

O-233-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3133635 BY
PETER MACK & RICHARD MACK
TO REGISTER:**

UNCLE SAM'S AMERICAN CIRCUS DAREDEVILS

AS A TRADE MARK IN CLASSES 9, 16, 25, 28 & 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 406349 BY UNCLE SAM GMBH**

BACKGROUND & PLEADINGS

1. On 28 October 2015, Peter Mack and Richard Mack (“the applicants”) applied to register **UNCLE SAM’S AMERICAN CIRCUS DAREDEVILS** as a trade mark for a range of goods and services in classes 9, 16, 25, 28 and 41. The application was published for opposition purposes on 1 January 2016.

2. On 1 April 2016, the application was opposed by Uncle Sam GmbH (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition, which is only directed against the goods in classes 25 and 28 of the application (shown in paragraph 12 below), was originally based upon two earlier trade marks. One of these earlier trade marks was subject to proof of use and in their counterstatement the applicants asked the opponent to provide such proof. In a letter dated 24 October 2016, the opponent advised the tribunal that it did not intend to submit any evidence. As a consequence of that decision, in an official letter dated 2 November 2016, the opponent was advised that the proceedings would only proceed on the basis of the other trade mark upon which it relied and which was not subject to proof of use.

3. The opponent now relies solely upon European Union Trade Mark (“EUTM”) registration no. 10392892 for the trade mark **UNCLE SAM** which was applied for on 4 November 2011 and entered in the register on 10 April 2012. Although the opponent indicates that it relies upon all the goods for which it is registered i.e. in classes 3, 18, 24, 25 and 28, the relevant goods in classes 25 and 28 are shown in paragraph 12 below. In its Notice of Opposition, the opponent states:

“4. The mark applied for reproduces and encompasses the entirety of the opponent’s earlier mark at its beginning. This element is visually, phonetically and conceptually identical. The mark applied for includes the words “AMERICAN CIRCUS DAREDEVILS”. These will be perceived as indicating the subject matter to which the goods relate, further and alternatively, they will be perceived as possessing weak distinctive character in relation to the contested goods. They merely qualify that which is possessed by “UNCLE SAM” and are accordingly of

negligible importance in a comparison of the signs. It is submitted that “UNCLE SAM” is the distinctive and dominant element of the marks in comparison, further and alternatively, “UNCLE SAM” retains an independent and distinctive role in the mark applied for.

5. The contested goods in class 25 and class 28 are wholly contained within the opponent’s registered goods in the same classes and, as such, are identical. Further, and in the alternative, the goods are highly similar to those covered by the earlier marks.”

4. The applicants filed a counterstatement in which the basis of the opposition is denied. In their counterstatement, the applicants explain that they are the owners and operators of UNCLE SAM’S AMERICAN CIRCUS, which has been touring the United Kingdom and Republic of Ireland since at least 1996. They state that they “enjoy significant goodwill and reputation in and to the mark UNCLE SAM’S AMERICAN CIRCUS for “circus services” and associated merchandise goods...” (paragraph 1 refers).

5. The applicants further state that they are the owners of, inter alia, United Kingdom trade mark registration no. 2100090 for, inter alia, “UNCLE SAMS AMERICAN 3 RING CIRCUS” which, I note, was applied for and registered for “circus services” in class 41 in 1996. The applicants state:

“6. Insofar as the opponent’s word mark is concerned, the fact the applicants’ mark incorporates the element UNCLE SAM’S (note the possessive form) is entirely irrelevant. As noted, the applicants have been trading as UNCLE SAM’S AMERICAN CIRCUS since at least 1996, and have had registrations in the UK and Ireland including the words UNCLE SAMS since 1996, both of which predate the opponent’s alleged “earlier rights”. Further, the applicants have significant goodwill and reputation in their mark UNCLE SAM’S, generated by 20 years of continued use of the marks throughout the UK and the Republic of Ireland. The applicants have sufficient goodwill and reputation upon which to found a passing

off action, and have had since before the first application was filed by the opponent. Thus, if the marks are similar as the opponent alleges, then clearly the rights relied upon by the opponent are wholly invalid.

7. In any event, the AMERICAN CIRCUS DAREDEVILS element of the applicants' mark provides a clear delineation between the respective marks that negates any likelihood of confusion. The incorporation of the wording AMERICAN CIRCUS DAREDEVILS in the applicants' mark serves to designate trade origin, the essential function of a trade mark, and **cannot** be dismissed from the assessment as the opponent suggests. Indeed it dominates the mark.

8. It is denied that the element UNCLE SAM in the applicants' mark is the distinctive and dominant element, and it is further denied that UNCLE SAM retains an independent and distinctive role in the mark. It is merely an insignificant part of the mark. The distinctive and dominant element is really AMERICAN CIRCUS DAREDEVILS.”

6. In these proceedings, the opponent is represented by HGF Limited and the applicants by Murgitroyd & Company. Only the applicants filed evidence. Although neither party elected to attend a hearing, both filed written submissions in lieu of attendance.

The applicants' evidence

7. This consists of a witness statement from Peter Mack accompanied by 12 exhibits. Although I have read this evidence, for reasons which will shortly become obvious, I do not need to provide a summary of it here. I will, however, return to it later in this decision.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“5 (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 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.”

9. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not been registered for more than five years at the date when the application was published, it is not subject to proof of use, as per section 6A of the

Act. As a consequence, the opponent is entitled to rely upon all of the goods it has identified.

Section 5(2)(b) – case law

11. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) 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;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

12. The competing goods are as follows:

The opponent's goods in classes 25 and 28	The applicants' goods in classes 25 and 28
<p>Class 25 - Clothing, Including of leather, in particular sportswear and Articles of clothing for casual wear, Tracksuits, leotards and Swimming costumes, Footwear, Headgear.</p> <p>Class 28 - Games, Toys, Dolls, Gymnastic and sporting articles (included in class 28).</p>	<p>Class 25 - Clothing; footwear; headgear; masquerade costumes and masks.</p> <p>Class 28 - Toys; games; computer games; playthings; juggling equipment; juggling balls; juggling plates; juggling pins; juggling equipment namely diabolos and flower sticks; juggling sticks; toy musical rainsticks, namely long hollow tubes partially filled with small pebbles or beans in order to make a sound; juggling scarves; skipping ropes; jigsaw puzzles; 3-D puzzles; spin toys; toy mobiles; spinning discs incorporating string which rewinds and returns to the hand when thrown; dolls and accessories therefor; plush toys; mechanical action toys; golf balls; soap bubbles [toys]; kites; balls; Christmas tree decorations; face masks and costume masks; puppets and marionette puppets; clown noses; ordinary playing cards; collectible dolls; decorative masks; toy miniatures and toy models; parts and fittings for the aforesaid goods.</p>

13. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

Class 25

14. The words “including” and “in particular” which appear in the opponent’s specification have no limiting effect. As a consequence, the terms “clothing”, “footwear” and “headgear” appearing in both parties’ specifications are literally identical. The terms “masquerade costumes and masks” in the application are encompassed by the term “clothing” in the opponent’ specification and are identical on the principle outlined in *Meric*.

Class 28

15. The opponent’s specification includes the broad terms “games”, “toys” and “gymnastic and sporting articles.” The terms “toys” and “games” also appear in the applicants’ specification and are literally identical. Collinsdictionary.com defines (i) “game” and (ii) “toy” as (i) “an activity or sport usually involving skill, knowledge, or chance, in which you follow fixed rules and try to win against an opponent or to solve a puzzle” and (ii) “an object that children play with, for example a doll or a model car.” The above accords with my own understanding of the words and, more importantly, will accord with that of the average consumer. As the above definitions make clear, the dividing line between what is a game and what is a toy is often a difficult one to draw.

That being the case, the following analysis represents what, in my view, are the most obvious categories into which the various goods fit.

“Computer games” in the application is encompassed by the term “games” in the opponent’s specification; they are identical on the *Meric* principle;

Terms in the application most likely to be regarded as games

“Ordinary playing cards”;

Terms in the application most likely to be regarded as toys

“Playthings, juggling equipment; juggling balls; juggling plates; juggling pins; juggling equipment namely diabolos and flower sticks; juggling sticks; toy musical rainsticks, namely long hollow tubes partially filled with small pebbles or beans in order to make a sound; juggling scarves; skipping ropes; jigsaw puzzles; 3-D puzzles; spin toys; toy mobiles; spinning discs incorporating string which rewinds and returns to the hand when thrown; dolls and accessories therefor; plush toys; mechanical action toys; soap bubbles [toys]; kites; Christmas tree decorations [which may be in the nature of toys]; face masks and costume masks; puppets and marionette puppets; clown noses; collectible dolls; decorative masks; toy miniatures and toy models”;

Gymnastic and sporting articles

Golf balls; balls;

Parts and fittings for the aforesaid goods

I have concluded that all of the applicants’ goods are identical to one or more terms which appear in the opponent’s specification. It follows that even if the parts and fittings in the application are to not be regarded as identical to the goods in relation to which

they will be used, given the overlap in, inter alia, the users, nature, intended purpose, method of use and trade channels, they are, nonetheless, similar to a high degree.

The average consumer and the nature of the purchasing act

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

17. The average consumer of the goods at issue is a member of the general public. As to how the goods in class 25 will be selected, in its decision in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to

purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

18. In my experience, all of the goods at issue will, for the most part, be obtained by self-selection i.e. from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue; visual considerations are, as a consequence, likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants, aural considerations must not be forgotten.

19. I go on to consider the degree of care the average consumer will display when selecting such goods. The cost and importance of the goods in class 25 can vary considerably. However, in relation to even relatively inexpensive goods in class 25, the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items of clothing. That, in my view, points to at least a normal degree of attention being paid during the selection process.

20. The cost and importance of the goods in class 28 may also vary considerably. Contrast, for example, the degree of care taken when selecting a bottle of “soap bubbles” (which is only likely to cost a few pounds) with that likely to be displayed when selecting a “collectible doll” (which may cost many hundreds or even thousands of pounds). Although this indicates that the degree of care displayed will vary from low to high, the cost of the vast majority of the goods at issue will be between and towards the lower end of these two extremes. I shall return to this point when I consider the likelihood of confusion later in this decision.

Comparison of trade marks

21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual

similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

22. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

The opponent’s trade mark	The applicants’ trade mark
UNCLE SAM	UNCLE SAM’S AMERICAN CIRCUS DAREDEVILS

23. The opponent’s trade mark consists of the two words “UNCLE” and “SAM” presented in block capital letters. Although “UNCLE” and “SAM” have their own distinct meanings, Collinsdictionary.com states that: “some people refer to the United States of America or its government as Uncle Sam.” That meaning will, in my view, be well-known to the average consumer and is how they will interpret the opponent’s trade mark. Consequently, while the opponent’s trade mark consists of two words, those words create a unit. It is that unit which conveys the overall impression and in which the distinctiveness lies.

24. The applicants' trade mark consists of five words all presented in block capital letters; these words also have their own distinct meanings. However, in my view, these words form two distinct units. Like the opponent's trade mark, the first unit consists of the words "UNCLE SAM'S". Notwithstanding the presence of the apostrophe after the letter "M" in the word "SAM" and before the letter "S" which follows it (indicating possession), the meaning of this unit is all but identical to the unit created by the opponent's trade mark. The second unit consists of the final three words in the applicants' trade mark i.e. "AMERICAN CIRCUS DAREDEVILS". The meaning of this second unit is fairly obvious i.e. more than one daredevil performing in an American Circus. In their counterstatement, the applicants state that it is this unit in their trade mark which (i) provides the origin message, (ii) is the distinctive and dominant element of their trade mark and (iii) that the first unit in their trade mark "is merely an insignificant part of the mark." Those submissions appear to me to be at odds with the following comment which appears in Mr Mack's statement in which, by reference to, inter alia, the UNCLE SAM'S AMERICAN THREE RING CIRCUS" trade mark), he states:

"1...The UNCLE SAM'S element of the mark was always the distinctive and dominant element of the name for my circus."

25. Although both units contribute to the overall impression the applicants' trade mark conveys, I agree with the opponent that whatever distinctive character the second unit in the applicants' trade mark may possess, it is significantly weaker than the first unit.

26. Having reached those conclusions, I go on to compare the trade marks from the visual, aural and conceptual standpoints. The unit created by the opponent's trade mark and the first unit in the applicants' trade mark differ only to the extent that the applicants' trade mark also contains an apostrophe symbol and the additional letter "S". As I mentioned earlier, I consider the first unit in the applicants' trade mark to be by far the more distinctive unit. Notwithstanding the presence of the second unit in the applicants' trade mark, there is, in my view, at least a medium degree of visual similarity between the competing trade marks.

27. As all of the words in the competing trade marks will be very well-known to the average consumer, the manner in which they will be articulated is entirely predictable. Although the applicants' trade mark is aurally significantly longer than the opponent's trade mark, the fact that the first unit is aurally virtually identical, again results in at least a medium degree of aural similarity between them. Finally, the conceptual comparison. The opponent's trade mark and the first unit in the applicants' trade mark will convey virtually identical conceptual messages i.e. as relating to the United States of America. Although the second unit in the applicants' trade mark will create a concept in the average consumer's mind that the opponent's trade mark will not, the fact that the second unit in the applicants' trade mark begins with the word "AMERICAN" (which reinforces the meaning conveyed by the opponent's trade mark), it represents a further point of conceptual similarity between the competing trade marks.

Distinctive character of the earlier trade mark

28. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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 trade 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 trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

29. In its submissions, the opponent states:

“22...As the words UNCLE SAM have no meaning in relation to the opponent's goods, the earlier mark enjoys a high degree of distinctiveness.”

30. As the opponent has not filed any evidence in these proceedings, I have only the inherent characteristics of its trade mark to consider. As I mentioned earlier, the meaning conveyed by the opponent's trade mark will be well-known to the average consumer. When considered in relation to its goods in classes 25 and 28, it is likely to evoke connotations of, for example, goods of American origin and/or design. It is not, as consequence, a trade mark possessed of a high degree of inherent distinctive character as the opponent suggests. Rather, it is, in my view, possessed of an average degree of inherent distinctive character.

Likelihood of confusion

31. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the competing goods are identical or similar to a high degree;
- the average consumer of the goods at issue is a member of the public;
- although the goods at issue will be selected by predominantly visual means, aural considerations will also play their part in the selection process;
- the average consumer will pay at least a normal degree of attention to the selection of the goods in class 25 and a low to high degree of attention to the selection of the goods in class 28;

- the overall impression conveyed by the opponent's trade mark and its distinctiveness lies in the unit it creates;
- while the overall impression conveyed by the applicants' trade mark stems from the combination of units of which it is composed, its distinctiveness is heavily weighted in favour of the first unit i.e. the words "UNCLE SAM'S";
- the competing trade marks are visually and aurally similar to at least a medium degree;
- the opponent's trade mark is conceptually identical to the first unit in the applicants' trade mark and that conceptual similarity is reinforced by the presence of the word "AMERICAN" as the first word in the second unit in the applicants' trade mark;
- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character.

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

33. In reaching a conclusion, I begin by reminding myself that identical/highly similar goods are in play, the competing trade marks are visually and aurally similar to at least a medium degree, consist of or contain a unit conveying an identical conceptual message and that the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character. In relation to those goods to which the average consumer will pay only a low degree of attention during the selection process, the prospect of direct confusion (through imperfect recollection) is, in my view, a real one. I am, however, less convinced that conclusion applies in relation to those goods in

relation to which the average consumer will pay a normal to high degree of attention (thus making them less susceptible to the effects of imperfect recollection).

34. However, the fact that the words which form by far the most distinctive unit in the applicants' trade mark appear first in its trade mark and are virtually identical to the unit of which the opponent's trade mark consists is, in my view, likely to lead the average consumer (even one paying a high degree of attention), to assume that the identical/highly similar goods at issue are simply an alternative/variant range of goods being offered by the opponent under its "UNCLE SAM" trade mark i.e. there will be indirect confusion.

The relevance of the applicants' evidence

35. In reaching the above conclusion, I have not overlooked the applicants' evidence. In its submissions, the opponent comments upon this evidence in the following terms:

"6...In particular, whether or not the applicant enjoys goodwill in the words UNCLE SAM or UNCLE SAM'S AMERICAN CIRCUS is irrelevant for the purposes of these proceedings."

7. The applicant's allegedly accrued goodwill is not a valid defence to, and can have no bearing on the outcome of, these opposition proceedings..."

36. In support of its submissions, the opponent draws my attention to guidance which first appeared in Tribunal Practice Notice ("TPN") 4 of 2009. The relevant parts of that TPN read as follows:

Defences including a claim that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.

1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but

only in cancellation proceedings brought in the Member State concerned (Case T 6/01 Matratzen Concord v OHIM - Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.

37. This TPN deals with the applicants' submissions and evidence in relation to both the existence of its earlier trade mark (registered in relation to circus services) and its claim to use of trade marks (but not the trade mark for which registration has been sought) also, primarily, in relation to circus services, which precedes the date of the opponent's earlier trade mark. As the TPN makes clear, these are not valid defences. The proper course of action is, as the TPN explains, for the applicants to apply to invalidate the

opponent's earlier trade mark. A review of the EUIPO's database prior to issuing this decision, indicates that the opponent's earlier trade mark is not subject to any cancellation actions.

Conclusion

38. The opposition has succeeded and, subject to any successful appeal, the application will be refused in respect of all of the goods in classes 25 and 28.

Costs

39. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of TPN 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicants' statement:	£200
Considering the applicants' evidence:	£250
Written submissions:	£200
Official fee:	£100
Total:	£750

40. I order Peter Mack and Richard Mack (jointly) to pay to Uncle Sam GmbH the sum of £750. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16TH day of May 2017

C J BOWEN

For the Registrar