

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2213986
BY THE ORIGINAL FISH COMPANY LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASS 21

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 50925 BY UNIQUE CONCEPTS LIMITED**

TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2213986 by
The Original Fish Company Limited
to register the trade mark:



in class 21
and
IN THE MATTER OF Opposition thereto under No 50925
by Unique Concepts Limited.

Background

1. On 11 November 1999 The Original Fish Company Limited of Daventry, Northampton applied to register the trade mark:



in respect of the following goods: *small domestic utensils and containers; corkscrews; bottle openers; devices for removing corks from bottles; drinking vessels; decanters; stoppers; pouring spouts; ice bowls, ice buckets and moulds for ice cubes; instruments, materials, cloths and brushes for cleaning purposes; glassware, porcelain, ceramics and earthenware; trays; carriers; napkin rings; coasters; cocktail shakers and stirrers* - in class 21.

2. On 19 April 2000 Unique Concepts Limited of Adel, Leeds filed notice of opposition to this application.

The opponent stated that he is the registered proprietor of United Kingdom registration no 2204480 of the trade mark:



which is registered in respect of: *small domestic utensils and containers; glassware, porcelain and earthenware; drinking vessels and glasses and cloths for cleaning the aforesaid goods; ice bowls and ice buckets; syphons for carbonated water; corkscrews, bottle openers, devices for removing corks from bottles; pouring spigots and spouts; cocktail shakers, cocktail stirrers (sticks), moulds for ice cubes, brushes for cleaning bottles; trays; pipettes (wine-testers), wine tasters* - in class 21.

3. The opponent claimed that he is successor in title to Bacchanal Limited, who had commissioned and paid for his trade mark. He stated that the respective trade marks are confusingly similar and to all intents and purposes identical in appearance. He stated that the following goods of the application in suit are identical to those of his earlier registration:

small domestic utensils and containers; corkscrews; bottle openers; devices for removing corks from bottles; drinking vessels; pouring spouts; ice bowls, ice buckets and moulds for ice cubes; cloths and brushes for cleaning purposes; glassware, porcelain, earthenware; trays; cocktail shakers and stirrers.

4. He stated that the following goods of the application in suit are similar to the goods of his earlier registration:

decanters; stoppers; instruments and materials for cleaning purposes; ceramics; carriers; napkin rings; coasters.

Consequently in respect of the goods he claimed that are identical he stated that registration of the application in suit would be contrary to section 5(1) of the Act; in respect of goods which are similar, registration would be contrary to section 5(2)(a).

5. The opponent stated that registration of the application in suit would be contrary to the provisions of section 5(4)(b) of the Act; in that use of the application in suit is liable to be prevented by the law of copyright and/or design right.

6. The opponent stated that the applicant knew of the opponent's rights in the trade mark and so the application was made in bad faith and contrary to section 3(6) of the Act.

7. The opponent sought an award of costs.

8. The applicant filed a counterstatement.

The applicant denied that the opponent is the successor in title to Bacchanal Limited and that Bacchanal Limited commissioned the earlier trade mark.

9. The applicant admitted that the respective trade marks are substantially identical. He admitted that the following goods are either identical or similar:

small domestic utensils and containers; corkscrews; bottle openers; devices for removing corks from bottles; drinking vessels; decanters; stoppers; pouring spouts; ice bowls, ice buckets and moulds for ice cubes; instruments, materials, cloths and brushes for cleaning purposes; glassware, porcelain, ceramics and earthenware; trays; cocktail shakers and stirrers

10. The applicant denied that *carriers, napkin rings and coasters* are either identical or similar to the goods of the earlier registration.

11. The applicant denied the other grounds of opposition and sought an award of costs.

12. Only the opponent filed evidence. Neither party requested to be heard and so a decision will be given from the papers.

13. Acting on behalf of the Registrar I duly give the following decision.

Opponent's evidence

14. The opponent's evidence consists of a statutory declaration by Huw Anthony, who was the managing director of Bacchanal Limited, dated 5 January 2001. Mr Anthony's declaration deals with the history of the "lazy fish" device and the rights in the property of Bacchanal Limited. Owing to the findings I make below in relation to the section 5(1) and (2)(a) issues I do not consider it necessary to rehearse the essential points of the evidence.

Opponent's submission

15. The opponent submitted a "submission". In fact this was a deed of assignment and as such in no way could be considered to be a submission. This clearly is evidence. As the opponent did not make a request for additional evidence under rule 13 (11) to be adduced into the proceedings I take no account of this deed of assignment.

Decision

16. The grounds of opposition pursued by the opponent are those under sections 5(1), 5(2)(a), 5(4)(b) and 3(6) of the Trade Marks Act 1994. The relevant provisions read as follows:

Section 5:

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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."

Section 3:

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Section 5(1) objection

17. I consider that the respective trade marks are identical.

18. The following goods are rehearsed in the specification of the earlier registration:

small domestic utensils and containers; corkscrews; bottle openers; devices for removing corks from bottles; drinking vessels; pouring spouts; ice bowls, ice buckets and moulds for ice cubes; ; glassware, porcelain, and earthenware; trays;; cocktail shakers and stirrers

The goods are, therefore, identical.

19. As the trade marks and goods are identical the application must be refused in respect of the above goods.

Section 5(2)(a) objection

20. In determining the question under section 5(2)(a), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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.* page 84, paragraph 27.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

(f) 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 BV v. Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;

(h) further, 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; *Marca Mode CV v. Adidas AG*

page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

21. It has already been decided that the respective signs are identical. The applicant only disputes whether the following goods are identical or similar:

carriers; napkin rings; coasters

22. Therefore, I believe it necessary to only analyse whether these particular goods are similar to the goods of the earlier registration.

23. In *Canon* the European Court of Justice held, in relation to the assessment of the similarity of goods, that the following factors inter alia should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

24. The earlier registration includes *glassware* at large. *Napkin rings* and *coasters* could be items of glassware, in such a respect the goods would be identical. If the aforesaid goods were made of another material they would still be similar in all other ways to the same goods made of glass. Therefore, I consider that *napkin rings* and *coasters* are, depending upon the circumstances, either identical or similar to the goods of the earlier registration.

25. The term *carriers* is somewhat vague. The nature and purpose of the *carrier* is not defined. In such circumstances I consider that I must consider the term in its full potential meaning. A *tray* is a *carrier*; it serves the purpose of carrying objects. As such *carriers* are potentially identical to *trays*. If the *carrier* is not a tray it could still readily have exactly the same purpose as a *tray*; wherein it would potentially have the same nature, end user, method of use and be in competition with the latter goods. Therefore, I consider that *carriers* and *trays* are, depending upon the circumstances, either identical or similar.

26. I, therefore, find that all the goods of the application in suit which have not been covered by my decision in respect of section 5(1) are similar to the goods of the earlier registration, indeed some are potentially identical.

Conclusion

27. The device of a fish sitting in a chair, smiling as he imbibes enjoys a high degree of inherent distinctiveness in relation to the goods in question. It is such an unusual device that the public would be most surprised if two different undertakings were using it. Consequently in respect of similar goods:

decanter; stoppers; ice bowls, instruments, materials, cloths and brushes for cleaning purposes;

ceramics; carriers; napkin rings; coasters

28. I have no doubt that there is a likelihood of confusion.

29. I note that the applicant put the opponent to strict proof that he is the successor in title to Bacchanal Limited. In relation to the objections under section 5(1) and (2)(a) this is not relevant. The opponent does not require a locus standi. However, it is to be noted that the opponent is indeed the registered proprietor of registration no 2204480.

Section 5(4)(b) and section 3(6) objections

30. The opponent could succeed to no greater of extent under these grounds of opposition and so I will say no more about them.

31. Consequent upon the above findings the application is to be refused in its entirety.

32. The opponent is entitled to a contribution towards his costs and I therefore order the applicant to pay him the sum of £535. 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 22ND day of October 2001

**D.W.Landau
For the Registrar
the Comptroller-General**