

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2114979
BY FARTY PANTS LIMITED
TO REGISTER THE MARK
FARTY PANTS AND DEVICE
IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO
BY JOHN BROWN PUBLISHING LIMITED

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2114979
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5 TO REGISTER A TRADE MARK IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO
by JOHN BROWN PUBLISHING LIMITED

10 **DECISION**

BACKGROUND

15 On 7 November 1996, Fartypants Limited of 19 Regent Street, Rugby, CV21 2PE applied under the Trade Marks Act 1994 for registration of the Trade Mark FARTY PANTS and Device (reproduced below for ease of reference) in respect of the following goods in Class 5:

“Filters for sanitary use and / or flatulence odour removing filters”

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30 On the 23 July 1997 John Brown Publishing Limited of The Boathouse, Crabtree Lane, Fulham, London, SW6 6LU filed notice of opposition to the application. The grounds of opposition are in summary:

- 35 i) The goods of the applicants are in the nature of novelty goods rather than items for medical use
- ii) The opponents are the publishers of a comic magazine called VIZ, which features a character called Johnny Fartpants.
- 40 iii) The opponents also have a substantial business in merchandising based on the characters appearing in the magazine VIZ, including the character Johnny Fartpants.
- iv) The opponents have through sales of the magazine VIZ and sales of merchandising goods acquired reputation in the character Johnny Fartpants. Use of the applicants' mark is likely to deceive or cause confusion.
- 45 v) The general public may be confused into thinking that the applicants' products are licensed by the opponents as part of its merchandising activities, and so offend against Section 5(4).

vi) The opponents own the copyright in the image of the character Johnny Fartpants which appears in the magazine VIZ. The applicants' depiction of a character in its trade mark is a substantial copy of the Johnny Fartpants character and therefore offends against Section 5(4)(b).

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The applicants filed a counterstatement denying all the grounds of opposition. Both sides asked for costs. Neither party wished to be heard in this matter. My decision will therefore be based on the pleadings and the evidence filed.

10 **OPPONENTS' EVIDENCE**

This takes the form of a statutory declaration, dated 27 February 1998, by Thomas James Gleeson the financial director of John Brown Publishing Ltd, a position he has held for two years.

15 The opponents are the publishers of a satirical comic magazine called VIZ. This magazine was first published in 1979, and Mr Gleeson claims that in March 1990 the magazine was fifth in terms of circulation in the IPC List of Top 100 Magazines. Mr Gleeson states that an article in "The Times" dated 5 March 1991 stated that "VIZ is now read by 2 out of 3 men between the ages of 18 and 35".

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Mr Gleeson provides circulation figures for the magazine which are based on the average figures for each issue of the magazine published during the year period.

Year	Circulation
1985	4,000
1986	12,000
1987	30,000
1988	309,084
1989	923,015
1990	1,128,151
1991	980,411
1992	875,408
1993	733,707
1994	571,295
1995	505,865

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Mr Gleeson states that "consistently in the magazine produced in the magazine sold since 1995 there has been a comic strip entitled 'Johnny Fartpants'." Copies of Johnny Fartpants comic strips from several magazines are provided at exhibit TG2. Dates from 1984 to 1996 have been handwritten in the top left hand corner of the exhibits. This would suggest that prior to 1995 the

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comic strip appeared infrequently in the magazine.

5 Following the considerable success of the magazine Mr Gleeson states that the opponents decided to enter into character merchandising and have sold items via the magazine. At exhibit TG3 are copies of advertisements which appeared in the magazine offering T-shirts, boxer shorts and mugs all bearing the Johnny Fartpants image and name. In addition the opponents have granted licences to other companies who produce merchandising. Characters, including the Johnny Fartpants character, have been licensed for use on goods such as computer games, slot machines, videos, 10 Easter eggs, greetings cards, clothing and records.

15 Mr Gleeson states that “the character appearing in the Viz magazine was first licensed for clothing in 1988 and has been used for clothing since 1988”. Separate figures for clothing bearing the name Johnny Fartpants are not available, but the turnover for clothing for all characters has been provided:

Year	Turnover £
1990	460,542
1991	400,781
1992	186,237
1993	117,717

20 Mr Gleeson points out that the clothing includes T-shirts which cost around £8. He states that the opponents have spent approx. £60,000 per annum advertising the range of clothing sold by the company, and have also advertised in their own magazine. 25

Mr Gleeson provides details of other licences granted for products, which feature amongst others the character Johnny Fartpants, and the resulting royalties paid:

Name of Licensee	Product	Date License granted	Royalties paid to date £
Virgin Games Ltd	Computer game	1991	85,000
Barcrest	fruit machines	1992	31,000
Athena (subsequently taken over by Cartel International)	posters, calendars, greetings cards and postcards	1990	25,000
Downplace	mugs	1991	11,000

30 Mr Gleeson states that the opponents have refused to grant licences on a number of occasions because of problems of quality. The opponents he claims are “keen to ensure that the characters appearing in the magazine only appear on goods of a quality which is acceptable to the company”. 35

5 He goes on to claim that the magazine, and the characters which appear in it, have achieved a high profile and have become associated with a range of merchandising products. It is Mr Gleeson's belief that the general public would assume that the applicants' product was licensed by the opponents as part of their merchandising programme. In Mr Gleeson's view the applicants' product is a novelty product targeted at the purchasing public who enjoy the bawdy humour of the VIZ magazine.

10 Further, Mr Gleeson states that the public would associate the applicants' product with the opponents as the name used, FARTY PANTS, is similar to the name of the magazine character, Johnny Fartpants, and also as the representation of the man with his trousers dropped appearing in the applicants' trade mark is similar in character, style and overall impression to the Johnny Fartpants character.

15 APPLICANTS' EVIDENCE

This takes the form of a statutory declaration, dated 2 June 1998, by Thomas John Costello the Managing Director of Fartypants Ltd, a position he has held since the company's inception in 1995.

20 Mr Costello claims that the applicants have a reputation in the market as their product has been the subject of considerable media attention since the patented invention was launched. He provides the names of TV and radio shows, national newspapers and magazines that featured the product. Further, he claims that regional radio and newspapers also covered the story. Mr Costello states that the applicants have placed advertisements in "many magazines and newspapers including Private Eye and Punch. Viz was considered for advertising but was rejected as it was considered that its readers did not fit the profile for our product, the profile being mainly older readers".

30 Mr Costello states that "a notable successful outlet for our mail order campaign has been GUT REACTION the magazine for sufferers of irritable bowel syndrome. Since starting trading the company Fartypants Ltd have sold in excess of 10,000 fart filters. Not one customer has ever indicated confusion that Fartypants Ltd might be licensed by Viz."

35 With regard to the opponents' evidence Mr Costello points out that the evidence is concerned with Viz magazine, but the name Viz is not a registered trade mark. Also that the magazine makes reference to "thousands of different characters" and all merchandising and licensing has been under the Viz name.

40 Mr Costello also refers to the points raised in his counterstatement which stated that the product, fart filter, is protected under patent number 2308303, and that Fartypants Ltd is the recognised patent licensee. Finally, that the character in the applicants' trade mark was designed by an independent graphic designer.

45 That concludes my review of the evidence. I now turn to the decision.

DECISION

The opposition is based on Section 5(4) (a) & (b) which states:

5 “5. (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 an unregistered trade mark or other sign used in the course of trade, or

10 (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

15 A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

20 I shall first consider Section 5(4)(a). In deciding whether the mark in question “FARTY PANTS and DEVICE” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

25 “The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

30 A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

35 ‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

40 (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

 (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

45 (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

5 *The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of “passing off”, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’*

10 *“ Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:*

15 *To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:*

20 *(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and*

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

25 *While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.*

30 *In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:*

(a) the nature and extent of the reputation relied upon;

35 *(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;*

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

40 *(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.*

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

45 With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision.

The opponents claim to have a reputation in the market such that any consumer who saw the FARTY PANTS product would assume that it came from the opponents. However, apart from this assertion there is little evidence of such a reputation. The opponents have provided sales figures for the magazine Viz and have stated that in 1990 their magazine was 5th in terms of circulation in the UK with a circulation figure of 1.2 million copies. I note that the last circulation figures provided are for the year 1995 and show that circulation had fallen to just over 500,000 copies. The opponents also claim to spend £60,000 annually in advertising for the magazine. They have also provided figures for the sales of merchandising and royalty fees. All of this evidence shows clearly that the opponents enjoy a reputation in their magazine VIZ. There is some evidence that, at the relevant date, readers of Viz magazine would have recognised the name Johnny Fartpants as a character from the magazine. However, there is no evidence that the public regarded the name as a sign which identified the trade origin of goods bearing that name and character. The opponents seem to suggest that as he is one of the characters in the magazine that, axiomatically, the reputation of VIZ is conferred onto each and every character portrayed in the magazine.

In case I am found to be wrong about this I will go on and consider similarity of signs and other relevant circumstances. The opponents contend that the applicants' product is a "novelty product targeted at the purchasing public who enjoy the bawdy humour of the VIZ magazine". The applicants have shown that their product is purchased by sufferers of Irritable Bowel Syndrome and so is not simply a novelty product, although clearly it has this appeal as well.

The opponents claim that the applicants' trade mark and their magazine character "Johnny Fartpants" are so similar that the public will assume that the applicants have been licensed by the opponents. I must therefore compare the applicants' trade mark to the magazine character. For ease of reference both are reproduced below:



As can be seen the magazine character is clearly a young boy wearing short trousers and with a clown like face in that the nose is large and the eyebrows exaggerated and finally a very distinctive star pattern hairstyle residing on the very top of his head. In contrast, the applicants' trade mark shows an adult male wearing a collar and tie, albeit with his trousers round his ankles. The character has a normal face apart from an elongated nose, a full head of hair and what seems to be a quiff. Regarding the names "Johnny Fartpants" and FARTY PANTS, clearly there are

5 similarities in that both contain a reference to the words “fart” and “pants”. However, the
opponents use in their magazine clearly is a reference to a character, whilst the applicants’ use
implies a condition rather than relating to the character shown as part of its mark. Additionally,
there is no evidence that the opponents have used or licensed use of their Johnny Fartpants
10 character on the goods applied for or on any goods that might be considered similar. In my
opinion the marks are not sufficiently similar that use of the applicants’ mark, on the goods
applied for, would give rise to confusion by the public.

10 The opposition under Section 5(4)(a) therefore fails.

15 I now turn to the other ground of opposition under Section 5(4)(b). This relates to the law of
copyright. The opponents have not filed any evidence that they own the copyright in relation to
the character of Johnny Fartpants, which I would have expected as it forms one of their two
grounds for opposition. The applicants have denied that their trade mark resembles the magazine
20 character and have stated that they commissioned a graphic designer to produce the mark in
question. Earlier in this decision I have decided that the two marks are sufficiently different that
there is no likelihood of confusion between the two characters. The applicants’ character cannot
be regarded as a copy of the opponents. The opposition under Section 5(4)(b) therefore fails.

20 The opposition having failed, the applicants are entitled to a contribution towards their costs. I
order the opponents to pay to the applicants the sum of £535.

Dated this 3 Day of March 1999

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30 George W Salthouse
For the Registrar
The Comptroller General