

TRADE MARKS ACE 1994
IN THE MATTER OF APPLICATION No 2122230
BY CHANNEL 5 BROADCASTING LIMITED
TO REGISTER A SERIES OF TWO MARKS
GIVE ME FIVE / give me 5 (& device)
IN CLASSED 9, 14, 16, 21, 25, 28 & 35

AND IN THE MATTER OF OPPOSITION THERETO UNDER
OPPOSITION NO 47449 BY GIMME 5 LIMITED

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No 47449 by GIMME 5 LIMITED

10 **DECISION**

BACKGROUND

15 On 30 January 1997, Channel 5 Broadcasting Ltd of 22 Long Acre, London, WC2E 9LY
applied under the Trade Marks Act 1994 for registration of a series of two trade marks
reproduced here:

GIVE ME FIVE



For goods in Classes 9, 14, 16, 21, 25, 28 & 35. Full details are provided at annex A

30 On the 3 September 1997 Gimme 5 Limited filed notice of opposition to the application. The
grounds of opposition are in summary:

- 35 i) that the opponents are the registered proprietors of the trade mark GIMME 5,
number 1492991, dated 4 March 1992, for goods in class 25.
- 40 ii) The opponents have used their trade mark “extensively and continuously in the
UK” in relation to goods in classes 14,16 & 25 and have built up a substantial
reputation throughout the UK.
- 45 iii) Given the opponents’ reputation in its mark, registration of the applicants’
marks would offend against Section 3(6) of the Trade Marks Act 1994.
- iv) As the applicants’ marks are “in essence identical” to those of the opponents
and for identical goods, registration of the applicants’ marks would offend against
Section 5(1) of the Trade Marks Act 1994
- v) If the applicants’ marks are not identical to the opponents’ registered trade
mark they are similar, registration would therefore offend against Section 5(2),

Section 5(3) and, by virtue of the law of passing off, it also offends against Section 5(4) of the Trade Marks Act 1994.

5 The opponents also requested the Registrar to exercise his discretion in their favour. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse trade marks as he did under the old law. A mark can only be refused if it is shown to offend against the requirements of the Act and Rules in one or more aspects. The applicants subsequently filed a counterstatement denying all of the grounds of opposition, other than agreeing that the opponents are the registered proprietors of the trade mark as claimed. Both sides ask for an award of costs. Only the opponents filed evidence. Neither party wished to be heard in the matter. My decision will therefore be based on the pleadings and the evidence filed.

OPPONENTS' EVIDENCE

15 This takes the form of a statutory declaration by Mr Michael Robert Kopelman, dated 11 June 1998, who is the Managing Director of Gimme 5 Ltd the opponents in these proceedings.

20 Mr Kopelman states that he founded the company on 12 June 1991, confirmed by a copy of the Certificate of Incorporation. He claims that since this time it has operated at the upper end of the fashion industry designing and manufacturing products for retail or designing and producing, on a limited basis, specific products for third parties upon request in the UK and abroad. As a result he says the company is particularly well-known and successful in Japan and the USA.

25 The opponents are the registered proprietors of trade mark 1492991 **GIMME 5** which is registered for "Articles of outerclothing; footwear; headgear;" all included in Class 25. In addition the opponents have used their mark on jewellery, badges, stickers, labels for clothing, boxes, compliment slips, letterheads, mats and business cards. The opponents have also used what is described as "the phonetically identical trade mark GIMME FIVE, with and without the trade mark of a numeral five in a circle."

30 A number of exhibits which are claimed to show the use of the marks are provided as follows:
GIMME 5: stickers, DJ's felt record mat, pizza style clothes box, jacket and T-shirt.
GIMME FIVE with the numeral five in a circle: business cards and letterheads, a badge, two T-shirts.
35 GIMME FIVE without the numeral five in a circle: clothing labels, seven T-shirts.

The trade mark is visible on the outside of the articles. All of the clothing items had a label with the mark (GIMME FIVE without the numeral five in a circle) sewn in at the neck.

40 Invoices to companies in the UK, Japan, Italy, Guernsey, Germany, France and USA for the period 5 December 1994 to 30 May 1996 are produced at exhibit MRK10. The invoices are for various items of clothing and are all on GIMME FIVE headed notepaper with the number 5 in a circle at the bottom of the page.

45 Mr Kopelman states that the reputation gained by the use of its mark has been enhanced by widespread advertising in national magazines newspapers and publications such as: *i-D:i-DEAS*, *Fashion*, *Clubs*, *Music*, *People*, *Fashion Weekly*, *Touch Magazine*, *The Face*, *Evening Standard*,

5 *Sky Magazine, News of the World, Sunday Magazine, Elle, Clothes Show Magazine.* Dated copies of extracts from these publications are provided at exhibit MRK11. These show the opponents as the supplier of clothing articles, and are dated from 1991 to 1997. There are also a number of press articles etc. at exhibit MRK 12 which are not dated but show the opponents as the supplier of a range of clothes. Both exhibits allude to GIMME 5 and GIMME FIVE in equal measure.

10 There are also letters, at exhibit MRK 13, from editors of two magazines which confirm that the opponents are known as GIMME FIVE and have been in existence since 1991. Further, copies of compact disc and vinyl record album covers are produced at exhibit MRK 14 and show acknowledgement to the opponents under both GIMME FIVE and GIMME 5.

15 As the result of the above coverage Mr Kopelman states that the opponents' reputation is such that their advertising expenditure is not high as they often provide items for photo shoots in return for a credit by the magazine. This is shown in some of the exhibits under MRK11 and MRK12. The opponents also claim to provide clothing to groups such as the Spice Girls for use on tour and so gain media exposure.

20 The opponents do carry out some advertising and invoices totalling £9,268 for promotional and advertising work for the period October 1994 to January 1997 are provided at exhibit MRK 15.

Mr Kopelman provides turnover figures for goods sold under the GIMME 5, GIMME FIVE or the 5 device as follows:

Year to 30 th June	Turnover £
1992	96,800
1993	191,500
1994	347,100
1995	460,400
1996	765,500

30 Mr Kopelman contends that the respective trade marks and goods are the same, if not extremely similar, and therefore he believes that it is inevitable that confusion will arise between the marks to the detriment of his company.

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

DECISION

40 I first consider the ground of opposition under Section 3(6) which is as follows:

“3 (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

5 The Act does not define the term bad faith; leaving it to the Tribunal and the Court to determine whether an application was made in bad faith based upon the circumstances of a particular case. The Notes on Sections, published by the Patent Office, and based upon the Notes on Clauses provided to Parliament during the passage of the Trade Marks Bill in relation to Section 3(6) provides examples of where bad faith might be found, these are:

(i) where the applicant had no bona fide intention to use the mark, or intended to use it, but not for the whole range of goods and services listed in the application.

10 (ii) where the applicant was aware that someone else intends to use and / or register the mark, particularly where the applicant has a relationship, for example as employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the United Kingdom.

15 (iii) where the mark incorporates the name or image of a well-known person without his agreement. (This should not be taken as meaning that this provision is legislating for the protection of a personal name or reputation - these remain unprotected under English Law, but the nexus between unregistrability and the name of a well-known person is that of bad faith in which the application is made.)

20 In my view there is an onus on the opponents when basing a ground of opposition under Section 3(6) on point (ii) above to demonstrate that the applicants are seeking to register a trade mark which it knows belongs to another. An allegation that the applicants should have been aware of the earlier trade mark, which the opponents consider similar to the applicants' trade mark in suit, is not sufficient to sustain an objection to registration under this head. The applicants have denied the allegation. In the absence of any evidence that the applicants made their application in bad faith this ground of opposition is bound to fail. The onus is on the opponent under Section 3(6). That onus has not been discharged and this ground of opposition is therefore dismissed.

30 Next, I turn to the grounds of opposition under Section 5(1) & (2) which is as follows:

35 “5.- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected

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

45 An earlier right is defined in Section 6, the relevant parts of which state:

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

5 (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,*

10 (b) *.....*

15 (c) *a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.*

20 I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding whether the two marks are similar I rely on the decision of the Court of Justice of the European Communities (ECJ) in the Sabel v Puma case C251/95 - ETMR [1998] 1-84. In that case the court stated that:

25 *“Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.*

30 *Global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “there exists a likelihood of confusion on the part of the public” - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.*

35 *In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”*

45 I also have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (case C-39/97) (ETMR 1999 P.1) which also dealt with

the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

5 *“A global assessment of the likelihood of confusion implies some interdependence*
10 *between the relevant factors, and in particular a similarity between the trade marks and*
 between these goods or services. Accordingly, a lesser degree of similarity between these
 goods or services may be offset by a greater degree of similarity between the marks, and
 vice versa. The interdependence of these factors is expressly mentioned in the tenth
 recital of the preamble to the directive, which states that it is indispensable to give an
 interpretation of the concept of similarity in relation to the likelihood of confusion, the
 appreciation of which depends, in particular, on the recognition of the trade mark on the
 market and the degree of similarity between the mark and the sign and between the goods
 or services identified.”

15 The opponents’ registration in Class 25 for “ Articles of outerclothing; footwear; headgear; all
 included in Class 25" clearly encompasses the applicants’ goods in the same class. The opponents
 have provided evidence that they had sold clothing under the mark prior to the material date, 30
20 January 1997. The opponents have provided sales figures relating to the period July 1992 - June
 1996 showing annual sales averaging £372,260 with the figure for the year July 1995 - June 1996
 being £0.75million. The sales figures in the context of the clothing industry are not vast but cannot
 be regarded as de minimis. In my view the opponents have not shown that their mark is so highly
 distinctive through use that a lesser degree of similarity of goods / services is required under
 Section 5(2) (b).

25 I therefore find that the applicants’ goods in Classes 9, 14, 16, 21, 28 and 35 bear little or no
 similarity to the goods for which the opponents’ mark is registered and there is no likelihood of
 confusion. The opposition under Section 5(2) with regard to these goods therefore fails.

30 I therefore turn to consider whether, taking into account the fact that the goods covered by the
 application in Class 25 are the same or similar to the goods of the opponents, the trade marks
 themselves are similar.

For ease of reference both the applicants’ and opponents’ trade marks are reproduced below:

APPLICANTS’ MARK	OPPONENTS’ MARK
<p style="text-align: center;">GIVE ME FIVE</p> <p style="font-size: 2em; font-weight: bold;">give me</p> 	<p style="text-align: center;">GIMME 5</p>

Visually the two marks convey the same image.

Phonetically the marks are identical with only the minor variation possible in the first of the three syllables. In oral use the marks would be likely to cause confusion.

Conceptually the marks convey the same message. The applicants' marks are written in what might be termed "correct" English and spelt according to the Oxford English Dictionary. However, the spelling used by the opponents is in the Collins English Dictionary and is defined as "Slang. Contraction of give me." Both marks bring to mind the American alternative to a handshake, the hand slap.

In view of the close similarity of the respective marks and the identity of the goods, I am of the clear view that there exists a likelihood of confusion. The opposition under Section 5(2) therefore succeeds insofar as Class 25 of the application is concerned.

I next turn to the ground of opposition under Section 5(3) which is as follows:

5. (3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The onus under Section 5(3) falls on the opponents, who must establish through the filing of evidence that their mark or goods have acquired reputation, and that the use of the mark applied for would damage or be detrimental to them in some way. The opponents have filed evidence to show that they have used their mark for clothing. However, no independent testimony has been filed, nor have they filed any survey evidence from the relevant public. The opponents have shown the turnover in their mark, but not provided evidence on their share of the market, which given the size of the clothing market would appear minuscule. Further, the opponents have not shown how the use of the applicants' mark would damage them. Use of the marks applied for by the applicants on the goods applied for (except clothing in Class 25) would not, in my opinion, take unfair advantage of or be detrimental to the distinctive character or repute of the opponents' mark. In the absence of any evidence to the contrary I find that the opposition under Section 5(3) fails.

Finally, I turn to the ground of opposition under Section 5(4) which states:

"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

5 (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.”

10

I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the CORGI case (Declaration of Invalidity No 9236, dated 30 September 1998). In that decision Mr Hobbs stated that:

15

“The elements of an action for passing off are helpfully summarised in the passages from Halsbury’s Laws of England 4th Edition Vol.48 (1995 reissue) quoted in Wild Child TM[1998] RPC 455 at 460,461. The concept of ‘misrepresentation.....leading or likely to lead to the public to believe that goods or services offered by the defendant are goods or services of the plaintiff’ is quite flexibly interpreted with a view to preventing the mixing and switching of identities between different goods, services and businesses. The concept of ‘damage as a result of the erroneous belief engendered by the defendant’s misrepresentation’ also embraces cases where the use of the later mark is liable to take unfair advantage of or be detrimental to the distinctive character or repute of an earlier trade mark, with adverse consequences for the proprietor of the goodwill of the existing business. Misrepresentation nevertheless remains an essential element of the action for passing off and it is not possible at the present time to say that the action prevents ‘association’ independently of confusion symptomatic of misrepresentation.”

20

25

Later in the same decision he stated:

30

“I do not regard it as self-evident that people would be misled (with a concomitant risk of damage to the Applicant in its use and enjoyment of the goodwill built-up and acquired in connection with the promotion and sale of CORGI model vehicles) if the word CORGI was used by the Respondent as a trade mark for outerwear, sport and leisure wear. The Applicant’s evidence leaves me in doubt on these matters. I think it is quite possible that people would perceive or assume correctly that the same mark was being used by separate undertakings trading independently of one another (one in the field of model vehicles, and the other in the field of clothing).”

35

40

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

45

The opponents have shown that they have acquired goodwill under their mark by the relevant date. The goodwill is in their business as a clothing supplier. Earlier in this decision I found that the use of the applicants’ mark on clothing related goods in Class 25 would cause confusion. Such use would be a misrepresentation and damage can be inferred in these circumstances. Therefore the opposition under Section 5(4) for goods in Class 25 succeeds.

The opponents also contend that their mark has such reputation that anyone who saw the use of the marks "GIVE ME FIVE / give me 5" on goods in Classes 9,14,16,21,28 & 35 would assume that they came from the opponents. However, apart from this assertion there is no evidence of such goodwill or reputation.

5

The opponents sales figures stated that they related to "goods sold under the trade marks GIMME 5, GIMME FIVE or the 5 device", although there was no breakdown for individual goods.

10

I am not persuaded that at the relevant date, 30 January 1997, the opponents had any reputation or goodwill in goods in classes 9,14,16,21,28 or 35. Other than items of clothing none of the exhibits showed use of the trade mark on goods other than what might be termed promotional items such as badges, labels, stickers and clothes boxes. Such items are, in my view, used to promote the companies clothing goods and cannot be regarded as goods which are sold under the mark. Therefore it cannot be assumed that the public would find the applicants' use of their trade mark as deceptive in such circumstances. As I am not convinced that members of the public would have confused the products of the applicants for those of the opponents the opposition under this section therefore fails.

15

20

The opposition to the applicants' mark in relation to "Articles of clothing; footwear; headgear" in Class 25 has been successful. As grounds for refusal exist only in respect of goods in Class 25 the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a TM21 deleting Class 25.

25

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

The opposition having partly succeeded the opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £535

30

Dated this 18 day of May 1999

35

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Class 9:

Sound recordings in the form of phonograph records, discs and tapes; compact discs; video recordings in the form of discs and tapes; discs and tapes, all for recording sound and/or vision; cassettes and cartridges all for use with or containing video and sound recordings; CD ROMS; cinematographic films; television films, programmes and advertisements; sound and/or visual reproducing, amplifying, recording and transmitting apparatus and instruments; computers; computer software; computer hardware; computer firmware; computer programs; electronic data processing apparatus; telecommunications apparatus and instruments; magnetic recording tape; pre-recorded audio and video programmes; CD's; printers; multimedia products; parts and fittings for all the aforesaid goods.

Class 14:

Jewellery; imitation jewellery; costume jewellery; articles of semi-precious or precious metal or coated therewith; semi-precious and precious stones; watches; clocks; horological and chronometric apparatus and instruments.

Class 16:

Printed matter; printed publications; posters and prints; stationery; bags; paper and paper articles; cardboard and cardboard articles; books; calendars; paper ornaments; postcards; transfers; decalcomanias; albums; boxes; cards; pens and pencils; diaries; stickers; labels.

Class 21:

Combs, brushes, coasters, ice-buckets, pitchers, decanters, cups, drinking glasses, figurines, mugs, plates, trays, vacuum bottles, toilet cases; small household and kitchen apparatus and instruments; glassware, porcelain, earthenware; sponges.

Class 25:

Articles of clothing; footwear; headgear.

Class 28:

Toys, games and playthings; gymnastic and sporting articles and apparatus

Class 35:

Advertising services; marketing services; market research services; marketing studies services; publicity services; sales promotional services; television, radio and direct mail advertising, marketing and sales promotional services; business management and consultancy services relating to broadcast and advertising services; information and advisory services relating to all the aforesaid including such services available on the Internet.