

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2162848  
BY KISS FM RADIO LTD AND ALEXANDRA STILLMAN  
TO REGISTER A SERIES OF TRADE MARKS IN CLASSES 9, 16, 38 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 50083  
BY CREAM HOLDINGS LTD**

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by Cream Holdings Ltd**

### **DECISION**

1. On 31 March 1998 Kiss FM Radio Ltd applied to register COOKIES AND CREAM and COOKIES & CREAM as a series of marks for the following specification of goods and services:

“Class 9:

Computer software, computer programs, computer databases; data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; pre-recorded videos and tapes, compact discs; CD-ROMS; CDI's; publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites).

Class 16:

Printed matter, printed publications, magazines, periodical publications, newsletters; address books, note books, diaries, calendars; pictures, photographs, posters; banners, flags and pennants; labels, decals, stickers, emblems, badges; writing utensils, pens, pencils; paper bags; plastic bags; party goods, paper party decorations; dry transfer characters, iron-on transfers; temporary tatoos.

Class 38:

Radio broadcasting services.

Class 41:

Production and presentation of radio programmes; entertainment, instruction and education services by means of or relating to radio broadcasting; organisation of competitions relating to radio programmes; organisation and production of entertainment, musical, recreational and dance events; organisation and provision of live entertainment, musical, recreational and dance events; provision of facilities for entertainment, musical, recreational and dance events.”

2. The application is numbered 2162848. The application has since been assigned to Kiss FM Radio Ltd and Alexandra Stillmann.

3. On 19 August 1999 Cream Holdings Ltd filed notice of opposition to this application. They are the proprietors of the CTM application, details of which are shown in the Annex to this decision. They claim to have made use of, and to enjoy a substantial reputation in this mark. They say that:

“The trade mark the subject of application no. 2162848 is confusingly similar to the opponents trade marks and is to be registered for goods or services identical with or similar to those for which the opponents trade marks are protected. Accordingly, the trade mark applied for should be refused registration in accordance with the provisions of Section 5(2)(b) of the Trade Marks Act 1994 (‘the Act’).”

4. Further objections are raised under Sections 1(1)/3(1)(a), 3(3), 3(4), 3(6), 5(3) and 5(4) of the Act without explanation as to the basis for such objections. The opponents seek refusal of the application in its entirety.

5. The applicants filed a counterstatement denying the above grounds.

6. Both sides ask for an award of costs in their favour.

7. Both sides filed evidence. The case was reviewed by a Hearing Officer who indicated that as no evidence had been filed to support the grounds other than that under Section 5(2)(b) that those other grounds should be struck out. He suggested that the sole remaining ground could be determined without the need for a hearing. The parties were nevertheless reminded of their right to be heard or to offer written submissions. In the event neither side has asked for a hearing. I note that a letter from Urquhart-Dykes & Lord, the applicants’ professional representatives, dated 28 February 2002 contains what amount to submissions.

8. Acting on behalf of the registrar and with the above material in mind I give this decision.

9. The opponents have not commented on, or sought to rebut, the preliminary view that all the grounds bar Section 5(2)(b) should be struck out. I can see no obvious basis in evidence or submissions for the other grounds. I, therefore, dismiss all grounds except Section 5(2)(b).

10. Section 5(2)(b) reads:

“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.”

11. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* 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*, paragraph 23;
- (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*, paragraph 23;
- (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*, 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*, 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*, paragraph 26;

- (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*, 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*, paragraph 29.

12. The evidence filed in this case is as follows:

**Opponents' Evidence in chief:**

Statutory Declaration by Roger Stuart Grimshaw with Exhibits RSG1-2;  
Statutory Declaration by Roger Stuart Grimshaw with Exhibit RSG1;  
Statutory Declaration by Matthew John Naylor with Exhibits MJN1-4.

**Applicants' Evidence in support:**

Witness Statement by Andrew Pickering with Exhibit AP1.

13. It will suffice at this point to refer to those parts of the parties' evidence which go to their activities to date under the respective marks.

14. Mr Grimshaw is a trade mark attorney in the firm of Mewburn Ellis who act for the opponents. The information in his declaration is said to come from Mr Stuart Davenport of the opponent company or from his own knowledge. Mr Grimshaw says that:

“The opponents commenced use of the trade mark ‘CREAM’ in the UK in October 1992. The mark was initially used in relation to a nightclub based in the city of Liverpool. The opponents reputation in their mark CREAM grew rapidly. It would be no exaggeration to state that the mark ‘CREAM’ is one of the most well known marks in the music/nightclub industry and has been for many years. By 1995 the nightclub had a capacity of 3000 people however their popularity was such that on occasions up to 5000 would queue for entry, travelling from throughout the country. The company’s success and consequent reputation in the trade mark ‘CREAM’ has continued to expand. Further nightclubs have been opened in other parts of the country and abroad. For example, the opponents reputation in the mark ‘CREAM’ has no doubt been further enhanced by their nightclub activities under the CREAM mark on the island of Ibiza since 1995. Tens of thousands of British holiday makers will have visited the club whilst on their holidays.

Over the years, the contribution of the opponents to dance culture and the music industry has been formally recognised with many prestigious awards including ‘Club of the Year’ in 1998, awarded by the leading music magazine ‘MIX MAG’.

The mark 'CREAM' has also been used for many years in relation to compilation albums sold on record, tape and compact disc. The mark has also been successfully used on a range of clothing for many years and the marks reputation has been further enhanced by its use in relation to an annual music festival under the name of 'CREAMFIELDS' in the UK and elsewhere.

The opponents have publicised their mark CREAM widely since 1992 with advertisements in many leading magazines including 'MIX MAG', 'MUZIK', 'FACE', 'SKY' and 'NME'. Furthermore, the mark has also been widely publicised for many years through television, radio and poster sites."

15. In his second statutory declaration Mr Grimshaw exhibits (RSG1) copies of advertisements placed in 'Mixmag' and 'The Face' magazines.

16. Mr Pickering who gives evidence for the applicants is the Business Manager of Kiss FM Ltd. He says that the applied for mark was first used in the UK on 31 May 1997 in relation to entertainment services, live entertainment events, live musical events together with associated advertising, publicity material and merchandise. The collection of materials exhibited at AP1 showing use of the mark suggests that COOKIES AND CREAM is a DJ hosted musical event which takes place at a number of London venues with different tastes catered for in separate event rooms. A turnover of £235,624 is said to have been generated in 1997. The 1998 figure is not broken down between the period up to and after the material date of 31 March 1998.

17. There is other evidence and submissions but I propose to introduce this material at relevant points in my consideration of the issues below.

### **The marks at issue**

These are:

**Applicants' series of marks**

**Opponents' mark**

COOKIES AND CREAM

COOKIES & CREAM

18. The mark relied on by the opponents is a CTM application with a filing date of 16 September 1997. At the time of writing this decision it had not progressed to registration. The position is, therefore, that it has the capacity to be an earlier trade mark within the meaning of Section 6(1)(a) by virtue of its earlier filing date but will not achieve the necessary status until such time as it is registered (Section 6(2)).

### **Similarity of goods and services**

19. The opponents' position is that the goods and services claimed by the applicants in Classes 9, 16 and 41 are identical to those claimed in the opponents' application No. 647024 covering those Classes and that the applicants' Class 38 services are similar to the opponents' 'entertainment and leisure services', 'production of radio programmes' and 'musical performances'. The submissions on behalf of the applicants contained in Urquhart-Dykes & Lord's letter of 28 February 2002 and Mr Pickering's evidence (paragraph 4) are silent on the matter of the goods and services. As both parties are operating in the musical entertainment field it is not unexpected that those interests are reflected in the specifications of goods and services sought. I agree with the opponents that there is considerable overlap in Classes 9, 16 and 41 resulting in identical and/or similar goods. The position in relation to the applicants' Class 38 services is more arguable. However, on balance I consider that the connection between the production of radio and television programmes and the broadcasting of those programmes is sufficiently close for these services to be similar too.

### **Distinctive character of the opponents' mark**

20. The distinctive character of the opponents' mark is a factor to be borne in mind in coming to a view on the likelihood of confusion (*Sabel v Puma*, paragraph 24). That distinctive character can arise from the inherent nature of the mark or be acquired through use.

21. The opponents' mark consists of the word CREAM surmounted by a device. The device is an unusual, and visually striking element in the mark. Neither the device nor the word CREAM appear to have any descriptive significance in relation to the goods or services. The combination of features makes for a highly distinctive mark.

22. Mr Grimshaw claims that "it would be no exaggeration to state that the mark 'CREAM' is one of the most well known marks in the dance/nightclub industry ....". That may be so but the evidence on the matter is not particularly strong. In particular it lacks quantification of numbers attending (other than a snapshot), turnover etc. The opponents' position is not improved on the basis of the evidence of use before me. But that is not a significant disadvantage in itself given the strong inherent characteristics of the mark.

### **Similarity of marks**

23. I am required to consider the matter from a visual, aural and conceptual perspective. The considerations are relatively straightforward so far as the first two are concerned. The word CREAM features as an element in both marks and is therefore, a point of similarity between them. There are also clear visual differences arising from the presence of the strong and prominent device element in the opponents' mark and the other words in the applicants' series.

Oral references to the opponents' mark are more likely to concentrate on the word CREAM, it being more difficult to know how or whether the average consumer would try to refer to the device (Mr Pickering, who gives evidence for the applicants, refers to it as a propeller device). The impact of the device is less likely, therefore, to be an influencing factor in oral usage. Conceptual considerations seem to me to be of some importance when comparing marks of this kind. In that respect the applicants' mark strikes me as more than the simple conjoining of two unrelated words or ideas. The words COOKIES AND CREAM seem to 'hang together' – perhaps because of familiarity with comparable expressions such as strawberries and cream. Further there is nothing inherently improbable in the idea created by the mark - cookie or cooky being a North American term for a cake or biscuit which would generally be understood in this country. I note with interest that the responses to a small survey conducted on behalf of the opponents to gauge reaction to the term COOKIES AND CREAM reveals a large number of people making an association with Haagen Daz ice cream. In all, almost a third of the people interviewed referred to ice cream. I am not suggesting that too much should be made of this point but it does provide some support for the view that COOKIES AND CREAM conjures up an idea of its own.

### **Likelihood of confusion**

24. Mr Grimshaw's evidence exhibits (RSG2) the results of a search of the UK and CTM registers for marks containing the word CREAM in Classes 9, 16, 38 and 41. Apart from the marks at issue only two marks were found, one a pending application for MILLIE'S ICE CREAM and the other a registration in the name of two individuals who are said to be directly related to the opponents. The suggestion is, therefore, that the only relevant marks in the above-mentioned Classes containing the word CREAM are the mark under opposition and the mark of the opponents or their associates. I note these circumstances but am not persuaded that the register position necessarily has any bearing on the question of likelihood of confusion.

25. I should, at this point, refer in a little more detail to the survey mentioned above. The results are exhibited to Mr Naylor's declaration. The declaration itself sets out the basis on which it was conducted and briefly summarises the results. Guidance on surveys can be found in *Imperial Group Plc v Philip Morris Ltd* [1984] RPC 293 (the RAFFLES case). A market research company, QCL Market Research, was commissioned to undertake the survey with instructions to conduct face to face interviews with around 100 people in the age range 17 to 24 years old. In the event some 115 questionnaires were completed by individuals within the age band specified. Interviewees were shown a card bearing the series of marks applied for and invited in question 1 to say whether it meant anything to them in relation to (a) recorded music (b) magazines (c) radio stations or programmes and (d) a nightclub or nightclub events. Further questions invited interviewees to say whether they associated either of the marks with any particular source and whether they would have given the same answer in March 1998.

26. Some 30 people are shown to have made some reference to the opponents' CREAM club in response to Q1 (d). There are some positive references in response to the other parts of Q1 but too few to be of significance.

27. I have no reason to suppose that the survey was not conducted fairly within the parameters prescribed by the commissioning trade mark attorney. However, I consider that it suffers from a number of defects which must cast doubt on its value to the opponents. The main ones seem to me to be:

- only a relatively small number of interviews took place. I doubt that 115 people could be considered “statistically significant” within the meaning of the RAFFLES test;
- the age range of people chosen for interview and the location (central Liverpool) meant that the survey was heavily skewed in favour of an outcome favourable to the opponents whose original nightclub is based in the city of Liverpool;
- interviewees were quite properly invited to say whether they would have responded in the same way in March 1998. A significant number of the 30 positive responses said ‘No’ or expressed doubts. Given that the survey was conducted almost 3 years after the material date, that the club only started in 1992 and was presumably building its reputation in the ensuing years some care must be exercised in interpreting the responses given;
- the questions asked (in particular Q1) must inevitably have led to some speculation on the part of interviewees, a problem that may have been exacerbated by the choice of location (it is not clear whether the survey was also conducted in close proximity to the nightclub);
- despite the basis on which the survey was conducted and the somewhat leading nature of the questions the results show only a modest degree of association between the marks applied for and the opponents’ club. That is particularly so if one eliminates from the 30 positive responses those who did not know, or were not sure, if they would have made the same association in March 1998 or made other associations with ice cream, biscuits or sweets.

The end product is that I find little assistance in the survey in reaching a view on the likelihood of confusion.

28. In reaching my own view of the matter I take into account the fact that identical goods and services are involved and that there are points of similarity and dissimilarity between the marks. I have little hesitation in concluding that the composite nature of the opponents’ mark and the different conceptual connotations inherent in the applied for series of marks leads me to the view that there is no likelihood of direct confusion.

29. On the other hand, it seems to me that, the element CREAM in the applicants’ mark will not go unnoticed. For some people it may bring to mind the opponent’s mark. CREAM is, after all, a particularly distinctive and, one might say, unusual name for the core nightclub/musical entertainment services. The key question that then arises is what is the

nature of that association – points (g) to (i) of the criteria distilled from the ECJ cases are relevant in this respect?

30. Is it simply a case of the applicants' mark bringing to mind the opponents' mark? Or would that association have the further consequence that the public would wrongly believe that goods and services supplied under the respective marks emanated from the same trade source? Giving the matter the best consideration I can I have concluded that the association, to the extent that it exists, is not a strong one. I am not persuaded that it is such that the public would be confused as to trade origin. The opposition therefore, fails. As a consequence I do not need to consider the possible question of suspension to await the fate of the opponents' trade mark application, CTM No. 647024.

31. The applicants have been successful and are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £700. 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 9<sup>th</sup> day of December 2002**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**