Applicant has used the Device or Logo exclusively in connection with the supply of Goods and Services and has in so doing acquired a very substantial reputation and goodwill in their said Service Mark. Fellow members of the trade, client companies and members of the public all recognise the Mark as that of Copy Cats Copy Limited.’

As I say, there is no evidence substantiating this.

I consider the opponent’s evidence below. He is the proprietor of an earlier mark for the purposes of s 5(2), which specifies ‘Document copying; offset printing services; dyeline services for document copying’. The extent to which these activities are similar to the applicants’ services, as specified above, remains to be seen. As does the extent to which the opponent may be able to enlarge the penumbra of protection the legislation provides him by virtue of the law of passing off. His evidence on the nature and extent of his goodwill is critical in this regard, and I have summarised it (from his one declaration) as follows:

1. Mr Brown says that the COPY CAT registration N^o: 1292719 has been used since 1986 (previously by predecessors in title) with a wide range of services (see paragraph 3). However, the only material supporting this is a complement slip incorporating that mark. It is undated, but displays the pre 01- telephone number format. This would place the document at least before April 16th 1995.
2. In 1990, Mr Brown apparently used a different logo - which he calls the ‘cat’s head’, still incorporating the name COPY CATS; there are variations in this design, but the example reproduced here (from Exhibit WB4) is typical:



Mr Brown says that Exhibit WB3 incorporates a brochure 'from that time' i.e. 1990 showing the wide range of services offered under the name. However, the brochure is undated, but contains the post April 16th 1995 telephone dialling code.

5 3. Exhibit WB4 contains a leaflet incorporating the above 'cat's head' logo, and stating:

GRAND OPENING
for all your printing requirements
15th November 1991

72 Station Parade
Barking, Essex

13 There is also other stationery - letters and telephone message pads - which incorporate the logo. One of the letters, again, contains the post April 1995 dialling code. There are photos of various shop fronts (including that given in the leaflet). The word
17 element of the mark is used in different forms, i.e. as above, but also as one word in 'THE COPYCAT SHOP'.

21 4. Exhibit WB5 contains an undated document (said to be from 1991) which largely provides advice to employees on customer care.

25 5. Exhibit WB6 contains a collection of items using the 'cat's head' logo, with the COPY CATS mark. I can find no dates in this material that clearly places any of them before the relevant date. One refers to a promotion ending on 31st July 1996, which appears to have been corrected by hand to 31st July 1997, rather confounding it's evidential value. There are two issues of the COPY CATS newsletter. The first says it will be produced quarterly, and wishes customers a successful 1996.

29 6. Other material is after the relevant date. Mr Brown says it demonstrates the wide range of services offered by company, but I can take no account of that.

33 7. In terms of the services offered under the mark before the relevant date, the opponent's best evidence is contained in Exhibit WB8, where copies of the yellow pages from 1994/95, and 1996/1997 are reproduced. The latter advertises services that include: printing services, including design and art work, screen printing, colour and black and white laser copying, T-shirt printing, facsimile services, laminating and binding.

37 8. Sales the under COPY CATS names are given as follows:
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	Year	Approximate Sales value of goods and services in £ Sterling
	1992	359,000
45	1993	437,000
	1994	681,000
	1995	1,077,000
	1996	1,794,000

Approximately £20,000 is claimed as spent each year in promotional activities up to 1994, with £50,000 spent in 1995.

9. Mr Brown says that, in addition, over the same period, £250,000 a year sales were achieved under the old COPY CAT logo as registered under N^o 1292719. There is no evidence of any of this.

THE DECISION

At the Hearing, Mr Goldring referred to ss 1 and 3. It was clear from his submission, first, that the opponent's claim that the applicant's mark is not capable of distinguishing its goods and services is based upon their prior COPYCATS registration. This does not amount to a challenge to the mark's inherent capacity to distinguish. It is really a relative ground dressed up as an absolute ground for refusal, and I am not going to consider it further. Equally, I am going to disregard Mr Goldring's second point under s 3, which went to bad faith under s 3(6). He said: 'It is also our belief that certainly at the time of filing the application in 1996, [the applicants] must have been aware of the opponent's reputation in their COPYCATS mark because the opponent by that time had become very well known, particularly in London, but also around other areas, because of their 24 hour opening photocopying services, which was a novelty in the early 1990s.' Bad faith is a serious accusation and I would need compelling evidence to support this assertion from Mr Goldring. There is none.

The first of the remaining grounds I consider to be under s 5(2)(b), though I was given no guidance on this, either in the very poorly pleaded Statement of Grounds, or at the Hearing. However, because I do not consider the marks to be identical (see s 5(1) and s 5(2)(a)); then s 5(2)(b) is that one that logically remains. This section states:

'A trade mark shall not be registered if because -

(1) .. ,

(2) 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.'

In doing so, I have taken into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199 at 224, *Canon v MGM* [1999] ETMR 1 and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ETMR 690 at 698. It is clear from these cases that:

(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/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;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

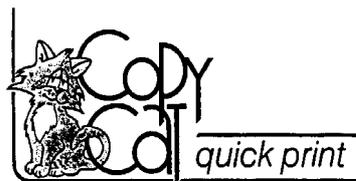
5 (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

9 (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

13 (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.

17 The issues raised by point (e) - that of the similarity of goods/services and that of the similarity of the marks - is a critical one here. Obviously these factors are interactive, but its is difficult to consider them in that way. Appraising the marks at issue first:

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29 Ms Bruce's contention on behalf of the applicants was that the marks '..are not so similar when looked at in their entirety.' I do not think I can accept this. In terms of imperfect recollection (point (b) above), in terms of the distinctive and dominant component of the mark - which I believe will be the name COPY CAT- in terms of the reaction of the average consumer, who may well be leafing through the yellow pages looking for one of the services I will discuss in a moment, I do not think I can come to any other conclusion than one of a very high degree of similarity between the marks.

37 Of course, set out side by side as they are above, one could point out various differences - the cats are not the same, the letters are different, the words 'quick print' appear on one, and the name COPY CATS appears twice on the other. However, as the case law observes '..the average consumer, of the .. services in question .. 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.' Though '..deemed to be reasonably well informed and reasonably circumspect and observant..' such individuals are very likely, in my view, to retain the distinctive, allusional name first and foremost, while the presence of a cat device would be more than not anticipated in some form, that is, conceptually the presence of a cat will hardly come as an over whelming shock; it will be expected. The *actual* cat will not necessarily be called to memory. Even where it is, the impact of the words in the mark are more than likely

to cause consumers to consider this is a different design from the same business - a species of the sort of origin confusion the Act is intended to preclude. The words 'quick print' will have little effect in my view; they are descriptive, and likely to be taken as such.

5 Orally the marks are identical (I have ignored the plural form in the applicants' mark; it will amount to very little in practice, particularly as the initial contact with customers may well be by telephone).

9 Against this background, I must come to the conclusion that the marks share a great deal of similarity. This conclusion necessarily means the 'penumbra' of protection the registered version enjoys will be extended to those goods and services that might not be 'caught' by marks which partake in less similarity. On this issue, at the Hearing, Mr Golding stated:

13 'However, we would say that there are .. services .. which are ... absolutely identical to, and several other services which are similar to, those covered the earlier mark and which are claimed in the later mark, particularly since the earlier mark covers offset printing services. 17 Quite clearly the services claimed in class 42 are essentially printing services. We also have some of the services in class 40 which are clearly printing services of one nature or another, and we also have faxing services in 38 which, I would have to say, are very similar to printing or copying services .. Effectively, what we have is an earlier registration which 21 covers, what I would call, print bureau services, and those were claimed fairly narrowly in an earlier mark and all we have here is a later mark which covers the same things spread out over a number of classes, but nevertheless the same services.'

25 The services at issue are:

29 Document copying; offset printing services; dye-line services for document copying; all included in Class 35.	Class 25: 'Clothing, footwear, headgear'; Class 35: 'Mail shooting, publication of publicity texts, facilities management, advertising and promotions, shredding documents'; Class 38: 'Fax bureau'; Class 40: 'Pattern and photographic printing, printing on clothing, collating and binding of documents, encapsulating documents, shrink wrapping, punching stapling and folding documents, scanning information on to computer disks' and Class 42: 'Printing services, black and white digital printing, black and white laser printing; full colour digital offset printing, full colour litho printing, art work and design services.'
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Clothing, footwear and headgear are goods, in my view, so far removed from the opponent's services specified that the necessary confusion is highly unlikely. As to the other services, I

am not so sure. The case law on this issue has previously been determined by the criteria established by Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] 9 RPC 281. The latter have been confirmed in *Canon*:

5 ‘In assessing the similarity of the goods or services concerned... all the relevant factors relating to those goods or services themselves should be taken into account...includ[ing], *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary..’

9 To this list, Jacob J included the respective trade channels through which the goods or services enter the market.

13 Returning to Mr Goldring’s statement above, taking all the services in Class 42 first (excluding art work and design services for the moment), I think I am inclined to agree that they are similar or identical to the printing services in the opponent’s registration. At the hearing, Ms Bruce sort to make a distinction in the following way:

17 ‘As you will appreciate, this is a very technical area. Offset printing is quite an old-fashioned form of printing. It involves use of film, chemicals to print and making up the plate to do it, very similar to a photograph. Our clients actually use digital offset printing which is a very different process. On that basis we submit that they are not the same services they are providing. If you will excuse me reading .. the printing they are involved in: “digital offset printing involves using either a computer to generate the plate, which is called digital litho-printing, or more advanced techniques such as pure digital printing where the printer reads from a hard drive computer and prints directly on to a laser printer.” We would submit that this is a much more advanced technique of printing. It is very different to the one under the registered mark.

21 It is therefore submitted that there is no conflict with the registered mark in terms of goods and services provided, although the applicants would agree to amend the specification in class 42 to just digital printing and digital litho-printing and pure digital printing to remove any confusion. Also at the moment the applicants have in class 42 the expression “printing services” which we again agree is confusing and they would be prepared to remove that description.’

25 I do not think such a change would help; it is, I think, too fine a distinction, which might lead to the applicants’ specification approaching that of a patent application, but would do nothing to mitigate the likelihood of confusion. As Mr Goldring pointed out, there have been many advances in the technology of printing, but it’s still printing. I consider these service to be the identical, and that confusion will occur.

33 And this also will be the case, in my view, with many of the service in Class 40. I agree with Mr Goldring’s assessment, that the majority of these are printing services of one sort or another, and either similar or identical to those specified by the opponent. Certainly pattern and photographic printing would be so, while printing on clothing, collating and binding of documents, encapsulating documents, shrink wrapping and punching stapling and folding documents would all be the *sorts* of services one might expect from a printer.

What remains are the services in Class 35, scanning information on to computer disks, fax bureau services and art work and design. Some of these I will revisit below, under s 5(4)(a), while others, considered in the light of the case law, I regard as similar to those specified by the opponent - they are the types of service that might be expected to be typically proffered where high-street printing and copying are offered, and taken up by the same end users. I am thinking specifically of document shredding, scanning and fax bureau services. The very close similarity of the marks I have found above makes for a likelihood of confusion for these services as well, and thus the opponent has been partially successful under this ground. Where he has not been - for the goods in Class 25, the remaining services in Class 35 and for art work and design services - I am unable to come to the same conclusion, despite the similarity of the marks. The goods/services are simply too far apart.

For the next ground, under s 5, I was directed by Mr Goldring to s 5(4)(a), which states:

‘(4) 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 a unregistered trade mark or other sign used in the course of trade..’

The usual reference at this point is the decision of Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] 14 RPC 455 in which he gave a summary of the law of passing off, which I will not repeat here. Essentially, the opponents need to show that at the relevant date (26th April 1996): (i) they had acquired goodwill under their mark, (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods/services; and (iii) that such confusion is likely to cause real damage to their goodwill.

My overall impression of Mr Brown’s evidence is one of disparity between the claims he makes and the evidence supporting them. However, this is not unusual in evidence presented to the Registry in passing off cases (see *Wild Child* for example). His claim that his provision of services under the name COPY CATS ‘..has become known and respected by a wide range of people’, and that his ‘..business has acquired and established a considerable goodwill in its trade marks going back to 1986..’ is, on the material before me, unconvincing. He says that the registered version of the mark:

‘..was in connection with copying and printing services, including photocopying and document reproduction services; printing and design services; consultancy on such services as well as the supply of goods bearing the printing or designs, including paper, printed matter, printed publications, leaflets, catalogues, cards, stationery, calendars, labels, pictures, posters, photographs, office requisites and other similar goods.’

There is no evidence of this. However, I am willing to accept he had a goodwill in the COPY CATS name at the relevant date for design, printing, photocopying and facsimile services. This is based on the evidence summarised above, in particular, at points 2, 7 and 8 on pages 3 and 4 above. The copies of the yellow pages from 1994/95, and 1996/1997 advertise services that include: printing services, design and art work, screen printing, colour and black and

white laser copying, T-shirt printing, facsimile services, laminating and binding. Mr Brown also claims sales of over £2.5 million under the 'cat's head' device, up to 1995, with an addition of some portion of approximately £1.8 million, that all occurred before the 26th April 1996. He also says that there was some £250,000 pa sales under the registered mark, though there is no evidence of this.

However, there is enough here for me to find a goodwill under the COPY CATS name. On the basis of my consideration of the likelihood of confusion above, I am confident that misrepresentation would also follow, for many the same services as I found previously. However, I extend this protection to design and art work as well. Mr Brown's earliest dated exhibit (Exhibit WB4), dated 15th November 1991, clearly refers to print, copy and design services, and it is clear from the yellow pages advertisements cited above that these were offered well before the relevant date.

I might add that the change in the design of the COPY CATS mark, described by Mr Brown, increases the likelihood of misrepresentation as the applicants' mark may well be viewed as another in a series from the opponent; i.e. the distinctive name remains, while the design has altered. Further, consumers are unlikely to be surprised by the purveyance of such services by the same provider, as I pointed out under s 5(2)(b) above. Also, contact may well be initiated via the telephone, which tends to increase the importance of the verbal similarity of the marks, which is identical. This result buttresses my findings under s 5(2)(b) for many of the services for which the applicants have applied. Outstanding is the issue of the goods in Class 25, and the remaining services in Class 35.

Taking the latter first, I can see no evidence of goodwill in mail shooting, publication of publicity texts, facilities management, advertising and promotions. This sort of activity seems to me to go well beyond the mere preparation of material - that might be encapsulated by design, printing and copying - to the provision a service that broadcasts and distributes such material abroad, *after* it has been prepared. There is no claim by the opponents, and certainly no evidence, that they have been engaged in such endeavours. I am aware that there is no strict requirement for a 'common field of activity' between marks for misrepresentation to occur under passing off, as was found in the *LEGO* case (see *Lego Systems Aktieselskab and another v Lego M Lemelstrich Ltd* [1983] FSR 155). However, in that instance a very famous **invented** mark was at issue, not a known word as here. Further, the opponent cannot claim to match the reputation residing in the LEGO name.

Then there is the issue of the goods in Class 25. I am not prepared to accept that the opponent had a reputation in clothing sales under his mark at the relevant date. At the Hearing Mr Goldring said:

'I said earlier on that I have not claimed class 25 and so there were not any rights in class 25 as far as the earlier rights were concerned, but again I can take you to the points in the evidence where we clearly see use in relation to printing of clothing and sale of clothing. They are not selling clothing *per se*. It is clothing which has been printed, but they do sell the finished items. You do not bring in your T-shirt and ask them to print it. It is actually clothing which is printed which they sell on. So there is the sale of clothing, as shown in the evidence.'

5 The latter point is not clear from the evidence; however, even if it were, I would hesitate to consider this activity has created for the opponent a goodwill in clothing sales. It had engendered at the relevant date, as I have found, a goodwill in T-shirt printing, but the perception that is likely to produce in consumers is very different to that that might accrue for a dealer in clothes *per se*. I do not believe that any consumer will believe that the opponent trades in clothes in that manner.

9 All this means that the application will proceed to registration, but in a somewhat decimated form, that is, the application will be allowed to progress if, within one month of the end of the appeal period for this decision, the applicants file a TM21 restricting the specification as follows:

13 Class 25: ‘Clothing, footwear, headgear’;

17 Class 35: ‘Mail shotting, publication of publicity texts, facilities management, advertising and promotions.’;

21 If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

25 At the Hearing, Ms Bruce referred to turnover by the applicants under their mark to the extent of £3 million in 1999. This is obviously well after the relevant date and, anyhow, is new evidence, which I was not prepared to consider at the Hearing. Other submissions made concerned the way the applicant uses the name (as ‘COPY CATS COPY’), and referred to use of the name COPY CATS by a number of registered companies. Again, this is new evidence and really was too little too late; it required substantiation, which, in my view, would have been unfair to the opponent to allow in to the proceedings at this advanced stage. Anyhow, on use of the name COPY CATS COPY I do not think that this would have been enough to distinguish it from that of the opponent’s use, so as to avoid misrepresentation.

33 Finally, Ms Bruce stated:

37 ‘The cat logo is particularly important to [the applicants] ... Depending on the outcome of the hearing, if it becomes evident they cannot register the words Copy Cat Copy, they would like to keep the cat logo part of the application.’

I note that Mr Goldring, on behalf of the opponent, said:

41 ‘We would not object to the logo alone. If they [the applicants] were to file an application now for the cat device, we would not object to that. We accept that other people should be allowed to have cat devices *per se*, but not with the word COPYCATS.’

45 This would require another application by the applicants. Such an application, in my view, would be unlikely, on the evidence I have seen, to be subject to the objections I have identified here, subject, of course, to the normal examination procedures.

The opponent has been partially successful and is entitled to a contribution towards his costs. I order the applicants to pay them £450. 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.

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Dated this 2nd Day of February 2001.

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**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**

ANNEX

Mark	Number	Filing date	Services
	1292719	18.11.1986	Document copying; offset printing services; dye-line services for document copying; all included in Class 35.
<p align="center">COPYCATS</p> <p align="center"><i>Copycats</i></p>	2119120	19.12.96	<p>Class 16: 'Paper, printed matter, printed publications, leaflets, brochures, catalogues, cards, stationery, calendars, labels, pictures, posters, photographs, office requisites.'</p> <p>Class 25: 'Articles of clothing, headgear, footwear.'</p> <p>Class 35: 'Photocopying and document reproduction services; data processing and word processing services; telefax transmission services; business consultancy and information services.'</p> <p>Class 40: 'Binding and laminating services.'</p> <p>Class 42: 'Printing services, design services; consultancy and information services in relation to these services.'</p>

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