

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2026302
BY TOMY UK LIMITED TO REGISTER THE
MARK LITTLE WORLD IN CLASS 28**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 44403 BY ANDONIS VIOLARIS**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2026302**
by Tomy UK Limited to register the mark
Little World in Class 28

and

10 **IN THE MATTER OF Opposition thereto**
under No 44403 by Andonis Violaris

15 **DECISION**

On 7 July 1995 Tomy UK Limited applied to register the mark LITTLE WORLD in Class 28 for a specification which after an amendment requested by the proprietor reads “Toys and playthings; but not including any such goods in the form of, or which incorporate, or which relate to globes of the world”.

The application is numbered 2026302.

25 On 16 April 1996 Mr Andonis Violaris filed notice of opposition to this application. Mr Violaris has represented himself throughout these proceedings and his statement of grounds is not presented in the form normally adopted by professional representatives but has not, so far as I am aware, been challenged by the applicants. I summarise what I understand to be Mr Violaris’ grounds of opposition as follows:-

- 30
- (i) that the mark applied for is confusingly similar to existing trade marks owned by Mr Violaris and is of such a nature as to deceive the public. This goes to Section 5(2) of the Act;
 - 35 (ii) that the mark applied for is devoid of any distinctive character. This goes to Section 3(1) of the Act;
 - (iii) that the mark is open to objection under Section 3(4);
 - 40 (iv) that registration of the mark is liable to be prevented by virtue of Mr Andonis’ copyright and design claims. This goes to Section 5(4)(b) of the Act.
 - 45 (v) Mr Andonis also refers to the goodwill established through the promotion of his cartoon character, Spinnny the Little World. I take this to be a claim that registration of the mark at issue is liable to be prevented by the law of passing off. This would go to Section 5(4)(a) of the Act.

The applicants filed a counterstatement denying the grounds raised by Mr Violaris and requesting an award of costs in their favour. Only Mr Violaris filed evidence in these proceedings. The matter came to be heard on 25 February 1998. At the hearing Mr Violaris represented himself and the applicants were represented by Mr J F Symonds of Brookes & Martin, Trade Mark Agents.

Opponents' evidence (Rule 13(3))

Mr Violaris filed a statutory declaration dated 7 November 1996. He describes himself as a self employed composer, music producer, writer and artist.

He starts by outlining his own position in relation to the proceedings and says that he has received some assistance from the Islington Legal Advice Centre. He exhibits a letter from the Centre making a number of observations in relation to the claim that the mark at issue is devoid of distinctive character. I will comment on this when I consider the individual grounds of opposition.

In an Exhibit (D) to his main declaration Mr Violaris provides a summary of the development of his activities and what he terms his pre-trading activities. For ease of reference it will be convenient to record his summary as follows:-

“June 1990

It was suggested to me by Viviane Ventura and her Partner Michael Cali, that I should write a song that could be sung by Placido Domingo and Tina Turner, and which made a connection between the Olympic Games and Environmental issues. I wrote the first draft of the song during the same month. Placido Domingo ultimately agreed to record the song, subject to contract (see letter of intent).

January 1991

I formed Gold To Green Music Limited, together with the writing partner I teamed up with for the project, so we could exploit the song's commercial potential.

Around that time, I also began to think about and begin developing spin-off marketing and merchandising ideas and concepts which could run along side the record release of the song. One of my ideas was for an Environmental Mascot; a fun type character which would also compliment my alliterative song title and slogan 'Gold to Green'. I first conceived of the name of the mascot around February or March 1991, around the time of forming an additional company called Gold To Green Enterprises Limited. I had not at that time yet thought of what 'Little Green' would look like.

Following a trip to Los Angeles by Sean MacGuire, an additional partner in Gold To Green Enterprises Limited, to discuss a potential deal with a Hollywood based entertainment company, I began sketching out ideas for 'Little Green'. I came up with the idea of a little world; a cartoon type character in the shape and configuration

of the planet earth. This was around August or September 1991. I put my drawings in a registered envelope from the post office, sealed it and posted it to myself on the 22nd November 1991 as proof of copyright. It remains unopened to date.

5 I then embarked on making plasticine models of 'Little Green' and also creating in plasticine, some new characters as friends for 'Little Green'. The property then became known as 'Little Green and Friends'. I promoted this as such, with pre-trading activities and generating good will in this respect (see enclosed details). I took out a design registration on the 18th June 1993 and was given a certificate by the
10 Patent Office on 30th December 1993 number 2031851.

The name of the character, 'Little Green' remained unaltered until around May or June 1993. I had been considering taking out a registered trade mark for the name at the same time as my design registration, but refrained from doing so as I had been
15 considering an alternative name for my character. This was partly due to my market research with children as to the suitability of the name, and also because I was finding some resistance in the entertainment industry in respect of Environmental based projects. I felt that the word 'Green' in 'Little Green', would have to change. I then devised the name of 'Spinny' for my 'little world' character because one of his special
20 characteristics is that he spins like the real world. I was to develop this concept further in the cartoon story I began to write as a Television Special and series. My cartoon character and the property as a whole from then onward became known as 'Spinny the Little World and Friends', much in the tradition as other cartoon properties, such as 'Thomas the Tank Engine' or 'Budgie the Little Helicopter' -
25 Specific names given to cartoon characters followed by a short description of what the characters are. 'Spinny' is a graphic and stylised representation of the planet earth; a globe; a sphere and more relevant to the fact, a 'Little World'.

Around January 1994 I began developing ideas I had been formulating in respect of a
30 'sword and sorcery' cartoon adventure. This was to be called 'The Magic of The Spheres'. By December 1994 I was ready to show my project to people. The first person I gave sight to of the new and developed characters and story outline was Frixos Constantine, managing director of Poseidon Films, who two years or so earlier had reviewed 'Little Green', and had expressed interest in making the cartoon
35 adventure together with 'Star War's' producer Gary Kurtz (see enclosed details). My new character designs and drawings are in an unopened registered envelope dated 18th January 1994. I also placed my story and character designs and drawings with the Writers Guild of America around the same time, registered number 089858-00.

40 I formed Magic Sphere Limited around the beginning of 1995 to promote the property and to enter into deals with any interested parties in respect of television programmes, video's, interactive video's, books, music and recordings, computer games and merchandising etc. I embarked on prolific pre-trading activities immediately. At
45 present I have some serious interest from an American company called Empire Industries (see enclosed details) which is being pursued by my American agent Jack Gordon."

The Exhibit goes on to record a number of observations on intellectual property issues arising from his activities. I bear these comments in mind in reaching my decision.

5 Returning to Mr Violaris' main declaration he provides further information on his pre-trading activities and exhibits (B) specimen letters, invoices and descriptions of goods, photographs of three dimensional models etc.

10 In response to the applicants' claims that his goodwill does not extend to the field of toys and playthings he says that he does in fact have specific goodwill in this field through his long standing association with Ms Janice Georgiou of Just Janice, an applique artist, designer and toy maker. He exhibits (C) a letter from Ms Georgiou in confirmation of this and (D) letters from various organisations (film and television companies for instance) responding to approaches made.

15 Mr Violaris goes on to give further information on his company Magic Sphere Ltd and the services and financial input to his venture received from Mr K Kyriacou (Exhibit E). He says that his outgoing costs for creating, developing and promoting his "little world" character and all the associated characters are as follows:-

| | | |
|----|-------------------------|-----------|
| 20 | 1991/1992 | £830.00 |
| | 1993 | £934.00 |
| | 1994 | £887.00 |
| | 1995 | £2,267.00 |
| | 1996/up until September | £1,167.00 |

25 The above figures do not take into account his own time.

Finally he deals with his own trade mark position including an application made in January 1996 and designs intended to support pre-trading activities.

30 That concludes my review of the evidence.

Although at the outset I framed the grounds of opposition in what I consider to be the widest possible terms in the light of the statement of case filed by Mr Violaris, submissions at the hearing concentrated on two grounds. These are Mr Violaris' claim under Section 5(4)(a) that the applicants' mark is liable to be prevented by the law of passing off and under Section 3(1)(b) that the mark is devoid of any distinctive character. I agree that these are the main issues of substance arising from the case but for the sake of completeness I will deal briefly with the other grounds. Reference is made in the evidence to Mr Violaris' own application for a trade mark. I understand that he has in fact since secured registration of a composite (word and device) mark but that this registration bears a later filing date than the application in suit. As such it cannot in my view constitute a barrier to the latter because it is not an "earlier trade mark" for the purposes of Section 5(2)(b) and within the meaning of Section 6(1). Mr Violaris refers also to copyright and design registration claims (Section 5(4)(b) refers). There can of course be no copyright in plain words as such and I do not think any ground can be made out under this head. The design registration (No 2031851)

covers various drawings showing perspective views of the Spinny character. This registration cannot form the basis for an objection to the trade mark application for the words LITTLE WORLD. A further ground under Section 3(4) of the Act was referred to in the statement of grounds but no evidence has been placed before me in support of this particular objection.

5 Accordingly the opposition on each of these grounds, that is Sections 3(4), 5(2)(b) and 5(4)(b), fails.

I turn now to the ground based on Section 5(4)(a). This Section reads as follows:-

10 “(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 -

15 (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,”

Mr Symonds referred me to Erven Warninck BV and another v J Townend & Sons (Hull) Ltd and another 1980 RPC 31 with regard to the characteristics for a valid cause of action in passing off. Lord Diplock identified the factors as being:

20 “(1) a misrepresentation (2) made by a trader in the course of his trade (3) to prospective customers of his or ultimate consumers of goods or services supplied by him (4) which is calculated to injure the business or goodwill of another trader (in the sense that it is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.”

In the same decision Lord Fraser of Tullybelton said that a plaintiff in such an action must show:

30 “(1) that his business consists of, or includes, selling in England a class of goods to which the particular trade name applies; (2) that the class of goods is clearly defined, and that in the mind of the public, or a section of the public, in England, the trade name distinguishes that class from other similar goods; (3) that because of the reputation of the goods, there is goodwill attached to the name; (4) that he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England which is of substantial value; (5) that he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendant selling goods which are falsely described by the trade name to which the goodwill is attached.”

I accept that these are the appropriate judicial tests to apply.

45 At the hearing Mr Symonds took me to a number of documents in the opponents’ evidence which, he said, showed that Mr Violaris could not satisfy the above tests. In particular my

attention was drawn to a letter of 3 June 1995 (Exhibit B) from Magic Sphere, Mr Violaris' company, to Fox Children's Network, the fourth paragraph of which reads:

5 "We have only shown our property to the ITV Network in the UK, PolyGram and
BMG Kidz, the latter of whom are very interested in the areas of video distribution,
music publishing and CD's. Our intention is to see if we can achieve a co-production
situation between British and American talent. *The Magic of the Spheres* will be an
animated feature for television and video release."

10 This letter and responses from the companies mentioned indicate, in Mr Symonds' view, that
what Mr Violaris was able to show was an intention to trade rather than evidence of actual
trade. That correspondence was of course mainly in relation to the film and television
potential of Mr Violaris' stories and characters. The letter of 3 June 1995 referred also to the
potential for character merchandising which might involve the sale of goods but it was put to
15 me that clearly no trade in toys and playthings existed at that point such as might form the
basis for an objection under Section 5(4)(a). Mr Symonds further supported his view by
reference to the letter from Janice Georgiou (Exhibit C) dated 25 October 1996 which
suggests that there had still been no actual trade in the goods at issue over a year after the
material date in these proceedings (7 July 1995). Mr Violaris, on the other hand, said that the
20 facts contained in his declaration and the Exhibits thereto were evidence of the work he had
put into the development of his concept and demonstrated his firm intentions. It takes time to
develop such projects and he considered that he had built up goodwill through his activities.

25 It is in my view clear from the evidence that Mr Violaris has put considerable effort into
developing his cartoon/animation characters and the associated stories etc. He has brought
matters to a stage where he has been able to offer the project to television and film production
companies for further development. It is, of course, no criticism of Mr Violaris that it takes
time to interest such organisations in projects of this kind. However, I think it is inescapably
the case that at the material date in these proceedings there had not been trading activity of a
30 kind which would support an opposition based on Section 5(4)(a). Indeed Mr Violaris' own
evidence refers at several points to pre-trading activities. I also bear in mind that the project
is variously referred to as "The Magic of the Spheres" and "Spinny - The Little World".

35 Whilst Mr Violaris was clearly alert to the merchandising opportunities offered by the project
there is again no identifiable trade in toys and playthings. It may be that the approaches to
film and television companies generated some awareness of Mr Violaris' activities but, given
that such companies no doubt receive approaches from many quarters, their lasting
recollection of projects not taken up must be limited. I do not, therefore, think that
Mr Violaris can claim that his pre-trading activities alone have given rise to the reputation
40 and goodwill necessary to sustain this part of his action. The opposition, therefore, fails
under Section 5(4)(a).

I go on to consider the claim that the mark applied for is devoid of any distinctive character
under Section 3(1)(b) of the Act. Exhibit A to Mr Violaris' declaration consists of a letter
45 from an adviser at the Islington Legal Advice Centre in relation to this issue. Mr Violaris
indicated that he wished to rely on the submissions contained in that letter. There was some

discussion before me as to whether the letter and its contents should form part of the evidence. I propose to take account of its accounts and to treat them as in effect written submissions in lieu of oral presentation at the hearing.

5 The substance of the submissions which Mr Violaris has asked me to take into account are that the mark LITTLE WORLD is made up of words which are in common English usage, and are descriptive and laudatory in relation to the goods. I have been referred to passages from a number of reported cases in support of this view, in particular Joseph Crosfield & Son's Application ("Perfection") 26 RPC 837 (at page 854); British Sugar plc v James
10 Robertson & Sons Ltd 1996 RPC 283 (at page 306); Fantastic Sam's Service Mark 1990 RPC 531; Colorcoat Trade Mark 1990 RPC 511 and Budget Service Mark 1991 RPC 9. I take account of these cases in reaching my decision.

I cannot see that the mark at issue is open to objection as being laudatory nor is it disqualified
15 from registration simply because it is made up of common words of the English language. It is the use of the words in relation to the goods at issue that I must consider. It is, however, quite properly argued that I must consider how registration of the mark would impinge on other traders. Mr Symonds sought to distinguish the cases relied upon from the
20 circumstances surrounding his clients' application. I think he is right to say that FANTASTIC SAM, COLORCOAT and BUDGET were decided on the basis of evidence as to practice amongst other traders or use of the words in a descriptive sense by the applicants themselves. It is submitted on behalf of Mr Violaris that other traders may wish to use the words in expressions such as "The Little World of the Mr Men", "Barbie's Little World",
25 "The Little World of the Hobbit", "Disney's Little World". If there had been evidence on this point rather than speculation as to what other traders might legitimately wish to do, the opponent's position would have been somewhat stronger. But in the absence of trade usage of the term (and I bear in mind Mr Symonds' comments on the question of burden by reference to the EUROLAMB decision 1997 RPC 279 at page 288) I cannot see that the mark is devoid of any distinctive character or one that needs to be reserved for traders at large.

30 I should say at this point that the Registry has a published practice in relation to WORLD marks. I reproduce this below for ease of reference:-

35 "The practice in respect of WORLD was reviewed under the 1938 Act and this later practice should be followed under the 1994 Act.

Therefore, the following is not acceptable, object under Section 3(1)(b):

40 WORLD plus the name of the goods eg WORLD OF COMPUTERS or COMPUTERWORLD. In this latter case, use of the word WORLD in such expressions as "In the computer world" or "In the world of computers" is a common figure of speech."

45 At the hearing Mr Symonds also referred me to Mecklermedia Corp v D C Congress Gesellschaft mbH 1997 FSR 627 where Jacob J in dealing with the words INTERNET WORLD (in relation to trade shows) said "I think here the words are to some degree

descriptive though not wholly so. "Internet World" is not so descriptive that people familiar with past trade shows under that name would not expect further "Internet World" trade shows to be run by the same people who used that name in the past". In the light of this decision the Registry has relaxed the above practice. A notice published in the Trade Marks Journal

5 (No 6186) on 30 July 1997 contains the following:

10 "... trade marks consisting of the word "WORLD" in combination with the name of, or a description of, the goods will be accepted prima facie other than in Classes 9 and 16 for publications".

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Published practices are, of course, no more than a guide to the Registry's approach on particular issues and cannot be a substitute for consideration of the facts and circumstances pertaining in individual cases. I do not regard the Registry's acceptance of LITTLE WORLD as being inconsistent with the above practices but, more importantly, there is no evidence before me to suggest that I should arrive at a different conclusion. The opposition, therefore, fails on this ground.

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Although the opposition has not been successful Mr Violaris may take some comfort from Mr Symonds' comment at the hearing that his clients had no wish to hinder his business.

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Indeed the amendment they had voluntarily made to their specification, by way of an exclusion clause, was out of consideration for Mr Violaris' concerns (his Spinny - the Little World being a cartoon character whose body consists of a globe of the world). Nevertheless the applicants are entitled to a contribution to their costs. I hereby order the opponent to pay the applicants the sum of **£435**.

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Dated this 13th day of March 1998

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M REYNOLDS
For the Registrar
the Comptroller General