

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2257927
OF THE TRADE MARK :**

SUNNY CITIES

IN THE NAME OF SUNNY CITIES LTD

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 80045
BY SUN MICROSYSTEMS INC**

**In the matter of registration no 2257927
of the trade mark: SUNNY CITIES
in the name of Sunny Cities Ltd
and the application for an application for a declaration of invalidity
thereto under no 80045
by Sun Microsystems Inc**

Background

1) On 29 August 2001 Sun Microsystems Inc filed an application for a declaration of invalidity in relation to trade mark registration no 2257927 standing in the name of Sunny Cities Ltd. The trade mark was filed on 12 January 2001 and registered on 13 July 2001 in respect of the following goods and services:

computer software for use in designing, installing and executing mainframe and client/server application programs, and for managing of enterprise-wide risks of a business

business management consulting, business consulting, and project management in the fields of information technology and risk management; personnel placement and recruitment services; employment agency services; dissemination of advertising for others via an on-line electronic communications network

risk management services; financial services, valuation of financial products; information in the field of risk management provided via a global computer network

mediation services; providing information in the field of information technology by means of a global computer network; computer services, providing databases and on-line bulletin boards in the fields of risk management and information technology; information technology consulting services; computer software design for others; computer site design; installation, implementation, maintenance, and repair services with respect to computer software.



The goods and services are registered in classes 9, 35, 36 and 42 respectively.

Grounds for application of invalidity

2) The applicant states that he carries on business in the fields of computers, information technologies, communication technologies and related goods and related services.


3) The applicant states that he is the proprietor of the following United Kingdom trade mark registrations which include the element “SUN” as an essential feature and that they constitute a family of trade marks:


TRADE MARK	REGISTRATION NO	CLASS
SUN	1502653	9

	1256594	9
	1502557	9
SUN WORKSTATION	1188313	9
SUN MICROSYSTEMS	1256593	9
SUNLINK	1339862	9
SUNEXPRESS	1502842	9
SUNSCREEN	1588540	9
SUN WORLD	1508989	9
SUN SITE	1573491	35
SUNSPECTRUM	1534825	37
SUNSERVICE	1543203	37
SUNNETWORKS	1557803	37
SUNNETWORKS	1557804	38
SUNSERVICE	1543204	41
SUNSPECTRUM	1534826	42
SUNSERVICE	1542727	42
SUNNETWORKS	1557805	42
SUN MEDIACENTRE	2042045	9
SUN MICROELECTRONICS	2055564	9
SUN STOREDGE	2173246	9
SUN ULTRA	2029125	9
SUNDANCE	2045913	7, 9
SUNREADY	2109006	9



(Registration numbers 1557803, 1557804 and 1557805 expired on 23 December 2000 and so do not represent earlier rights)

4) The applicant states that he is the proprietor of the following United Kingdom trade mark applications for trade marks incorporating the element "SUN":



TRADE MARK	APPLICATION NO	CLASS
	2139531a	9, 16, 35, 37, 38, 41

	2139531b	41
SUNSOFT	1478484	9

5) The applicant states that he is the proprietor of the following Community trade mark registrations, each including the element “SUN” as an essential feature and that they constitute a family of trade marks:

TRADE MARK	REGISTRATION NO	CLASS
SUN	124610	9, 16, 35, 38, 41, 42
	124594	9, 16, 35, 38, 41, 42
SUN MICROSYSTEMS	124669	9, 16, 35, 38, 41, 42
	564815	9, 16, 37, 42
SUNEXPRESS	124560	9, 16, 38
SUN DATA	298869	9, 42
SUNSERVICE	124552	37, 41, 42
SUNPLAZA	646596	9, 16, 42

6) The applicant states that he is the proprietor of the following Community trade mark applications incorporating the element “SUN”:

TRADE MARK	APPLICATION NO	CLASS
	125781	9, 16, 35, 38, 41, 42
SUNSOFT	124503	9, 16, 38
	310540	9, 42

Since the filing of the application for invalidity application no 125781 has been registered.

7) The applicant states that he has used the trade mark SUN and the trade marks prefixed SUN extensively throughout the United Kingdom in relation to the goods and services for which the above trade marks are registered. He states that the activities of Sun in the United Kingdom have been advertised in the United Kingdom and have received coverage in national newspapers, as well as in computer related literature. Therefore, these trade marks have become well known to the trade and public as the trade marks of the applicant denoting his goods and services.

8) The applicant states that the registration of the trade mark in suit is contrary to sections 5(2)(a) and (b) of the Act. The applicant states that the trade mark in suit is similar to the SUN trade mark because it incorporates the trade mark SUN which is distinctive of the applicant. He states that all goods and services of the registration in suit are similar to those for which the applicant's trade marks are protected. He states that the "consuming" public would be confused into thinking that the goods and services of the trade mark in suit might emanate from the applicant.

9) The applicant states that he has used the trade mark SUN in the United Kingdom since 1983 in relation to computers, information technologies, communication technologies and related goods and related services and have as such established a considerable reputation and business goodwill under this trade mark. The applicant submits that use of the trade mark in suit in respect of all the goods and services it encompasses will cause such a misrepresentation in the minds of the public that significant damage will be caused to his goodwill and reputation. The applicant submits, therefore, that use of the trade mark in suit is liable to be prevented by virtue of the law of passing-off and so the registration of the trade mark in suit is contrary to section 5(4)(a) of the Act.

10) The applicant states that the registered proprietor has clearly sought to capitalise on the notoriety and reputation which the applicant enjoys under their trade mark SUN. The applicant states that by seeking to incorporate the element SUN within the trade mark in suit it is obvious that the proprietor hopes that the public, on seeing the proprietor's goods bearing a trade mark incorporating SUN, will think that the goods emanate from the applicant. The applicant submits that this is a clear indication of bad faith and so the registration of the trade mark in suit is contrary to section 3(6) of the Act.

Counterstatement

11) The registered proprietor denies the grounds of opposition.

12) The registered proprietor rejects the allegation that the trade mark in suit is similar to the SUN trade mark because it incorporates the string of letters SUN. He states that none of the trade marks registered by the applicant contains either the string SUNNY or the string CITIES. He states that SUNNY quite obviously means sunshine and does not suggest a relation to the applicant. He states that any average member of the public, even while using the services or products of the applicant, still would associate SUNNY with sunshine. The registered proprietor states that CITIES clearly has no association with the applicant. He states that the words in conjunction provide even less association with the applicant.

13) The registered proprietor rejects the claim that all the goods and services of the registration in suit are similar to those provided by the applicant.

14) The registered proprietor asks the registrar to demand supporting evidence from the applicant to justify his claim that the application for the registration in suit was made in bad faith.

Other matters

15) Both parties seek an award of costs.

16) Only the applicant provided evidence.

17) The parties were advised that I considered that a decision on the case could be made without recourse to a hearing. They were advised that if they did not request a hearing it would be assumed that they were content for a decision to be made from the papers. The registered proprietor did not respond. The applicant filed submissions in lieu of attendance at a hearing. I will, therefore, take them into account and refer to them below. Consequently a decision will be taken from a careful study of the papers.

18) Although the registered proprietor did not furnish submissions he did write to the registrar on 25 February 2002. A copy of this letter was sent to the applicant. The letter effectively represents submissions in relation to the claims by the applicant.

19) Acting on behalf of the registrar I duly give the following decision.

Decision

Applicant's evidence

20) The applicant's evidence consists of witness statements by Charles Andrews and Bernard Harrington. I have read the evidence that they have furnished. I do not consider that this evidence has a bearing upon the outcome of the instant case and so will say no more about it here. However, if I consider it necessary I will refer to elements of it in the body of my decision.

Applicant's submissions

21) The applicant refers to *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585 in relation to the test for defining the distinctive character of a trade mark. He submits that SUN and SUN based trade marks are inherently distinctive. He refers to the declarations of Messrs Andrews and Harrington to show the longstanding use of the applicant's SUN and SUN based trade marks. The applicant refers to *Sabel BV v. Puma AG* [1998] RPC 199 in relation to the global assessment that needs to be made in relation to the likelihood of confusion. He quotes from paragraphs 20 –22 of *Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV* [2000] FSR 77:

“20. That global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital in the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

21. Furthermore, the more distinctive the earlier mark, the greater will be the likelihood of confusion and therefore marks with a highly distinctive character, either *per se* or because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character.

22. It follows that, for the purposes of Article 5(1)(b) of the Directive, there may be a likelihood of confusion, notwithstanding a lesser degree of similarity between the trade marks, where the goods or services covered by them are very similar and the earlier mark is highly distinctive.”

22) The applicant submits that his earlier trade marks have a highly distinctive character not only *per se* but because of the recognition that they possess in the market. He submits that because of this distinctiveness there is a greater possibility of likelihood of confusion.

23) The applicant submits that the registration in suit is similar to his earlier registrations. He states that as the beginning of SUNNY comprises SUN that the respective signs are conceptually similar.

24) The applicant goes on to make submissions about the similarity of the respective goods. Submitting that the respective goods are identical and similar.

25) The applicant refers to the criteria to establish a claim for passing-off from *Reckitt & Colman v Borden* [1990] RPC 341. The applicant states that he has used the trade mark SUN in the United Kingdom since 1983 in relation to computers, information technologies, communication technologies and related goods and services. He states that he has established a considerable reputation and business goodwill under this trade mark. The applicant states that in seeking to incorporate his trade mark SUN in the trade mark in suit the registered proprietor is misrepresenting the goods and services of his trade mark as those of the applicant. He submits that consumers would be confused into thinking that the class 9 goods of the registration in suit originated from the applicant. He states that it is inevitable that such confusion will cause damage to the reputation which he enjoys.

26) The applicant also makes a claim to protection under article 6bis of the Paris Convention.

The registered proprietor's letter of 25 February 2002

27) As I stated in paragraph 18 this letter effectively represents submissions and so I will treat it as the submissions of the registered proprietor.

28) The registered proprietor does not dispute that the applicant is a well-known computer manufacturer. He does not accept that his registration and those of the applicant encompass similar or identical goods.

29) The registered proprietor states that almost every user will associate SUNNY with good weather rather than with the brand of the main frame or server that resides in the basement, computer centre or even on a different continent.

30) The registered proprietor states that the applicant has failed to provide any evidence of the claim that the registration in suit was filed in bad faith.

Preliminary issues

31) The applicant includes in his list of earlier rights several applications that have not been registered. Under section 6(1)(a) an application can only have the effect of acting as a barrier to an application or registration when it is registered. Consequently, the instant proceedings could have been suspended pending the registration of the applications. Owing to the number of earlier registrations upon which the applicant relies I cannot see that this would serve any purpose. Nothing turns upon these applications, the outcome of this case will not change if they are included in my deliberations. I have, therefore, not considered it appropriate to suspend the proceedings. To do so would serve no purpose and could lead to an unconscionable, and pointless, delay.

32) The declaration of Mr Harrington exhibits a large number of printouts for trade mark registrations and applications. Certain of these are not included in the statement of grounds. There has been no request to amend the statement of grounds and therefore I take no cognisance of them. I do not consider that anything turns upon this matter owing to the large number of other earlier rights.

33) In his submissions the applicant claims protection under article 6bis of the Paris Convention. This was not pleaded in his statement of grounds and there has been no request to amend them and therefore I take no cognisance of the claim to 6bis. I note, however, that even if I did, owing to the registrations that the applicant already relies upon, he would be no better off under 6bis.

Grounds of opposition

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

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:

“(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.

(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-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade....”

Section 6(1) defines an earlier trade mark as:

“(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) objection

35) An allegation of bad faith is a serious allegation and one that must be strictly proved. The applicant has put in no evidence to substantiate his claim that the registration in suit was applied for in bad faith. He has not dealt with this ground of opposition in his submissions. **This ground of opposition is, therefore, dismissed.**

Section 5(2)(a) objection

36) None of the respective trade marks are identical. **This ground of invalidity is, therefore, dismissed.**

Section 5(2)(b) – likelihood of confusion

37) 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] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] FSR 77 and *Marca Mode CV v. Adidas AG* [2000] ETMR. 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 132, 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 224;
- (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 133 paragraph 29.

Comparison of signs

38) The earlier trade marks of the applicant are shown in paragraphs 3 to 6 inclusive. The registration in suit is for the sign **SUNNY CITIES**. The applicant has raised the issue of a family of trade marks. In considering the respective signs I must make a mark to mark comparison (*ENER-CAP Trade Mark* [1999] RPC 362). However, as part of the global appreciation of the signs I do need to take into account the issue of a family of trade marks, the presence of a common element could lead to the respective trade marks being considered similar. The relevance of families of trade marks has been accepted by OHIM (see for instance decision no 1649/2000 of the Opposition Division) and by Professor Annand, sitting as the Appointed Person (see BL 0/411/01).

39). The public will only be influenced in their perception of trade marks by a common element if they are aware of it. Consequently for a family of marks to be considered the party relying upon them has to show their use, the public are not in the habit of consulting trade mark registers. The applicant relies upon the SUN element of his various trade marks. The evidence of applicant shows use of various of his trade marks: SUN, SUN MICROSYSTEMS, SUN DEVICE, SUN DEVICE with SUN MICROSYSTEMS, SUN with SUN DEVICE, SUN WORKSTATION, SUNLINK, SUNSERVICE, SUNSPECTRUM, SUN STOREDGE and SUNREADY. It is not possible to gauge from the evidence furnished the scale of use of all the trade marks, although clearly there has been use. The evidence is indicative of a wide use of SUN, SUN MICROSYSTEMS, SUN DEVICE, SUN DEVICE with SUN MICROSYSTEMS, SUN with SUN DEVICE. Owing to the stylisation of the SUN DEVICE I do not consider that its use simpliciter is use of SUN as a word. However, the use of the device is invariably with the aforesaid words. Even if I were to accept that all the trade marks referred to above represented a family of trade marks I do not consider that anything would turn upon this matter.

40) None of the trade marks of the applicant include the word CITIES or anything close to this. Neither do they contain the word SUNNY, although they all contain the word SUN in some shape or form. The conceptual association of the trade mark in suit is that of cities which are bathed in sunlight. I cannot see that any of the trade marks of the applicant have a similar conceptual association or anything close to it. I, therefore, find that the respective trade marks are not conceptually similar.

41) Aurally the respective trade marks enjoy the SUN element. However, this is where the similarity ends. The CITIES sound is alien to the earlier registrations. The “hy” syllable of the trade mark in suit is alien to the earlier registrations. Considering the respective trade marks in their entireties I find that they are not aurally similar.

42) Certain of the trade marks of the applicant are stylised or contain a device element. This is alien to the registration in suit. Other than the commencement of the registration in suit, “sun”, there is no other visual similarity. The overall visual impression of the trade mark in suit is very different from the earlier registrations. I, therefore find that the respective trade marks are not visually similar.

43) Consequent upon the above I find that the respective trade marks are not similar. Indeed, I consider that they are very different.

Conclusion

44) For a finding of a likelihood of confusion the respective signs must be similar. In the absence of this similarity the ground of opposition under this head must fail. The inherent distinctiveness of the earlier registrations, their reputation, the potential proximity of the respective goods and service, the nature of the goods and services, the possibility of imperfect recollection, the family of marks argument cannot, in my view, affect the outcome of these proceedings. The trade marks are too dissimilar. Such factors as reputation cannot turn the non-similar into being similar. The crux of the argument of the applicant seems to be the presence of the trade mark in suit of “sun”. However, the public do not normally dissect trade marks, they consider them in their entirety. Even if someone did dissect the trade mark in suit I do not see why they should consider SUNNY CITIES to be similar to trade marks which begin with the word SUN when there is no other coincidence in the respective trade marks. I cannot see how there would be confusion, even if one considered association in the non-strict sense. The respective trade marks are just too dissimilar. Owing to this degree of dissimilarity I do not see that it serves any purpose to compare the goods of the respective trade marks. Although I note that if one considers the respective goods and services they are certainly not in the “bag of sweets” category. They are the sort of goods and services where the purchasing decision is likely to be careful and considered. Again, however, even if the goods and services were purchased in a slapdash, ill considered manner the dissimilarity between the respective trade marks is such that I cannot envisage how confusion would arise.

45) I, therefore, find that there is not a likelihood of confusion.

Section 5(4)(a) – passing-off

46) To succeed under this head there must be deception or confusion which is dependant on a similarity of the respective trade marks; the public will not be deceived or confused where the respective trade marks are not similar. **As I have already found that the respective trade marks are not similar this ground of opposition must be dismissed.**

47) The registered proprietor is entitled to a contribution towards his costs and I therefore order the applicant to pay him the sum of £600. 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 5th day of June 2002

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