

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1354287  
BY SHARI LEWIS ENTERPRISES INC TO REGISTER  
THE MARK HUSH PUPPY IN CLASS 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
No 28978 BY WOLVERINE WORLD WIDE INC**

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

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**IN THE MATTER OF Application No 1354287  
by Shari Lewis Enterprises Inc to register the  
mark Hush Puppy in Class 41**

10 **and**

**IN THE MATTER OF Opposition thereto under  
No 28978 by Wolverine World Wide Inc**

15

**DECISION**

20 On 8 August 1988 Shari Lewis Enterprises, Inc of Beverly Hills, California applied under  
Section 17(1) of the Trade Marks Act 1938 to register the mark HUSH PUPPY for a  
specification of services which reads as follows:

25 “Publication of books; entertainer and television entertainment services; production of  
cine films, video films and of radio and television programmes; recording studio  
services; theatre production services; all included in Class 41.”

The application is numbered 1354287.

30 On 2 September 1991 Wolverine World Wide Inc filed notice of opposition to this  
application.

The grounds of opposition are in summary:

- 35
- i under Section 11 by reason particularly of the opponents’ use of and reputation  
in their trade mark HUSH PUPPIES
  - ii under Section 17(1) in that the applicant cannot claim to be the proprietor of  
the mark and, furthermore, that the applicant did not, at the date of application  
use or intend to use the mark at issue
  - 40 iii under Section 68 in that the applicant did not, at the date of application, use or  
propose to use the mark applied for in relation to services for the purpose of  
indicating, or so as to indicate, that a particular person is connected, in the  
course of business, with the provision of those services, and the application  
45 was not accompanied by an application for the registration of a person as a  
registered user.

The opponents also ask that the application be refused in the exercise of the Registrar's discretion or, alternatively, that it be refused in respect of some services (unspecified). I have expressed the grounds in the above terms after deciding a matter which had been held over for determination as a preliminary point prior to the hearing on the substantive issues. The statement of grounds as originally filed was founded on a Section 11 objection; a Section 17 objection based on the issue of proprietorship and a request for an exercise of discretion. The opponents sought at an early stage to raise the additional issues reflected in my above summary.

10 The parties, and it seems the Registry, had agreed that the proposed amendments should be considered as a preliminary issue at the main hearing. I should briefly record that the main considerations leading me to accept the amended statement of grounds were that

- 15 - the amendments were requested at an early stage and before any evidence had been filed
- the proposed amendments do not appear to have impacted adversely on the parties' ability to file evidence (and in effect to address the points raised)
- 20 - no further evidence was sought to be adduced
- the amendments enable all relevant issues to be considered
- 25 - the additional points raised under Sections 17(1) and 68 are in my view matters which should be within the applicant's knowledge. The applicant is not, therefore, prejudiced in having to respond to the issues raised.

30 In coming to this decision I should, however, say that I do not accept the opponents' contention that the amendments are merely clarificatory. It seems to me that new issues are raised which require separate consideration.

35 Both sides filed evidence in these proceedings and the matter came to be heard on 1 April 1998. The applicant was represented by Mr D Alexander of Counsel instructed by Marks & Clerk, Trade Mark Agents and the opponents by Mr R Ashmead and Mr G V Roberts of Kilburn & Strode, their Trade Mark Attorneys.

40 By the time this matter came to be heard, the old Act had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the Trade Marks Act 1938 however, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the provisions of the old law, unless otherwise indicated.

Opponents' evidence (Rule 49)

The opponents filed three statutory declarations in support of their case. The first, dated 4 February 1993 comes from Lawrence C Paulson who is the Assistant Secretary of Wolverine World Inc (Wolverine). He has been associated with Wolverine since 1983 and enjoys full and free access to all relevant books and records of the company.

He says that Wolverine have been in the business of manufacturing footwear and/or materials since about 1883. He exhibits (A) a booklet about the company and (B) an extract from a radio programme on the subject. Wolverine is the originator and owner of the trade marks HUSH PUPPIES and dog devices. Examples are illustrated in the declaration. The trade mark HUSH PUPPIES is said to have been adopted in the United States of America in 1957. The dog devices followed later and have been developed and modernised over the years. The HUSH PUPPIES range of trade marks has been in continuous use in the United Kingdom for many years. Mr Paulson says that as a result of extensive advertising and promotion the HUSH PUPPIES marks have achieved international notoriety and constitute a major asset of Wolverine. He refers to the overwhelming level of recognition achieved in magazine surveys and market research enquiries.

Wolverine first registered HUSH PUPPIES as a trade mark in the United States in 1958. Registrations throughout the world have followed. A list of UK registrations and applications is exhibited (C).

Mr Paulson goes on to say

“9. The HUSH PUPPIES and associated dog device trademarks have been used, and are still being used on product labels, hang-tags and sewn-in tags attached to footwear products, hosiery and other goods, on packaging, in advertising, on outdoor signs and displays, in fliers and promotional products, and in many other ways customary in the trade. The trade mark HUSH PUPPIES is always associated with the particular dog device or combination which is used.

10. Since the adoption of the HUSH PUPPIES and the various associated dog device trade marks, Wolverine has greatly expanded its use of these marks onto different types of goods and services, notably:

“clothing for men, women and children, namely coats, jackets, dresses, blouses, skirts, slacks, trousers, shirts, sweaters, belts, gloves; leather; retail store services; carpet undercushions; foot care products, namely arches, insoles, shoe inserts, handbags, needlework kits to make rugs and wall hangings, containing canvas, yarn, binding and instructions; headwear; leather belts; luggage; children's tote bags, satchels, and knapsacks; rain slickers; school and stationery supplies for children, namely pencil pouches, memo books, ink markers, memo pads, erasers, and pencil sharpeners; shoe care products namely, shoe polish and shoe cleaning preparations; household towels and cloths, namely bath towels, hand towels, jogging towels, tennis

towels, beach towels, bath sheets (towels), kitchen towels, dish clothes, pot holders, oven mitts, pot grabbers, place mats, toaster covers, and blender covers; toys, namely stuffed toys, toy banks, toy puzzles, toy backpacks, toy yoyo, toy balloons, toy boxes, toy magnets, and toy carpets or walling hangings; watch bands”.”

During the period 1977 to 1991, in the United States alone, Wolverine sold over \$1,470,456,000 worth of HUSH PUPPIES shoes and in excess of \$340,000,000 worth of other HUSH PUPPIES brand products (at wholesale values). Mr Paulson says that in the United Kingdom Wolverine , through its licensee and registered user British Shoe Corporation, has recorded gross sales as follows:

	<u>Year</u>	<u>Sales in Pounds Sterling</u>
15	1984	15,634,497.27
	1985	16,875,977.40
	1986	17,277,887.03
	1987	16,358,663.18
	1988	19,630,373.98
20	1989	23,247,046.93
	1990	23,738,605.16
	1991	23,065,318.19
	1992 (to November)	20,785,194.65

Mr Paulson goes on to describe the extensive advertising associated with the products. This has included direct advertising by Wolverine and its licensees and cooperative advertising with various dealers and retailers. A variety of promotional mechanisms have been used including the print media, radio, television, outdoor signs and displays.

Finally Mr Paulson says he believes that as a result of the above facts goods bearing the HUSH PUPPIES and dog device trade marks are immediately recognised and associated with Wolverine and no other company.

The second declaration, dated 4 February 1993 came from Julian Hill who is employed by The MRH Partnership Ltd, an investigation company. Mr Hill says that he was asked by Kilburn and Strode, the opponents’ trade mark agents, to make enquiries for any indications of use of HUSH PUPPY as a trade mark in relation to each or any of the services listed in the advertisement of the applicant’s mark (the services quoted above). The results of his enquiries were conveyed to Kilburn and Strode in the following terms:

“We have telephoned contacts in the film productions business and they have searched in “Spotlight”, which is the actors and actresses’ directory and have found that Shari Lewis is not listed. A check has also been made in “The Knowledge”, which is the trade directory for the film production industry, and no entry can be found for Shari Lewis or Shari Lewis Enterprises. On the trade [mark] application is an address for Shari Lewis Enterprises Inc. in Beverly Hills, California but

International Directory Enquiries cannot give us a telephone number for this company.

5 A call was made to the BBC who used to broadcast “Shari Lewis & Lamb Chop” with a request for Shari Lewis’s theatrical agent. Ms Caroline McQuay in the BBC’s Artist’s Index Department gave us the number of BCC Limited - 071-486-1222. This number was called but BCC claim never to have heard of either Shari Lewis or Lamb Chop. A further call was then made to Ms McQuay who told us that BCC were last used in 1988 and not since. The first programme to include Shari Lewis was  
10 transmitted on 22nd May 1976. Sadly the exact date in 1988 when the programme ceased is not listed. Ms McQuay did find, however, two further telephone numbers in the United States - one for SLS Entertainments tel: 010-1-213-462-2666 and the other for Jack Globenweld tel: 010-1-248-5502. The number for SLS has been discontinued. The second number is answered by an answerphone as  
15 Jack Globenweld Associates and Cabaret Records.

We did not initially leave a message as we wished our contact if possible to be on a personal basis. We did later leave a message on the Globenweld answerphone, but have yet to have any response”.

20 The third declaration is dated 16 February 1993 and is made by Susan N McFee, an attorney employed by Wolverine World Wide, Inc. Ms McFee is responsible for the corporation’s trade mark portfolio. She says that, at her request, a Wolverine employee made on-line enquiries through Dun and Bradstreet on 25 January 1993 into the activities of Shari Lewis Enterprises Inc. A copy of the resulting printout is exhibited (SNF1). Ms McFee says that she has called the telephone number given in that report and requested further information concerning Shari Lewis Enterprises but has not received any such information to date. She adds that neither Shari Lewis personally nor Shari Lewis Enterprises Inc has a US trade mark registration of HUSH PUPPY(IES).

30 Applicant’s evidence (Rule 50)

35 The applicant filed two declarations by Shari Lewis, the President, a position she has held since 1982. The first declaration is dated 27 February 1995. In it Ms Lewis says that her company is the owner of several trade marks including her own name, LAMP CHOP, CHARLIE HORSE and HUSH PUPPY. Shari Lewis Enterprises, Inc was established to carry on the business originally conducted through Tarcher Productions from 1957 until 1982.

40 Ms Lewis says that she is an entertainer/performer of international repute and, in the field of entertainment, is particularly associated with children’s entertainment. For her performance as a ventriloquist she has created a number of puppet characters the most famous of which are LAMB CHOP, HUSH PUPPY and CHARLIE HORSE. Ms Lewis says that they have enjoyed considerable success and popularity with her audiences. Her shows have been performed regularly on stage and have been broadcast regularly on television. In every one of  
45 her own show series and specials, all three characters regularly appeared.

Ms Lewis says that her first appearance in the United Kingdom was in 1958 when she appeared on BBC television's "Sunday Night at the Palladium". From 1968-75 she had a regular TV series which was broadcast on BBC 1 television in which all three characters regularly appeared in each show. The broadcasts were in "prime" time and would normally appear at 6.00 pm on a Sunday evening. As a result she considers that both she and her puppet characters became "household names" in the United Kingdom. During this period she says that she also appeared at four Royal Command Performances which reflected the popularity of her shows with the British public. In addition, she recorded six one hour musical variety specials for London Week-End Television which were broadcast in 1974, and HUSH PUPPY appeared in each of these specials. Although her own shows finished in 1975, she says that in every year from 1968-1983, she guested on at least two major variety shows broadcast on UK television including the shows of such famous artists as Val Doonican, Paul Daniels, Cilla Black and others. After 1983, her commitments in the United States prevented her from continuing appearances on such shows. Her current show, "Lamb Chop's Play Along" has been broadcast on B-Sky-B Satellite Television for the last two years. On "Lamb Chop's Play Along", HUSH PUPPY appears as a major character in each of the seventy five existing episodes.

Ms Lewis goes on to say that in 1969 she licensed the use of her name and the characters including HUSH PUPPY to a UK merchandising company, owned by Walter Tuckwell, who marketed on her behalf a wide range of products including puppets, clothing, character dolls, colouring books, comic books, cutout books, posters, puzzles and other products. She has also published in the United Kingdom numerous books which feature the characters including HUSH PUPPY.

As a result of the above activities Ms Lewis believes that her own name and that of her puppet characters have become well known to the British public. In particular she believes that the name HUSH PUPPY is readily understood to be a character in her shows. She is not aware of any instances of confusion with the goods of the opponents notwithstanding the merchandising activities described above. She concludes by saying that HUSH PUPPY is a service mark which has been used by her and her company in the field of entertainment and products for children since 1956. She considers it to be distinctive of her services exclusively.

Ms Lewis' second declaration is dated 31 July 1995. The purpose of the declaration is to provide further evidence in support of the reputation enjoyed by the name HUSH PUPPY in the United Kingdom. To this end she exhibits (SL1) a selection of press clippings and (SL2) illustrations of various toys, games, books and records featuring the name or character HUSH PUPPY. These products were marketed in this country by Walter Tuckwell & Associates Ltd.

That concludes my review of the evidence.

I propose to deal firstly with the ground under Section 11.

This Section reads as follows:-

“11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

5 The established test to which I was referred at the hearing is that set down in Smith Hayden & Co Ltd’s application but as adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand the test may be expressed as:

10 “Having regard to the user of the opponents’ mark HUSH PUPPIES, is the tribunal satisfied that the mark applied for HUSH PUPPY if used in a normal and fair manner in connection with any services covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?”

15 The applicant’s position put simply is that in terms of the above test the goods for which the opponents have an acknowledged reputation are wholly different from the services in the applicant’s specification. As a result Mr Alexander said there is no prospect of confusion. It was also pointed out that the applicant’s mark is HUSH PUPPY (singular) as distinct from  
20 the plural form normally used by the opponents. However this latter point could not, I think, save the applicant if I were to find against them in other respects on the Section 11 ground.

Mr Roberts, for the opponents, referred me to a number of cases in support of the opponents’ position on the risk of confusion. The cases principally relied on at the hearing were (in  
25 addition to BALI), Hack’s application 1941 RPC 91 (the BLACK MAGIC case), LIVRON Trade Mark 1937 RPC 161 and 327, KOJAKPOPS: KOJAK LOLLIES 1977 RPC 275 and NINJA TURTLES 1991 FSR 145. Mr Roberts argued, correctly I think, that there was an onus on the applicant to satisfy me that there was no likelihood of confusion and that the position of the public at large needed to be considered (per LIVRON). He suggested, by  
30 particular reference to the NINJA TURTLES case that it might be thought the applicant’s mark was being used under license as it were from the opponents.

I accept for the purposes of the Section 11 test that it is not necessary for the goods and services to be of the same description as is required for Section 12 purposes. Nor is it  
35 necessary for Section 11 purposes for an opponent to establish the sort of case that would be necessary to succeed in a passing off action. The evidence before me confirms that the opponents have a substantial reputation in relation to footwear. Claims are also made in Mr Paulson’s declaration that the opponents have extended their activities into other areas as indicated in the summary of evidence. However these claims have not, in my view, been  
40 substantiated by, for instance, detailed information on turnover, promotional mechanisms and expenditure, or evidence as to consumer recognition of the HUSH PUPPIES brand in these wider areas of trade in this country. Nor is there evidence to suggest that the opponents’ mark has been used in relation to services (leaving aside an unexplained reference to retail store services).

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Whilst, as I have acknowledged, the test under Section 11 is not restricted to one of the same goods or the same description of goods or services I think there must be some solid basis in evidence if an opponent is making a broader claim in relation to his mark than appears to be justified by the normal commercial boundaries of the trade. Such evidence might for instance, go to the overwhelming reputation of the mark itself across a range of goods; to some peculiarity of a particular product area which leads customers to make an association between sets of goods or services where one might not otherwise be apparent; or to the nature of the business (a supermarket or department store perhaps) which might naturally support a broadly based claim. The opponents here have sought to rely in part on the claim that the reputation in their mark is such that use of the applicant's mark in relation to the services at issue might be seen as some sort of licensing spin-off with a resultant risk of confusion. This claim might have been slightly more credible if there were more evidence before me about the extent of the opponents' licensing arrangements in the United Kingdom beyond their agreement with British Shoe Corporation. I accept that merchandising activities whilst commonly associated with cartoon characters are not limited to this area and can be found in diverse areas of trade. But the opponents give little information about other aspects of the licensing of their marks and have provided no corroborative material on the point. I bear in mind that in the NINJA TURTLES case relied upon by the opponents over 150 licences were said to have been granted in the United Kingdom in respect of various goods. Moreover the defendants in that case had entered the field in one of the product areas for which a licence had already been granted. The circumstances were, therefore, quite different to those of the case before me.

I conclude, therefore, that the applicant's services are so distanced from the opponents' goods that there is no reasonable likelihood of confusion. Furthermore, there is no identifiable consumer expectation arising from the licensing activity undertaken by the opponents that might point to the risk of confusion if the applicant's mark is used for the services applied for. In short I consider that the opponents are some way from establishing their case under Section 11 and the opposition, therefore, fails on this ground.

I go on to consider the issues raised under Sections 17(1) and 68.

The relevant parts of these Sections read as follows:

“ 17.-(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.”

Section 68

““service mark” means a mark (including a device, name, signature, word, letter, numeral or any combination thereof) used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person.”

The original Section 17(1) objection related to the issue of proprietorship. However in my view the evidence clearly sets out the background to, and use of, the mark HUSH PUPPY by the applicant. I do not think the opponents' evidence contains any serious challenge to the applicant's claim to proprietorship. The opponents, therefore, fail in this aspect of their attack.

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The second matter under this head, which in effect spans the two sections, relates to use of, or intention to use, the mark. The opponents point out that there has been no request for the application to proceed on the basis of a registered user agreement (Section 29(1)(b)). They also draw attention to the fact that the application was made in the name of Shari Lewis Enterprises Inc and not Ms Lewis herself. In their view there is no evidence of actual use or intention to use in respect of some or all of the services at the material date in these proceedings (that is to say the application filing date of 8 August 1988). Nor is there evidence of later activity such as might suggest that a clear intention did in fact exist as at that date. In particular Mr Ashmead questioned whether the applicant had any real intention to function as a publisher, a producer of films, a provider of recording studio services etc. He was suggesting, I think, that these services go some way beyond Ms Lewis' activities as an entertainer.

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I think the opponents are right in saying that the applicant's evidence blurs the line between the activities of the applicant company and those of Ms Lewis herself. I will, therefore, deal briefly with this point at the outset. Mr Alexander, for the applicant, argued that the distinction was a somewhat artificial one and that the company was simply a vehicle for Shari Lewis herself. In any case, he said, the evidence explained that the company was incorporated to carry on her business. Furthermore Ms Lewis states in her declaration that "the name HUSH PUPPY is a service mark which has been used by me and my company in the field of entertainment and products for children ..." (my emphasis). Similar issues of ownership and control have arisen in the past - see for instance the ASTRONAUT and TROOPER rectification actions (1972 RPC 655 and 1994 RPC 26 respectively). In the case before me I note from the opponents' evidence (Exhibit SNF1 - the Dun and Bradstreet report) that Shari Lewis is listed as the owner of the company and that under the heading "Employees" the information given is "1 including owner". The company is also said to operate from the residence of Shari Lewis. I conclude from this that the company is owned and wholly controlled by Ms Lewis and that Mr Alexander is right to say that there is no meaningful distinction to be drawn.

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Turning to the evidence it is clear that Ms Lewis was most active in this country during the period 1968-1975 when she had a regular TV series but that her reputation extended beyond this time particularly during the period up to 1983 by virtue of guest appearances on well known TV shows. Mr Alexander made the perfectly reasonable point that it is in the nature of the entertainment industry that trends come and go and that successful artists make comebacks. There is support for this in the fact that Ms Lewis' show "Lamb Chop's Play Along" has been broadcast on B-Sky-B satellite television in the two years up to 1995 (the date of Ms Lewis' first declaration). Mr Ashmead, for the opponents, pointed out that this was after the material date in the proceedings. That is, of course, true but I think it is permissible to take it into account as evidence of fulfilment of the applicant's intentions. I

conclude from all this that there has been past use of the mark in relation to “entertainer and television entertainment services” and that, even if the mark was not in use at the date of application there was a clear intention to use as evidenced by subsequent events.

5 However the specification also covers the following services in Class 41 “publication of  
books; ... production of cine films, video films and of radio and television programmes;  
recording studio services; theatre production services”. I, therefore, go on to consider the  
position in relation to these services. Firstly there is in my view no evidence to suggest that  
10 the applicant was using the mark HUSH PUPPY in relation to any of the above services at the  
material date. I note that Ms Lewis says in her declaration that she “published in the  
United Kingdom numerous books which feature the characters including HUSH PUPPY”.  
There is no supporting material on the point and I am left in some doubt as to whether this  
refers to publishing services as such (and if so under the mark) or simply the offering for sale  
15 of books. Exhibit SL1 contains two newspaper cuttings relating to Shari Lewis’ Lamb Chop  
magazine but I note from the articles themselves that the magazine is published by Gresham  
Publishing. It is not clear, therefore, that the applicant or Shari Lewis have offered publishing  
services in their own right. Still less is there anything to suggest that the applicant was using  
the mark in relation to the other services claimed at the material date. I must, therefore, go on  
20 to consider whether an intention to use has been established.

In the PALM Trade Mark case 1992 RPC 258 at page 267 the Hearing Officer said:

25 “A person’s intention, at any point in time, is, of course, a difficult matter for any  
other person to know with certainty. Intentions change as the circumstances which  
give rise to them change. The process of application for, and registration of, a trade  
mark is sufficiently lengthy to allow a number of different intentions to arise quite  
legitimately in the mind of the applicant. But I think it reasonable to assume that a  
businessman, with an established business, has a certain fixity of purpose when  
30 preparing to do some act or take some step in relation to that business.”

These remarks were made in the context of a rectification action but are, I think, equally  
relevant in the context of an application to register. I also bear in mind the following Court of  
Appeal guidance in DUCKER’S Trade Mark 1928 RPC 397 at page 402:

35 “Section 3 gives a definition of a trade mark, and it is this: “A ‘trade mark’ shall mean  
a mark used or proposed to be used upon or in connection with goods for the purpose  
of indicating that they are the goods of the proprietor of such trade mark by virtue of  
manufacture, selection, certification, dealing with, or offering for sale.” It appears to  
me quite impossible to read that definition without confidence that it was contrived  
40 after consideration had been given to the words of Lord Justice Lindley in *Batt’s  
Trade Marks*, where he said, in the passage I have already quoted - I put it in the  
affirmative form - that a man must have an intention to deal, and meaning by the  
intention to deal some definite and present intention to deal in certain goods or  
descriptions of goods. I agree that the goods need not be in being at the moment, and  
45 that there is futurity indicated in the definition; but the mark is to be a mark which is  
to be definitely used or in respect of which there is a resolve to use it in the immediate

future upon or in connection with goods. I think that the words “proposed to be used” mean a real intention to use, not a mere problematical intention, not an uncertain or indeterminate possibility, but it means a resolve or settled purpose which has been reached at the time when the mark is to be registered.”

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Although decided under an earlier Act, and prior to the introduction of service marks, the principle thereby established holds good in my view under the comparable provisions of the 1938 Act. It is clear from this guidance that an applicant must have a settled intention to use the mark and that a mere speculative or contingent intention to use is insufficient for the purposes of Sections 17 and 68.

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As I have already indicated there is nothing in the applicant’s past activities to suggest that the intention to use resides in a resumption of past use (as I have found to be the case in relation to entertainer services). There is, of course, evidence that there has been merchandising of goods based on the characters in Ms Lewis’ show. Such activities were undertaken on Ms Lewis’ behalf by Walter Tuckwell & Associates Ltd and are said to have included puppets, clothing, character dolls, comic books, cutout books, posters, puzzles and other products. There is nothing to suggest that the licensing arrangements extended to services of the kind at issue (or other services). Nor so far as I can tell is it suggested that the applicant offers these services in the United States of America where Ms Lewis is based.

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Mr Alexander’s response was that the core entertainer services support the claim to the other services listed. In my view that outwardly attractive proposition needs to be treated with some caution. The core entertainer services give rise quite naturally to merchandising of the products mentioned above. I do not think the same can necessarily be said about the services now under consideration. The range of services applied for is in practice quite diverse and different in character to what might be expected under a merchandising banner. They are in my view specialist services and some way removed from entertainer services. Delivery of such services are likely to involve special facilities and equipment. Given that the applicant is effectively a one-person company and, given also that no registered user application has been made, it is difficult to see how the applicant was expecting to conduct such activities. At the very least it would have been reasonable to expect some explanation as to how it was intended to bring the mark into use in relation to such services or what preliminary steps had been taken.

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Making the best I can of the matter I have come to the view that the opponents have done sufficient to cast doubt on the applicant’s intentions and, therefore, it is incumbent on the applicant to meet those objections. The applicant has not persuaded me that a definite and fixed intention to use the mark HUSH PUPPY in relation to these services existed at the material date. Nor is it suggested that there has been such use at any subsequent date.

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One other matter touched on briefly at the hearing was whether the mark HUSH PUPPY was being used simply as the name of a character or as a service mark within the meaning of Section 68 in relation to the full range of services at issue. (*Mothercare UK Ltd v Penguin Books Ltd*, 1988 RPC 113 was referred to). The point has not in my view been fully explored in the evidence or in submissions at the hearing. In the light of the conclusions I

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have reached and what I go on to decide below I do not think I need consider it further. There is also the matter of the Registrar's discretion but again I see no need for an exercise of discretion in the circumstances of the case.

5 Accordingly if the applicant files a Form TM21 within one month of the end of the appeal period for this decision amending the specification to

“Entertainer and television entertainment services; all included in Class 41”

10 the application may proceed to registration. If they refuse to do so the application will be refused.

15 If the application is amended in the manner indicated above the opponents will have achieved a significant reduction in the specification applied for. In these circumstances I take the view that they are entitled to a proportion of the costs that would normally accompany a successful action. If, therefore, the application is amended as indicated I order the applicant to pay the opponents the sum of £500. If the applicant refuses to amend the specification, however, the application will be refused and the opponents will be free to apply for a full award of costs based on the normal scale.

20 Dated this 20th day of April 1998

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