

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 45855**

**IN THE NAME OF BARTER INTERNATIONAL GROUP LTD  
AND FRANKLIN LOUFRANI**

**TO APPLICATION No. 2048360**

**TO REGISTER A TRADE MARK IN CLASS 25**

**IN THE NAME OF BOXER HOLDINGS INC.**

**ON ASSIGNMENT FROM JOE BOXER CORPORATION**

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**DECISION**

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**Application No. 2048360**

1. On 12<sup>th</sup> December 1995 Joe Boxer Corporation (“the Applicant”) applied to register a series of two signs for use as trade marks in relation to “complete articles of clothing; underwear; pyjamas; nightshirts and nightgowns; dressing gowns; hosiery; ties; and footwear” in Class 25. The two signs were:



2. At certain points in the evidence noted below, the signs are referred to respectively as “the smiley logo” and “the licky logo”. Other expressions used in relation to “the smiley logo” are “the happy face logo”, “the happy face design” and “the smiley face”. These expressions are used interchangeably in the evidence before me.

3. By an assignment dated 4<sup>th</sup> April 2000 the application was assigned to Boxer Holdings Inc. Nothing turns on the fact of assignment for present purposes.

### **Opposition No. 45855**

4. On 6<sup>th</sup> November 1996 Barter International Group Ltd and Franklin Loufrani (“the Opponents”) filed notice of opposition to the application for registration. The application was opposed on various grounds. For the purposes of this decision I need only refer to the Opponents’ contentions that registration should be refused:

- (i) under Section 3(1)(b) of the 1994 Act on the basis that the signs put forward for registration were devoid of any distinctive character;
- (ii) under Section 3(6) of the 1994 Act on the basis that the application for registration was made in bad faith;
- (iii) under Section 5(4) of the 1994 Act on the basis that use of the relevant signs as contemplated by the application for registration would be actionable in passing off at the suit of the Opponents.

The Applicant joined issue with the Opponents on these objections.

### The Opponents' Evidence

5. The evidence in support of the opposition consisted of a Statutory Declaration of Franklin Loufrani and 5 Exhibits dated 28th August 1997. Mr. Loufrani states that he designed the following logo in 1971:



With reference to that logo (which does not, in my view, differ materially from “the smiley logo” represented in the application in suit) he makes the following points:

- (i) He and persons associated with him have licensed others to use the logo for commercial purposes. “Hundreds of licences have been granted over a period of 25 years”. Licences “have been signed by amongst others Ferrero, Kelloggs, Hewlett Packard, McCain, Mars, Agfa, Carrefour and General Biscuit and advertising agents acting for Shell, the Xerox Corporation and Sony”. “Licences to use the logo in the United Kingdom have been signed by amongst others Sony,

France Maillots, Baumann, Simon Lahu, the Commonwealth Toy and Novelty Co and Weldite for goods including clothing, bicycle bells, bags and plushes.”

- (ii) In 1994 Barter International Group Ltd was licensed to use the logo in the European Union, Eastern Europe and Russia and to grant sub-licences to third parties. Barter International Group Ltd and its licensees have used the logo in connection with a wide variety of goods and services.
- (iii) Royalties received in respect of worldwide sales of goods and services under the logo varied between FF.1,240,000 and FF.1,416,000 per annum in the years 1993 to 1996. Separate figures for UK sales are not available.
- (iv) The logo is the subject of registrations and applications for registration “in over 60 countries in 30 classes”.
- (v) The Opponents commenced proceedings in France against the Applicant and Timex Corporation in October 1995. The proceedings were brought in respect of the sale of watches bearing the logo at a duty free show in Cannes. “A writ was issued on 8 November 1995. Neither Joe Boxer nor Timex have served pleadings in respect of the Writ. Application no. 2048360” [the present application] “was filed shortly after these proceedings were commenced”.

6. Exhibit FL2 shows variations of the logo applied to various products. It also shows variations of the logo graphically represented in advertising and promotional materials for

various products. Exhibit FL4 shows similar usage of the logo. It also shows use of the logo to identify cheerful news items in French and Swiss newspapers.

7. Exhibit FL3 contains copies of material in which the logo is identified as a “property” available for use under licence, with what appear to be different entities named as licensors for different countries at different times. In amongst this material is an article entitled “The Story Behind The Smile” which appears to have been published in 1997. The author states that: “The story of the world famous yellow smiley face has its roots in France in the early 1970’s. The country was going through a low period and the government, led by Prime Minister Chaban Delmas, wanted and needed something to boost the general mood of the public. Enter Franklin Loufrani, a journalist with leading French newspaper France Soir. Loufrani came up with the simple idea of highlighting every piece of good news in the paper with a smile, instead of focusing only on bad news as had always seemed to be the case.” The article refers to the subsequent licensing of the logo for use in product areas “as varied as apparel, toys, stationery, food, jewellery, promotions and accessories”.

8. The Opponents’ evidence does not condescend to particularity in relation in the nature, duration or extent of the use of the logo under licence in the United Kingdom.

### **The Applicant’s Evidence**

9. The evidence in support of the application for registration consisted of an Affidavit of Stephen Langmaid (Chief Financial Officer of the Applicant) and Exhibits A to T; an Affidavit of William Wallace (Executive Director of the Worcester Historical

Museum in Worcester, Massachusetts) and Exhibits A to E; two Statutory Declarations of Esmond Hitchcock (of the Applicants agents of record in the United Kingdom) and an Affidavit of Thomas Onda (attorney and partner in the firm of Steinhart & Falconer LLP of San Francisco).

10. Mr. Wallace identifies Harvey Ball, a well-known resident of Worcester, Massachusetts, as the acknowledged originator of the “happy face” logo represented in the application in suit. (I note that on 14<sup>th</sup> April 2001, after the hearing of the present appeal, The Times newspaper published an obituary of Harvey Ball entitled “Harvey Ball. Inventor of the yellow Smiley Face which became the emblem of a generation”.)

11. Mr. Wallace confirms that the Worcester Historical Museum made its own enquiries as to the origins of the logo when preparing for an exhibition which it mounted in 1996. Various materials relating to the exhibition and the logo are exhibited to his Affidavit. A number of the published articles he exhibits refer to Mr. Ball having drawn the “happy face” logo in or around 1963. He notes that “the article in the Worcester Sunday Telegram of January 23rd, 1972 is the most specific, citing December 1963 as the date of its creation”.

12. The exhibits to Mr. Wallace’s Affidavit indicate that there has been widespread and diverse use of the logo since it was originally produced by Harvey Ball in 1963 for the purposes of a “friendship campaign”. The Worcester Historical Museum’s synopsis of events (Exhibit E) states that:

“In 1963, State Mutual Life Assurance Company of American faced a problem. The Worcester-based firm had

purchased Guarantee Mutual Company of Ohio the previous year in conjunction with a State Mutual subsidiary, Worcester Mutual Fire Insurance Company. Low employee morale created by reorganization in the merged companies prompted State Mutual Vice President John Adam, Jr. to suggest a 'friendship campaign'. Adam assigned the task of developing the campaign to Joy Young, the assistant director of sales and marketing for the Worcester-Guarantee companies.

Young turned to Harvey Ball, a freelance commercial artist, and asked him to create a little smile that could be used on buttons, desk cards, and posters. Ball drew a smile. Not satisfied with the result, he added two eyes, making a smiling face. The whole drawing, he recalled later, took ten minutes.

The Worcester-Guarantee companies launched the campaign in 1964, distributing the initial order of 100 smile buttons to their representatives. Agents and client enthusiastically responded to the yellow buttons; thereafter Young reordered in lots of 10,000. State Mutual and its affiliates billed themselves as the 'Smile Insurance Companies'. According to William Loubier, retired Second Vice President for Marketing and Communications, the entire campaign 'somehow ... got a life of its own'. Employees in all the affiliates embraced the smile button and its message."

Tens of millions of representations of the logo are said to have appeared on button badges and "boxer shorts, yo-yos, pencils, watches, key rings, earrings, lunch boxes, mugs, glasses, cocktail shakers, pillows, bags, alarm clocks, snack trays, cookie jars, Frisbees and light shades" and more besides (Exhibit D). The logo is said to have been used in relation to merchandise offered by major retailers like Macy's and Bloomingdales in New York and "Marks & Spencer and Kensington Market in London featured speciality smiley face boutiques by 1990" (Exhibit E).

13. Mr. Langmaid confirms that the “happy face” logo was in common use in the United States in the 1960’s. He exhibits an article from the issue of Newsweek magazine published on 15th July 1996 (Exhibit B) as showing that the logo was at that time being used on various products from various sources. The article carries the comment “Proving once again that old clichés don’t go away, they just come back bigger than ever, the once dreaded ‘Have a nice day’ smileys are popping up in more places than ‘Independence Day’ ...”. It shows, among other items, T-shirts and watches adorned with the logo.

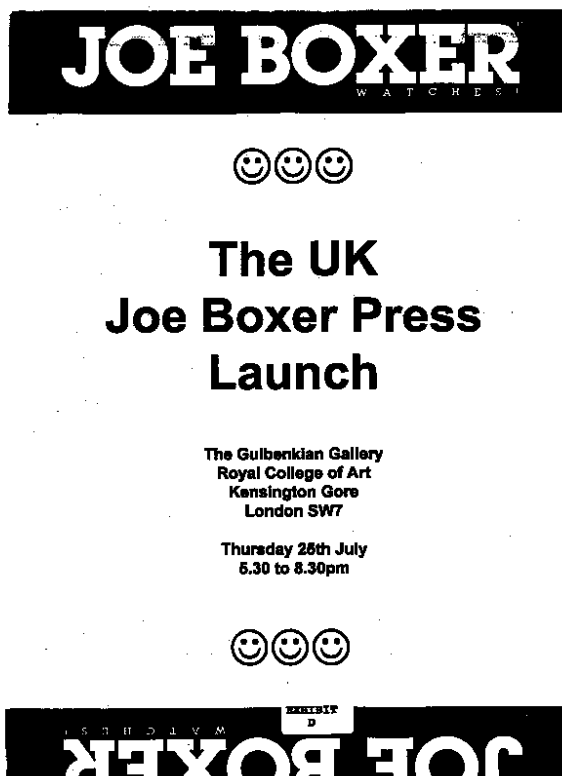
14. Exhibit C is a list of countries in which the Applicant has sought (and in some cases) obtained registration of the signs put forward for registration in the present application. It appears from this exhibit that the “licky logo” simpliciter has been registered in Australia (Class 25), Canada (Classes 14 and 25), Germany (Classes 14 and 25), Hong Kong (Class 14), Iceland (Classes 14 and 25), Japan (Classes 14 and 25), Mexico (Classes 14 and 25) and the United States (Classes 15 and 25). The “smiley logo” and the “licky logo” appear to have been registered in the United Kingdom under number 2046611 with effect from 23<sup>rd</sup> November 1995 for use in relation to “clocks and watches” in Class 14.

15. In paragraph 6 of Mr. Langmaid’s Affidavit it is confirmed that the signs in suit were used by the Applicant from at least September 1993. He says that use in the United Kingdom commenced in 1994 and “Total sales of products bearing those marks in the United Kingdom since then have been approximately \$300,000” (paragraph 8). He then observes as follows: “I understand that other parties have used a ‘happy face’ design in the United Kingdom to promote and identify their products, but such activities have not



been in conflict with the interests of my Company. I am not aware of any such use of the design in the United Kingdom by Franklin Loufrani or Barter International Group Ltd” (paragraph 9). He does not condescend to particularity in relation to the nature, duration or extent of the non-conflicting use of the “happy face” design by other traders in the United Kingdom.

16. The advertising and promotional materials exhibited to Mr. Langmaid’s Affidavit include material (Exhibit D) relating to the launch of the JOE BOXER watches in the United Kingdom. This Exhibit, which appears to relate to a launch event in London on Thursday 25th July 1996, contained numerous representations of a smiley face. The first page of the Exhibit gives a flavour of the way in which the smiley faces were used in the text of that document:



17. In Exhibit E and subsequent exhibits, “the smiley logo” and “the licky logo” appear in various different forms and in various different contexts associated with JOE BOXER goods in Class 25.

18. Mr. Langmaid confirmed in paragraph 11 of his Affidavit that his company was a defendant in the proceedings brought by the Opponents in France in October 1995. He provided no further information as to the nature or progress of those proceedings.

19. Mr. Hitchcock and Mr. Onda provided copies of certain supporting materials, including a short ‘History of the Happy Face’ item videotaped from a television programme called American Journal broadcast in the United States on 30 December 1996.

### **The Hearing**

20. The opposition proceeded to a substantive hearing before Mr. M. Foley, acting on behalf of the Registrar of Trade Marks, on 22nd May 2000. Both sides were represented by leading counsel. The transcript of the proceedings has been made available to me in connection with the present appeal.

21. At the outset of the hearing Counsel for the Opponents confirmed that the only relevant objections to registration were those based on Sections 3(1)(b), 3(6) and 5(4) of the 1994 Act. The submissions directed to the objection under Section 5(4) appear to have been constrained by what Counsel described as the spartan nature of the Opponents’

evidence. The recurrent theme of the case advanced on behalf of the Opponents was that the signs in question possessed a non-distinctive character and were therefore caught by the exclusion from registration contained in Section 3(1)(b). The objection under Section 3(6) was put upon the broader than pleaded basis that the application represented an inappropriate attempt by the Applicant to steal a march on other persons in the trade in business selling goods bearing the happy face logo.

22. Counsel for the Applicant insisted that the Opponents' evidence provided no or no sufficient basis for a finding that the application in suit was objectionable under Section 5(4). He maintained that there was, on the evidence, no substance in the objection under Section 3(6) (whether or not the objection was put on the basis that the Applicant was unfairly attempting to register signs in the common domain). He acknowledged that the application could not proceed on the basis of distinctiveness acquired through use in the United Kingdom prior to the date of the application for registration (12th December 1995). He nevertheless maintained that the signs in question were devices which could and should be taken to possess enough visual distinctiveness to be free of objection under Section 3(1)(b).

### **The Hearing Officer's Decision**

23. In a written decision issued on 22nd June 2000 the Hearing Officer rejected the objections to registration and ordered the Opponents to pay the Applicant £785 as a contribution towards its costs of the unsuccessful opposition.

24. The objection under Section 5(4) was rejected for lack of evidence sufficient to render it viable in any material respect. Similarly, in relation to the objection on the ground of bad faith, the Hearing Officer said:

“In my view the onus in such cases rests firmly with the opponents. If they are claiming that the trade mark is theirs and not the applicants’, they must establish that their mark was well known, in the United Kingdom, to the point that the applicant must have known it belonged to them, or would have known through some other circumstances, for example, a trade connection. I find no evidence which shows any use of the mark at all, let alone to support a claim that the applicants would have known that the opponents were using it. Nor is there any evidence which shows that the HAPPY FACE is widely used by other traders and cannot function as a badge of origin, or that registration would deprive others of that which they are legitimately entitled to use. I find that the opponents have not established that the applicant acted in bad faith in making this application, and consequently, the opposition under Section 3(6) also fails”.

25. The state of the evidence also weighed heavily with the Hearing Officer in relation to the objection under Section 3(1)(b). In that connection he said:

“There is no suggestion by the opponents that the trade mark applied for is a sign which is incapable of distinguishing, that it describes a characteristic of the goods or that its use is customary in the trade, and there is no evidence which would lead me to such a view. Consequently, Section 1(1), and Sections 3(1)(a), (c) and (d) are not an issue. The opponents’ objection appears to rest in subsection (b) that the trade mark is devoid of any distinctive character, and in support of this contention [Counsel] referred to the statement by Stephen P. Langmaid in his Affidavit in which he says that other parties have used a “happy face” design in the United Kingdom to promote and identify their products, but that such activities have not been in conflict with the interests of his company. [Counsel] sought to persuade me that this was an admission by the applicants that the trade mark applied for was in

common use, and consequently, it could not be distinctive of them. In my view the statement of Mr. Langmaid is ambiguous and could equally be taken to mean that other traders are using similar signs but on dissimilar goods and services. I cannot, therefore, agree with [Counsel]. In the absence of any evidence to the contrary, I can only come to the view that the trademark applied for is, prima facie, a good and registrable mark. The objection under Section 3(1) is dismissed accordingly.”

### **The Appeal**

26. In July 2000 the Opponents gave notice of appeal to an Appointed Person under Section 76 of the 1994 Act. They maintained in their Statement of Case in support of the appeal that their objections to registration were well-founded and ought to have been upheld. With particular reference to Section 3(1)(b) of the Act, they claimed that the Hearing Officer “failed to pay sufficient attention to the evidence that the [trade mark applied for] is used to denote a happy and smiling face and as an attractive design. ... (t)he Opponents submit that the evidence showed that the [trade mark applied for] is the sort of attractive design that a trader might wish to use without any improper motive”.

27. The Opponents were not represented at the hearing of their appeal and they filed no written submissions in lieu of appearance. The Applicant was represented, as before, by leading Counsel. In his Skeleton of Argument for the hearing and in his oral submissions Counsel maintained that the Hearing Officer was right, for the reasons he gave, to arrive at the conclusions he did.

## **Decision**

28. I have uncontradicted evidence in support of the opposition in which Mr. Loufrani deposes to licensed use of the logo shown in paragraph 5 above in various territories including the United Kingdom. However, his evidence is so lacking in particularity that no findings can be made with regard to the nature, duration or extent of the use of the logo which is said to have taken place under licence in the United Kingdom. I also have uncontradicted evidence from Mr. Langmaid on behalf of the Applicant in which he confirms his understanding that other parties have used a “happy face” design in the United Kingdom to promote and identify their products. He states that such activities have not been in conflict with the interests of his company. But again, his evidence is so lacking in particularity that no findings can be made with regard to the nature, duration or extent of the use of the “happy face” design by other traders in the United Kingdom which is said to have been non-conflicting.

29. The evidence on both sides is somewhat more informative with regard to use of the smiley face logo outside the United Kingdom. It points to use of the logo upon and in connection with the marketing of different products by different traders in other European countries, the United States and Japan. The duration and extent of the different uses cannot be determined, but I am left with the clear impression that there has been intermittent, substantial, widespread and diverse commercial use of the logo outside the United Kingdom and that this has included use upon and in connection with the marketing of items of clothing.

30. I do not understand the paucity of the evidence in relation to the United Kingdom to be symptomatic of lack of awareness or use of the smiley face here. The evidence on both sides includes exhibits which emphasise the fame of the smiley face. In *The Story Behind The Smile* in Exhibit FL3 it is characterised as “world famous”. In an article from the Worcester Sunday Telegram published on 23rd January 1972 (Exhibit D to Mr. Wallace’s Affidavit) it is referred to as “the best known smile since the Mona Lisa”. I have no doubt that Mr. Langmaid is correct in his understanding that the smiley face has been used by others to promote and identify their products in the United Kingdom. As a member of the public in the United Kingdom I think it would be quite unreal to suppose that awareness and use of the smiley face had not spread to this country well before 1995.

31. In the instances illustrated in the evidence before me, the smiley face appears to have been wanted for use (in commercial contexts, no less than in other contexts) for its inherent capacity to communicate the sentiments that a warm and friendly smile is capable of conveying to people everywhere: light-heartedness, pleasure, amusement, benevolence, affection, approval, satisfaction and so forth. I do not think that in the instances I have seen in the evidence, the use of the smiley face was likely to have been perceived as an indication that the goods or services with reference to which it was used came from the same undertaking or from economically-linked undertakings: c.f. Case C-39/97 Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc. [1998] ECR I-5507, paragraphs 27 to 29. On the contrary, I would expect people to have seen the smiley face as being, in and of itself, an origin-neutral expression of amiability.

32. The inclusion of the smiley face as a standard icon in Microsoft Word for Windows software suggests that it has been recognised and accepted as a basic unit of communication. As discussed (and as demonstrated by the shorthand writer) at the hearing before me, Word 95 provided users in the United Kingdom with the 'Auto Correct' facility to type : followed by ) whenever they wanted to include the graphic ☺ in the text of the documents they were producing. The same is true of Word 97 and Word 98.

33. Counsel for the Applicant likened the inclusion of this facility in Microsoft Word software to the inclusion of it in a dictionary. I agree. He maintained that it was not inconsistent with the possession of a distinctive character in the context of commercial use. However, I think it provides support for the view that in 1995 a smiley face was apt to be seen and used as an expression of amiability in commercial and non-commercial contexts. The launch material in Exhibit D to Mr. Langmaid's Affidavit (see paragraph 16 above) appears to me to show use of the smiley face as an expression of amiability in a commercial context. Although I gave the Applicant an opportunity to make further observations in writing on the inclusion of the smiley face as a standard icon in Word software packages within seven working days after the hearing no further observations were submitted.

34. So far as I can tell from Exhibit C to Mr. Langmaid's Affidavit, the Applicant first began filing applications in November 1995 to register itself as proprietor of the smiley face logo for use in relation to the goods of interest to it. That was after the commencement of the proceedings which the Opponents had brought against it in France.



I am willing to infer that the applications for registration in the name of the Applicant were precipitated by the action taken in France. I am not willing to accept that the applications (and more particularly the present application for registration in the United Kingdom) should therefore be taken to have been made in bad faith.

35. In the present proceedings the propriety of the application is to be presumed in the absence of evidence sufficient to displace the presumption. That appears from the observations of Lord Wright in Joseph Constantine SS Line Ltd v. Imperial Smelting Corporation Limited [1942] AC 154 at 192, 193:

“In addition, the ordinary rule is that a man is not held guilty of fault unless fault is established and found by the Court. This rule, which is sometimes described as the presumption of innocence, is no doubt peculiarly important in criminal cases or matters, but it is also true in civil disputes ... There is, for example, no presumption of fraud. It must be alleged and proved. So also of other wrongful acts or breaches of contract .... If the matter is left in doubt when all the evidence has been heard, the party who takes upon himself to affirm fault must fail.”

36. On the evidence before me it looks as though the Applicant applied for registration to protect what it perceived to be its legitimate commercial interests in the face of adverse claims raised by the Opponents for the protection of what they, in their turn, perceived to be their legitimate commercial interests. I can see nothing in the nature or circumstances of the present application which could justify the rejection of it as improper. I agree with the Hearing Officer in thinking that the application was unobjectionable under Section 3(6) of the Act.

37. I also agree with the Hearing Officer in thinking that the application was unobjectionable under Section 5(4) of the 1994 Act. However the basis upon which I would reject the objection is broader than that upon which he rejected it. It appears to me that the use of the signs put forward for registration, in relation to goods of the kind specified in the application, would not have been likely to cause deception or confusion among buyers and sellers or users of such goods in the United Kingdom in 1995. That would, in my view, be the position even if (which cannot be taken to have been established) the logo shown in paragraph 5 above had previously been used to a significant extent in the United Kingdom in some one or more of the different ways shown in Exhibits FL2 and FL4 to Mr. Loufrani's Statutory Declaration. I say that because I consider that in the United Kingdom in 1995 the signs put forward for registration and the logo upon which the Opponents rely were simply not liable, in and of themselves, to be perceived as an indication of origin, type or quality when used upon or in connection with the marketing of such goods.

38. My reasons for regarding the application as unobjectionable under Section 5(4) are also my reasons for regarding it as objectionable under Section 3(1)(b) of the Act.

39. The Act gives effect to the provisions of Council Directive No. 89/104/EEC of 21<sup>st</sup> December 1988. It is clear from paragraph 46 of the Judgment of the European Court of Justice in Joined Cases C-108/97 and C109/97 Windsurfing Chiemsee Produktions-und Vertriebs v. Boots-und Segelzubehör Walter Huber and Franz Attenberger [1999] ETMR 585 that possession of a distinctive character "*is one of the general conditions for registering a trade mark under Article 3(1)(b)*" i.e. under Section 3(1)(b) of the 1994 Act.

The distinctive character required by Section 3(1)(b) is “a *pre-requisite for its registration*” (paragraph 44).

40. In order to be registrable a visual device, no less than any other sign, must possess enough of “a *distinctive character*” to be perceived as an indication of trade origin by “*the relevant class of persons or at least a significant proportion thereof*”. Windsurfing (above) paragraphs 44, 46 and 52. Paragraph 29 of the Judgment in Windsurfing case further confirms that the “*relevant class of persons*” consists of “*the trade and ... average consumers of that category of goods in the territory in respect of which registration is applied for*”. The “*average consumer*” of the products concerned is to be regarded as “*reasonably well-informed and reasonably observant and circumspect*”. Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v. Klijsen Handel BV [1999] ETMR 690 paragraph 26.

41. The purpose of the inquiry is to determine whether the sign put forward for registration is, in and of itself, sufficiently distinctive in the United Kingdom as a whole to perform “*the essential function of a trade mark*” which “*according to the settled case-law of the Court ... is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without the possibility of confusion, to distinguish the product or service from others which have another origin*”. Case C-39/97 Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc [1998] ECR I-5507, paragraph 28.

42. If it is, the absolute protection envisaged by Sections 5(1) and 10(1) of the 1994 Act (Articles 4(1)(a) and 5(1)(a) of the Directive) can properly be conferred upon it consistently with the provisions of Article 16(1) of the Agreement on Trade-Related

Aspects of Intellectual Property Rights (“TRIPs”) O.J. 1994 L 366 p.213 which envisage that “*a likelihood of confusion shall be presumed*” in the event of unauthorised use of an identical sign in relation to goods or services identical to those for which the protected sign has been registered.

43. It is precisely because I consider that use of the smiley face by rival suppliers of the relevant goods would not, of itself, have given rise to any likelihood of deception or confusion in the United Kingdom in 1995 that I do not regard the smiley face as, of itself, eligible for the absolute protection requested in the present application for registration. The smiley face appears to me to be meaningful (as an origin-neutral expression of amiability) to a degree which makes it unacceptable for registration under Section 3(1)(b) in the absence of evidence sufficient to establish that it has come, through use in the United Kingdom, to be seen and understood as a single source specific indication of trade origin.

44. I recognise that the exhibits to Mr. Langmaid’s Affidavit show use of the smiley face with other matter (notably the designation JOE BOXER) in a manner which may be said to render the usage of the combined elements distinctive. However, it is not the use of the smiley face in combination with other elements, but the use of the smiley face simpliciter which the Applicant is seeking to monopolise by means of the present application for registration.

45. The “licky logo” does not express quite the same sentiments as the smiley face logo. However the two signs have been put forward for registration in series on the basis that they resemble each other as to their material particulars and differ only as to matters

of a non-distinctive character not substantially affecting the identity of the mark applied for: Section 41(2) of the 1994 Act. The Applicant has not sought to amend or sub-divide the application for registration so as to present the “licky logo” for registration independently of the smiley face logo. In the circumstances I consider that the registrability of the “licky logo” remains tied to the registrability of the smiley face logo with the result that refusal of the latter leads inevitably to the refusal of both.

### **Conclusion**

46. The Opponents’ objection to registration under Section 3(1)(b) of the 1994 Act will be upheld. Their objections under Sections 3(6) and 5(4) of the Act will remain rejected. The Hearing Officer’s decision to allow registration will be set aside, as will his order for costs.

47. It appears to me that the burden of preparation shouldered by the Applicant in relation to the Opponents’ unsuccessful objections under Section 3(6) and 5(4) is significantly larger than the burden of preparation shouldered by the Opponents in relation to their successful objection under Section 3(1)(b). I do not think it would be right to make matters worse for the Applicant by making an order for costs in favour of the Opponents. There will, accordingly, be no order for costs in respect of the proceedings in the Registry or on appeal.

Geoffrey Hobbs Q.C.

16<sup>th</sup> July 2001.

Christopher Morcom QC instructed by Messrs. Lloyd Wise Tregear appeared as Counsel on behalf of the Applicant.

The Opponents were not represented at the hearing of the Appeal.

The Registrar was not represented at the hearing of the Appeal.