

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2181668B  
BY SARAH SPENCER LIMITED**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50830  
BY PAP STAR VERTREIBSGESELLSCHAFT MBH CO KG**

**TRADE MARKS ACT 1994**  
**IN THE MATTER of Application No 2181668B**  
**by Sarah Spencer Limited**

**and**

**IN THE MATTER OF Opposition thereto under No 50830**  
**by Pap Star Vertriebsgesellschaft mbH Co KG**

**Background**

1. On 10 November 1998, Sarah Spencer Limited applied under the Trade Marks Act 1994 to register a series of two trade marks. The application was given the number 2181668. The applicants applied to divide the trade mark application and that in suit here, proceeded under the number 2181668B for the trade mark PUPSTER. The specification of goods reads as follows:

Class 03:

Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 06:

Bells for animals; bins; cash boxes; bronzes; dog chains; door bells; door handles and door knockers; door fittings; hooks; identity plates; keys and key rings; plaques and plates; money boxes; padlocks; boxes; statues and statuettes; tool boxes; tree protectors; all wholly or principally of metal.

Class 09:

Electric, photographic, cinematographic or optical apparatus and instruments; apparatus for recording, transmitting or reproducing sound or images; data carriers; computer software; computer software relating to animals and pets; computer games; sunglasses and spectacles; parts and fittings for all the aforesaid goods.

Class 16:

Paper, cardboard and goods made from these materials; printed matter; stationery; adhesives; artists materials; instructional and teaching material; playing cards; plastic bags.

Class 18:

Goods made of leather and imitations of leather; trunks and travelling bags; bags, backpacks and cases; collars for animals; dog and cat collars; umbrellas and parasols; parts and fittings for all the aforesaid.

Class 20:

Furniture, mirrors and picture frames; sleeping bags; bedding; bedding for animals; bins; boxes; toy chests; chests; kennels; door fittings; drinking straws; figurines; nesting boxes; trays and trolleys; wall plaques; wind chimes; parts and fittings for all the aforesaid.

Class 21:

Household or kitchen utensils and containers; brushes; glassware, porcelain and earthenware.

Class 24:

Textiles and textile piece goods; bed and table covers.

Class 25:

Clothing, footwear and headgear.

Class 26:

Badges and buttons.

Class 28:

Toys, games and playthings; gymnastic and sporting articles; decorations for Christmas trees.

Class 31:

Foodstuffs for animals; animal litter; edible chews for animals; dog biscuits; beverages for pets; pet food; animal litter; litter peat; yeast, protein and supplements for animals; stall food for animals.

Class 32:

Non-alcoholic drinks; syrups and other preparations for making beverages.

2. The application was accepted and published. On 17 March 2000, Pap Star Vertriebsgesellschaft mbH Co KG filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition set out two grounds of opposition, these can be summarised as follows:

- (a) under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application is similar to the opponents' earlier trade marks PAPSTAR and PAPSTAR and device details of which are shown in an Annex

to this decision and, in so far as the application covers goods in classes 16, 21, 24, 25 and 28, covers goods identical or similar to the goods for which the earlier trade marks are protected;

- (b) under section 5(4)(a) having regard to the opponents' goodwill and reputation in the earlier trade marks, the application is liable to be prevented by the law of passing off in so far as the applicant seeks protection for goods falling in classes 16, 21, 24, 25 and 28.

3. The applicants filed a counterstatement denying the grounds of opposition and admitting that certain of the goods under opposition were identical or similar to those for which the earlier trade marks are registered. In respect of other goods under opposition, the applicants make no such admission. I will set out the position of the two parties in more detail later in my decision but it should be noted that no objection is taken to the goods falling in classes; 3, 6, 9, 18, 20, 31, or 32. Both sides seek an award of costs and both parties filed evidence in the proceedings.

4. After reading the pleadings and the evidence I asked for the Office to issue a letter indicating that I was of the view that an oral hearing was not required in these proceedings. The parties were given a period of time within which to request a hearing or to file written submissions. Only the applicants filed written submissions and these were received with their letter of 16 October. Therefore, in reaching a decision on this case I take careful note of the pleadings, evidence and the applicants' written submissions and give this decision.

#### Evidence

5. As noted above, both parties filed evidence in the proceedings. The opponents' evidence consists of a declaration of Mr Wolfgang Kupper dated 23 February 2001. Mr Kupper is the Marketing Director of Pap Star Vertriebsgesellschaft mbH. The applicants' evidence consists of a witness statement by Sarah Spencer dated 23 May 2001. Ms Spencer is a Director of Sarah Spencer Limited. The opponents' evidence in reply consists of a witness statement of Nicola Brasier, dated 22 August 2001. Ms Brasier is a registered trade mark attorney with Mathisen, Macara & Co, the opponents' representatives in this matter.

6. I need not set out the evidence in full. Much of it relates to events after the relevant date in these proceedings, 10 November 1998. By way of background, I note that the opponents, I will refer to them as Pap Star, are a company producing a range of products. An undated product catalogue at Exhibit A, lists, products including; napkins, candles, table cloth on roll, household foils, sandwich paper, aluminium dishes, pan sponges, tableware made of melamin, and sanitary articles such as toilet paper, paper towels and handkerchiefs. In addition, the catalogue lists gift wrapping paper and ribbons, party tableware, snack plates, doilies, flower rings and other party decorations. Although that catalogue is undated, there are other catalogues at exhibit A covering the period 1998 -2000. These seem to be catalogues for a specific range of products, eg "Table Decoration 2000" and "Christmas Assortment 2000" but taking them all together, they cover a similar range of products as that listed above. Of course, to be relevant to the question before me, under section 5(2), the opponents must show that as at the relevant date, they enjoyed an enhanced level of recognition amongst the

relevant public. In so far as they rely on the provisions of section 5(4)(a) it will be necessary to consider whether they have established the necessary goodwill and reputation.

7. Mr Kupper in his evidence states that the first use of the trade marks PAPSTAR and PAP STAR and device in the United Kingdom occurred in 1996. He gives a list of products on which he says the trade marks have been used. These he states, have been sold throughout the United Kingdom. At exhibit B he gives a list of retailers to whom products bearing the two trade marks have been supplied. Mr Kupper gives annual sales figures in deutschemarks under the two trade marks in the United Kingdom for the period 1996 - 2000. Those for 1996-98 are:

1996	1,452,650.22
1997	2,995,405.50
1998	2,939,621.19

8. Mr Kupper says that between 1996 - 2000, his company spent not less than DM 75,000 per annum on advertising and promoting products bearing the two trade marks in the United Kingdom. In addition, products bearing the two trade marks were exhibited at the Grocer INFF (International Non Food Fair) in London in 1997 and 1998.

9. In 1997, the applicants started selling a range of SNOOZZZEE DOG pet bedding and related products. From the evidence, it seems that the idea for these products came from a Ms Sarah Spencer. The original products were made in her kitchen and garage but the company grew quickly. In an undated article in the applicants' evidence, the applicants are listed in an advertising supplement in Pet Product Marketing. The supplement is headed "Market Leaders - a focus on some of the top brands in the UK pet industry". The applicants are listed alongside other companies such as Friskies Pet Care and Spiller Speciality Feeds. The article on the applicants states:

"In just three years, Sarah Spencer's SNOOZZZEE Dog, manufacturers of premium quality co-ordinated pet bedding, has built a brand which has shaken up the pet accessory market in the UK, Europe and Japan...."

10. That said, this and most of the applicants' evidence relates to the use of a trade mark SNOOZZZEE DOG. Ms Spencer in her evidence states that the trade mark PUPSTER was developed in Autumn 1998 as a companion to SNOOZZZEE DOG. There are examples of the name PUPSTER used in relation to a toy dog in the evidence. The catalogues at exhibit SS1 are dated 2000-2001 and 2001; such use is after the relevant date. There is a statement from Ms Spencer that they currently offer and have historically offered a range of products under the PUPSTER trade mark. There are no turnover figures given and no supporting evidence of use before the relevant date. Given that Ms Spencer states that the trade mark was developed in Autumn 1998 and the application was filed in November 1998 this is perhaps not surprising.

11. Ms Spencer includes a letter from one of her customers, a Paul Mason, Category Manager - Petworld who states that he has not heard of the trade mark PAP STAR. Given my summary of the two companies set out above, and their current areas of trade, the fact that the

Category Manager of Petworld has not heard of PAP STAR is not surprising. In any event, Mr Mason is merely one member of the public and this letter is of no assistance to me.

12. That concludes my review of the evidence.

### **Decision**

13. The grounds of opposition refer to sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

“5.- (1) .....

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

(3).....

(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
- (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.

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.

14. The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,”

15. I will deal first with the opponents’ ground of opposition under section 5(2)(b). In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, 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* page 224;
- (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* page 224;
- (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* page 132, 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* page 8, 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* page 224;
- (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* page 732, 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* page 133 paragraph 29.

16. Under section 5(2), the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind I proceed to consider the opponents' case under section 5(2)(b).

17. The opponents' have five earlier trade marks within the definition of section 6 of the Act, these are set out in an Annex to this decision. They comprise, two United Kingdom registrations for the trade mark PAPERSTAR. These cover goods in classes 16 and 21. The opponents also rely on three Community Trade Marks (CTMs). The first is for the trade mark PAPERSTAR, CTM 572818, in various classes. The other two are for the trade mark PAPERSTAR and device, the goods covered by these two registrations are the same as those in CTM 572818. It seems to me that the opponents' best case falls to be determined by reference to their CTM 572818 for the trade mark PAPERSTAR. It is the closest visually to the applicants' mark, covers a range of goods and in my view represents the opponents' best case. However, I will also assess the question under section 5(2)(b) by reference to their UK registrations and other Community Trade Marks where I see them to be in a better position. The applicants' mark and opponents' CTM mark 572818 are reproduced below. I have only listed those of the applicants' goods under opposition.

Applicants' trade mark

Opponents' trade mark

**PAPERSTAR**

**PAPERSTAR**

Class 4:

Candles, wax candles

Class 8

Knives, forks, spoons of wood and plastic

Class 16:

Paper, cardboard and goods made from these materials; printed matter; stationery; adhesives; artists materials; instructional and teaching material; playing cards; plastic bags.

Class 16:

Paper, cardboard and fleece goods (as far as contained in class 16), gift paper, baking paper, wrapping paper, napkins, table-cloths, lace papers for pastry and as table decoration, toilet paper, kitchen paper, towel paper, garlands, streamers, confetti, fans, wreaths, crepe paper for decorating and doing handicrafts, Chinese lanterns - also as party decoration; wrappings of paper, cardboard, plastics and aluminium, particularly in form of paperbags, foils,

bags, sacks - also in form of waste bags and waste sacks -, receptacles and other coverings; office supplies, particularly tracing paper.

Class 20:

Drinking straws of plastics.

Class 21:

Household or kitchen utensils and containers; brushes; glassware, porcelain and earthenware.

Class 21

Cleaning utensils, particularly cleaning sponges, cleaning cushions; candles sticks of metal and glass; toothpicks, pickers, cocktail stirrers, single-use dishes of paper, cardboard, plastics and aluminium.

Class 24:

Textiles and textile piece goods; bed and table covers.

Class 25:

Clothing, footwear and headgear.

Class 25:

Hygienic clothes for handling foodstuffs and for hospitals of paper, fleece and plastics.

Class 26:

Artificial flowers, candle garlands for purposes of ornaments and decoration.

Class 28:

Toys, games and playthings; gymnastic and sporting articles; decorations for Christmas trees.

Class 28:

Christmas-tree decoration, including candle-sticks; toys, balloons.

#### Inherent Distinctiveness/Reputation of the Opponents' Earlier Trade Marks

18. The opponents trade mark PAPSTAR appears to be an invented word. As such, it is inherently distinctive for the goods covered by the opponents' earlier registrations. The same is true of the opponents' other marks both of which I would describe as PAP STAR and device. The case law set out above, indicates that 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. In my view, the opponents' trade marks are distinctive per se

but I will consider whether, on the basis of the evidence before me, the opponents' trade marks also enjoyed an enhanced level of recognition at the relevant date.

19. The first point to note is that all the catalogues and exhibits showing use of the mark are either undated or dated after the relevant date in these proceedings. All I have in support of a claim to use before the relevant date is a statement by Mr Kupper to the effect that his company started selling products under the trade marks in the United Kingdom in 1996. Turnover figures for 1996 - 2000 are provided in Deutschemarks. The applicants' in their written submissions point to this and provide figures converted into pounds sterling. I too have converted these figures to pounds sterling and arrived at the following figures (these figures were obtained using Oanda.com FX converter based on the exchange rate at 31 December each year):

1996	£551 395
1997	£1 010 084
1998	£1 057 037

20. The opponents' evidence does not provide me with supporting evidence detailing the extent and nature of the trade leading up to the relevant date. The opponents' catalogues produced after the relevant date show a large range of products. It is not clear whether all these goods were available before the relevant date and even if they were, I am given no indication as to the level of market penetration the turnover figures given represent.

21. As such, I am reluctant to infer too much into the opponents' evidence and decline to find that they enjoyed an enhanced level of recognition at the relevant date. That said, as noted above, the opponents' marks are inherently distinctive and I will take this factor into account in reaching my decision.

#### Identity/Similarity of Goods

22. The applicants seek registration for various goods but only those falling within classes 16, 21, 24, 25, and 28 are opposed. Which if any, of the goods falling within these classes are similar or identical to the goods covered by the opponents' earlier trade marks?

23. As noted above, the likelihood of confusion must be assessed globally. In *Canon*, the ECJ indicated that this implied some interdependence between the relevant factors. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks (and vice versa); *Canon* paragraph 17, page 132.

24. That said, it has been recognised by the ECJ that section 5(2), (Article 4(1)(b) of the Directive) requires that the goods/services are similar. In particular in *Canon* at paragraph 22 the court stated:

“22. It is however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which

the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

25. Mr Hobbs Q.C., sitting as the Appointed Person in *Raleigh International* [2001] R.P.C. 11 has stated:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

26. In order to assess the similarity of the goods, I note the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- (a) the uses of the respective goods or services;
- (b) the users of the respective goods or services;
- (c) the physical nature of the goods or services;
- (d) the trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same of different sectors.

27. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgment, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

28. In these proceedings, the statement of grounds filed by the opponents sets out those goods which they consider to be identical and those they considered similar to the goods for which their trade marks are registered. The applicants in their counter-statement made certain admissions as to goods which they acknowledged were either identical or similar to the opponents’ goods. I will look at each class in turn and consider the opponents’ claim and any admissions made by the applicants.

Class 16

29. The applicants’ specification covers ‘paper, cardboard and goods made from these materials; printed matter; adhesives; artists materials; instructional and teaching material; playing cards; plastic bags’. In their counter-statement, the applicants admit that ‘paper, cardboard and goods made from these materials; stationery; adhesives; and plastic bags are all

similar or identical to goods for which the opponents' earlier trade marks are protected. I agree.

30. The opponents' UK registration 993053 for the trade mark PAPSTAR covers "Cardboard and articles made from cardboard and like pulp-based materials, all included in Class 16; paper serviettes". Their CTM 572818, set out above, covers 'paper, cardboard and fleece goods' These are identical to the goods "paper, cardboard and goods made from these materials." appearing in the applicants' specification.

31. The term 'plastic bags' in the applicants' specification would seem to me to be identical or very similar to the terms 'wrappings of paper, cardboard, plastic and aluminium, particularly in the form of paperbags, foils, bags, sacks - also of waste bags and waste sacks'.

32. Several of the terms within the opponents' specification will also be identical or similar to the following goods; 'stationery; adhesives;', for example, 'paper, cardboard and fleece goods' is so far as they cover stationery. The opponents' specification also covers 'office supplies' which could include stationery and adhesives.

33. The applicants contend that the remaining goods within the specification are not identical or similar. These are 'printed matter; artists materials; instructional and teaching material; playing cards.' Let us consider each in turn.

34. 'printed matter' - is a broad term and some of the goods falling within this term, such as goods of paper, cardboard & fleece will be covered by terms in the opponents' specification. The same is true of playing cards in class 16 in the applicants' specification. 'Artists materials' - it seems to me that terms such as 'crepe paper for decorating and doing handicrafts', would fall within the term artists materials. Further, in so far as the term artists materials covers goods of 'paper, cardboard and fleece' then the goods are identical to those within the opponents' specification. Finally, the application covers 'instructional and teaching material', in so far as such goods are covered by goods in the opponents, specification then again, the goods will be identical or similar.

35. Thus, some of the applicants' goods in class 16 will be identical to the goods falling within the opponents' specifications others will be similar.

#### Class 21

36. The applicants' in their counter-statement admit that the goods of the application 'Household or kitchen utensils' are identical or similar to the goods covered by the opponents' registration 1001338 and that the goods 'household containers' are identical or similar to the goods covered by CTM 572818. I would agree. Further it seems to me that 'brushes' in the applicants specification are similar to 'cleaning utensils' appearing in the opponents' specification.

37. The applicants' specification also covers 'glassware, porcelain and earthenware'. In so far as these could cover candle sticks of glass then the goods are identical to those covered by the opponents' specification. Those terms will also cover household and kitchen utensils or containers made from glassware, porcelain and earthenware and again the goods here will be

identical or similar. However, there will be other goods falling within this class which will not be identical or similar.

#### Class 24

38. The application covers 'textiles and textile piece goods; bed and table covers'. The opponents do not have a registration in class 24. However, their registration in 16 covers table-cloths. There will in my view be some similarity between a table-cloth made of paper, or like material falling in class 16 and a table cloth made of fabric falling within class 24. The uses, potential users of the goods and purpose would be the same, although physically one would be made of paper and the other textile. They would not be in competition with each other, a paper tablecloth is usually used for a special occasion such as a party, but they would be complementary. The same would be true of products such as napkins. This term is found in the opponents' specification in class 16. If the napkin was made of linen it would fall within the terms textiles and textile piece goods' in class 24.

39. However, in so far as the applicants' specification covers other textile goods in class 24 such as curtains, beddings etc there would in my view be no similarity with the goods covered by the opponents' specifications. The uses, users, physical nature and trade channels are all different. As there is no similarity in relation to textile goods none being table cloths or napkins, the provisions of section 5(2)(b) do not apply to those goods.

#### Class 25

40. The applicants' specification covers 'clothing, footwear and headgear'. The applicants in their counter-statement admit that these goods are identical or similar to the goods covered by the opponents' specification. The opponents' specification in class 25 covers, 'Hygienic clothes for handling foodstuffs and for hospitals of paper, fleece and plastics.' The applicants' specification is a broad one and would include the goods for which the earlier mark is registered. As such, the application is to some extent, for identical goods. However, the type of product covered by the opponents' specification seems to me to be a relatively specialised product, whilst the applicants' specification will cover many other types of clothing. The uses, users, physical nature and trade channels of the opponents' products would seem to be specialised and different from the users, uses, physical nature and trade channels of clothing per se. As such, whilst I find that the applicants' specification as worded in the application does include goods identical to those for which the earlier mark is protected, it seems to me that if those goods are excluded from the applicants' specification then the remaining goods will not be identical or similar and the provisions of section 5(2)(b) will not apply to those goods.

#### Class 28

41. Both the application and the opponents' earlier CTM cover 'toys and decorations for Christmas trees'. The goods are therefore identical. The application also covers games and playthings, these in my view are similar to the term 'toys' in the opponents' specification. The application also covers gymnastic and sporting articles. There will be some cross-over between these goods and those falling within the term 'toys' as such there is some similarity between the goods.

## Comparison of the Trade Marks

42. I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their distinctive and dominant components. The question must be assessed through the eyes of the average consumer taking into account the fact that the average consumer rarely has an opportunity to make a direct comparison between the trade marks; so called imperfect recollection.

43. Visually, the opponents' earlier trade mark is PAPSTAR, the applicants' is PUPSTER. There is some visual similarity between the two trade marks. Both are seven letter in length and the letters P PST R appear in the same order in both trade marks. The visual differences occur in the second and sixth letters which are vowels. I note that the opponents' trade mark starts with the letters PAP, whilst the applicants' starts with the letters PUP. Taken in isolation, the letters A and U appearing in these elements would seem to enable the average consumer to differentiate between the two elements. However, the second elements are, STAR and STER, these elements also differ in only one letter but it seems to me that there is greater visual similarity between these two elements. The marks must be assessed as a whole with regard to their overall impression, as such, it seems to me that there is some visual similarity between the two trade marks.

44. Aurally the two marks are again PAPSTAR and PUPSTER. It seems to me that the average consumer would split the opponents' trade mark into two syllables, PAP STAR. The applicants' trade mark also falls naturally into two syllables PUP STER. Whilst I agree with the applicants' submission that the first element in the opponents' mark has a harder sound to the ear than that of the applicants, the overall impression that both marks make to the ear is in my view similar.

45. In considering the question of aural similarity, I also take into account the tendency of consumers to slur the ending of their words. This was well established under the old law and I see no reason why this consideration should not be taken into account under the Trade Marks Act 1994. It seems to me that the ending of the applicants' mark may become slurred. In oral use the mark might be pronounced PUPSTA. Applying the same principle to the opponents' mark, there may be a tendency to slur the ending so that the trade mark is pronounced PAPSTA as compared to the applicants' mark PUPSTA.

46. Conceptually, the opponents' trade mark appears to be a made up word. It contains the element STAR but in a meaningless context. The applicants' trade mark also appears to be meaningless in relation to the goods for which registration is sought. Taking into account the manner in which the mark has been used by the applicants, albeit after the relevant date, I agree with the applicants' submission, that the average consumer would see the mark as a reference to a puppy. As such, there is no conceptual similarity between the marks

47. To conclude on this point, I reach the view that there is some aural and visual similarity between the marks but, conceptually there is no similarity.

## Conclusions under section 5(2)(b)

48. Together with my finding in relation to the inherent distinctiveness of the opponents' mark, how do my findings in respect of the similarities of the marks and the similarities of the goods and services come together under section 5(2)(b). As noted above, the ECJ has stated that a lesser degree of similarity between the goods or services can be offset by a greater degree of similarity between the marks (or visa versa).

49. Mr Hobbs, Q.C., sitting as the Appointed Person *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, he found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows:

Are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the "earlier trade mark", PAPSTAR and the sign subsequently presented for registration, PUPSTER, were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?

50. Having considered the various factors, I reach the view that this question must be answered in the affirmative in so far as the applicants seek registration for goods that are identical or similar to those for which the opponents' trade marks are registered. In so finding, I have taken account of the distinctiveness of the opponents' mark, the fact that the applicants seek protection for goods which are identical or similar to those for which the opponents' marks are protected. I have also taken note of the fact that many of the goods for which registration is sought are every day low costs items to which the average consumer may not pay great attention when purchasing.

51. In considering the visual, aural and conceptual aspects of both marks, I concluded that whilst there was no conceptual similarity, there was some visual and aural similarity. I reach the view that taking into account the visual similarity, a likelihood of confusion would exist if the mark the subject of the application were used in relation to those goods that I have identified as identical or similar to those for which the earlier marks are protected. The visual similarities in the marks, are in my view sufficient for me to reach such a conclusion. That conclusion is only strengthened if, as I must, I take into account the fact that the average consumer is unlikely to see the two marks side by side but instead must rely on imperfect recollection. In my view, there is even greater aural similarity between the two marks and as such, a likelihood of confusion exists in oral use. However, I have not taken this factor into account in reaching my decision under section 5(2)(b) as it seems to me, taking into account the goods for which registration is sought, that visual recognition would be the primary means of selection and oral use would not play a prominent role. To the extent that I am wrong in that conclusion then my findings under section 5(2)(b) can in my view only be strengthened when considering the likelihood of aural confusion.

52. I will deal with the effect of my decision under section 5(2)(b) after considering the opponents' other ground of opposition.

### Section 5(4)(a)

53. The opponents also seek to rely on the ground of objection under section 5(4)(a) of the Trade Marks Act 1994. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

54. Under section 5(2)(b), I considered whether the use shown of the opponents' trade mark entitled them to an enhanced level of recognition. I found that their evidence was insufficient for me to find or infer such a recognition. Under section 5(4)(a) I must consider whether the opponents' trade mark has acquired a goodwill or reputation in the United Kingdom as at the relevant date. Whilst the test for establishing a goodwill under section 5(4)(a) is not necessarily the same as that under section 5(2)(b), it seems to me that in considering the question under section 5(4)(a), the opponents' evidence suffers from the same defects that I identified above.

55. The catalogues and exhibits showing use of the mark are undated or after the relevant date in these proceedings. All I have in support of a claim to use is the previously mentioned statement by Mr Kupper to the effect that his company started selling products under the trade marks in the United Kingdom in 1996 and the turnover figures for 1996 - 2000 provided in Deutschemarks.

56. That evidence does not provide me with details of the extent and nature of the trade leading up to the relevant date. The opponents' catalogues produced after the relevant date show a very large range of diverse products and I am given no indication as to the level of market penetration the figures given represent. There are many questions left unanswered by this evidence, for example; Was use made across all the goods and what was the level of use?

57. As such, I find that the evidence filed by the opponents in this case is insufficient for me to find that at the relevant date they enjoyed the necessary goodwill or reputation on which to base a claim under section 5(4)(a). As such, their case under section 5(4)(a) falls to be dismissed.

## Conclusions

58. I have found that the opponents' grounds of objection under section 5(2)(b) has been made out in so far as the application covers goods identical or similar to those for which the earlier marks are protected. The opposition was made in respect of classes; 16, 21, 24, 25, and 28.

59. Therefore, the application stands refused in respect of the following classes; class 16 and class 28. In so far as the application covers goods in classes 21, 24 and 25, I found that only some of the goods covered in the specification were identical or similar, as such, the opposition to the goods in these classes has succeeded only in part. **The applicants have one month from the end of the appeal period within which to file Form TM21 restricting the specification of goods in classes 21, 24 and 25 as follows and removing classes 16 and 28 from the application; so that the trade mark can proceed to registration for the following specification:**

Class 03:

Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 06:

Bells for animals; bins; cash boxes; bronzes; dog chains; door bells; door handles and door knockers; door fittings; hooks; identity plates; keys and key rings; plaques and plates; money boxes; padlocks; boxes; statues and statuettes; tool boxes; tree protectors; all wholly or principally of metal.

Class 09:

Electric, photographic, cinematographic or optical apparatus and instruments; apparatus for recording, transmitting or reproducing sound or images; data carriers; computer software; computer software relating to animals and pets; computer games; sunglasses and spectacles; parts and fittings for all the aforesaid goods.

Class 18:

Goods made of leather and imitations of leather; trunks and travelling bags; bags, backpacks and cases; collars for animals; dog and cat collars; umbrellas and parasols; parts and fittings for all the aforesaid.

Class 20:

Furniture, mirrors and picture frames; sleeping bags; bedding; bedding for animals; bins; boxes; toy chests; chests; kennels; door fittings; drinking straws; figurines; nesting boxes; trays and trolleys; wall plaques; wind chimes; parts and fittings for all the aforesaid.

Class 21

Glassware, porcelain and earthenware, none being candlesticks, household or kitchen utensils and containers.

Class 24

Textiles and textile piece goods, none being table covers or napkins; bed covers.

Class 25:

Clothing, footwear and headgear, none being hygienic clothes for handling foodstuffs or for hospitals use.

Class 26:

Badges and buttons.

Class 31:

Foodstuffs for animals; animal litter; edible chews for animals; dog biscuits; beverages for pets; pet food; animal litter; litter peat; yeast, protein and supplements for animals; stall food for animals.

Class 32:

Non-alcoholic drinks; syrups and other preparations for making beverages.

60. If the applicants fail to file Form TM21 within the one month specified above, then the application will be refused in its entirety.

#### Costs

61. The opponents have succeeded in their opposition to two of the classes covered by the application and in part in relation to their opposition to goods in classes 21, 24 and 25. It seems to me that given these findings, they are entitled to a contribution towards their costs. I order that the applicants pay the opponents the sum of £500-00 as a contribution towards their costs.

**Dated this 15 day of February 2002**

**S P Rowan  
For the Registrar  
the Comptroller General**

## **Annex**

United Kingdom Trade Mark number: 9930353

### **PAPSTAR**

Class 16

Cardboard and articles made from cardboard and the like pulp-based materials, all included in Class 16; paper serviettes.

United Kingdom Trade Mark registration number: 1001338

### **PAPSTAR**

Class 21

Eating utensils and drinking utensils, all included in Class 21 and made from cardboard or from the like pulp-based materials, and all being disposable.

Community Trade Mark number 572818

### **PAPSTAR**

Class 4

Candles, wax candles.

Class 8

Knives, forks, spoons of wood and plastics.

Class 16

Paper, cardboard, and fleece goods (as far as contained in class 16), gift paper, baking paper, wrapping paper, napkins, table-cloths, lace papers for pastry and as table decoration, toilet paper, kitchen paper, towel paper, garlands, streamers, confetti, fans, wreaths, crepe paper for decorating and doing handicrafts, Chinese lanterns - also as party decoration; wrappings of paper, cardboard, plastics and aluminium, particularly in form of paperbags, foils, bags, sacks - also in form of waste bags and waste sacks -, receptacles and other coverings; office supplies, particularly tracing paper.

Class 20

Drinking straws of plastics.

Class 21

Cleaning utensils, particularly cleaning sponges, cleaning cushions; candle-sticks of metal and glass; toothpicks, pickers, cocktail stirrers, single-use dishes of paper, cardboard, plastics and aluminium.

Class 25

Hygienic clothes for handling foodstuffs and for hospitals of paper, fleece and plastics.

Class 26

Artificial flowers, candle garlands for purposes of ornaments and decoration.

Class 28

Christmas-tree decoration, including candle-sticks; toys, balloons.

Community Trade Mark number 573063



Class 4

Candles, wax candles.

Class 8

Knives, forks, spoons of wood and plastics.

Class 16

Paper, cardboard, and fleece goods (as far as contained in class 16), gift paper, baking paper, wrapping paper, napkins, table-cloths, lace papers for pastry and as table decoration, toilet paper, kitchen paper, towel paper, garlands, streamers, confetti, fans, wreaths, crepe paper for decorating and doing handicrafts, Chinese lanterns, also as party decoration; wrappings of paper, cardboard, plastics and aluminium, particularly in form of paperbags, foils, bags, sacks - also in form of waste bags and waste sacks -, receptacles and other coverings; office supplies, particularly tracing paper.

Class 20

Drinking straws of plastics.

Class 21

Cleaning utensils, particularly cleaning sponges, cleaning cushions; candle-sticks of metal and glass; toothpicks, pickers, cocktail stirrers; single-use dishes of paper, cardboard, plastics and aluminium.

Class 25

Hygienic clothes for handling foodstuffs and for hospitals of paper, fleece and plastics.

Class 26

Artificial flowers, candle garlands for purposes of ornaments and decoration.

Class 28

Christmas-tree decoration, including candle-sticks; toys, balloons.

Community Trade Mark number 573089



**PAP** \*  
**STAR**

Class 4

Candles, wax candles.

Class 8

Knives, forks, spoons of wood and plastics.

Class 16

Paper, cardboard, and fleece goods (as far as contained in class 16), gift paper, baking paper, wrapping paper, napkins, table-cloths, lace papers for pastry and as table decoration, toilet paper, kitchen paper, towel paper, garlands, streamers, confetti, fans, wreaths, crepe paper for decorating and doing handicrafts, Chinese lanterns - also as party decoration; wrappings of paper, cardboard, plastics and aluminium, particularly in form of paperbags, foils, bags, sacks - also in form of waste bags and waste sacks -, receptacles and other coverings; office

supplies, particularly tracing paper.

Class 20

Drinking straws of plastics.

Class 21

Cleaning utensils, particularly cleaning sponges, cleaning cushions; candle-sticks of metal and glass; toothpicks, pickers, cocktail stirrers, single-use dishes of paper, cardboard, plastics and aluminium.

Class 25

Hygienic clothes for handling foodstuffs and for hospitals of paper, fleece and plastics.

Class 26

Artificial flowers, candle garlands for purposes of ornaments and decoration.

Class 28

Christmas-tree decoration, including candle-sticks; toys, balloons