

O-181-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2341221
BY BOURNE LEISURE LIMITED
TO REGISTER A SERIES OF THREE TRADE MARKS**



IN CLASSES 41 AND 43

AND

**THE OPPOSITION THERETO
UNDER NO 93514
BY KELLOGG COMPANY**

Trade Marks Act 1994

**In the matter of application no 2341221
by Bourne Leisure Limited
to register a series of three trade marks**



**in classes 41 and 43
and the opposition thereto
under no 93514
by Kellogg Company**

Introduction

1) On 20 August 2003, Bourne Leisure Limited, which I will refer to as BL, applied to register the above trade marks. The application was published for opposition purposes on 1 April 2005 with the following specification:

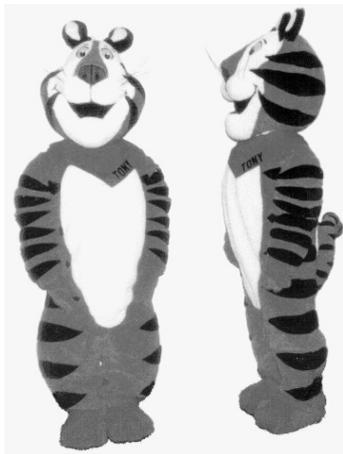
Provision of entertainer, amusement, leisure and recreation facilities, services and amenities; nightclub, discotheque, music hall, concert, dance hall, ballroom, cabaret, cinema and theatre services; amusement park, arcade and centre services; gaming, gambling and casino services; snooker and pool club services; theme park services; leisure centre, boating lake and water-shute complex services; funfair, circus and bingo hall services; provision of public baths, aquatic recreation, swimming, windsurfing, water skiing and outdoor recreation facilities, services and amenities; health and fitness club services; tenpin bowling alley and bowling green services; sports instruction services; organisation of recreational activities, quizzes, games and competitions; production of shows and of cabarets; organisation of beauty competitions; instruction and tuition in association with all of the aforesaid; educational services; club membership services.

Hotel, motel and boarding house services; provision of tourist house and accommodation services, cafe, cafeteria, canteen, bar, coffee shop, snack-bar and restaurant services; catering services; provision of holiday camp and camp ground services, facilities and amenities; operation of nurseries and creches; provision of exhibition facilities and amenities; provision of facilities and amenities, all for

conferences, seminars and banquets; provision of holiday accommodation; provision of caravan, mobile home, camp and camp ground services.

The above services are in classes 41 and 43 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) Kellogg Company, which I will refer to as KC, filed a notice of opposition to the registration of the application for. It bases its opposition on section 5(2)(b) of the Act and opposes all of the services of the application. KC relies upon a single earlier right, Community trade mark registration (CTM) no 946699, which is registered in classes 16, 25, 28, 29, 30, 31, 32, 41 and 42 for the following goods and services:



Paper, cardboard and goods made from these materials, not included in other classes; printed matter, book-binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes) playing cards; printers' type; printing blocks.

Clothing, footwear, headgear.

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and other milk products; edible oils and fats.

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

Beers, mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Education; providing of training; entertainment; sporting and cultural activities.

Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming.

The application for registration of KC's mark was made on 2 October 1998 and the registration process was completed on 19 March 2003. Since it had been registered for less than five years before the date that BL's application was published, it is not subject to the proof of use regulations. CTM 946699 bears the following description:

“The trademark is a three-dimensional tiger figure shown from the front and from the side ...Orange, black, white, red blue, yellow.”

3) KC claims that the respective trade marks are similar and that the applicant's services are either identical or similar to the goods and services covered by CTM 946699.

4) BL filed a counterstatement, following a period of cooling-off. BL denies that the respective marks are similar, arguing that its marks show a single (front) view of a tiger in contrast to the front and side views of KC's tiger, which is represented in colour. BL also says that it has used its mark in relation to the services of the application for a number of years without there having been any instances of confusion between the marks. It points to the co-existence of its own CTM (for the second tiger in the series) for identical services, which the opponent did not oppose.

5) In relation to the similarities claimed by KC between the respective services, BL says in its counterstatement:

“It is acknowledged that the application is currently on record in respect of services that are identical to or similar to those for which the earlier mark is registered.”

BL seeks dismissal of the opposition and an award of costs in its favour.

6) Both sides filed evidence. A hearing was held in 12 June 2008 by video conference. KC was represented by Mr Martin Krause of Haseltine Lake. BL was represented by Mr Douglas Campbell of counsel, instructed by Wildbore and Gibbons.

Evidence

Opponent's evidence

7) KC filed three witness statements supported by exhibits. These were from Robert Woodall, the Marketing Manager for Kids and Family Brands at Kellogg Company in the UK; from Jane More O'Ferrall, a trade mark attorney; and from David A. Herdman, Corporate Counsel for Kellogg Company in the United States. Mr Woodall's evidence consists largely of statements and exhibits attesting to the use of their tiger character ('Tony') to market Kellogg's breakfast cereal ('Frosties') and the appearance of the tiger in connection with various third party sporting programmes and initiatives, such as the 'Gladiators' television programme of the 1990s and the Amateur Swimming Association. KC's tiger first appeared in the UK on cereal and television adverts in the UK and Mr Woodall states that sales figures for 'Tony'-endorsed products are in excess of £70 million for 1997 decreasing to £50 million for 2002. He says that "TONY always appears as an animated character taking on anthropomorphic characteristics."

8) Ms More O'Ferrall's evidence consists of a BBC website print where it is stated that Tony the Tiger is one of the most familiar of tigers used in advertising; a print from the online encyclopaedia, Wikipedia, where the entry for Tony the Tiger describes some of the ways he has been used as a mascot and in advertising; and a print from the website of the Diocese of York, internally dated 26 May 2006, where reference is made to support for the diocese by the applicant and its mascot "Tony the Tiger" (which is the name of KC's tiger. BL's tiger goes by the name of 'Rory'). All three of the internet prints are dated 16 February 2007 and are therefore after the relevant date for these proceedings (20 August 2003).

9) Mr Herdman's witness statement repeats much of what Mr Woodall says in his witness statement. Mr Herdman also gives turnover figures, but these are global and, therefore, do not assist in establishing the position in the UK. Mr Herdman claims worldwide reputation and fame for KC's tiger, achieved through extensive marketing of its food products using the cartoon character, licensing and live costumed appearances. He says that KC's tiger was pitched at the 9th most famous advertising icon of the 20th century, according to the American "Advertising Age" magazine, whose articles on the subject were reported in the UK press in April 1999; again, this does not tell one of the position in the UK.

Applicant's evidence

10) BL's evidence consists of two witness statements and supporting exhibits, from Sarah Janella Barr, a trade mark attorney, and from Ruth Shaw, responsible for intellectual property at BL. Ms Barr's evidence is largely submission, and I therefore do not include it here, but I have taken account of the submissions in reaching my decision. Ms Barr has also exhibited a large amount of 'state of the register evidence' in an attempt to demonstrate the proliferation of tiger trade marks on the UK register. She states that BL first used a tiger character in 1991 and has used the version which is the subject of this trade mark application since at least 1998. Like Ms More O'Ferrall, Ms Barr also exhibits an internet print which shows the various ways in

which the general public encounters tigers, e.g. in poetry, film and comics (I note that of the two entries for tigers used in advertising, the opponent's tiger is one of them).

11) Ms Shaw states that BL has children's clubs at its holiday parks at 34 locations throughout the UK. BL has developed a range of characters, amongst others, "Anxious the Elephant", "Greedy the Gorilla" and "a tiger by the name of Rory". The characters, particularly the tiger, play a large part in the £1 million per annum promotion of the holiday parks. The design of the tiger character has evolved over the years and the tiger costumes the staff wear have changed. Ms Shaw distinguishes BL's tiger (Tony) from KC's (Rory) by saying that "Rory is light orange and black with more curved features whereas Tony is almost red and black with chiselled features and he always wears a red handkerchief around his neck and Rory has no clothes".

Section 5(2)(b) of the Act – likelihood of confusion

12) The relevant part of section 5(2)(b) of the Act is as follows:

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

(a) –

(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 marks 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.”

Section 6(1)(a) of the Act defines an earlier mark as:

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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”.

KC's CTM 946699 is an earlier mark as per section 6(1)(a).

13) The leading authorities which guide me in this ground are from the European Court of Justice: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*.

Comparison of goods and services

14) KC, in its notice of opposition, claims that BL's application covers identical services to those for which their earlier mark is registered, with the exception of “club

membership services” in Class 41 and “operation of nurseries and crèches; provision of exhibition facilities and amenities”, which it claims are similar. BL accepted this in its counterstatement, stating

“It is acknowledged that the application is currently on record in respect of services that are identical to or similar to those for which the earlier mark is registered.”

So, in relation to this issue, all I need to consider is the degree of similarity in relation to those services which are identified as being similar rather than identical.

Average, relevant consumer and the purchasing process

15) The services are centred around the provision of temporary accommodation, entertainment and sporting activities. There is nothing about them which suggests that they are aimed at any particular group of people or any specialism. I consider the average, relevant consumer of the services to be the general public. The purchasing process may be different in terms of the level of attention the consumer pays, depending on what the services are; for example, selection of a family holiday site or a nursery service will be a considered purchase, whilst a visit to a canteen is unlikely to engender the same level of scrutiny by the purchaser. I consider that exposure to the mark will be primarily visual, since it is a device without words and clearly meant to work as a visual rather than an aural trade mark. BL refers to it as “a tiger by the name of Rory”, but ‘Rory’ does not appear in the mark. The mark does not lend itself to articulation and I conclude that the part it plays in the purchase of the services will be visual rather than aural.

Similarity of marks

16) The authorities direct that, in making a comparison between the marks, I must have regard to each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant. The likelihood of confusion must be appreciated globally by evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. However, I should guard against dissecting the marks so as to distort the average consumer’s perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

17) Although the application is for a series of three marks, I must compare each mark individually rather than treat the series as a homogenous whole. That said, each mark comprises a slight variation on a theme: an upright anthropomorphised cartoon tiger character with identical features in terms of stripes, facial expression and white facial, ear and torso markings, facing the onlooker, but with its arms in different positions. KC’s mark is also an upright anthropomorphised cartoon tiger character with stripes, a facial expression and white facial, ear and torso markings, facing the onlooker, with its arms by its sides. I take the view that the slight variations in the stances of BL’s tiger do not affect my comparison of the marks. I should also mention that KC’s registration is for a three-dimensional colour mark, but since BL’s mark is a two-

dimensional upright tiger figure shown from the front and KC's mark is also an upright tiger figure shown from the front, and the side in addition, I do not consider that anything turns upon the extra dimension of KC's tiger.

18) With regard to the colour aspect of the marks, BL (in Ms Shaw's evidence) submitted that its tiger, not applied for in colour, is "light orange and black", whilst KC's tiger, which has a colour description on the registration, is "almost red and black". In fact, the colour description of CTM 946699 is "orange, black, white, red, blue, yellow". The colours of KC's trade mark are those which one would expect for a tiger (anthropomorphised or not).

19) It is well established that the comparison of marks must be made on the basis of visual, aural and conceptual considerations. Both marks consist of an upright anthropomorphised cartoon tiger character with stripes, a facial expression and white torso markings, facing the onlooker. There is a substantial amount of visual similarity both in terms of the upright, forward-facing stance and the arrangement of stripes, and to the white markings on the torso, ears and face. BL places emphasis upon the blue nose of KC's tiger and the neckerchief it wears, which has 'TONY' written upon it. BL's tiger is unnamed in its trade mark application. I do not consider either the nose or the neckerchief elements to be dominant within the mark; certainly they do not move the marks apart which are very similar visually. Mr Campbell submitted that the tigers are dissimilar because KC's tiger is 'jowly' and more muscular than BL's tiger. If one were to place the tigers together in an identity parade, the relative fitness of their physiques might be discernable; however, that is not a test that I have at my disposal. The overwhelming visual impact of the tigers is that they are similar to a high degree.

20) In this case, what strikes the eye in terms of visual similarity leads one to the inevitable conclusion that the marks are also highly similar conceptually. There are many ways to depict a tiger. Tigers are cats and walk as any cat does, on four legs. They do not walk around on two legs in a human way. The tigers in the marks I am comparing have been given human characteristics: facial expressions, human hand gestures and an upright, two-legged posture. They have been anthropomorphised. The concept of the marks is the same: animated, anthropomorphised tiger characters.

21) I find that the marks are highly similar visually and conceptually. Owing to the neckerchief, KC's trade mark might be referred to as Tony whilst BL's tiger is anonymous. So in this respect there is an aural difference, although not aural dissonance owing to the anonymity owing to the anonymity of BL's tiger. The overwhelming visual and conceptual similarity swamps and negates the aural difference. Indeed, the average, relevant consumer could consider that BL's tiger has just forgotten to wear his neckerchief.

Likelihood of confusion – conclusion

22) BL has stated that it knows of no instances of confusion between the two marks. In *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at paragraph 26, Laddie J said:

“The reason why the rule of thumb referred to above does not give a safe indication of whether there is infringement in this case is because of the nature of the parties’ respective presences in the market. They are not in competition with each other. The business consultancy field is enormous. Indeed, on the basis of the evidence before me, the logistics section of the business consultancy field is enormous. The claimant’s core activities are not in the logistics field, the defendant’s are. Furthermore, even within that field, the defendant is a very small player, as will be explained below. In those circumstances it is not surprising that there has been no confusion in the market-place. To date the claimant and the defendant are in different parts of the market. This does not come close to imitating the notional world used for determining likelihood of confusion under Art.9.1(b).”

This is a principle that was confirmed by Warren J in *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch):

“99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says. *O2 v H3G* was a case considering infringement, not invalidity, and although there is of course some commonality between matters relevant to each, it is correct, in the context of infringement, to look only at the particular circumstances of the alleged infringement. In contrast, in cases of validity, it is necessary to look across the whole range of goods covered by the registration. The Court of Appeal was unimpressed by the suggestion that the abstract test applicable to validity applies in the case of infringement, but it did not give even a hint that the validity test as understood was incorrect: see paragraph 34 of the judgment of Jacob LJ.”

Of course this was also the position of the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at p 291 and *Phones 4U Ltd v. Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.) The matter was succinctly summed up by Millet LJ in the former case:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

On the evidence provided, it would seem that KC’s primary use of their mark is in relation to its breakfast cereal (‘Frosties’), and that there is a connection to the Amateur Swimming Association. BL, on the other hand, has used its mark in its holiday parks and by reference to the name Rory. It is not surprising that there have been no instances of confusion known to the applicant. The absence of evidence of confusion tells me nothing. I have to decide what the position would be assuming

notional use across the opponent's specifications since CTM 946699 is not subject to proof of use. BL were sceptical about KC's reliance upon this single registration as the basis of its opposition, instead of any other of its numerous registrations, since it would not have to prove use of it. I am not concerned with KC's motives for selecting this registration; this is the earlier right upon which the opposition is validly based. Since BL has admitted identity or similarity of services, whether there is a likelihood of confusion boils down to whether the marks are similar. BL has referred to its earlier CTM. However, I have to consider the case before me; I do not know the situation in relation to the CTM. The existence of the CTM is a fact but it is not a defence (see by analogy *Pepsi Co, Inc v OHIM*, T-269/02).

23) BL's evidence contained numerous prints of 'feline' trade marks protected in the UK in an attempt to demonstrate that the average consumer is used to distinguishing between them on account of the prevalence of such marks. The state of the register is irrelevant, as has been stated by the UK and European courts (see, in particular, *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281). I have no idea how many of the marks, if any, are actually in use in the UK and what the relevant public's perception of these marks may be in relation to the various goods and services. Furthermore, the exhibits are not limited to tiger marks but include many 'feline' trade marks, which are without relevance to the case before me.

24) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (*Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585). KC's exhibit JMOF1 from the BBC website shows that tigers are common in popular culture and have inherent comic talents, appearing in various animated cartoons. I consider that it is not unusual for animated characters to be used as trade marks, but that is not to say that they lack distinctiveness, any more than dictionary words which are commonly used as trade marks. I am of the view that the earlier trade mark has a reasonably high degree of inherent distinctiveness.

25) Mr Campbell drew my attention to *Kerly's Law of Trade Marks and Trade Names*, Fourteenth Edition, 2005, paragraph 9-071, footnote 86, citing e.g. Pumfrey J in *DaimlerChrysler v Javed Alavi* [2001] RPC 42 and *Reef Trade Mark* [2001] RPC 19. He submitted that Kellogg's undoubted reputation/enhanced distinctiveness in relation to breakfast cereal leads one to the conclusion that the average consumer is more likely, rather than less likely, to distinguish between KC's mark and the application. However, isolating paragraph 9-071 from the remainder of the passage distorts the picture. Paragraph 9-073 states:

“By contrast, when a mark is very well-known the use of the same mark on rather different goods may be likely to cause confusion.”

That is relevant here; KC’s mark may well have an established reputation for breakfast cereals, but there is no evidence of that in relation to the services covered by CTM 946699 which come into conflict with BL’s application. Consequently, I have to consider what the likelihood of confusion is between BL’s mark and KC’s mark on services for which there is no reputation.

Whatever Kerly’s says, it is firmly established jurisprudence 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 (*Sabel*, above). If it were otherwise, distinctive marks would be entitled to a lesser degree of protection than marks weaker in distinctive character. This is a matter of law.

26) The services of KC’s earlier mark and BL’s application are identical or closely similar. Both marks are for tigers. I bear in mind *Sabel v Puma*, a case which was also concerned with two big cats, in which the ECJ said:

“26 The answer to the national court’s question must therefore be that the criterion of “likelihood of confusion which includes the likelihood of association with the earlier mark” contained in Article 4(1)(b) of the Directive is to be interpreted as meaning that the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of the provision.”

KC’s and BL’s tiger marks share analogous semantic content as tiger marks. However, KC’s and BL’s tiger marks share more than analogous semantic content. They are strikingly visually and conceptually similar, bearing almost identical stripes and white facial, ear and torso markings. They are facing the onlooker. They have animated cartoon faces and stand on two legs. It is possible to compare them side by side and to find some differences. However, such an exercise would be to reduce the comparison to a ‘spot the difference’ puzzle, which is not a mode of comparison contemplated by established jurisprudence. Indeed the test I should apply is the very opposite; the matter must be judged through the eyes of the average, relevant consumer for the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* BL has pointed out the presence on KC’s tiger of the blue nose and the neckerchief which says ‘Tony’. These features are not the dominant features of the earlier mark, which is overwhelmingly an anthropomorphised tiger; it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*. The tiger cannot be said to be negligible. The average consumer normally perceives a mark as a whole and does not analyse its various details, particularly when they are small. Having regard to the identity or close proximity of the services, close similarity between the marks, **I find that there is a likelihood of**

confusion within the meaning of Section 5(2)(b) of the Act. Indeed, this is a case where I fear that confusion would be inevitable.

Costs

27) KC has been successful and is entitled to a contribution towards its costs. This case has largely been determined on a straight mark-to-mark, goods-to-services comparison. KC's evidence did not greatly contribute to my overall determination. Consequently, I have given a limited award in respect of the evidence of KC.

I award costs on the following basis:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£200
Evidence of KC	£100
Considering the evidence of DCA	£500
Preparation and attendance at hearing	£500
TOTAL	£1,800

28) I order Bourne Leisure Limited to pay to Kellogg Company the sum of £1800 . This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of June 2008

**David Landau
For the Registrar
the Comptroller-General**