

O-211-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2433429
BY MOMENTUM LIMITED
TO REGISTER THE TRADE MARK
BATTLE STORM
IN CLASSES 28 & 41**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 95039
BY JAKKS PACIFIC, INC.**

BACKGROUND

1) On 23 September 2006, Momentum Limited applied to register the trade mark **BATTLE STORM** for the following goods and services:

Class 28: Toys, games and playthings; sporting and gymnastic articles; amusement apparatus for use in entertainment centres, sports centres and amusement parks; guns, swords, phasers, rifles all for shooting beams of infra-red or laser emission; targets for receiving beams of infra-red or laser emission and simulating combat conditions.

Class 41: Entertainment services; amusement services; advisory services all relating to entertainment centres, sports centres and amusement parks; education and training services relating to installation and running of entertainment centres, sports centres and amusement parks; rental of amusement apparatus for use in entertainment centres, sports centres and amusement park.

2) Following examination, the application was accepted and published for Opposition purposes in Trade Marks Journal No.6662 on 8 December 2006.

3) On 6 March 2007, Jakks Pacific Inc, filed a notice of opposition. This consists of a single ground based upon section 5(2)(b) of the Act, under which they rely on the following trade mark:

Trade Mark	Number	Application Date	Registration Date	Goods
THE STORM	E5138300	26.05.2006	Not applicable	28 - Water toys, namely toy water guns.

4) I note that the opposition is only directed at the following goods in class 28 of the application:

“Toys, games and playthings; amusement apparatus for use in entertainment centres, sports centres and amusement parks; guns, swords, phasers, rifles all for shooting beams of infra-red or laser emission; targets for receiving beams of infra-red or laser emission and simulating combat conditions.”

5) On 29 May 2007 the Applicant filed a counterstatement in which they say:

“In our opinion, The Storm and Battle Storm are not similar. The trademarks are clearly for very different products and market places. Further we have been using the word storm as part of our product trademarks since 2001....

1. Whilst both items are in the same class, the registration for Battle Storm covers Laser Skirmish type systems whilst The Storm is simply for water pistols, totally different products....

2. Intended market for both products is very different, JAKKS Pacific Inc’s product is a low cost retailer sales toy, and ours is a professional high spec product aimed at the entertainment market and not sold through retail outlets.

Therefore customer confusion would be very unlikely. Further, we have an additional Class 41 relating to entertainment centres and alike, which reinforces our statement regarding different markets.

3. The term Battle Storm is a derivative of a trademark used for a similar product Laser Storm, introduced about October 2001 (our earliest known 3rd party reference to this is a Yellow Pages advert dated 29th April 2002...)."

6) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 3 July 2008 when the opponent was represented by Ms Peebles of Messrs Ablett & Stebbing. The applicant was represented by Mr Morris a Director of the applicant company.

OPPONENT'S EVIDENCE

7) The Opponent elected not to file any evidence-in-chief in these proceedings, but did file written submissions contained in a letter from their professional representatives, dated 3 October 2007. I note that following the receipt of these written submissions, the Trade Marks Registry directed, under the provisions of rule 13C(2) of the Trade Marks Rules 2000 (as amended), that the proceedings should continue.

APPLICANTS' EVIDENCE

8) This consists of a witness statement, dated 8 January 2008, by David Morris, a Director of the applicant company. In his witness statement Mr Morris refers to a letter from the Opponent's agents which he says is dated 18 September 2007 and he refers to it as exhibit DM23 to his witness statement. In fact the letter he refers to is dated 3 October 2007 and is referred to by me in paragraph 7 above.

9) Mr Morris notes that in that letter the Opponent's agent say, *inter alia*:

"Conversely, it will be appreciated that the "STORM" component of both the marks "BATTLE STORM" and "THE STORM" is highly distinctive for toy guns, because the word "STORM" has no normal association with guns or toy guns."

10) In response to this contention, Mr Morris explains that his research has found this not to be the case, adding that the word STORM is used in a range of products relating to battle and conflict. He refers to a number of exhibits which he says supports this contention. Insofar as it is necessary I have summarised the contents of these exhibits below. Where dated, the exhibits carry download dates of 7 and 8 January 2008, which is of course after the material date in these proceedings. That said, many of the exhibits refer to the position prior to the material date, and I will keep this in mind when making a decision.

- Exhibit DM01: consists of a web extract from the Compact Oxford English Dictionary which he notes defines STORM as a verb meaning: "(of troops) suddenly attack and capture (a place)" and which appears in phrases such as "take by storm".

- Exhibit DM02: consists of an extract from the free on-line encyclopaedia Wikipedia which relates to the Gulf War which took place between August 1990 and February 1991 which Mr Morris notes contains a reference to Operation Desert Storm which was, the article explains, the name given by the United States to their air and land operations and which is often used to refer to the conflict.
- Exhibits DM03 and DM04 consist respectively of web extracts from Wikipedia and the StarWars Databank in which Imperial Stormtroopers and Storm Commandos are featured. He adds that more recently films such as Hidden Wars of Desert Storm and Heroes of Dessert Storm have been released; exhibits DM20 and DM21 consist respectively of web pages in which the films mentioned appear.
- Exhibits DM05, DM06, DM07 and DM09 consist of web pages which refer to the use of the word STORM in battle and conflict based computer games such as: Conflict Global Storm for Sony Playstation from www.tothegame.com, Desert Storm, Arcade & Classic games from www.addictinggames.com, Bladestorm – The Hundred Years War from www.koei.com and GameStorm from Wikipedia.
- Exhibit DM08 consists of a page from the website www.rap4.com and refers to a paintball gun called the M4 Tactical Storm which I note retails at \$179.
- Exhibit DM10 consists of another extract from Wikipedia in relation to the word Stormtrooper. Mr Moore comments that the word STORM was used to construct a new word for military units i.e. Stormtroops with the word being used by the Germans to describe a type of assault force as early as 1915.
- Exhibits DM11 and DM24 show use of the word STORM in trade marks for real armament systems such as Metal Storm and Hail Storm. The exhibits consist respectively of an extract from Wikipedia which describes the company Metal Storm Limited of Australia as “..a research and development company that specialises in electronically initiated stacked projectile weapons technology” and an extract from www.strategycenter.net which appears to refer to two military concept vehicles known as the Hailstorm –A1 and Hailstorm A2;
- Exhibits DM12 and DM13 refer to use of the mark LASER STORM in relation to a toy gun based game. The exhibits consist respectively of an advertisement which is said to have appeared in Yellow Pages on 29 April 2002, and a product flyer which appears to be undated. I note that the advertisement and the product flyer contain references to the Applicant.
- Exhibit DM14 consists of a page from the Opponent’s website at www.jakkspecific.com, in which THE STORM water guns are featured. When one compares this advertising material with that used by the Applicant at exhibit DM15 one can, says Mr Moore, clearly see the differences in the products and their target customer. Basically the applicant’s use is an updated

version of paintball, which offers corporate days out for team building etc, whereas the opponent's product is a water pistol for use by children in the pool or outdoors.

- Exhibits DM16 and DM17 consist respectively of searches conducted in class 28 of the United Kingdom trade mark register for the terms STORM and BATTLE which returned 75 and 99 hits respectively. Mr Moore adds that a search of the whole of the trade marks register indicates that class 28 contains the fifth highest occurrence of the word STORM.

11) Mr Moore concludes his witness statement in the following terms:

“In conclusion, the word storm has been used extensively by many products relating to battles and conflicts and, as a consequence, could not be considered distinctive for toy guns. Also, my experience in the market place with the Laser Storm product for many years, and more recently Battle Storm, has found consumers refer to the products in their entirety. I am not aware of either product referred to as storm, only as Laser Storm or Battle Storm. Further, both products are traded under the mark Hangar51, which has been used as a trademark by Momentum Ltd for their leisure products since 1999. I have found that customers use Hangar51 to associate the products (which is distinctive) not the word storm.”

OPPONENT'S EVIDENCE IN REPLY

12) This consists of a witness statement, dated 9 April 2008, by Katrina Peebles the opponent's Trade Mark Attorney. She confirms that the information in her witness statement comes from either her own personal knowledge or from relevant documents to which she has full access.

13) Ms Peebles explains that in his witness statement and at exhibit DM08, Mr Moore comments on the M4 Tactical Storm paintball gun to be found at www.rap4.com. She explains that she visited this site and the results are provided at exhibit KP1. Of this evidence Ms Peebles says:

“These evidence use of the mark STORM in combination with other marks or descriptive text on various paintball guns by RAV [sic] 4 which is a US seller of such weapons.”

14) Ms Peebles adds that she also investigated the comments made by Mr Moore and the associated exhibits DM16 and DM17 and a search of the United Kingdom trade marks register for the marks STORM and BATTLE was conducted; the results are provided as exhibits KP2 and KP3. Of these searches, she says:

“It will be noted that 63 results were found in the STORM search and 87 results were found in the BATTLE search.”

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

DECISION

16) The sole ground of opposition is based upon section 5(2)(b) of the Act. This reads:

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

(a)

(b) it is similar to an earlier 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.”

17) An earlier right is defined in section 6 of the Act, the relevant parts of which state:

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

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

18) In these proceedings the Opponent is relying on one trade mark, application No. E5138300 which has an application date of 26 May 2006 and which qualifies as an earlier trade mark under the above provisions. Notwithstanding the Applicant's request in its counterstatement for the Opponent to provide proof of use, as this trade mark has not yet achieved registration, it is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

19) In reaching a decision I take into account the following cases: *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, *Matratzen Concord GmbH v. OHIM* [2004] ECR I-3657, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2005] ECR I-8551 and *OHIM v. Shaker di L. Laudato & C. Sas* [2007] ECR I-4259.

20) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

21) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

22) The opponent has shown no use of its mark. I have to consider whether the opponent’s mark has a particularly distinctive character arising from the inherent characteristics of the mark. In my opinion, the opponent’s mark THE STORM is inherently distinctive for toy water guns.

23) I have to determine who is the average consumer of the goods in question. The average consumer for the opponent’s goods (water pistols) must clearly be children or adults purchasing a present for a child. I doubt that many adults would purchase such items for themselves. As to the applicant’s goods these cover a vast range of items. The actual use shown is on very expensive enclosures in which the game can be played. However, their opposed products are, essentially, toys, games and playthings. Ms Peebles contended that the average consumer of toys would be children. However, this overlooks the fact that children’s toys are mostly purchased by adults and are only sometimes then given to children. I take judicial note that increasingly games are aimed at adults, the recent advertising for the Wii system, aimed at home fitness is but one example. The average consumer must therefore be regarded as the whole population of the UK.

24) I shall first consider the specifications of both parties. Just prior to the hearing the applicant sought to restrict the specification by the addition of “but not including water toys, namely toy water guns”. Initially the opposition was restricted to certain

goods in Class 28 only. This was further reduced at the hearing. The net result is that the relevant goods are as follows:

Applicant's specification	Opponent's specification
In Class 28: Toys, games and playthings; guns, swords, phasers, rifles all for shooting beams of infra-red or laser emission; targets for receiving beams of infra-red or laser emission and simulating combat conditions, but not including water toys, namely toy water guns.”	In Class 28 Water toys, namely toy water guns.

25) It was accepted at the hearing by the opponent that the specifications were not identical, merely similar. Although this was contested by the applicant it is my view that the specifications must be regarded as similar.

26) I therefore turn to the marks of the two parties. For ease of reference I reproduce them below:

Applicant's mark	Opponent's mark
BATTLE STORM	THE STORM

27) The opponent contended that battles are fought with weapons and so the initial part of the applicant's mark will not be regarded as distinctive or dominant. Instead the average consumer will focus on the second part of the applicant's mark and will assume that the applicant's whole mark is merely a subset of the opponent's mark.

28) I do not accept this contention. Clearly in the opponent's mark the dominant element is the word STORM the definite article merely adding emphasis. To my mind the word "STORM" would bring to mind a climatic event such as rain and/or thunder and lightning, perhaps even gales. The applicant's mark has the word "BATTLE" preceding the word "STORM" which, in my opinion, changes the conceptual nature of the whole mark so that the average person would immediately view the mark as having a militaristic overtone. Clearly, the fact that the word "STORM" appears in both marks provides a degree of visual and aural similarity. However, the visual and aural differences between the marks far outweigh any slight similarity. I take into account the case of Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH Case T-292/01 [2004] ETMR 60 where the CFI held:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the

word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

29) Taking account of all of the above when considering the marks globally, I believe that there is not a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

30) As the applicant has been successful it is entitled to a contribution towards its costs. The applicant has represented itself during the course of this action. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley Q.C. sitting as the Appointed Person on appeal, observed that:

“8. It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgement it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR [Civil Procedure Rules]. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

31) Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6 – (1) This rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

32) I order the opponent to pay the applicants the sum of £1,200. This sum 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 21st day of July 2008

**George W Salthouse
For the Registrar,
the Comptroller-General**