

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION TO REGISTER  
TRADE MARK NO 2171117 IN CLASS 16 IN THE  
NAME OF MARS U.K. LIMITED**

On 2 July 1998, Mars U.K. Limited of 3d Dundee Road, Slough, Berkshire SL1 4LG, applied to register the mark:-

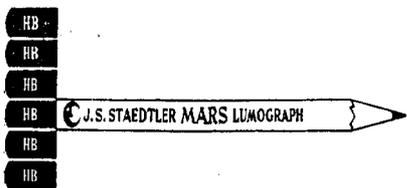


in Class 16 respect of:-

“Books, printed matter, posters, and stationery; books, printed matter, posters and stationery for personal recruitment”.

Objection was taken under paragraph (b) of Section 3(1) of the Act on the grounds that the mark was devoid of distinctive character for example printed matter relating to the planets.

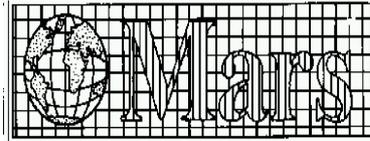
Objection was also taken under Section 5(2) of the Act in respect of the following marks:

| Number  | Mark  | Class | Specification  |
|---------|---|-------|--|
| 320845  | Mars  | 16    | Stationery   |
| 729792  |  | 16    | Pencils  |
| 1227269 | Mars Mastercoin   | 16    | Printed publications for instructional and teaching purposes; all relating to the analysis and operation of computerised apparatus and instruments; but not including any such goods relating to planetary research.   |
| 1565988 | Mars Plot   | 16    | Stationery; pens, pencils, felt pens, fountain pens, ball point pens, technical pens, mechanical-action pencils, propelling pencils, push-button pencils, pencil lead, nibs, ink pens, disposable liquid ink pens, refillable liquid ink pens, refillable liquid ink points, refillable liquid ink plotter points, adaptors, |

drawing inks, cartridges, plastic tipped cartridges, ballwriter cartridges, pressurized ballpoint cartridges, ultrasonic cleaners, cleaning bulbs for plotter pens, storage units for pens, pen caddies, seals to prevent leakage in storage carousels; fittings for all the aforesaid goods.

2027632

35



Recruitment services, personnel management consultancy services, updating of advertising material related to recruitment.

E788687

16



Pens, pencils, crayons, writing or drawing implements, artists' materials; office requisites; postcards, stickers, photographs, greeting cards; diaries, journals, printed matter, stationery; books; decalcomanias; gift wrap; playing cards; globes, adhesives in class 16; files, binders; pencil cases, placemats of paper; photo frames; modelling materials; paper tablecloths or table linen, paper handkerchiefs, paper napkins, babies' paper bibs, babies' disposable napkins, posters, writing or drawing books, plastic packaging materials.

In response to the examination report dated 17 July 1998, Ms. Claire Hutchinson, of Grant Spencer Caisley & Porteous, the agents of the applicants, agreed in her letter of 18 January 1999, to add the following exclusion, "but not including any such goods relating to planets". Subsequently, the Section 3(1)(b) objection was waived and I need therefore make no further reference to this objection.

In relation to the Section 5 objections raised at the examination stage, application numbers 1227269, 2027632 and E788687 are technical citations. Application No. 2027632 is now in the same ownership as the applicant and in correspondence the agent indicated that a letter of consent would be provided to overcome E788687. Although No. 1227269 has not been mentioned specifically in correspondence, it appears the proprietor of that mark is closely allied to the applicant and a letter of consent may have been provided as proposed in relation to No. E788687. If this is not the case my comments relating to the remaining citations are valid for this mark.

In respect of citations 320845, 729792 and 1565988 in the name of J.S. Staedtler GmbH & Co. the agents indicated in their letter of 18 January 1999, that the applicants were in negotiations with the owners with a view to obtaining consent.

The agents also agreed to the following colour claim, “The applicants claim the colours red, brown and grey as an element of the mark”.

In response to the letter of 18 January 1999, the agents were allowed to the 17 April 1999 to resolve the outstanding Section 5 objections. However, by the 20 May 1999, no response had been received and the application was therefore refused in accordance with Section 37(4) of the Act.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence of use has been put before me, I have, therefore, only the prima facie case to consider and the provisions of Section 7(2) of the Act are not applicable.

Section 5(2) of the Act reads as follows:-

5. (2) A trade mark shall not be registered if because -
  - (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
  - (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.

Dealing firstly with the respective goods, it is immediately apparent that the goods contained within the specification of the application are identical to, or contained within the broader specification of the earlier applications. Consequently, the matter hinges on the question of the similarity between the respective marks. However, the application could have proceeded for a specification limited to, “books, printed matter, posters; printed matter, books, posters for personnel recruitment; but not including any such goods relating to planets”.

Since the mark of this application is not identical to the cited marks the matter falls to be decided under sub-section (b) of Section 5(2). The question, therefore, is whether the mark of this application is so similar to the marks of the cited applications that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

In the Sabel v Puma trade mark case (C-251/95), The European Court Of Justice stated:

22. “...In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

23. The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive- "...there exists a likelihood of confusion on the part of the public..."- shows that the perception of marks in the minds of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.
24. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.

The judgement links the question of a likelihood of confusion to two factors; the conceptual similarity, and whether the earlier mark has a particularly distinctive character, either *per se*, or by reputation. The earlier marks and the mark applied for include the same word and I would take this as constituting a "conceptual" similarity. The earlier marks all comprise the word "MARS" either alone or in combination with descriptive or other distinctive matter while the applicant's mark consists of the identical word combined with a globe device. I should mention that the word "MARS" has no other meaning other than that of a Roman god or the fourth planet from the sun.

I have no reason to assume that the cited marks were wrongly accepted and must be considered to have a distinctive character. Whilst the presence of a device element in the present application renders it visually distinctive, the mark would still be viewed and referred to as a "MARS" mark. Therefore, I must take the view that if "MARS" is distinctive, then the public when seeing the applicants mark would associate it with marks already known to them.

Therefore, I consider there is a likelihood of confusion between the applicants mark and the cited marks, which includes the likelihood of association with the earlier marks.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 23 day of November 1999

CRAIG REDMORE  
For the Registrar  
The Comptroller General