

O-063-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2556916
BY INTERPET LIMITED TO REGISTER THE FOLLOWING TRADE MARK IN
CLASSES 3, 5, 10, 16, 18, 20, 21 & 28:**

MIKKI

AND

OPPOSITION THERETO (NO 101336) BY MICKI LEKSAKER AB

The background and the pleadings

1) Application 2556916 was filed by Interpet Limited (“Interpet”) on 25 August 2010 and it was published in the Trade Marks Journal on 24 September 2010. The mark, together with the class 28 goods which are the subject of the opposition (the goods in the other classes are not opposed), are set out below:

MIKKI

Toys for domestic pets

2) Micki Leksaker AB (“ML”) opposes the registration of Interpet’s mark in respect of the above goods. Its opposition was filed on 22 December 2010 and is based on grounds under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”); a ground under section 5(3) was also initially pleaded but this was dropped at the hearing. The earlier marks/signs ML relies upon are:

Community Trade Mark (“CTM”) registration 2972636 which was filed on 13 December 2002 and which completed its registration procedure on 14 May 2004. The mark and the class 28 goods for which it is registered are:



Games and playthings

ML claims that the mark has been used and has a reputation for all of the goods for which it is registered.

A sign corresponding to the above mark is relied upon under section 5(4)(a). It is claimed that the sign has been used in the UK since as early as 1961. On account of such use, it is claimed that the use of Interpet’s mark is liable to be prevented under the law of passing-off.

CTM registration 2972578 which was filed on 13 December 2002 and which completed its registration procedure on 23 August 2004. The mark and the class 28 goods for which it is registered are:

MICKI

Games and playthings

The same grounds/claims are made as the above CTM.

3) Given their filing dates, both of ML's marks constitute earlier marks as defined by section 6 of the Act. Given the dates on which they completed their respective registration procedures, both earlier marks are subject to the proof of use provisions set out in section 6A of the Act.

4) Interpet filed a counterstatement denying the grounds of opposition. It puts ML to proof of use in respect of its earlier marks. It anticipates that if use is proven then such use will relate to children's games and playthings which it considers not to be identical or similar to Interpet's toys for domestic pets. Interpet considers that the section 5(2) claim will fail on this basis. Under section 5(4)(a), Interpet claims that the respective marks have co-existed, which demonstrates that if there was a risk of misrepresentation, confusion or damage, this would already have become apparent.

5) Both sides filed evidence. The matter then came to be heard before me on 17 January 2013 at which Interpet was represented by Mr Martin Krause of Haseltine Lake LLP and at which ML was represented by Mr Ian Gill of AA Thornton & Co.

ML's evidence

Witness statement of Jonas Aronsson

6) Mr Aronsson is ML's managing director. The following emerges from his evidence:

- ML is a Swedish company founded in 1944.
- ML produces "a variety of games and playthings".
- Retail catalogues from 2006-2011 are provided showing a large range of the games and playthings produced. They are clearly aimed at children, indeed, given their nature, I would estimate that the majority of the goods are for young children of pre-school/nursery school age. There are no goods which are aimed at adults or teenagers.
- The earlier trade marks are featured in the above catalogues. There is no evidence as to the circulation of these catalogues, be it geographical or quantitative information. The text is in English.
- Brand research conducted in 2003 and 2007 shows a 50% recognition rate for the MICKI brand in Sweden.
- ML has attended the Nuremberg Toy Fair for the past 40 years. This event is a large one with around 2,600 exhibitors from 64 countries.

- ML has featured in press articles, some examples are provided from Swedish publications. No evidence as to the circulation of said publications is provided.
- Various figures relating to turnover and promotion are provided as follows. Unless stated otherwise, the figures are in Swedish Krona (“Sek”):
 - EU (but additionally including Norway) – turnover has ranged between 96 million and 131 million in the date range 2000 to 2009. Promotion has ranged between 2.5 million and 4.7 million in the same date range.
 - Denmark - turnover has ranged between 4.3 million DKK (Danish Krona) and 8.1 million in the date range 2005 to 2010. Promotion has ranged between 120k DKK and 465k in the same date range.
 - Sweden - turnover has ranged between 27 million and 48 million in the date range 2005 to 2010. Promotion has ranged between 1.9 million and 3.6 million in the same date range.
 - UK - turnover has ranged between 61k and 500k in the date range 2005 to 2010. Promotion has been 100k in each of the years in the same date range.
 - The Netherlands - turnover has ranged between 197k and 380k in the date range 2005 to 2010. Promotion has been 100k in each of the years in the same date range.
 - Germany - turnover has ranged between 155k and 1.6 million in the date range 2005 to 2010. Promotion has been 100k in each of the years in the same date range.
 - France - turnover has ranged between 6k and 36k in the date range 2005 to 2010. Promotion has been 100k in each of the years in the same date range.
 - Finland - turnover has ranged between 1.8 million and 2.9 million in the date range 2005 to 2010. Promotion has ranged between 100k and 264k in the same date range.
- The promotional figures for the UK, Netherlands, Germany and France appear to represent that countries proportionate contribution to ML’s attendance at the Nuremberg Toy Fair. The promotional figures for other countries also include a proportionate contribution but the figure is not exclusively for this.

- Various catalogues are provided showing the marks in use as a result of the promotion referred to above, showing similar products to that already discussed. Invoices and price lists for certain countries are also provided. In respect of the UK, the mark is said to have appeared in catalogues available on the Amazon retail website. Some UK price lists and invoices are provided.

7) Mr Aronsson states that ML has a good reputation in the EU. He believes that consumers may be confused into believing that MICKI used on toys for pets are related to ML. He says such confusion is increased by toys for pets often being sold through the same trade channels as ML's goods (such as supermarkets and on websites such as Amazon). Mr Aronsson adds that toys for animals can be animal shaped which adds to confusion. He adds that confusion could lead to safety issues. Exhibit 15 contains examples of the respective goods being sold through the following trade outlets:

- B&Q selling on the one hand a toy bike, play balls, a kite, hopscotch mats, a Swingball™ game, a water gun, a slide, a bat and ball set, a flying disc, a skipping rope, a cricket set, and on the other selling toys for pets including a dental twister, a feather boa cat toy, various animal shaped pet toys, a bone toy and action balls for a cat (small plastic balls that contain a bell), a ball on a rope, sponge balls for a dog, a ball thrower.
- Waitrose selling children's toys with a pet theme – none are for pets
- Sainsbury selling children's toys with a pet theme and other toys but also selling toys for pets such as battling balls and animal shaped cat toys.
- Tesco Direct selling pet themed children's toys and also toys for pets such as pet ball light

Witness statement of Mattia Karlsson

8) Mr Karlsson is an attorney at law working for Awapatent AB. Mr Karlsson's evidence consists of a translation of certain of the Swedish articles (and other documents) provided in Mr Aronsson's evidence. Mr Karlsson states that he is fully acquainted with the Swedish and English languages and that his translation is true to the original. I do not consider it necessary to summarise the translation in detail. It is suffice to say that the name MICKI (albeit most often referred to as Micki Leksaker) is used in the articles. It is also clear that in Sweden at least, the products appear to have been doing well.

Interpet's evidence

Witness statement of Melvyn Driver

9) Mr Driver is managing director of MDC Exports Limited ("MDC") and was chairman of Mikke Pet Products Ltd ("MPP") since its incorporation in 1993. The relationship between these two companies with Interpet is not fully explained. Mr Driver states that he developed the MIKKI trade mark in 1985. It was originally used in relation to muzzles, but the range expanded to include toys for pets and other pet products.

10) In the period 1989-1996 applications to register the trade mark were made in various countries – the details in Exhibit MD1 show that the applications were filed either in the name of Mr Driver, MPP, MDC or MDC Trade Marks Limited ("MDCTM"). For example, a UK mark is referred to, namely no. 1392410, which consists of a stylized version of the word MIKKI and is registered in Class 18 for a variety of pet products; the registration does not cover toys for pets. The mark is now owned by Interpet by way of an assignment from Lawrence Plc who took an assignment from Mr Driver, the original applicant of the mark. Exhibit MD2 contains a list of designs either in the name of Mr Driver or the joint names of a Mr Davies and Mr Driver. The designs include designs of pet toys from as early as 1993.

11) MPP was incorporated in 1993. In that year it was involved in a passing off action with another party in respect of the MIKKI trade mark. Other than how much this cost by way of legal expenses, no details of the actual conflict are provided. Mr Driver states that between 1994-1997 MPP's turnover grew significantly. This is shown in data sheets provided in Exhibit MD5. The figures themselves are around the £40-60k mark per month in 1994 which grew to what appears to be an average of over £100k per month in 1997.

12) In 1997 MPP sold its business to Lawrence Plc following which MPP then changed its name (to what is not clear). MPP's main customer was Petsmart (now Pets at Home) as well as independent pet shops. It is stated that MIKKI pet products were available throughout the UK from the late 1980s. It is stated that animal toys and playthings were an important part of the business. Exhibit MD6 contains a letter to a prospective client about the purchase of a parrot toy. Exhibit MD7 contains an export price list from 1996 which includes a variety of toys for pets. The word MIKKI is used to identify the brand. Exhibit MD8 is a 1995 catalogue which includes a MIKKI cotton rope play toy.

Witness statement of Mark Hoskins

13) Mr Hoskins is the commercial director of Interpet. Mr Hoskins states that the MIKKI mark has been continuously used since its development in 1985. As well

as use of the word MIKKI, Mr Hoskins states that the mark is used in the following two forms:

The logo consists of the word "Mikki" in a stylized, handwritten-style font. The letter 'M' is significantly larger and more prominent than the other letters.

1985-2007



2007-present

14) Mr Hoskins states that Interpet has used the MIKKI brand since “it was acquired from the original owner in 1997”. Exhibit IL2 is an extract from the website of Eco Animal Health Group Plc. In 1997 this company was called Lawrence Plc. The history detailed on the website indicates that in 1997 it acquired MIKKI PET PRODUCTS. Mr Hoskins states that Interpet Limited was owned by Lawrence Plc from 1995 until its purchase by Central Garden and Pet Company in 2004.

15) It is stated that the MIKKI trade mark has been used by Interpet in respect of a range of pet care products, accessories and toys for pets. Exhibit IL3 contains extracts from Interpet’s catalogues between 1997-1999, including price lists and promotional material. They include toys for pets such as balls, flying discs, animal shaped articles for cats to chase etc. Sales are said to be made through national chains, independent pet stores and wholesalers. By way of example, in 2010 around 40% of sales took place through national chains such as Pets At Home, 35% through independent pet stores and 20% through wholesalers; the remainder of the sales are made to house accounts and clearance sales.

16) Exhibits IL4-IL8 contain extracts from a number of MIKKI distributors in the UK. They contain information about the distributors rather than about MIKKI products. Annual turnover of MIKKI branded goods was just under £2 million in 2008 and between £2 and £2.5 million for the years 2009-2010. This is not broken down by product type.

17) Mr Hoskins then focuses on the use made in respect of pet toys, the price of which he says is between £3.09 and £8.89. Examples of use are shown in Exhibit IL9 in respect of pet toys. Exhibit IL0A contains UK sales figures for MIKKI pet toys since 2001. The exhibit has been granted confidentiality. It is suffice to say, as the witness does, that the turnover figures have risen from just under £50,000 to over three times that amount by 2010. Exhibit IL10B is a redacted version of IL10A with the financial information removed. It shows the various types of goods sold – a large range of pet toys are listed. Mr Hoskins states that although MIKKI is not shown next to the name of all of the products, they all bear the name on the product or packaging. An example of such packaging is provided in Exhibit

10C which is a product (Behaverite Boredom Rugby Ball) listed on Amazon.co.uk; the word MIKKI is used in the product description and a stylized version of MIKKI is used on the packaging.

18) Exhibits IL11-12 contain advertisements dated 1995 and 1996 placed in the publication The Service Dog, which feature MIKKI (stylized). Mention is made of pet toys as being part of the range. Exhibit IL13 are pages from catalogues for the Crufts Dog Show 1991-2001 and 2007. They contain references to exhibitors including MDC/MIKKI PET PRODUCTS, "Interpet (Mikki)" and also MIKKI alone. Exhibits IL15-16 contains information about two professional dog groomers who endorse MIKKI goods. Website extracts containing details of the dog groomers are provided, one of the extracts refers to MIKKI grooming products.

19) Mr Hoskins then provides evidence about Interpet's competitors and the pet toys (and other pet products) sold in the market. This is all noted, but I do not need to summarise this here. Also provided are: i) a 2006 article for AMA Market Research about the pet accessories market, ii) a 2010 YouGov article on the UK pet product market, and iii) a 1994 news article about pet toys from the website of The Independent.

Witness statement of Heather Orr

20) Ms Orr is a trade mark administrator at Haseltine Lake. I will summarise her evidence by reference to the exhibits she provides:

- HO1 – An extract from the Toy Safety Directive in which a "toy" is identified as being for use in play by children under 14 years of age.
- HO2 - An article from a marketing agency on the toy industry (the articles discuss only children's toys) including statistics showing the extremely large scale of the market in the UK. Information about this marketing company's clients is provided in Exhibit HO3.
- HO4 – An article from a marketing company about the UK toy market, again focusing on children's toys, the main players in the market and the large size of the market. Information about the marketing company is provided in Exhibit HO5.
- HO6 – A report from the organizers of the Nuremberg International Toy Fair. The information is about children's toys, the toy market and the trade fair itself, including exhibitor statistics. A Wikipedia print about the toy fair is provided in Exhibit HO7.
- HO8 – The alphabetical list from the Nice Classification for Class 28 which shows an entry for "toys" and an entry for "toys for domestic pets".

- HO9 – An extract from the IPO’s classification search system which shows that toys for children and animals are distinctly categorized.
- HO10 – An extract from the UK Trade Tariff in relation to toys and sporting goods which states that the relevant section does not apply to articles which on account of their design, shape or constituent material, are identifiable as intended exclusively for animals.
- HO11-16 – This exhibit contains extracts from the websites of various retailers which sell both toys for pets and toys for children and that they fall under different headings as follows: Argos – children’s toys under the heading “Toys and games”, pet toys under the heading “Pet Care”; Asda – pet toys under the heading “Pets” and children’s toys under “Toys”; Sainsbury’s – children’s toys under the heading “Toys & Nursery”, although not detailed, there is a category called “Garden & Pet”; Wilkinson – various pet products under the general heading “Pets” and children’s toys under the general heading “Toys, Games & Bikes”; Littlewoods – pet toys under the heading “Pet care”, children’s toys under the heading “Kids Toys & Games”; Amazon.co.uk where toys for pets are categorized under the “pet supplies” category whereas children’s toys are under the “Toys and Games” category.
- HO17-18 contains the floor plans of two supermarkets showing that the pet care area is not in the same place as the area for toys/baby care products.
- HO19 – An extract from the website of the Toy Retailers Association which lists the range of safety markings applicable to children’s toys.
- HO20-22 – These are various articles which highlight that there are no safety requirements from pet toys and the danger that can arise from this to pets – although safe for children, some children’s toys may be dangerous to pets.
- HO23 – A number of examples of pet toy products which indicate that the products are not intended for children.
- HO24 – A further extract from the Toy Retailers Association showing that safety is the number one factor consumers consider when buying toys.

Proof of use of the earlier mark(s)

21) The use conditions that relate to the earlier marks are set out in section 6A(3) of the Act:

“...The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.”

22) Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

23) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position¹ was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of

¹ Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28.

confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

24) The argument at the hearing was not whether the mark had been genuinely used or not, but whether the use that had been made entitled ML to rely on its full specification(s) which both currently read: “games and playthings”. In terms of deciding upon a fair description, the description must not be over picky². It is necessary to consider how the relevant public would likely describe the goods³. The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 (“Alladin”)* held:

² See *Animal Trade Mark* [2004] FSR 19.

³ See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or

services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

25) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed Page 23 of 68 in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

26) It was brought to my attention that ML’s earlier mark was the subject of an unsuccessful revocation before OHIM. The decision is apparently the subject of appeal. OHIM considered the matter of partial revocation focusing on whether the goods should be revoked other than in respect of children’s games and playthings. OHIM decided that the specification should be retained in full, its primary reasoning being based on what it considered to be the fine line between children’s and adult’s games and playthings. Whilst this decision is borne in mind, it is not binding upon me. Neither party asked for my decision to be suspended to await the outcome of the appeal, both parties being content that I should decide the matter based on the facts before me.

27) Games and playthings is a term which encompasses goods for children, adults and pets. It is clear from the evidence that the trade differentiate between such goods for pets and such goods for children. This was highlighted by Mr Krause in his submissions who argued that this meant that there were clear sub-categories of goods to consider. There is less evidence in relation to the adult market, but they will either be categorized on their own or sold alongside the goods for children. Mr Gill argued that it would be wrong to sub-categorize on the basis of the user of the goods and that there was a fine line between them in any event; he argued that use had been demonstrated on a broad range of goods and that ML was justified in being able to rely on its specification unaltered. My

view is that toys for pets are a clear and separate sub-category. The same applies to goods for children or, at the very least, to humans. Whilst nothing in what I say here eliminates the possibility that the goods are similar, they are nevertheless clearly in a different market. The trade sub-categorise them and I consider that such sub-categorisation would accord with how the consumer sees it. I do not consider it reasonable for the broad range of goods to be retained.

28) The resulting specification should reflect the use shown and should be specified to an appropriate sub-category. As stated earlier, ML's goods are for children. Mr Gill highlighted some examples of where the goods may be used by adults as well as by children. I have carefully gone through the catalogues and other evidence provided by ML. There are a few examples of games called couronne, bagatelle and korono. They appear to be games where a player uses a stick to push balls or counters around a board, similar, in a way, to pool. However, given that these still appear to be aimed at children and given that such games form only a very small part of a quite large catalogue, it would be a mischaracterisation to regard ML's use as anything other than children's games and playthings. The fact that adults may play with such games in order to interact with the child does not affect the nature of the goods so marketed. All of this is consistent with ML's business in terms of its own corporate information contained in its catalogues and, as Mr Krause pointed out, the types of publications it advertises in. ML has used its mark in order to create or maintain a share in the market for children's games and playthings. I consider a fair specification (and consequently the specification on which ML may rely in these proceedings) to be:

“Children's games and playthings”

Section 5(2)(b)

29) Section 5(2)(b) of the Act reads:

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

(a)

(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.”

30) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v.*

Klijzen Handel B.V [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

31) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

32) The conflict now involves "toys for domestic pets" on the one hand and "children's games and playthings" on the other. The average consumer is a member of the general public, albeit the pet owning public versus the general public with children to buy for. Obviously, such public can overlap, many pet owners have children. In terms of the degree of care and attention likely to be adopted in the purchase of the goods, I consider that this will be an average one, no higher or lower than the norm. Whilst Mr Krause highlighted that safety issues are important in the minds of consumers (a point touched on by some of the evidence), this does not necessarily mean that the average consumer will pay a greater degree of care and attention than the norm. Most consumers will, in my view, assume that the goods are safe and that they meet any relevant safety requirements. I consider that both sides' goods are likely to be selected more by the eye (self-selection, perusal of websites etc) than by the ear; whilst visual similarity may therefore have more significance, aural similarity will not be ignored from the assessment.

Comparison of marks

33) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

MICKI v MIKKI

34) Neither mark breaks down into separate components so there is only one dominant and distinctive element, the words MICKI/MIKKI respectively.

35) From a visual perspective, the marks are both of five letters, four of which are shared, with the common letters being in the same order. The only difference is the interchanging of a K for a C in respect of the third letters in the respective marks. The marks are not particularly long which, in the case before me, means that the different letter is not completely lost. However, weighing this differences with the similarities, I consider there still to be a good deal of visual similarity,

36) From an aural perspective, I take the view that the marks will be pronounced in an identical fashion.

37) In terms of concept, there is no evidence that the words MICKI or MIKKI have a specific meaning in the UK spelt in those particular ways. However, I consider that the average consumer in the UK will nevertheless regard both words as a variant spelling of the name MICKEY. To that extent the marks are conceptually identical. Overall the marks are similar to a reasonably high level.

Comparison of goods

38) When making the comparison, all relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

39) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

40) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

41) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”⁴ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁵.

42) As stated in my assessment of the average consumer, whilst the average consumers of the respective goods come from different categories of the general public, there is nevertheless a potential for overlap. In terms of trade channels, the evidence shows that the trade categorise (on websites for example) the competing goods distinctly and separately. The same applies in physical retail environments. The goods could be sold in completely different shops (pets shops as opposed to toy shops). Whilst it is true that supermarkets and similar

⁴ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁵ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

establishments may sell both pet toys and children's toys under the same roof, they will be sold in different areas of the store. Therefore, being sold under the roof of the same supermarket is, I agree with Mr Krause, far too superficial a fact to create any meaningfully degree of similarity.

43) In terms of the physical nature of the competing goods, it is difficult to say when comparing the specifications at a general level. I say this because the nature of certain pet toys may be very similar to certain counterparts in the human world, whereas other pet toys may have nothing equivalent. For example, a flying disc for a pet, a ball for a pet, a squeaky toy for a pet, are all types of goods likely to have a human counterpart product. The precise nature may differ in that the pet versions are likely to be made of a stronger material to withstand, for example, a dog's bite. Nevertheless, the nature in terms of size, shape, look and feel may be very similar. On the other hand, certain goods, for example a hamster's wheel, a rope pull for dogs to chew and pull, have no clear counterpart and, thus, for such goods there is no similarity in nature. I will bear these variances in mind, but as things stand for an unlimited specification, the applied for mark contains within its ambit goods which have a very similar nature to goods which fall within the ambit of the earlier mark(s)'s specification.

44) In terms of purpose, at a general level the goods are all for playing with. Mr Krause suggested that this was, again, too general an assessment. I disagree. Whilst the exact purposes are different, there must be some similarity in purpose in that the competing goods are all for playing with. This creates at least a moderate degree of similarity in purpose. In terms of methods of use, the comments in the preceding paragraph apply here in that goods which have pet/human counterparts will have some similarity in terms of how they are used; there will though be some differences as the type of play between a child and a pet will not be the same.

45) The goods are certainly not complementary in the sense described in the case-law. In terms of competition, whilst it is possible that a consumer could opt, for example, to buy his pet a ball or flying disc intended for children (or indeed humans), I think the most likely scenario is that if you want a pet toy then one will buy a pet toy and if you want a children's version then you will buy that. I do not consider that there is any material aspect of competition.

46) Weighing the above factors, I consider that the goods are similar. For the specification as it stands, I consider there to be a moderate degree of similarity overall on the basis of such goods with human counterparts. To the extent that the specification notionally covers goods with no pet/human counterpart, then any similarity is of only a very low degree.

The distinctiveness of the earlier mark

47) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In terms of inherent characteristics, I have already stated that the mark alludes to the name MICKEY. Mr Krause referred to the existence of other Mickey brands (Disney's Mickey Mouse, for example) but I do not consider that this affects the position. Although not a highly distinctive mark, it is not a mark which should be treated with only a low degree of distinctiveness. I consider that it possesses a reasonable degree of inherent distinctive character.

48) I must also consider the use put forward by Interpet. Although the mark has been used, and used significantly in some Member States, it is the likelihood of confusion on the part of the UK average consumer with which the tribunal is concerned. The use in the UK is not significant, so I cannot see how the use of the mark elsewhere will increase the likelihood of confusion from the perspective of the UK average consumer. There is no relevant enhanced distinctiveness.

Likelihood of confusion

49) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

50) The marks are similar to a reasonably high level. The purchasing process is an average one, with no higher or lower degree of care and consideration likely to be used. Imperfect recollection is a factor to bear in mind, a factor which in this case may mean that the actual difference between the marks may not be recalled and, thus, there is potential for the marks to be mistaken for one another. In terms of the goods, for goods with a pet/human counterpart then it seems to me likely that the average consumer will regard the use of the mark on pet toys to be an expansion of the use of the mark on the human/children's counterpart, or vice versa. The average consumer is likely to realize that the goods are not the same and they will not buy a pet toy instead of a human toy by mistake (or vice versa) but they will put the similarities down to the same or a related company being responsible for both. The opposition succeeds for such goods as it does for the specification as it now stands.

51) What, though, is the position for the other types of pet toys which may have no human/children's counterpart. Here I assessed the degree of similarity

between the goods to be very low. The other factors remain the same. In my view, the factors in this assessment do not combine to result in there being a likelihood of confusion. The average consumer will not see an expansion point because there would be no good reason to expand from one form of children's games/playthings to an unrelated pet toy (or vice versa). There is no likelihood of confusion. Given this finding it may be necessary to consider a revised specification to reflect the scope of my decision. However, I will firstly consider the opposition with regard to the other pleaded ground.

Section 5(4)(a) of the Act

52) Section 5(4)(a) of the Act prevents the registration of a mark the use of which 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..”

53) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

54) The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom.”

55) I note from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature⁶. However, being a small player does not necessarily prevent the law of passing-off from being relied upon⁷.

56) In terms of the material date, I note the judgment of the GC in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Joined Cases T-114/07 and T-115/07 where it was stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (Cadbury Schweppes v Pub Squash (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

57) Use of the applied for mark before its date of application may be relevant. It could establish that Interpet are the senior users, or that there had been common law acquiescence, or that the status quo should not be disturbed which, in turn, could mean that the use of the mark could not have been prevented under the law of passing-off at the material date⁸.

58) I will give my view of this claim briefly, but succinctly enough for a clear understanding of my findings. The claim under section 5(4)(a) fails for the following reasons:

- i) Although Mr Gill criticised Interpet’s evidence, it is clear from its evidence that Interpet have been producing pet toys since at least as early as the mid 1990s.

⁶ *Hart v Relentless Records* [2002] EWHC 1984

⁷ See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49

⁸ See, for instance: *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

- ii) ML's use of its mark in the UK is not clear. The only figures and evidence stem from 2005 onwards.
- iii) The consequence of points i) and ii) combined is that Interpet is in fact the senior user and, therefore, the use of its mark may not be restrained under the law of passing-off.
- iv) Even if ML's evidence established that it had been using its mark in the UK for longer (and before the use of Interpet), Interpet's use has been ongoing for so long that it would not, at the material date, be capable of being restrained.
- v) Furthermore, the character of any goodwill owned by ML is of a specialist children's toy producer particularly of nursery aged toys and games – I do not consider that when measured against such actual use (as opposed to the notional use assessed under section 5(2)(b)) there would be an assumption that the use of the mark MIKKI on pet toys was being made by ML. There would be no misrepresentation.

Revised specification

59) I have identified that the broad term of the applied for mark includes some goods which will lead to a likelihood of confusion but some goods which will not. In the circumstances, I invite Interpet to file a revised specification and accompanying submissions detailing any types of goods it wishes to register that:

- a) Fall within the ambit of "toys for domestic pets";
- b) Fall within the scope of this decision in that the goods so specified have no human/children's counterpart;
- c) Do not fall foul of the guidance issued by the CJEU in the *Postkantoor* decision;
- d) If the specified goods are exemplified in the evidence, a reference to that appropriate part of the evidence be made.

60) Interpet's written submissions should explain why it considers the terms to be within the scope of my decision. A period of 14 days from the date of this decision is permitted for such action. Upon receipt of the above, ML will be allowed 14 days to comment on any proposed terms and I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If Interpet puts forward no revised terms then I will issue a supplementary decision confirming the outcome as it stands in paragraphs 50 above. In the supplementary decision I will also issue my decision on costs. The

appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision.

Dated this 8th day of February 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**