

O-110-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2142579  
BY THE CARTOON NETWORK LP, LLLP  
TO REGISTER THE TRADE MARK:**



**IN CLASSES 9, 16, 18, 25, 28, 30, 32, 35, 41, 42**

**AND**

**THE OPPOSITION THERETO  
UNDER No 52625  
BY CARTOON TRIANGLE APPAREL INC  
BASED UPON THE EARLIER TRADE MARKS:**

**CARTOON**

**AND**



## Trade Marks Act 1994

**In the matter of application no 2142579  
by The Cartoon Network LP, LLLP  
to register the trade mark:**



**in classes 9, 16, 18, 25, 28, 30, 32, 35, 41 and 42  
and  
the opposition thereto  
under no 52625  
by Cartoon Triangle Apparel Inc**

### **BACKGROUND**

1) On 19 August 1997 The Cartoon Network, Inc applied to register the above trade mark (the trade mark). Following the filing of the application the trade mark was assigned to The Cartoon Network LP, LLLP (referred to afterwards as CN). The application was published for opposition purposes in the Trade Marks Journal on 28 February 2001. This opposition concerns only three of the classes of the specification: 18, 25 and 35. The specifications for these classes are respectively:

*trunks, suitcases, and travelling bags; goods made from leather and imitations of leather including pocketbooks, handbags, shoulder bags, cosmetic bags, eyeglass cases, attaché cases, brief cases, travelling cases, portfolios, wallets, billfolds, key cases, coin cases, pouches, purses, card cases, passport cases, tool bags, tote bags, duffel bags, sport bags; umbrellas, sun umbrellas, parasols, small leather and plastic goods, vanity cases; laundry bags, storage bags; walking sticks*

*suits; hosiery; articles of underclothing; shorts, shirts, blouses, tops, slacks, trousers, skirts, dresses, jackets, coats, raincoats, capes, slickers, overalls, waistcoats, pantyhose, knitted articles of clothing, scarves, mufflers, caps, hats, sun visors, dressing gowns, bathrobes, children's and infants' clothing; bibs, tuxedos, dinner jackets, shirts, cummerbunds, ascots, ties, waistcoats, trousers, gowns; articles of sports clothing, underclothing and outerclothing for sports; leisurewear; sleeping garments, sweaters, cardigans, vests, belts, aprons, tights, jeans, ties, swimwear, wristbands; and footwear including sandals, boots, sneakers; stockings, gloves, neckwear, shoes, clothing, headwear, hairnets*

*the bringing together, for the benefit of others, of a variety of goods and service providers, enabling customers to conveniently view and purchase these goods or engage the services of the service providers in a department store or in a gift, souvenir or toy shop*

2) On 29 May 2001 Cartoon Triangle Apparel Inc (referred to afterwards as CTA) filed a notice of opposition to the above classes of the application. CTA states that it is the owner of the following registered United Kingdom trade marks:

- No 1095755 for the trade mark:



It is registered for the following goods:

*dresses, blouses, tunics, shorts, vests, swimsuits jumpsuits, sleeping garments, all for women; suits for men; skirts, shirts, pants being articles of under clothing, jackets, sweaters, scarves, coats, all for men and women; belts for wear*

The above goods are in class 25 of the International Classification of Goods and Services.

- No 1206647 for the trade mark **CARTOON**. It is registered for the following goods:

*bags included in Class 18, none bearing cartoon characters*

- No 1206648 for the trade mark **CARTOON**. It is registered for the following goods:

*articles of outer clothing for women and children, but not including any such goods bearing representations of cartoon characters*

The above goods are in class 25 of the International Classification of Goods and Services.

CTA states that the goods and services of the application in classes 18, 25 and 35 are similar or identical to the goods of its earlier registrations and that the respective trade marks are similar. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) CTA states that it uses the above trade marks in the United Kingdom for the goods encompassed by their specifications and has a goodwill in its business associated with the above trade marks. Consequently, use of the trade mark is liable to be prevented by the law of passing-off and so its registration would be contrary to section 5(4)(a) of the Act.

4) CTA requests that the application is refused in respect of all the goods and services in classes 18, 25 and 35. It also seeks an award of costs.

5) CN filed a counterstatement in which it denies the grounds of opposition. It states that it already has registrations for the trade mark in the United Kingdom in respect of goods and services in classes 3, 14, 21, 24, 38. CN states that the registrations upon which CTA relies were all raised as objections to the application at examination stage but were subsequently waived. CN states that its trade mark is famous in the entertainment industry. CN states that registrations of its trade mark and those of CTA co-exist in the United States. CN states that registrations of its trade mark and that of CTA co-exist in Australia, China, Iceland, Ireland, Japan, Korea, New Zealand, Portugal and Turkey.

6) CN requests that the opposition is dismissed and seeks an award of costs.

7) Both sides filed evidence.

8) A hearing was held on 9 April 2003. At the hearing CN was represented by Ms Clark of counsel, instructed by Wildbore & Gibbons, and CTA was represented by Mr Vanhegan of counsel, instructed by Stevens Hewlett & Perkins.

## **EVIDENCE**

### **Evidence of CTA**

#### **Statutory declaration of Gerald M Laban**

9) Mr Laban is an officer of CTA. Much of Mr Laban's declaration consists of submissions rather than evidence of fact. I will only record what can be characterised as evidence of fact.

10) Mr Laban states that CTA, or its predecessors in business, began making clothing, bags and accessories in 1977 and that it is the registered proprietor of trade mark registrations in more than thirty countries for such goods. He states that CTA began using its CARTOON trade mark in 1990 in the United Kingdom for clothing and bags.

11) Mr Laban states that the word NETWORK is not distinctive. He exhibits a copy of an extract from "Collins English Dictionary" and refers to the part of the definition which states: "an interconnected group or system: *a network of shops*".

12) Mr Laban gives the following figures for sales by CTA of goods bearing the CARTOON trade mark in the United Kingdom:

<b>Year</b>	<b>Approximate turnover (£)</b>
1995	1,477,460
1996	867,060
1997	503,573
1998	272,420
1999	290,003
2000	358,477

He gives the following approximate figures for promotional expenditure:

1995	£32,650
1996	£12,229
1997	£4,798
1998	£4,479
1999	£4,744
2000	£12,495

The date of filing of the application (the relevant date) is 19 August 1997. Figures relating to turnover and advertising after the relevant date cannot assist CTA; they might, however, assist CN by indicating co-existence in the marketplace without confusion.

### **Statutory declaration of Jonathan Sutton**

13) Mr Sutton is a trade mark agent. Most of Mr Sutton's evidence can be characterised as representing submissions rather than evidence of fact. I will only record what could be characterised as evidence of fact. Mr Sutton states that he has conducted a search for the word CARTOON in connection with clothing and bags in classes 18 and 25. He states that he found no relevant trade mark other than that of CTA.

### **Evidence of CN**

#### **Declaration of Louise S Sams**

14) Ms Sams is vice-president of CN. She states that CN adopted the trade mark the subject of this opposition on 1 October 1992 for use for cable and television broadcasting services and the production of television programmes and cinematographic films. She states that the trade mark has been used continuously since that date in respect of these services. Ms Sams states that these services, bearing the trade mark, are available to millions of viewers in the United States and in 145 other countries, including the United Kingdom. Ms Sams exhibits, at exhibit 1, news articles relating to the viewing figures for CN's services and the initial launch of the network.

15) Ms Sams states that from 17 September 1993 CN's services have been available in the United Kingdom. She states that in the first year after the launch of CN's services in the United Kingdom approximately 3.35 million homes in the United Kingdom had access to its services. Ms Sams exhibits, at exhibit 2, material about the launch of TNT and CARTOON NETWORK across Europe.

16) Ms Sams gives the following figures for the approximate numbers of subscribers to CN's services in the United Kingdom:

1995	4,429,031
1996	5,202,102
1997	5,909,749

1998	6,396,087
1999	6,402,851
2000	7,466,000
2001 (third quarter)	8,060,000

As I have indicated above in paragraph 12 the relevant date in this case is 19 August 1997 and I am concerned with the position at that date.

17) Ms Sams exhibits at exhibit 3 various materials. Some of these, from the telephone numbers and reference to dollars, would appear to emanate from the United States and so have no bearing upon the position in the United Kingdom. Other material relates to TNT rather than CARTOON NETWORK. This exhibit does little to assist either myself or CN.

18) Ms Sams goes on to state what she “believes”. Her beliefs are not matters of fact and I will say no more about them here.

19) Ms Sams states that CN has undertaken to broaden the use of its trade marks by using and registering the trade mark in respect of other goods, including bags, knapsacks and similar articles and articles of clothing. She states that these goods are used by CN as both promotional items and sold to the public. She exhibits material at exhibit 4 relating to such goods, none of this material would appear to relate to United Kingdom usage – all costs are in dollars – and so I do not consider that it has a bearing upon this case. Included in the material are pages from CN’s website. All of the pages are from well after the relevant date, prices are in dollars, only one type of size is given (presumably using the United States size system). There is no evidence of purchases or “hits” from on or before the relevant date. I consider this part of the evidence also to have no bearing upon the outcome of this case.

20) Ms Sams states that CTA is engaged in the field of women’s, children’s and infant’s clothing. She states that it is also known as Cartoon Apparel, Inc and is related to Cartoon GmbH. She exhibits at exhibit 5 printouts from D & B Duns Market Identifiers in relation to these undertakings. Ms Sams states that both CN and CTA have registered their trade marks for various articles of clothing in the United States. She exhibits at exhibit 6 a copy of details of CN’s registration for clothing in the United States. Ms Sams also exhibits at exhibit 7 details of a United States registration of CTA for clothing. Ms Sams states that both registrations contain a claim to use in commerce in the United States. She goes on to say that assuming that CTA has not abandoned its use after registration both it and CN have been using their respective trade marks in the United States for clothing and so they have co-existed in the market place in the United States. She states that CN has not received any complaints in the United States from either viewers or consumers with respect to confusion between CTA’s trade mark on clothing and CN’s trade mark on clothing.

21) Ms Sams gives the following approximate figures for sales of goods in the United Kingdom:

1999	US \$ 1 million
2000	US \$ 4 million
2001	US \$ 7 million

Ms Sams states that goods bearing the trade mark consist of a wide variety of articles of clothing, bags and knapsacks. Ms Sams states that she exhibits at exhibit 8 a representative sample of the goods sold in the United Kingdom bearing the trade mark. In fact this seems to be one item. It appears to be a top for an eight year old girl sold by the chain store Adams. Attached, as far as I can see, to the top are two types of swing label; both of which bear the trade mark (as well as other matter).

22) Ms Sams states that she is not aware of any complaints of confusion in the United Kingdom. Ms Sams goes on to give further examples of what she “believes”; again not evidence of fact and not matters that need concern me.

23) Ms Sams goes on to give evidence of the state of trade mark registers across the world in relation to the trade marks of CN and CTA. The comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 have been quoted time and time again by the registrar:

In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.@

I will, therefore, say nothing about the state of the register evidence that Ms Sams relies upon.

24) Ms Sams states that information about the goods and services that CN furnishes under the trade mark can be found on its website and that it also has a co.uk website. She exhibits at exhibit 11 pages downloaded from the .com web site on 8 June 2002. One page shows the trade mark and pictures of two caps and a t-shirt. The prices of the goods are in dollars, the customer service telephone number appears to be a United States number. Three pages, also downloaded on 8 June 2002, from the co.uk website are exhibited. None of them show any goods.

25) Ms Sams exhibits at exhibit 12 what she states are pages from CTA’s website. These were downloaded on 8 June 2002. The only page showing goods shows various items of outerwear for women. The printouts indicate that the website is “under construction”. She goes on to give further details about what she “believes”.

### **Witness statement of Linda Ann Bray**

26) Ms Bray is a partner in the firm of Wildbore & Gibbons, who are the trade mark agents of CN. She begins by giving a history of the formation of CN and supplies supporting documentation at LAB1. Ms Bray exhibits at LAN2 contents lists relating to the documents that Ms Sams exhibits at exhibit 9 and 10 of her declaration (those exhibits relate to trade mark registrations in various jurisdictions). Ms Bray goes on to furnish documentation for trade mark registrations. For these reasons I give in paragraph 23 about state of register the evidence, I will make no further comment on this part of the evidence.

27) Ms Bray exhibits at LAB6 a copy of the examination report of the application in which the registrations of CTA were raised as citations. She further exhibits a hearing officer's report which states that the citations were waived at a hearing. Ms Bray exhibits at LAB 7 a letter from the Australian Trade Marks Office. The Australian letter advises that citations are waived but does not indicate what they were. Also in LAB7 are translations from actions in Finland and Korea. The Finnish translation relates to a decision of the Board of Appeals of the National Board of Patents and Registration which overturned a decision of the National Board of Patents and Registration which cancelled the trade mark of CN. The clash is between the trade mark CARTOON and the trade mark the subject of this application. The Korean translation relates to a decision of the Korean Industrial Property Tribunal which quashed a decision to refuse CN's trade mark; part of the refusal had been based upon the cited trade mark CARTOON.

28) The rest of Ms Bray's statement can be characterised as opinion and/or submission. It is not evidence of fact and so I will say no more about it.

### **Evidence in reply of CTA**

### **Witness statement of Jonathan Sutton**

29) This is the same Mr Sutton who made the declaration referred to at paragraph 13 above. The vast majority of Mr Sutton's statement represents submissions and/or a critique of the evidence of CN. I will only deal with that part of the statement which represents evidence of fact. Mr Sutton states that he has visited CN's .com website and that it is only possible to acquire goods from this website from the United States and Canada. He exhibits at JS1 printouts relating to the billing and shipping information on the website. These were downloaded on 9 January 2003. He states that the drop menu for the country only contains options for Canada and the United States. I also note that the printouts also only have a space for a zip code not a post code.



## DECISION

### Likelihood of confusion - section 5(2)(b) of the Act

30) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

The trade marks upon which CTA rely are all earlier trade marks for the purposes of the Act.

31) In determining the question under section 5(2)(b), 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 BV* [2000] FSR 77.

32) At the hearing both sides put some emphasis on the weight that needed to be given to the degree of similarity of the goods and services, if any, and the degree of similarity between the trade marks. Consequently, I intend comparing the two trade marks of CTA and the trade mark of the application separately and considering the degree of similarity, if any, between all the various goods and services.

### Comparison of goods and services

33) Ms Clark commented upon the absence of evidence of similarity. I am aware that in *Sabel* the ECJ referred to the need to furnish evidence as to the similarity of goods. However, the test for similarity of goods is a legal one rather than one resting on evidence. There will be cases where evidence may be very helpful to identify the nature of the trade, channels of trade, uses, etc. In many cases the ordinary experience of the hearing officer will be enough. This has been the consistent approach both by the registrar and by the Opposition Division of the Office for Harmonization in the Internal Market (OHIM). It would be over-burdensome and often pointless to expect evidence. I do not see that I would be helped by having evidence as to the nature of use and user and channels of trade for rolls and buns in order to decide whether the goods are similar. Ms Clark helpfully commented that such an approach would also be unWoolfian. In

reaching my conclusions I am not acting in the abstract as I have the settled law of the Community in *Canon* on how to decide upon the similarity of goods.

34) In his submissions Mr Vanhegan referred to the test formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 282 in relation to the comparison of goods and services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Since that decision the European Court of Justice ruled on this issue in *Canon* where it held that in relation to the assessment of the similarity of goods and/or services, 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. There is no great discrepancy between the two sets of tests recommended, however, the United Kingdom judgement does not cover the issue of goods and/or services being complementary.

35) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I will give the words in the specifications their natural meaning, but within the context that they appear in a specification derived from the International Classification of Goods and Services. I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the

purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). As far as the services of the application go I am mindful of the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

36) I start by considering the goods of CN and CTA in class 18. The goods of CTA’s registration are: *bags included in Class 18, none bearing cartoon characters*. The class 18 specification of CN is:

*trunks, suitcases, and **travelling bags**; goods made from leather and imitations of leather including pocketbooks, **handbags**, **shoulder bags**, **cosmetic bags**, eyeglass cases, attaché cases, brief cases, travelling cases, portfolios, wallets, billfolds, key cases, coin cases, pouches, purses, card cases, passport cases, **tool bags**, **tote bags**, **duffel bags**, **sport bags**; umbrellas, sun umbrellas, parasols, small leather and plastic goods, vanity cases; **laundry bags**, **storage bags**; walking sticks*

I have highlighted all the goods which are described as bags. Other than if they bear cartoon characters they are encompassed by the goods of the earlier registration which are bags at large. They are, therefore, identical. If the goods did bear cartoon characters they would be exactly the same as the goods of the earlier registration except in the nature of their decoration. The goods would not be identical but be as close to identical as possible. The relative difference between goods bearing cartoon characters will be the same in relation to all the goods of the respective trade marks and will, in my view, not have a real bearing upon the issue of similarity. I will, therefore, say no more about this matter in relation to any of the other goods, in so far as the comparison of goods and services goes.

37) “Collins English Dictionary” (5th Ed 2000) includes in its definitions for bag the following: “a piece of portable luggage; short for; handbag; a flexible container with an opening at one end.” There is nothing, in my view, surprising in this definition. Bag is in my experience used to encompass such a generality of items. Working on this basis it seems to me that in effect the term bags would in normal usage be an alternative general term for all the goods which I have underlined. If these underlined goods are not identical their uses, users, nature, channels of trade etc are identical and consequently I consider that if they are not identical they are so similar that it makes no effective difference. *Trunks* have hard sides, in my experience one does not call a trunk a bag. However, I consider that they share virtually all the characteristics with bags at large and so are highly similar. “Collins English Dictionary” (5th Ed 2000) defines a portfolio, amongst

other things, as a “flat case, esp. of leather, used for carrying maps, drawings, etc”. Accordingly I consider that, again, in everything it is highly similar to the general term *bags*. “Collins English Dictionary” (5th Ed 2000) tells me that *pocketbooks* is an Americanism for a small bag or case for money, papers etc carried by a handle or in the pocket. They are defined as bags and therefore fall within the scope of CTA’s specification and so are identical. A *pouch* in my view is a form of bag and so again is identical with the goods of the earlier registration. *Billfolds* is an Americanism for wallets. I consider that owing to the nature of the goods that I can deal with *eyeglass cases, wallets, billfolds, key cases, coin cases, purses, card cases* and *passport cases* for the most part together. All of these goods are small containers that are normally carried in the pocket or a handbag. In my experience they are normally of leather, imitations of leather or of a material that has the characteristics of leather. They all have a specific purpose, they are not general containers. I am not of the view that in any normal parlance that they would be described as *bags*, although this does not exclude them being similar to *bags*. They have the same purpose as *bags* in that they are used to carry objects whether it be money or spectacles or a passport. They could readily be of the same material as *bags*, such as leather or imitations of leather. In reality with the exception of *coin cases* and *purses* I cannot see that *bags* would be substituted for them and so with the exception of these two items they are not in competition. In my view when considering whether goods are complementary the first question that arises is whether they have a symbiotic or mutually dependant relationship; as is the case with computer hardware and software. I cannot see that the respective goods have such a relationship. Next I consider whether they have a de facto complementary nature through the norms of the trade. Such a consideration would arise with such goods as duvet covers, curtains and wallpaper, where it is common for a standard pattern to be used. I have no evidence that this is the case in respect of the goods I am now considering and no personal experience that is this case. I am, therefore, not prepared to find that the goods are complementary. All of the goods could be found in a leather goods shop or a luggage shop. Although I am not sure that this is the norm for *eyeglass cases*. However, although they could be found in the same emporia I believe that they would normally be in discrete areas. Taking these factors into account I am of the view that *coin cases* and *purses* have a reasonable degree of similarity with *bags*, none bearing cartoon characters. *Wallets, billfolds, key cases* and *card cases* have a limited degree of similarity. Although *passport cases* do carry a passport I see their primary aim as to protect a passport from wear and tear rather than to carry it; protection is also the primary purpose for *eyeglass cases*. Taking into account all the factors relating to the respective goods I consider that there are similarities between *passport cases* and *eyeglass cases* and *bags*, however, they are very tenuous. If one takes an approach that is reductionist enough it is possible to find a degree of similarity between virtually any goods. From a realistic point of view I do not consider that *passport cases* and *eyeglass cases* are similar to the goods of the earlier registration.

38) I now turn to the portmanteau terms: *goods made from leather and imitations of leather* and *small leather and plastic goods*. I cannot decide for CN what specific goods encompassed by these terms are of interest to them. I have to accept them in their broad meaning. *Goods made from leather and imitations of leather* will include *bags* made of

leather. Consequently, I have to consider the goods as being identical. *Small leather and plastic goods* must fall within the parameters of class 18. Small is a fairly unhelpful epithet being relative. Accepting the vagueness and wideness of the term I believe that I must come to the conclusion that it will encompass bags which are “small” and which are of leather or plastic. Consequently, I must find these goods to be identical to those of the earlier registration.

39) Mr Vanhegan submitted that *umbrellas, sun umbrellas, parasols* and *walking sticks* are similar to *bags included in Class 18, none bearing cartoon characters*. The main thrust of this claim seemed to be that they are sold in the same sort of shop. I do not consider that this is a very convincing line of argument. The ordinary chemist shop traditionally sells condoms and corn plasters, I do not think that this makes them similar. I would not buy a bag to keep the rain off me, the goods are not in competition. If I am buying a walking stick it is to help me to walk, I am not aware that bags serve this purpose; they do not have the same end use or end users. The nature of the goods is different. I will not further labour the point. I can see no validity to a claim that *umbrellas, sun umbrellas, parasols* and *walking sticks* are similar to *bags included in Class 18, none bearing cartoon characters*; nor, for the sake of completeness, to any of CTA’s class 25 goods. I, therefore, find that *umbrellas, sun umbrellas, parasols* and *walking sticks* are not similar to any of the goods encompassed by the earlier registrations.

40) I now turn to a comparison of the goods of registration no 1095755 and those in class 25 of the application. The specification of the earlier registration is:

*dresses, blouses, tunics, shorts, vests, swimsuits, jumpsuits, sleeping garments, all for women; suits for men; skirts, shirts, pants being articles of under clothing, jackets, sweaters, scarves, coats, all for men and women; belts for wear*

The specification in class 25 of the application is:

*suits; hosiery; articles of underclothing; shorts, shirts, blouses, tops, slacks, trousers, skirts, dresses, jackets, coats, raincoats, capes, slickers, overalls, waistcoats, pantyhose, knitted articles of clothing, scarves, mufflers, caps, hats, sun visors, dressing gowns, bathrobes, children's and infants' clothing; bibs, tuxedos, dinner jackets, shirts, cummerbunds, ascots, ties, waistcoats, trousers, gowns; articles of sports clothing, underclothing and outerclothing for sports; leisurewear; sleeping garments, sweaters, cardigans, vests, belts, aprons, tights, jeans, ties, swimwear, wristbands; and footwear including sandals, boots, sneakers; stockings, gloves, neckwear, shoes, clothing, headwear, hairnets*

All the goods that are highlighted rehearse items from the specification of the earlier registration. I take into account that the goods of the earlier registration are limited, with the exception of *belts*, to being either for women or for men and women. However, CN has not chosen to limit its goods away from these goods and so I take them as representing identical goods. The general terms *coats* and *jackets* of the earlier

registration will encompass *raincoats*, *slickers*, *tuxedos* and *dinner jackets* which are types of coats or jackets; such goods are, therefore identical to those of the earlier registration. *Gowns* are *dresses* and so are encompassed by the earlier specification, and so again are identical. *Tops* is a vague term that will include such goods as *blouses*, *tunics* and *shirts* in the earlier registration. In the absence of a lack of specification of these goods they must be treated as being identical. *Knitted articles of clothing* is another term that encompasses a wide range of goods, such as *sweaters*, *dresses* and *suits* in the earlier registration; so there is a further identity of goods. *Articles of underclothing*, whether for sports or not, will include *vests* and *pants* of the earlier registration. Consequently, the respective goods are identical. *Swimsuits* are a type of *swimwear* and so again there is an identity of goods. *Suits for men* of the earlier registration will include *trousers* and *waistcoats*. The former goods will be sold as an ensemble, whether two or three piece, of which the latter goods will form part. They are identical except in the manner of purchase. The goods are therefore similar to an extremely high degree. “Collins English Dictionary” (5th Ed 2000) defines *hosiery* as being “stockings, socks, and knitted underclothing collectively”. This definition would include *vests* and *pants* of the earlier registration and so as *hosiery* encompasses the goods of the earlier registration, albeit with other goods, I must treat the goods as being identical. The general terms *leisurewear* and *clothing* of the application will encompass in the former case some of the goods of the earlier registration and in the latter case all of them. So again I must treat the goods as being identical. *Cardigans* of the application are items of knitwear, usually worn for warmth over some form of top. In their nature their only main difference with *sweaters* is that they open up at the front and are buttoned, rather than being enclosed garments which are pulled over the head.

41) The specification of the application includes *jeans* and *slacks*. The earlier specification does not include trouser type goods on their own, although it includes trousers in so far as they are parts of suits. *Jeans* and *slacks* are casual rather than formal attire; “Collins English Dictionary” (5th Ed 2000) defines slacks as being informal trousers worn by both sexes. Trousers for suits would be formal attire. *Jeans* and *slacks* have the same basic use and users as the goods of the earlier registration, they are to cover the body. They are invariably worn with garments covering the upper body, the respective garments could be bought to match each other. Consequently, they are complementary on two levels. They have a symbiotic relationship with many of the goods of the earlier registration and could be bought in order to match. The respective goods could be made of the same materials ie denim shirts and denim jeans. It is not uncommon, in my experience, in certain clothing shops to arrange goods by colour co-ordination rather than simply by their function and so they could be in the same area of a shop. I doubt that generally one would substitute *jeans* or *slacks* for the goods of the earlier registration. So I do not believe that they are in direct competition. Taking into account all the factors listed in *Canon* I consider that there is a high degree of similarity between *jeans* and *slacks* and the goods of the earlier registration.

42) *Pantyhose* is an Americanism for *tights*. I will deal with *stockings*, *pantyhose* and *tights* together. All of these goods are for covering the legs of females. They occupy a netherland between undergarments and outer-garments; being partially visible depending

upon the outer-garment worn. These goods are often made by specialist undertakings. They are usually sold in discrete areas of shops. I do not consider that *stockings*, *pantyhose* and *tights* have a complementary relationship with the goods of the earlier registration in any meaningful sense. They are items of clothing and so have the same basic purpose as the goods of the earlier registration. However, I do not think that their similarity goes a great deal closer than this. I am of the view that *stockings*, *pantyhose* and *tights* are similar to the goods of the earlier registration but to a very limited extent only.

43) *Articles of sports clothing* and *outerclothing for sports* are very broad terms. *Sports clothing* is no longer confined to the sporting sphere. Indeed it is now worn by people who if they undertook any strenuous activity would seem to be in grave danger of a coronary. The tracksuit, the replica football shirt and the like are to be seen not only on the high street but in the workplace. It is also to be taken into account that various of the goods of the earlier registration encompass both sporting and non-sporting goods eg *shorts*, *shirts* and *tunics*. In the absence of any clear identification I must consider *articles of sports clothing* and *outerclothing for sports* as they stand and that they will encompass certain of the goods of the earlier registration. I, therefore, need to treat them as being identical with the goods of the earlier registration.

44) I turn now to *neckwear* in the specification of the application. As well as *neckwear* at large the specification includes specific items of *neckwear*, *ascots*, *ties* and *mufflers*. (According to "Collins English Dictionary" (5th Ed 2000) an ascot is a cravat with wide square ends, usually secured with an ornamental stud.) *Scarves* in the earlier registration will include *mufflers*. The general term *neckwear* will encompass *scarves*. A cravat is a form of scarf and so *ascots* will be encompassed by the term *scarves*. *Ties* like cravats, which are encompassed by *scarves*, are worn around the neck. They are worn for decoration rather than utilitarian purposes. They are likely to be of the same material eg silk or artificial forms of silk. A cravat could be worn or purchased instead of a *tie* and so they are in competition. They are likely to be in the same area of a shop. The end user is likely to be the same, someone who wishes to display decorative neckwear. Consequently, upon the above I find that *neckwear*, *ascots*, and *mufflers* are identical to the goods of the earlier registration and that *ties* are highly similar to the goods of the earlier registration.

45) *Headwear* at large and specific items of headwear, *hairnets*, *sun visors*, *caps* and *hats* appear in the specification of the earlier registration. For the moment I will not comment upon *hairnets*. There are no items of headwear in the specification of the earlier registration. *Sun visors* are functional goods designed to keep the sun out of the eyes. In my experience they are most commonly worn for sporting purposes, although not exclusively. They are items of wear but this appears to me to be the sole similarity with the goods of the earlier registration. Certain undertakings sell all items of clothing under a common trade mark, the average consumer will be aware of such practices owing to the presence on virtually every high street of shops such as Next. I do not say that this is the norm but it is certainly something that the consumer will be aware of. If it was not for this habit in trade I would consider the common area between *sun visors* and the

goods of the earlier registration to be so tangential that they could not be considered similar. However, taking into account the practice in trade I consider that the goods are similar, but to the most limited of degrees. *Headwear, caps and hats* are closer to the goods of the earlier registration as they are as much items of personal adornment as utilitarian items. However, they are likely to be sold in discrete areas of shops and in no meaningful sense are they complementary or in competition. I, therefore, consider that they are similar to the goods of the earlier registration but to a very limited extent. *Hairnets* I have left to the last as they are not appropriate to class 25. *Hairnets* according to the International Classification of Goods and Services are appropriate to class 26. The one exception occurs when they are used for medical or the like purposes, eg for use in operating theatres, when they are appropriate to class 10. Taking into account the *Canon* criteria I cannot see where or how *hairnets*, if class 26 had been included in the application, would coincide with the goods of the earlier registration. *Hairnets*, therefore, do not fall foul of the opposition. They do, however, fall foul of the fact that they are not in the correct class. **If CN wishes to continue with its application in respect of *hairnets* it would need to take action as per rule 8 (4) of the Trade Marks Rules 2000 and add an additional class.**

46) *Children's and infants' clothing* cover a vast area of goods. All of the goods of the earlier registration, with the exception of *belts*, are limited to being for men or women i.e. adults. There is no clear dividing line between *children's clothing* and clothing for adults. Owing to size some children buy adult's clothing and some adult's children's clothing. The only clear definition of *children's clothing* arises from its not attracting VAT, however, this is dependant on size. *Children's clothing* is identical to the goods of the earlier registration in terms of its nature. The target market is different but the actual market could be the same. There does not seem to me to be a great deal of difference between clothing designed for teenagers and clothing for young adults. I consider that there is a high degree of similarity between *children's clothing* and the goods of the earlier registration. *Infants' clothing* is not on a par with *children's clothing*. *Infants' clothing* is not worn by adults and infants do not wear clothing for adults. *Infants' clothing* is normally seen in specialist shops or in discrete areas of shops. It is to be worn obviously, and is likely to be of the same material as adults' clothing. I am aware from my own experience that various "adult" brands have diversified into clothing for infants. Taking this latter matter into account I consider that *infants' clothing* is similar to the goods of the earlier registration to a limited degree.

47) The application includes *footwear including sandals, boots, sneakers and shoes*. *Footwear* is a wide term that includes such things as socks and tights as well as shoes and the like. The earlier registration does not include any *footwear*. Taking this latter term in its broad meaning the respective goods could be of a similar nature, eg knitted socks. It clearly serves the most similar basic purpose. However, goods such as socks are usually in discrete areas of shops. I cannot see that in any meaningful sense that they are complementary to the goods of the earlier registration or in competition. Owing to certain clothing shops selling all items of clothing under their trade mark I consider that the respective goods have a low degree of similarity. In relation to *sandals, boots, sneakers and shoes* I am of the view that the nature of the goods is such, their purpose so



specific and definite, that although they have a similarity with the goods of the earlier registration it is at the very margins of what can be considered similar.

48) *Dressing gowns* and *bathrobes* are often worn over or in relation to *sleeping garments*. They are quite likely to be complementary in that they could be co-ordinated to match. They all serve a common purpose, to be worn during a state of dishabillé. It seems to me that these goods are highly similar to the goods of the earlier registration. *Capes* are over garments usually worn to ward off the effect of inclement weather. They serve the same purpose and could well be of the same material as *coats*. A *cape* could be worn or purchased as an alternative to a *coat*, so they are in competition. They are likely to be in the same area of a shop as *coats*. I consider that *cap*es are highly similar to *coats* in the earlier registration.

49) *Bibs* and *aprons* primary purpose is to prevent soiling of the clothes, they are more items for protection than traditional items of wear. *Aprons* are not likely to be found in a clothing shop, they are more likely to be found in relation to kitchenware and the like. If *bibs* were to be found in a clothing shop it would be with clothing for infants. I cannot see that *aprons* or *bibs* coincide in any meaningful sense with the goods of the earlier registration, taking into account the *Canon* criteria. “Collins English Dictionary” (5th Ed 2000) defines overalls as “a protective work garment usually worn over ordinary clothes” or “hard-wearing work trousers with a bib and shoulder straps or jacket attached”. It is possible to also find *coats* whose primary aim is to protect and cover during work, lab coats, dust coats and the like. In this context the goods would serve a common purpose. They could be sold in the same types of shops or same areas of shops. They could be of the same materials. A purchaser might purchase a protective coat in preference to *overalls* and vice versa, consequently they are in competition. Taking all these factors into account I consider that *overalls* are highly similar to *coats* in the earlier registration.

50) This brings me down to *wristbands*, *cummerbunds* and *gloves*. *Cummerbunds* are normally worn by men with formal wear. In my experience they are most commonly seen amongst musicians in orchestras. They are for decorative rather than any utilitarian purpose. They are unlikely to be worn except with formal wear, although formal attire does not require *cummerbunds*; so their relationship is one sided rather than being mutually dependant or symbiotic. It is quite possible that a *cummerbund* would be purchased at the same time as a suit and would be purchased so that it “went” with a suit. Taking these factors into account there is a limited degree of similarity between *cummerbunds* and the goods of the earlier registration. *Wristbands*, in the context of class 25, are sweatbands that go around the wrist. They are normally used during the playing of sport and are for the simple purpose of preventing sweat flowing down the arms on to the hands. I cannot see that the goods of the earlier registration coincide with the goods of the earlier registration in the terms of the *Canon* criteria. There are no goods in the specification of the earlier registration that are designed for hands, however, *gloves* appear in the application’s specification. This area of attire is quite specialist and is normally limited to two types of goods, *gloves* and *mittens*. In my experience it is not uncommon for *gloves* to be sold in sets with *scarves*. They can be of the same materials, have the same specific purpose – to ward off the cold. They can be complementary in

that they are matching. When sold in sets they are sold in the same place. I consider that *gloves* are similar to a high degree to *scarves* in the earlier registration.

51) I now turn to comparing the goods of registration no 1206648 with those of the application. Certain of the issues will have already been rehearsed above and where this is the case I will try to avoid spending a good deal of time repeating myself. The goods of registration no 1206648 are:

*articles of outer clothing for women and children, but not including any such goods bearing representations of cartoon characters*

In considering the above specification I have had to make a decision as to what could be defined as being an item of *outer clothing*. I have experienced some difficulty in fixing a precise parameter. In the end I have found it best to define it in a negative manner. "Collins English Dictionary" (5th Ed 2000) defines underclothing as being underwear. I take *outer clothing* being goods that are not underclothing, which in turn means goods that are not underwear. The specification above is limited to goods that are for *women* and *children*. Certain of the goods of the specification of the application would not necessarily be for children but there is nothing that would exclude them from being for children, eg *tuxedos* and *dinner jackets*. I have to consider all the potential rights that CN might or could claim from its specification. On the basis of this reasoning I have copied the specification below and have highlighted all the goods which encompass or are encompassed by the specification of the earlier registration. Where there is a lack of precise detail in a general term I have deemed that as it encompasses identical goods, as well as possibly non-identical goods, that it represents identical goods. As I have said earlier it is not in my remit to decide what specific goods within general terms are of interest to CN, I can only deal with the specification before me. I have considered the various items in the context of the class, giving the terms their normal meanings and taking into account that this is about trade and not an issue of philology.

The goods of the application are:

*suits; hosiery; articles of underclothing; shorts, shirts, blouses, tops, slacks, trousers, skirts, dresses, jackets, coats, raincoats, capes, slickers, overalls, waistcoats, pantyhose, knitted articles of clothing, scarves, mufflers, caps, hats, sun visors, dressing gowns, bathrobes, children's and infants' clothing; bibs, tuxedos, dinner jackets, shirts, cummerbunds, ascots, ties, waistcoats, trousers, gowns; articles of sports clothing, underclothing and outerclothing for sports; leisurewear; sleeping garments, sweaters, cardigans, vests, belts, aprons, tights, jeans, ties, swimwear, wristbands; and footwear including sandals, boots, sneakers; stockings, gloves, neckwear, shoes, clothing, headwear, hairnets*

I have included such goods as *pantyhose* as they could be considered as being both underclothing and *outerwear*. They are concealed beneath other clothing but also exposed to the elements and often protect the legs directly from the elements, as in the wearing of woolly tights in winter.

52) Children's clothing must merge into *infant's clothing*. There is no clear dividing line between the two. Consequently, I am of the view that *outer clothing for... children* of the earlier registration is highly similar to *infants' clothing* in the application. *Sleeping garments* are only worn indoors. However, they are worn outside and must be considered, I believe, items of outer clothing. They are, therefore, identical to the goods of the earlier registration. *Hairnets*, and the problem arising from their presence in a class 25 specification, I have dealt with in paragraph 45 above. The position I have given in relation to *sandals, boots, sneaker and shoes* in paragraph 47 above applies equally in relation to the specification of this earlier registration. The respective goods are on the very margins of what can be considered similar.

53) This leaves *articles of underclothing, underclothing for sports and vests*. All of these goods are patently items of underclothing. They are normally not seen being worn in public, unlike the goods of the earlier registration. In my experience *underclothing* is normally found in different areas of shops to *outer clothing*. One does not normally substitute an item of *underclothing* for *outer clothing*; they are not in competition. In normal circumstances the goods reflect what their wording describes; *outer clothing* is worn over *underclothing* and *underclothing* under *outer clothing*, to this extent they enjoy a symbiotic relationship and are complementary. I have come to the conclusion the respective goods enjoy a limited similarity; effectively limited to the fact that they are items of clothing and are complementary.

54) The services of the application are:

*the bringing together, for the benefit of others, of a variety of goods and service providers, enabling customers to conveniently view and purchase these goods or engage the services of the service providers in a department store or in a gift, souvenir or toy shop*

In considering the issue of the similarity of the services which are the subject of this application I have found the comments of the Bundespatentgericht (German Federal Patent Court) in *Smartweb Trade Mark Application* [2003] ETMR 22 useful, in particular the following:

“This can be the case with numerous goods, since for example at least the big chains of retail shops with their department stores as retail enterprises have their own brands under their operational control. But even numerous commercial enterprises which do not hold own their trade marks--for reasons of image transfer--often control the manufacturing process at the manufacturer's end and the quality of the products to be distributed by the trader. Both are generally known to the public. If the further factors to be taken into account in case of a collision can be affirmed, the scope of protection of the service mark would extend to all the goods when defending the mark, in opposition proceedings or when attacking other trade marks. That means that it may be possible to defend, with a retail service mark, a very broad range of goods reaching from foodstuffs

through clothing to do-it-yourself products and electrical appliances, computers, bicycles, *etc.* for which otherwise a large number of different classes of goods would have to be claimed. Thus, its scope of protection would almost equal that of a trade mark covering almost all goods.”

I think that the corollary must apply, infringement one way must imply infringement the other. In this case the example given by the Bundespatentgericht directly reflects some of the area of concern in this case, the service of a department store against clothing; of course this case goes further as the earlier rights include bags also. As the Bundespatentgericht comments, big chains and department stores have their own brands, brands that can reflect the name of the shop. The goods of the earlier registration could readily be sold in a department store, there is a complementary relationship. The end user is likely to be the same, someone who wants clothing or a bag. Of course, a department store is likely to sell a wide variety of goods that have no relationship with the goods of the earlier registration. In considering the issue of similarity I also consider that it must be taken into account that CTA might at some stage use its own outlets bearing the trade mark of its goods. I have to consider the full impact of notional and fair use. I consider that the goods of the earlier registrations are similar, *en masse* and individually, to the *department store* service of the application.

55) In considering the clash with retail services I consider that the nature of the service must be kept firmly in mind. Different retail outlets have different customers, goods and expectations. Mr Vanhegan submitted that, for instance, the goods of the earlier registration are similar to the services of a *souvenir shop* as it might sell t-shirts that are souvenirs. Yes that might be the case but I think it more useful to consider the purpose of the visit to a *gift, souvenir or toy shop*. It is to purchase a remembrance or a toy or a gift; it is not to primarily purchase clothing although clothing might be purchased. I can see nothing that would lead me to a conclusion that there would be a clash between the goods of the earlier registration and the service of a *toy shop*. I cannot see where the similarity can reside. The *gift or souvenir shop* might sell clothing or bags. However, I am not aware of any tradition of such goods branding their goods with their name, and ultimately this will be an issue of cross-branding. There is no evidence to this effect in the case. I consider that if CTA wish to make a fist of this area of attack they require more than a mere submission. I have nothing that I can see that suggests to me a similarity in goods and services according to the *Canon* criteria. Retail services will clearly increasingly present problems in relation to clashes with goods, it is for this reason that the Bundespatentgericht has taken such a careful and circumspect approach to the matter. I feel that as a starting-off point that there must be some clear link between the goods and the retail service which will normally be reflected by a custom in trade of use of the brand across both goods and the service; as with the major food supermarkets in the United Kingdom and department stores.

## Comparison of trade marks

56) The trade marks to be compared are:

**Trade marks of CTA:**

**Trade mark of CN:**

**CARTOON**



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). 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). I take into account 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 (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* page 84, paragraph 27).

57) Ms Clark made much of the stylisation of the lower mark of CTA and of the trade mark of CN. Mr Vanhegan in his turn, not surprisingly, considered that the stylisations were of very limited importance. CN's trade mark clearly has a background and a get-up which is not standard. It has a chess board effect and the letters are contrasted with the background colour. CTA's lower trade mark is not presented in standard script. It is also on a background that shows slight shading and a turning of the corner. The respective trade marks do not share a common get-up. Does this absence of a common get-up make them visually dissimilar? Both trade marks are fundamentally word marks, marks that consist of ordinary English words. The words will be remembered by the effect of their letters, their phonetic and semantic significance. It is not possible, in my view, to divorce the phonetic and semantic significance of the letters from their visual effect when considering the visual similarity. Part of that issue of similarity will depend on the recollection or imperfect recollection of the consumer 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*). The predominant recollection will, in my view, in the case of trade marks that are predominantly word marks lay with the words. We are used to identifying and remembering words, as using them as the basis of our recall and of internalising the universe and our experience. To divorce the word from its meaning and its identification as a word because of the get-ups presented here is not, in my view, tenable. There is a visual dissimilarity in the get-up but the memory is likely to rely on

the idealised memory of the word through its meaning and the pattern that the mind has learnt in relation to it. In the case of stylised word marks and imperfect recollection I am of the view that the shadows upon the cave wall will be formed by the significance and relevance of the word. CTA's lower trade mark and CN's trade mark share the word CARTOON. The word NETWORK is alien to the earlier registration. In order to come to a conclusion as to the degree of similarity between the respective trade marks conceptually, visually and orally I believe that it is necessary to come to a view as to the significance of the words as a whole in CN's trade mark.

58) Ms Clark emphasised the significance of CN's trade mark as a whole whilst Mr Vanhegan argued against this. Mr Laban in his evidence put in an extract from "Collins English Dictionary" in which amongst various definitions was: "an interconnected group or system: *a network of shops*". This could suggest that the NETWORK element is of limited importance and that the distinctive and dominant component of the application is CARTOON. NETWORK just describing a group of shops. Ms Clark stated that chain would be the more normal word for a conglomeration of shops. I believe that this is correct but equally I do not think that NETWORK would strike anyone as an unusual way of describing such a grouping, especially if it was a franchise system. Ms Clark, argued also that the trade mark as a whole "hung together" as describing eg a television network which shows cartoons; which is indeed the primary business of CN. To support her in this claim she relied on the evidence that CN has put in in relation to its penetration into homes in the United Kingdom. Ms Clark argued that because of use CN's trade mark would be seen as a whole and have a conceptual association based on that whole and the nature of its use. The case law of the ECJ is clear that in certain circumstances reputation can aid a party relying upon an earlier right. I believe that the issue as to reputation of a later trade mark has not been considered by the ECJ. However, I can see nothing that would preclude this. In considering the likelihood of confusion I must make a global appreciation that must include all the surrounding factors. Reputation might guide the perception of the average consumer when he/she considers a later trade mark. It cannot be ignored. The owner of a later trade mark might very likely eschew claiming a reputation as it could shoot him/her in the foot. Section 5(2) is about confusion. A later trade mark might enjoy an enormous reputation and an earlier trade mark none. The reputation of the later trade mark could then give rise to the public believing that the goods of the owner of the earlier trade mark are the goods of the owner of the later trade mark. This is still confusion and so would be damning to the owner of the later trade mark. In this way section 5(2) can be distinguished from passing-off where such a scenario would not necessarily lead to a finding for the owner of an earlier trade mark.

59) In her skeleton argument Ms Clark made reference to Disney and Warner Bros stores. There is no evidence in relation to these concerns and so this was a submission without evidence. I also consider that a comparison with Disney and Warner Bros is false. There is nothing that I see in the evidence which suggests that CN has given rise to such icons of the twentieth century as Bugs Bunny, Daffy Duck, Wil E Coyote and the like. Whilst Disney has become part of the common world lexicon. There is nothing to indicate that CN could be considered on a par with these two brands. The relevant date in this case is 19 August 1997. The number of subscribers in the United Kingdom to CN's service the

year before this was 5,202,102. It can be presumed that several people on average have access to the television services which are the subject of the subscription. However, normally viewers subscribe to a package of programmes. There could be services in which the subscriber has no interest and never watches, although this does not preclude him knowing about the services. The number of subscribers also indicates to me that the vast majority of the population are not subscribers and have no access to the channel. I doubt that they read television listings for channels that they do not have access. The premise upon which Ms Clark relies also requires the consumer to take an awareness and perception of CN's trade mark out of its main sphere of activity and into a completely different one. It presumes, for instance, that a consumer looking at the trade mark in relation to a smoking jacket or a ball gown or a suitcase will make an association with CN's core business to the extent that any other significance of the trade mark will be subsumed. It will be seen as an unbreakable whole signifying a link to CN's core service and the conceptual association of the trade mark will simply be that of a television network that broadcasts cartoons. I am afraid that on the basis of the evidence before me this is not a conclusion that I can draw. This might be the case for some consumers but the evidence does not convince me that this is the case for the average consumers. If all the goods were decorated with well-known cartoon characters this is more likely but the specifications are not so limited. (Of course goods bearing cartoon characters are excluded from two of the registrations of CTA.)

60) I am of the view that the distinctive and dominant component of CN's trade mark is the word CARTOON. I must consider this trade mark in its entirety still but bear in mind that NETWORK could well suggest a group of shops that sell CARTOON goods and so is an element that lacks a great deal of distinctiveness. As discussed above in the context of the goods and services under consideration I do not consider that the mark holds together in the way that Ms Clark has advanced. Conceptually and aurally all of the trade marks share this CARTOON element. Owing to its distinctiveness and dominance in CN's trade mark I consider that there is a reasonable degree of aural and conceptual similarity between the trade marks. This failure to establish the unity of the later trade mark also, following, my deliberations above leads to a degree of visual similarity.

## **Conclusion**

61) Ms Clark submitted that the absence of confusion in the market place should be taken into account. In relation to this issue the relevant date is not of key importance. If confusion has not taken place, regardless of when the goods have been on the market together, it could be indicative that in reality there is no likelihood of confusion. The fatal flaw to this argument is the absence of evidence of co-existence on the market place. CTA gives figures for turnover. However, it gives no examples of use of its trade mark. I have no idea how the trade mark has been used, upon what specific goods it has been used, in which locations it has been used and in what sort of shops. The sales figures are tied to nothing concrete. This absence of detail would be damning to the case of CN. However, CN's own evidence is damning to itself. It too has a paucity of details in relation to use in the United Kingdom. The sole example of actual use for the goods or services in question is a multi-branded top for an eight year old girl bearing cartoon

characters. This hardly represents normal and fair use across the range of goods and services. This case ends up being very much on a par with *Origins Natural Resources Inc v Origin Clothing Limited* [1995] FSR 280 and a matter of considering notional fair use of the trade marks upon the respective goods and services.

62) Ms Clark did not make anything of the claims to co-existence in other countries and the decisions in other jurisdictions. I will mention that the findings in other jurisdictions do not assist me. I do not know the full circumstances in these cases. Korea and Australia do not follow the law of the EU and both Korea and Finland have different linguistic regimes which means that the perception of trade marks will be difficult. I have to judge the matter on the evidence before me in the context of the United Kingdom. CN included in its evidence details of the examination of the application and of an ex parte hearing. I have to consider the issue on the facts before me and upon the basis of the submissions of the two sides. The view of the hearing officer has no influence upon me one way or the other.

63) Ms Clark cast doubt upon the degree of inherent distinctiveness of the earlier trade marks. She noted that two of the earlier registrations specifically excluded goods bearing cartoon characters which she considered indicative of the lack of distinctiveness. The distinctiveness or otherwise of the earlier trade marks is of importance as there is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49). On the basis of *Rewe Zentral v OHIM (LITE)* why are the earlier trade marks lacking in a great deal of distinctiveness? If the earlier rights related solely to goods bearing cartoons they would be singularly lacking in distinctiveness. However, in the case of two of the earlier registrations such goods are specifically excluded. If the public see CTA's trade mark upon a ball gown or a formal shirt CARTOON is doing nothing else than acting as a badge of origin. It is not alluding to the goods, it is not describing the goods. Taking into account the exclusions I consider that registration nos 1206647/8 are highly distinctive of the goods. In relation to registration no 1095755 the trade mark is equally highly distinctive for any of the goods that do not bear representations of cartoon characters; the specification will encompass goods both bearing representations and not bearing representations of cartoon characters.



64) Both counsel sought assistance from *React Trade Mark* [2000] RPC 285. In this case Mr Simon Thorley QC, sitting as the appointed person, stated:

“The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

Ms Clark emphasised the importance that is given to visual similarity or dissimilarity in this decision and that this could override a degree of aural similarity. Mr Vanhegan asked me to look at the facts of that case and in particular the actual trade marks that were compared. The case was indeed settled on its own facts. However, it does establish the importance of the issue of visual similarity in the clothing trade. The importance will depend on other factors of course. It will be necessary to take into account all matters and that will include how important the visual impression of the trade marks is. In this case I do not consider that the visual impression of CN’s trade mark is particularly overpowering. It is still very much linked to the semantic context of the words.

65) In relation to the services and the likelihood of confusion I have found it useful to consider the respective trade marks in the context of the potential problems of infringement. With retail services I find that it helps to put the matter into a framework. In relation to this I have particularly born in mind the analysis of the Bundespatentgericht in *Smartweb* of the problems that arise out of the registering of retail services and the need for reasonable certainty for both competitors and the public.

66) For CTA to succeed the respective goods or services must be similar. This is what the Directive states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

So the goods and services which I have not found similar are excluded from a finding of likelihood of confusion. I also need to discard *hairnets* as they are not appropriate to class 25, nor any of the other classes of the application and so cannot be transferred to them. In making my global appreciation I bear in mind the distinctiveness of the earlier registration. I also take into account that although the respective trade marks are similar there are also differences, and greater differences with CTA’s stylised trade mark. Put into the melting pot is that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*) – the interdependency principle. Making this global appreciation I have come to the conclusion that where the respective goods are identical or highly similar that there is a likelihood of confusion. For retail services, where they are similar, I consider that the NETWORK element is even less distinctive than for the goods; as it

could be readily be seen as a group of shops whether connected by a common owner or by franchise. Where the respective goods are not identical or highly similar I am of the view that the differences between the trade marks is such that it is likely to obviate confusion and so I do not consider that there is a likelihood of confusion. In reaching this conclusion I take into account that the purchaser of clothes takes some care in the purchasing decision. In my experience this is an area in which there is a good deal of brand consciousness. The brand is important in terms of being something which the purchaser considers gives him or her vicarious kudos or as indicator of the quality of the goods. The European Court of Justice in *Canon* stated:

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *Sabel*, paragraphs 16 to 18).”

Confronted with identical or highly similar goods using any of the three trade marks I believe that the consumer is likely to believe that they emanate from the same undertaking or an economically linked undertaking.

67) Based upon the above I find that there is a likelihood of confusion in respect of the following goods and services:

*trunks, suitcases, and travelling bags; goods made from leather and imitations of leather including pocketbooks, handbags, shoulder bags, cosmetic bags, attaché cases, brief cases, travelling cases, portfolios, pouches, tool bags, tote bags, duffel bags, sport bags; small leather and plastic goods, vanity cases; laundry bags, storage bags;*

*suits; hosiery; articles of underclothing; shorts, shirts, blouses, tops, slacks, trousers, skirts, dresses, jackets, coats, raincoats, capes, slickers, overalls, waistcoats, pantyhose, knitted articles of clothing, scarves, mufflers, caps, hats, sun visors, dressing gowns, bathrobes, children's and infants' clothing; bibs, tuxedos, dinner jackets, shirts, cummerbunds, ascots, ties, waistcoats, trousers, gowns; articles of sports clothing, underclothing and outerclothing for sports; leisurewear; sleeping garments, sweaters, cardigans, vests, belts, aprons, tights, jeans, ties, swimwear, wristbands; and footwear; stockings, gloves, neckwear, , clothing, headwear*

*the bringing together, for the benefit of others, of a variety of goods and service providers, enabling customers to conveniently view and purchase these goods or engage the services of the service providers in a department store*

68) Consequently, the application can proceed to registration in respect of the following goods and services in classes 18, 25 and 35 respectively:

*purses, card cases, wallets, billfolds, key cases, coin cases, passport cases, eyeglass cases; all being made from leather and imitations of leather; walking sticks, umbrellas, sun umbrellas, parasols*

*sandals, boots, sneakers and shoes*

*the bringing together, for the benefit of others, of a variety of goods and service providers, enabling customers to conveniently view and purchase these goods or engage the services of the service providers in a gift, souvenir or toy shop*

**69) CN should file, within one month of the expiry of the appeal period from this decision, a form TM21 to amend the class 18, 25 and 35 specifications to read as above. If no form TM21 is filed within the period set the class 18, 25 and 35 specifications will be refused in their entireties.**

#### **Passing-off – section 5(4)(a) of the Act**

70) Section 5(4)(a) of the Act states that a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented 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. In this case the rule of law relied upon by CTA is the law of passing-off. The requirements for bringing a successful action for passing-off are goodwill, misrepresentation and damage.

71) Mr Vanhegan considered that he would be no better off under this ground of opposition than under section 5(2)(b). He did not actively pursue this ground of opposition but neither did he abandon it. I accept that he can be in no better a position under this ground than under section 5(2)(b). However, I go further and consider that he has no position at all under this ground. In this case CTA has to establish what trade mark is associated with its goodwill, it needs to establish exactly what its business has been in, it needs to establish how and where it has used its trade mark. Without such an establishment the nature of the goodwill associated with its trade mark cannot be decided, neither is it possible to decide whether there would be deception. CTA gives figures for turnover, so as they are undisputed I can accept that it has goodwill in a business. It does not identify upon exactly which goods the trade mark has been used. It does not even identify if the trade mark which has been used is that of the stylised version or the word only version. It has not given one example of use of the trade mark. It has not given one example of where the trade mark has been used, either by location or by the nature of the selling establishment. There is nothing in the evidence of CTA which could allow it to build a viable claim to passing-off. The evidence most certainly does not satisfy the criteria set out by Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised

the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 As qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

**I, therefore, dismiss the ground of objection under section 5(4)(a).**

#### **COSTS**

**72) Cartoon Triangle Apparel Inc having been successful for the most part in its opposition it is entitled towards a contribution towards its costs. I order The Cartoon Network LP, LLLP to pay Cartoon Triangle Apparel Inc the sum of £2150. 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 17<sup>TH</sup> day of April 2003**

**David Landau  
For the Registrar  
the Comptroller-General**