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**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 325004
IN THE NAME OF
CARLSEN VERLAG GmbH
AND THE APPLICATION TO EXTEND PROTECTION IN THE UK TO**

PIXI

IN CLASS 16

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 72186
BY
RAINBOW SRL**

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND
THE TRADE MARKS ACT 1994**

IN THE MATTER OF International Registration No. 325004

In the name of Carlsen Verlag GmbH

And the application to extend protection in the UK to the trade mark:

PIXI

In class 16

AND IN THE MATTER OF opposition thereto

Under No. 72186

By Rainbow SRL

BACKGROUND

1. On 28 January 2010, the UK Trade Marks Registry was notified by WIPO of international registration (IR) 325004 (the above mark), in respect of which it had been designated under the relevant provisions of the Madrid Protocol.

2. The designation is in the name of Carlsen Verlag GmbH (hereafter the applicant) and is in respect of goods in class 16 of the Nice Classification System¹. The goods are as follows:

'Children's books and painting books for children.'

3. Following acceptance and publication of the designation on 9 July 2010 by the Registry, Rainbow SRL (the opponent) filed notice of opposition against the application.

4. The opposition was brought on grounds under section 5(2)(b) of the Trade Marks Act 1994 (the Act).

5. The opponent relies on the mark and goods shown below:

MARK DETAILS AND RELEVANT DATES	GOODS RELIED UPON
<p>IR(EC) 0945033</p>  <p>Date of International registration: 25 June 2007</p>	<p>Class 16</p> <p>Printed matter; artist's materials</p>

6. In its statement of grounds the opponent submits the marks are, *"visually highly similar,*

¹ International classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

aurally and connotatively identical". It considers the goods to be identical or highly similar.

7. On 17 December 2010, the applicant filed a counter statement which did not confirm whether or not it denied the grounds raised by the opponent. The counter statement was subsequently amended and re-filed on 17 January 2011. The applicant denies the grounds on which the opposition is based. It states:

"Both trade marks in question are not identical or similar. The trade mark of the opponent consists of four letters "PI IE" with a symbol of a butterfly or flower in between. The trade mark of the applicant is "PIXI"

...

If the opponent will bring forward that its graphical mark consists [sic] the word "PIXIE" then this word is only descriptive because it's another word for "fairy"".

8. The opponent's mark is an earlier mark which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.²

9. Both parties filed evidence; neither party asked to be heard. The opponent filed written submissions in lieu of attendance at a hearing; I will refer to these various submissions as necessary below.

EVIDENCE

Both parties have filed evidence in the form of witness statements by their respective representatives. However, the attached exhibits consist entirely of prints from the UK and Community Trade Mark Registers and a dictionary definition of the word 'pixie'. Consequently, I will not detail these here but will refer to them, where necessary.

DECISION

Section 5(2)(b) of the Trade Marks Act 1994, states:

"(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."

16. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

The CJEU cases

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; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 great 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods at issue. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

In its submissions the opponent states:

“We submit that the average consumer of the relevant goods will be members of the general public.

...

The relevant consumer will acquire the goods by self-selection either online, or from a physical premises or potentially by asking for them by name in a retail store or by orders over the telephone. The relevant goods are likely to be of relatively low cost. The process of purchasing the relevant goods will involve both a visual and aural aspect. There is no reason to expect the purchasing act will involve anything other than a reasonable to low degree of care or attention.”

I agree that the average consumer will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made, in the manner described by the opponent, from a website, catalogue or directly from a shelf. However, I do not ignore aural considerations as, in my experience, particularly in the case of books, it is not unusual to ask for a book rather than try and locate it on a particular shelf. The purchaser will pay a reasonable degree of attention, to the extent that they will ensure they are selecting a product, inter alia, for a particular task or containing the correct subject matter. In the case of products for children it is likely that the purchaser will also consider age group, topic, suitability, etc. However, these are relatively low value, fairly frequent purchases.

Comparison of goods

The goods and services to be compared are as follows:

The opponent’s goods	The applicant’s goods
Printed matter; artist's materials	<i>Children's books and painting books for children</i>

In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

In its submissions the opponent identifies Meric and concludes:

“In this case, ‘children’s books and painting books for children’ the subject of the Contested Application would fall within the more general category of ‘printed matter’ and artist’s materials’ covered by the Earlier Trade Mark. It is clear therefore, that the goods of the Contested Trade Mark and Earlier Trade Mark are identical.”

The opponent’s specification in class 16 includes the broad term ‘printed matter’, which can clearly include ‘children’s books and painting books for children’ (the opponent’s goods). Therefore the goods are identical in accordance with the *Meric* principle.

Comparison of marks

The marks to be compared are:

Opponent's mark	Applicant's mark
	

In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components³, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

Dominant and distinctive components

The applicant submits in its counterstatement that the opponent’s mark is the letters ‘PI’ and ‘IE’ ‘with a symbol of a butterfly or flower in between’. In its submissions the opponent states:

“Although the stylised X is proportionally larger than the other letters in the mark, the average consumer cannot fail to recognise the mark on [sic] being the word ‘PIXIE’.”

In my view, there is nothing in the presentation of the oversized letter ‘X’ to suggest that it represents a flower or a butterfly. The average consumer will recognise the letters ‘pi’ and ‘ie’ more easily than he does the letter ‘x’ but will not attempt to divide the mark into its constituent parts and will recognise the mark as the word PIXIE.

Due to its size and position within the mark and the fact that it possesses a high level of distinctiveness, the oversized letter “X” is a distinctive element of the mark. Nevertheless, the letters “pi” and “ie” cannot be ignored as they are fundamental in providing the mark with its identity, that of the word PIXIE. While the word PIXIE alone is possessed of a fairly low degree of distinctive character, given the nature of the goods, the distinctiveness of the mark in its totality resides in the combination of the word together with the device element.

³ *Sabel v Puma AG, para.23*

The applicant's mark consists of the single word 'PIXI' presented in plain upper case letters. Its distinctiveness lies in its totality.

In respect of the comparison of marks the applicant does not accept that the opponent's mark would be seen as the word 'pixie' and suggests that it consists of the four letters 'PI' and 'IE' with a device in between. It concludes that only the first, second and third letters are identical which:

"...is not even enough to anticipate a similarity that gives reason for a likelihood of confusion on the part of the public or the likelihood of association with the earlier trade mark."

Since the opponent has provided comments in relation to each aspect of the comparison I will refer to these as appropriate below.

Visual similarities

The opponent submits:

"...the average consumer will see the stylised X in the Earlier Trade Mark to be an X and therefore there is a high level of visual similarity between the Contested Trade Mark and the Earlier Trade Mark."

The opponent's mark contains an enlarged "x" device in the centre. On the left hand side of this device are the letters "pi" and, on the right, the letters "ie". The effect of this presentation is that the mark appears as the word PIXIE, with an enlarged letter "X". The similarity between the marks rests in the letters 'PIXI' which are the first four letters of the opponent's mark and the entirety of the applicant's mark. The first, second, fourth and fifth letters of the opponents mark are presented in lower case while the applicant's mark is presented entirely in upper case. The opponent's mark includes the additional stylisation to the central letter 'X' which is also considerably larger than the rest of the word. The differences in case between the two marks are unremarkable, and are of the kind the average consumer will be used to encountering and may not even notice. Taking all of these factors into account, I consider there to be a moderate degree of visual similarity between the marks.

Aural similarities

The opponent submits that the lack of a final 'E' in the applicant's mark does not change the pronunciation of the mark, which will be pronounced 'pixie' and concludes that the marks are aurally identical.

I have already concluded above that the average consumer will see the opponent's mark as the word 'pixie'. This is also how he will articulate the mark. The applicant's mark consists of the word 'PIXI'. I agree with the opponent that the lack of an 'E' at the end of the applicant's mark does not alter the pronunciation. In my view both marks will be pronounced 'PIK-SEE'. They are aurally identical.

Conceptual similarities

For a conceptual meaning to be relevant it must be one capable of immediate grasp by the

average consumer.⁴

The applicant provided a definition of the word 'pixie' from the Oxford Paperback Dictionary⁵ as follows:

'A small supernatural being in fairytales.'

The opponent provides the following definition from the 10th edition of the Chambers Dictionary:

'A small fairy'.

The applicant states:

"...the word 'PIXI' has no meaning in the English Language."

The opponent states that its own mark will be seen as the common word 'pixie' and concludes:

"The Contested Trade Mark consists of the four letters PIXI in plain block capitals. Both the Earlier Trade Mark and the Contested Trade Mark will be read and understood to be the word 'pixie'..."

Conceptually, the opponent's mark will be understood as a reference to the common word 'pixie'. I agree that it is likely that the average consumer would understand the applicant's mark to also be a reference to the known word 'pixie', either because the words are similar or because they do not notice the difference in spelling. If this is the case, then the marks are conceptually identical. However, it is also possible, as the applicant suggests, that the average consumer will view the mark 'PIXI' to be a made up word. Nevertheless, even in those circumstances, in my experience, misspellings of words are common in advertising and consequently, it is much more likely that the average consumer will either consider the applicant's mark to be the word 'pixie' or will see it as a reference to it. Consequently, I find the marks to be conceptually identical.

Distinctive character of the earlier mark

The inherent 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 used 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.

As no evidence has been filed I need only consider the inherent distinctive character of the mark. The mark is not descriptive of the goods but, as I have stated above, is possessed

⁴ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

⁵ 3rd edition, Oxford University Press.

of a fairly low level of inherent distinctive character. However, the highly distinctive device element in place of the letter 'X', enhances its distinctive character. Consequently, I conclude the earlier mark has a reasonably high level of distinctive character .

Likelihood of confusion

In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁶ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and must have regard to 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.

In its evidence the opponent draws my attention to a number of marks which contain words such as 'UNICORN', 'VAMPIRE', 'GIANTS' and 'BAD FAIRY'. It states:

"6. If the Holder's contention (letter and witness statement) of 20 April 2011 are accepted as true, then the UK Intellectual Property Office has clearly erred in accepting the Contested UK Designation of International Registration No. 325004 for the mark PIXI.

7. It is, however, submitted that supernatural beings, fantastical or mythological creatures, are all perfectly capable of functioning as trade marks, which is supported by the examples given above which are clearly on a par with the word PIXI."

It is clear from a number of cases decided by the courts of the UK and the Community, that state of the register evidence of this sort does not assist the opponent.⁷

I have found that the marks share a moderate degree of visual similarity and are aurally and conceptually identical. I have also identified a reasonably high level of inherent distinctive character in the opponent's earlier mark. I have concluded that identical goods are involved according to the principles in *Meric*. I have identified the average consumer, namely a member of the general public who buys books and printed matter. I have concluded that the purchasing act will, generally, be visual but may include an aural element, particularly where the average consumer asks for a book rather than locating it himself on a shelf. The purchase will involve a reasonable degree of care and attention.

Taking all the above factors into account, and considering the marks as wholes, I conclude that the differences between the marks are insufficient to outweigh the obvious similarities. Given that identical goods are involved I find the average consumer is likely to mistake one mark for the other i.e. there would be direct confusion. Even if I am wrong in this regard, I find that the average consumer would consider the goods to come from economically linked undertakings, i.e. there would be indirect confusion.

Conclusion

The opposition succeeds.

⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27

⁷ See, in particular, *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 and *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 the General Court (GC)

COSTS

The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and the opponent filed evidence as well as written submissions in lieu of a hearing. I make the award on the following basis.

Preparing a statement and considering the other side's statement:	£ 200
Preparing evidence and considering the other side's evidence:	£ 500
Written submissions:	£ 200
Official fee:	£ 200
Total:	£ 1100

I order Carlsen Verlag GmbH to pay Rainbow SRL the sum of £1100. 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 10th day of September 2012

**Ms AI Skilton
For the Registrar,
The Comptroller-General**