

O-373-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2200962  
BY EXXON CORPORATION TO REGISTER A  
TRADE MARK IN CLASSES 39 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 50310  
BY KELLOGG COMPANY AND  
KELLOGG MARKETING & SALES CO (UK) LTD**

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**IN THE MATTER OF Application No. 2200962  
by Exxon Corporation to register a Trade Mark in Classes 39 and 42**

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**IN THE MATTER OF Opposition No. 50310  
by Kellogg Company and Kellogg Marketing & Sales Co (UK) Ltd**

**BACKGROUND**

1. On 22 June 1999 Exxon Corporation applied to register the following trade mark in Classes 39 and 42 of the register:



2. The specifications of services for which registration is sought are:

**Class 39:**

Gasoline and/or petrol service station services.




**Class 42:**




Catering for the provision of food and beverages, catering, restaurant, café and cafeteria services; all being offered only at gasoline and/or petrol service stations.

3. The application was accepted by the Registrar and published in the Trade Marks Journal.

4. On 20 October 1999 Kellogg Company and Kellogg Marketing & Sales Co (UK) Ltd filed a Notice of Opposition to the application. The grounds are as follows:

- i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade marks owned by the opponent and is to be registered for services which are similar to those goods for which the trade marks are protected and there exists a likelihood of confusion on the part of the public –

Registration No.	Mark	Registration Effective	Specification of Goods
1075183	 <p data-bbox="389 712 783 891">Disclaimer: Registration of this mark shall give no right to the exclusive use of the letters "Jr" and the device of a bowl of cereal.</p>	3 March 1977	<b>Class 30:</b> Cereal preparations for food for human consumption.
1156475		24 June 1981	<b>Class 28:</b> Toys, games (other than ordinary playing cards), and playthings.
1156476	 <p data-bbox="389 1816 756 1955">Disclaimer: Registration of this mark shall give no right to the exclusive use of the letters "Jr".</p>	24 June 1981	<b>Class 28:</b> Toys, games (other than ordinary playing cards), and playthings.

894284		6 May 1966	<b>Class 30:</b> Cereal preparations for food for human consumption.
2101090		24 May 1996	<b>Class 30:</b> Breakfast cereals.
2005229		16 December 1994	<b>Class 9:</b> Computer games.

- (ii) Under Section 5(3) of the Act in that the mark applied for is similar to the opponent's earlier trade marks and is to be registered for services which are not similar to those goods for which the earlier trade marks are protected and for which they have a reputation, so that use of the mark applied for without due cause would take advantage of, or be detrimental to, the distinctive character or repute of the trade marks;

(iii) Under Section 5(4)(a) by virtue of the law of passing off.

5. On 27 January 2000 the applicant filed a Counterstatement denying the grounds of opposition, asserting decades of use of their mark on goods and services.

6. The opponents filed evidence and both sides have asked for an award of costs in their favour. The matter came to be heard on 24 November 2004 when the applicant for registration was represented by Mr Pennant of D Young & Co, the applicant's professional advisors in these proceedings. The opponents were not represented and did not forward written submissions for the Hearing Officer's consideration.

### **Opponents' Evidence**

7. The opponent's evidence consists of an affidavit by David A Herdman dated 15 August 2000. Mr Herdman is the Corporate Counsel – Trademark of Kellogg Company.

8. Mr Herdman states that to support the opponents' case in the current proceedings, copies of evidence already filed on behalf of the opponents in a prior UK opposition – No. 46422, is exhibited. He adds that the device applied for in that case is similar. At Exhibit DAH1 to Mr Herdman's affidavit is a copy of the tiger device applied for under application No. 2048637, the subject of opposition No. 46422. Exhibit DAH2 comprises copies of the evidence filed in opposition 46422.

9. Exhibit DAH2 contains –

(i) A copy of a statutory declaration by Mark Jeremy Sims, the Marketing Director of Kellogg Marketing & Sales Co (UK) Ltd, dated 19 January 1998. This evidence goes to the repute of the opponents' "Tony the Tiger" character, the tiger devices shown in the opponent's earlier marks, which first appeared on packs of Kellogg's "Frosted Flakes" in 1954 and from 1960 (when the product was re-named) "Frosties". The "Tony the Tiger" character has been used extensively in connection with promotions in the UK for "Kelloggs Frosties" breakfast cereal and has appeared on the cereal pack since 1996. "Tony the Tiger" has appeared on television, in advertisements in relation to television programme sponsorship of the 1993 "Gladiators" show. Mr Sims goes on to detail the product sales advertisement figures from 1985 to 1996. In 1996 sales amounted to £65 million and advertising expenditure £10 million.

(ii) A copy of a statutory declaration of Teresa Mary Dunlop dated 10 March 1998. Ms Dunlop is an associated solicitor at Taylor, Joynson Garrett who were instructed by Haseltine Lake to conduct surveys on behalf of the public on behalf of the opponent to verify whether the public identifies the applicant's device with the opponent's Tony the Tiger character. Ms Dunlop comments on the background detail to the survey and the conduct of the survey.

(iii) A statutory declaration dated 12 March 1998 by Jane More O'Ferrall who is a partner in Haseltine Lake. Ms O'Ferrall refers to the survey conducted on behalf of the opponents and attaches copies of the eighty questionnaires which were completed. She has also compiled a table summarising the responses. She concludes that about

thirty-four persons shown the tiger device of the application thought it was connected with a cereal product and about fourteen people thought it was connected with petrol.

(iv) Two affidavits by David A Herdman dated 27 April 1999 and 8 November 1999. Mr Herdman states that the reputation of the opponents' "Tony the Tiger" character has been enhanced by a wide range of promotional uses e.g. games, clothing and stationery products.

10. I now return to Mr Herdman's affidavit of 15 August 2000. Mr Herdman quotes from the decision of the Director General of the National Institute of Industrial Property in France, dated 6 July 1999, in relation to proceedings in which Mr Herdman states, his company was successful in relation to a slightly different version of the mark currently applied for. The quote relates to the similarity of the respective marks.

11. This completes my summary of the evidence filed in this case. I now turn to the decision.

## **DECISION**

12. Prior to the hearing it was pointed out that the opponent's earlier registration numbers 1156475 and 1156476 in Class 28 had lapsed and been removed from the register. Accordingly, these marks no longer form part of these proceedings.

Section 5(2)(b)

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

"5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

14. An earlier right is defined in Section 6, the relevant parts of which state:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

15. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, 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.*;
- (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*;
- (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*;
- (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*;
- (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*;
- (g) account should be taken on the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*;
- (h) 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*;
- (i) 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*;
- (j) 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.*

16. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark(s) at issue and widen the prenumbra of protection. The opponents have filed evidence relating to the reputation of the marks covered by its earlier registrations i.e. the “Tony the Tiger” character. The applicant has conceded that the opponents have a reputation in this character and the trade marks which depict this character, in relation to breakfast cereals – but not in relation to any other goods. I agree. While there has been use of the earlier marks on other goods, such use has been in the context of promoting the “Frosties” breakfast cereal. The evidence does not show that earlier marks have acquired a reputation in relation to products other than breakfast cereals.

17. In my view, the marks comprising the earlier registrations of the opponents have a considerable reputation in connection with breakfast cereals. Furthermore, it seems to me that the earlier registrations comprise trade marks which are inherently fully distinctive in their own right in relation to the particular goods for which they are registered.

18. The opponents have also filed survey evidence, which is taken from earlier opposition proceedings in relation to a different trade mark. This evidence is also directed at the opponents’ reputation and the likelihood of confusion. However, the evidence is fundamentally flawed in that it addresses public reaction to a mark which is not the mark in suit. The mark considered in the survey is the device of a “cartoon like” tiger viewed from the waist-up. It does not contain the word TIGERMARKET (which is a prominent distinctive element of the mark in suit) and the tiger device in that mark, is different to that contained in the mark in suit. Furthermore, the survey gives no indication as to how those questioned would perceive the mark if it were used in relation to the particular services at issue.

19. At the hearing, Mr Pennant on behalf of the applicant made a number of telling criticisms about the methodology and conduct of the survey but, in light of the basic fundamental flaws outlined above, I need not dwell on these points. In my view it would be unsafe to place any reliance on the opponents’ survey evidence in these proceedings. It does not assist.

20. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my considerations of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the services and goods, the category of goods and services in question and how they are marketed. In this case it is accepted that the opponent’s marks have a reputation in respect of cereals. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*,



paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

21. Furthermore, in addition to making comparisons which take into account actual use of the respective marks, I must also compare the mark applied for and the earlier registrations on the basis of their inherent characteristics assuming normal and fair use of the marks across their respective specifications.

22. I now go to a comparison of the respective services and goods.

23. In determining whether the services covered by the application are similar to the goods covered by the earlier trade marks I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (pages 296, 297) as set below:

“The following factors must be relevant in considering whether there is or is not similarity:

- (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 services;
- (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 particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or 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 the trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors.”

24. Whilst I acknowledge that in the view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods.

25. The opponents have made no submissions on the issue of similarity of the applicant’s services and the opponent’s goods. For my own part I am unable to ascertain any apparent connection between the applicant’s services i.e. petrol service stations and catering..../restaurant/cafe services provided by petrol stations, and the opponent’s goods i.e. cereal preparations and computer games. Although cafes or restaurants may offer breakfast cereals there is no real connection between the services and the goods as there may be with say, public house services and beer where beer may be brewed on the premises and sold under the same name as that carried by the outlet (public house).

26. In my view there is no similarity of services and goods in these proceedings. As such similarity is a pre-requisite to the success of the Section 5(2)(b) ground, the opposition on this ground must fail. However, in the event that I am wrong and there is some similarity between the respective services and goods, I go on to compare the mark in suit with the earlier trade marks.

27. The applicant's mark comprises the word TIGERMARKET over which is the "cartoon like" device of a tiger's head. Both elements are prominent and are on a fairly non-descript background. The earlier registrations are of "cartoon like" tiger devices. All the relevant marks are highly distinctive.

28. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. It is, of course, possible to overanalyse the marks as the real test is how customers would perceive the marks in the normal course and circumstances of trade. The average customer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind. (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* – mentioned earlier in this decision).

29. I now turn to a visual comparison of the respective marks. There is an obvious difference in that the mark in suit contains the distinctive word TIGERMARKET. However, the respective marks contain representations of "cartoon like" tiger devices. At the hearing, Mr Pennant detailed numerous differences between the devices and although his points are valid, it seems to me they amount to "over-analysis", bearing in mind my comments in relation to the "imperfect picture" of marks which I made in the preceding paragraph. While there are undoubted differences in the detail, a degree of similarity results from the fact that the tiger devices all possess a "cartoon like" appearance. I would also add that the tiger's head within registration numbers 2101090 and 2005229 is at a similar angle and pointed/looking in a similar direction to that of the mark in suit. In my view there is some degree of visual similarity between the respective marks as a whole.

30. Going to an oral comparison, it is well established that "words speak louder than devices". In aural use the applicant's mark is likely to be described by reference to the word element within it. The opponents' case is less strong.

31. Next, a conceptual comparison of the marks. As both marks contain "cartoon" tiger devices there is conceptual similarity. This may be relevant to imperfect recollection.

32. In my considerations relating to a global appreciation of a likelihood of confusion I must consider the services and goods at issue and the likely customer for the services and goods. The relevant customer in the present case is the public at large who are likely to purchase the services and goods in person. Accordingly, the customer is not a specialist or sophisticated consumer.

33. I have come to the following conclusions:

- (i) the applicant's services and goods covered by the earlier registrations are not similar and if I am wrong on this point any similarity is slight;
- (ii) there is some degree of similarity between the mark in suit and the earlier registrations in that both contain "cartoon like" tiger devices;

(iii) the relevant customer is the public at large.

34. On a global appreciation taking into account all the relevant factors I have come to the conclusion that while some people encountering the applicant's mark may think it reminiscent of the earlier marks, it does not follow that a likelihood of confusion exists among the average customer for the services, especially once the differences in the applicant's services and the relevant goods are taken into account. The possibility of confusion amongst customers cannot be regarded as a likelihood.

35. The opposition under Section 5(2)(b) of the Act fails.

#### **Section 5(4)(a)**

36. Next, the Section 5(4)(a) states:

“5.-(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, or “

37. The law on the common law of passing off is clearly set out by Geoffrey Hobbs QC, acting as the 'Appointed Person', in *Wild Child* [1998] 14 RPC 455:

“A helpful summary of the element of an action for passing off can be found in Halbury's Laws of England 4<sup>th</sup> Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townsend & Sons (Hull) Ltd* [1979] ACT 731' is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the marks and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public or believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.”

The restatement of the elements of passing off in the form of this classical trinity has been referred to as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. The latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of

the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

38. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective field of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

39. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date (i) they had acquired goodwill under their mark, (ii) that use of the applicant’s mark would amount to a misrepresentation likely to lead to confusion as to the origin of their services; and (iii) that such confusion is likely to cause real damage to the goodwill.

## GOODWILL

40. In my considerations under Section 5(2), I found that the opponent have a reputation in relation to breakfast cereals.

## MISREPRESENTATION

41. While the opponents possess a reputation in relation to breakfast cereals, it seems to me, that following the decision reached in relation to Section 5(2), the Section 5(4) ground places them in no stronger position. There is no obvious connection between the services within the application and those goods for which the opponents possess a reputation.

42. To succeed the opponents have to show that the relevant public will believe that these services provided by the applicant are services of the opponents..

43. I have already compared the applicant's and the opponent's trade marks and found some degree of similarity. It is well established that in the law of passing off there is no limitation in respect of the parties field of activity. Nevertheless the proximity of the applicant's field of activity to that of the opponents is highly relevant as to whether the acts complained of amount to a misrepresentation. Although the provision of catering, restaurant and café services may involve the serving of breakfast cereals, it does not follow that an undertaking which provides the services would be perceived as the source of the cereals themselves.

44. In essence the question that I have to address is whether the relevant public seeing the applicant's mark used on the services applied for, would be likely to believe the services were being offered by the opponent. In *Harrods Ltd v Harrodian School Ltd* [1997] RPC 697, Millet L J stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services.”

45. In the recent case of *South Cone v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* 16 May 2001, HC 2000 APP 00617, Pumfrey J in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“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 Section 11 of the 1939 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.”

46. I do not consider that the opponents have discharged the onus of showing that the necessary misrepresentation required by the tort of passing off will occur in relation to the services specified within the application. The opposition under Section 5(4)(a) fails.

### **Section 5(3)**

47. Finally, the Section 5(3) ground.

48. The Section 5(3) ground is only being pleaded in respect of dissimilar services, the appropriate position when the opposition was filed. There was no application to amend the pleadings in order to allege Section 5(3) against either identical or similar services.

49. Prior to the recent amendment, which does not impact upon these proceedings, Section 5(3) read:

“5.-(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,
- (c) shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of the Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

50. In relation to the current proceedings Section 5(3) requires consideration of:

- (i) whether the trade mark opposed is identical with or similar to the earlier trade mark;
- (ii) whether the trade mark opposed is sought to be registered for goods or services which are not similar to those for which the earlier trade mark is protected;
- (iii) whether, and to what extent, the earlier trade mark has a reputation in the United Kingdom;
- (iv) whether the use of the later trade mark is “without due cause”;
- (v) whether the use of the later trade mark;
  - (a) takes unfair advantage of; and/or
  - (b) is detrimental to the distinctive character of the repute of the earlier mark.

51. From my earlier findings in these proceedings it follows that I accept that a degree of similarity may exist in the respective marks and that the respective specifications cover services and goods which are dissimilar. Furthermore, I have found that the opponents have a reputation in its earlier trade marks in relation to breakfast cereals.

52. At the hearing Mr Pennant submitted that use of the applicant's mark was with due cause and that its mark has been used without resulting confusion. Although no evidence of use of the applicant's mark has been filed, I fail to see why the application is without due cause.

53. I also consider whether the opponent is able to make out any of the adverse consequences set out in paragraph 50 (v) of the decision (above).

54. It is clear from a number of reported cases that Section 5(3) is not intended to have the sweeping effect of preventing the use of any sign that is the same as, or similar to, a registered mark with a reputation.

55. In my view the opponent's reputation is in relation to breakfast cereals and it seems to me far from obvious that the opponents would be damaged in any way by or as a result of the applicant's use of their mark on the services the opponents have applied for. On the face of it, it seems to me that the services in question cover discrete, specialised operations. I would add that no evidence has been filed to support the contention that the relevant customer would expect the services to emanate from the opponents. The onus lies with the opponents and the onus has not been discharged.

56. The Section 5(3) ground fails.

## **COSTS**

57. The opposition has failed and the applicant is entitled to a contribution towards costs. I order the opponents to pay the applicant the sum of £1100 which takes into account the fact that the applicant did not file evidence and that the opponent did not attend the hearing nor forward written submissions in lieu. 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 21<sup>st</sup> day of December 2004**

**JOHN MacGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**