

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

**IN THE MATTER OF Application No. 1577116
by The Gymboree Corporation to register a
trade mark in Class 28**

and

**IN THE MATTER OF Opposition thereto under
No. 42844 by Tumble Tots International Limited
and Tumble Tots (UK) Limited (jointly)**

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DECISION

20 On 5 July 1994, The Gymboree Corporation of 700 Airport Boulevard, Burlingame,
California, USA, applied under Section 17(1) of the Trade Marks Act 1938 to register the
trade mark GYMBO. The application was made in respect of goods falling in Class 28 and
after examination proceeded to advertisement for a specification of goods comprising:-

25 Toys, games and playthings; dolls, puppets, toy stuffed animals, play parachutes, balls,
finger toys, toy boxes, party favour toys, bubbles, bubble blowing solutions, toy music
makers; cartoon character figures; activity and games mats; components for making
climbing structures, interlocking contoured units for making climbing structures,
30 interlocking contoured units for use as play exercise apparatus for children,
playhouses, all being in kit form; circular boards for developing balance, body
awareness and co-ordination; manually operated exercise apparatus; decorations for
Christmas trees; all included in Class 28.

35 The application, numbered 1577116 was advertised for opposition purposes on 26 April 1995
and on 24 July 1995, Tumble Tots International Limited and Tumble Tots (UK) Limited as
joint opponents filed notice of opposition to the application.

The grounds of opposition are in summary:-

- 40 **1. Under section 12(1)** The mark GYMBO is similar to the opponents' earlier
marks already on the register and the goods are identical
or similar to the goods used in the provision of the
services in respect of which those marks are protected
that there exists a likelihood of confusion or association
- 45 **2. Under Section 11** By virtue of the use the opponents have made of the
trade mark GYMBOBS, the use of the trade mark
GYMBO applied for by the applicant in relation to the
goods for which the application is made is likely to

5 cause deception and confusion in the minds of the public and would be disentitled to protection in a Court of Justice.

10 **3. Under Section 9 & 10** The trade mark is not at its date of application distinctive or adapted or capable of distinguishing the goods of the applicants.

15 Details of the opponents' registered marks cited in Section 12(1) of the grounds of opposition are as follows:

15	Number	Mark	Class	Journal/Page	Specification
20	1458725	Gymbobs	41	5920/3334	Provision of recreational facilities; gymnastic and physical exercise tuition services; all for children; all included in Class 41.
25	1548335		41	6046/6445	Provision of recreational facilities; gymnastic and physical exercise tuition services; rental of video tapes, films, cassettes, compact discs and of educational materials and apparatus; publication of books, magazines, periodicals and newsletters; all included in Class 41.
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The opponents ask the Registrar to exercise his discretion and refuse the application.

35 The applicants filed a counter-statement admitting that the opponents had notified the applicants of their intention to object to the registration of application number 1577116, albeit, 4 days before they filed the Notice of Opposition. The applicants allege that the mark is a good and registrable trade mark and deny all the grounds of opposition; they state also there is no reason for the registrar to exercise his discretion to refuse the application. The applicants request that the opposition be dismissed and that an award of costs be made in their favour.

45 Both sides filed evidence in these proceedings and the matter came to be heard on 6 July 1998, when the applicants were represented by Mr Adrian Speck of Her Majesty's Counsel. Instructed by S J Berwin & Co, their Trade Mark Attorneys. The opponents were represented by Ms Lindsey Wren of Pinsent & Curtis, their Trade Mark Attorneys.

By the time this matter came to be determined, the Trade Marks Act 1938 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 1938 Trade Marks Act must continue to

5 be dealt with under that Act, in accordance with the transitional provisions set out in
Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all reference in this decision are
references to the 1938 Trade Marks Act.

Opponents' evidence (Rule 49)

10 The opponents' Evidence in Chief comprises two Statutory Declarations. The first, dated 17
June 1996, completed by Veronica Pereira, a General Manager employed by Tumble Tots
(UK) Limited. Ms Pereira confirms that Tumble Tots International Limited is registered as the
proprietor of trade mark numbers 1485725 and 1548335, details of which can be found earlier
15 in this decision, and that Tumble Tots (UK) Limited is a registered licensee of trade mark
number 1458725. Ms Pereira refers to exhibit "VP1" which comprises certified copies of the
trade mark registration certificates, an extract from Trade Marks Journal 5979 advertising the
recordal of Tumble Tots (UK) Limited as a registered user of 1458725, and a copy of an
agreement dated 8 December 1992 between Tumble Tots International Limited and Tumble
20 Tots (UK) Limited.

Ms Pereira goes on explain that Tumble Tots International Limited and Tumble Tots (UK)
Limited are subsidiaries of Jack Chia - MPH Limited, a company registered in Singapore. She
says that the companies have used the trade mark "Tumble Tots" in the UK since 1979, and
25 the trade mark "Gymbobs" since 1980/81, in relation to a variety of goods and services for
children, and goes on to set out the opponents ground for opposing the application.

Ms Pereira explains that the concept of the opponents' business is the "promotion of children's
well being by the development of their physical capabilities through exercise programmes,
30 such as structured play to tests of agility, balance and coordination", and had been initiated in
1979 by Bill Cosgrave, an ex- National Olympic Gymnastics coach. Ms Pereira also refers to
a Statutory Declaration completed by Mr Cosgrave, the details of which I will set out later in
this decision.

Ms Pereira says that in 1984 the business was transferred from Tumble Tots Limited to
Tumble Tots (UK) Limited, becoming a franchise and is currently one of 75 located
throughout the United Kingdom. She describes the business as being "run like a club", with
the courses given names such as "gymbobs" to give the children a name to which they can
relate, which in turn helps to promote the children's interest in their own development and
40 contributes to the goodwill of the business, increases membership and sales of merchandise.

Ms Pereira says that children joining the club pay a subscription and are given a membership
pack, an example of which is shown in exhibit "VP2". This consists of a white plastic wallet
endorsed on the front "With the support of Munch Bunch" and a cartoon figure, and the text
45 "Welcome to Tumble Tots" which is marked as being a registered trade mark. The back of
the wallet contains a contact address for Tumble Tots (UK) Limited, the words "gymbabes" in
green and "gymbobs" in blue, with cartoon figures depicted jumping over the lettering.
Above the word "gymbabes" are the words "Crawling - walking" and above "gymbobs" the
text "School age- 7 years old", which, from the descriptions given by Ms Pereira, relates to
50 the level of the child participant. The pack contains a blue T shirt bearing the word
"gymbobs" with a cartoon character above and below, a badge for wear bearing the

5 inscription, "I'm a gymbob" the "o" being one of three balls being juggled by a cartoon
character, and various items of printed matter, mostly undated or dated after the relevant date
and only three items bear the "gymbobs" name; a mail order catalogue and a leaflet marked
"Autumn/Winter 95" and "Spring/Summer 96" respectively, advertising items of childrens'
10 wear, playthings and crockery with the word "gymbobs" appearing on a sweatshirt, shorts, jog
suit and T shirt, and a pack of "discount vouchers" for various goods and attractions with the
word "gymbobs" shown on the inside back cover.

Ms Pereira confirms that since the introduction of the "gymbobs" programme in 1981, the
word has been used and promoted on a large scale in the United Kingdom, both with "Tumble
15 Tots" as part of the corporate name or as a trade mark, or on its own as a trade mark. Ms
Pereira gives the current membership figures as approximately 60,000, and for the previous
years:-

20 As at 1995 year end 46,000
As at 1994 year end 47,500
As at 1993 year end 50,000

Ms Pereira states that each member will have received a membership pack promoting the
"gymbobs" mark, and will have seen or heard of "gymbobs" by either attending a "gymbobs"
25 class or other classes taking place before or after a "gymbobs" class. She also states that each
member will have seen publicity or merchandise bearing the word "gymbobs" and refers to
exhibit "VP3" which contains items of promotional material and 3 mail order catalogues
offering merchandise along the lines of the catalogues forming part of exhibit "VP2". One is
dated 1994/95, the other two are undated. All items in exhibit "VP3" refer to the word
30 "gymbobs" in association with "Tumble Tots". Ms Pereira goes on to refer to exhibit "VP4",
consisting of items of printed matter used in the "gymbobs" classes, and two badges for wear.
All are blue in colour and clearly bearing the word "gymbobs".

Ms Pereira confirms that the membership figures given earlier in this decision relate to all
35 classes run under the "Tumble Tots" umbrella, and she goes on to give the following
membership and turnover figures which she says relate specifically to "gymbobs":-

YEAR	GYMBOBS MEMBERSHIP	MEMBERSHIP FEES	LICENSEE FEES (estimated)
40 1995	2,674	£30,617.30	£254,030
1994	3,158	£36,159.10	£300,010
1993	2,853	£32,666.85	£271,035
Total	8,685	£99,443.25	£825,075

Ms Pereira states that sales of merchandise under the "gymbobs" name commenced in 1980/81
although stock distribution figures only go back as far as 1993. These show sales of
merchandise under the "gymbobs" name as follows:

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ITEM	YEAR			VALUE OF SALES
	April 1993-94	April 1994-95	April 1995-96	
Stickers	£1,243.62	£1,368.64	£917.91	£3,530.17
Posters	£25.20	£21.60	£46.80	£93.60
I Can Books	£505.60	£1,184.00	£1,132.80	£2,822.40
White T-shirts	£502.32	£370.76	£245.18	£1,118.26
Navy shorts	£406.98	£1,005.48	£809.97	£2,222.43
Sweat-shirts	£1,627.19	£1,312.54	£916.98	£3,856.71
Tracksuits	£3,072.95	£1,469.92	£1,394.13	£5,847.00
Staff sweat-shirts	£1,071.60	£573.40	£131.60	£1,776.60
Polo shirts	-	£122.50	£665.00	£787.50
			TOTAL	£22,054.67

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Ms Pereira goes on to say that the “gymbobs” name has been widely advertised in the press and refers to exhibit “VP5” which consists of copies of newspaper articles, advertisements for merchandise, and two lists detailing an advertising campaign endorsed as relating to Tumble Tots. The copies do not bear the name of the publication in which articles appeared or the date of publication although on the top of each is a handwritten date which I take to be the date of publication. One article dated June/July 1992 relates specifically to the “gymbob” classes, Two others dated April/May 1994 and June/July 1994 relates to Tumble Tots and refers to “gymbobs” in the body of the article, the remainder are either dated after the relevant date or make no mention of “gymbobs”.

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The second page of exhibit “VP5” is a copy of an article which appeared in “a nationally circulating magazine, “Right Start” in June/July 1992”, and confirms that the other articles appeared in the same magazine in February/March 1994, April/May 1994, June/July 1994, October/November 1994, December 1994 and June/July 1995. Two of the three copies of advertisements promote the Tumble Tots range of classes, including “gymbobs”, and appeared in the magazines “Parents” (circ 80,00), “Mother & Baby (circ 113,000), Practical Parenting (circ 125,000), “New addition” (circ 500,000), “Mother & Child Health” (circ 300,000) between September 1994 and June 1995, and in “Parents”, “Mother & Baby, Practical Parenting and “New Generation” between October 1995 and April 1996. The advertisement is headed Tumble Tots but also refers to the “gymbobs” classes. The remaining advertisement dated Feb/March 94 offers merchandise for sale, a similar same range to that detailed in the catalogues forming part of exhibit “VP2”.

5 Ms Pereira states that the “gymbobs” name has also been promoted by mail shots with some
40,000 leaflets promoting “Tumble Tots/gymbobs” being distributed in September 1995. She
confirms that the marks are promoted locally by posters, leaflets and in the press by the
licensees running a “gymbobs” franchises and goes on to set out the locations in which a
10 “gymbobs” programme is operating. This lists towns throughout England, and refers to
Northern Ireland.

Ms Pereira refers to exhibit “VP6” which contains examples of advertising which has taken
place in Stockport, Bangor, Norfolk, Southport, Devon, Newcastle-Upon-Tyne and West
Sussex. The exhibit partly comprises printed matter which would appear to be used in the
15 running of the Tumble Tots classes, the remainder is a range of leaflets and flyers which are
either undated or dated after the relevant date. The exhibit also includes articles and
advertisements which appeared in local newspapers. Two appeared in an un-named
publication and date from August/September 1989. One appeared in the Worthington
Guardian and is endorsed 21 October 1987. The remainder are either undated or dated after
20 the relevant date and in all but one case do not quote the publication.

Most items forming part of exhibit “VP6” refer to “gymbobs”, occasionally on its own
although more usually in conjunction with Tumble Tots. Ms Pereira concludes by setting out
the opponents reasons and grounds for opponents to the registration of the mark GYMBO,
25 and her views on the consequences to the opponents business should the mark being
registered..

The second Statutory Declaration forming part of the opponents' Evidence in Chief was
completed by William Pierce Cosgrave, and is dated 18 June. Although no year is given for
30 the date that of Declaration, the exhibits state that they relate to the Statutory Declaration of
the above dated 18 June 1996. Mr Cosgrave states that he is the Technical Consultant
employed by Tumble Tots (UK) Limited and goes on to set out his background in British
athletics. He explains how in 1979 he devised a programme for pre-school children to develop
35 their motor and mental skills through organised play and exercise. He called the programme
Tumble Tots, stating that the name is derived from the way that the children tackle exercise.
He goes on to set out the development of the Tumble Tots programme through to the
introduction of “gymbobs” for older children in 1980/81, a name chosen “because children of
that age always seem to be bobbing about”.

40 Mr Cosgrave goes on to refer to exhibit “WPC1” which consists of a blue coloured badge
bearing the word “gymbobs” with two cartoon character, one above and one below the word.
Mr Cosgrave says that this badge was supplied to the children who first participated in
“gymbobs” in 1980/81.

45 Mr Cosgrave states that the equipment and programme format for “gymbobs” was the same as
for Tumble Tots. Both use well known forms of gymnastic equipment as well as equipment he
has devised, with new items, either commercially available or devised by Mr Cosgrave being
added over the years. He goes on to refer to exhibit “WPC2” which has a cover sheet
endorsed “1979 - 1984 and contains copies of photographs of the exercise equipment used in
50 Tumble Tots and “gymbobs” classes. Pages 1 to 8 depict children exercising using various
items of gymnastic equipment, eg, vaulting horse, balance beam, trampoline, floor matting,

ropes, parachute. Pages 9 to 45 contains pictures of wooden and foam exercise apparatus custom made by Mr Cosgrave, including various hand-held items such as balls, cones, bean-bags, sticks, rhythmic streamers and hula-hoops. Between pages 45 and 46 is a sheet marked 1984 - 1988, with pages 46 to 60 showing the exercise apparatus being commercially produced for Tumble Tots. This is followed by a sheet marked 1988 - 1994 and two pages, one bearing a picture of a "play safe" display, the second with two exercise items, light weight water dumbbells and stepping shapes which "squeak" when stepped upon. None of the pictures show the "gymbobs" name being used on, or in conjunction with the apparatus.

Mr Cosgrave continues by describing the Tumble Tots and "gymbobs" programmes, and refers to exhibit "WPC3" which contains stickers awarded to children on successful completion of a particular activity, such as climbing, jumping, catching, etc, books entitled "I Can" in which to collect the stickers and "I Can" certificates awarded after completion of a set of activities. The stickers bear the "gymbobs" name and a cartoon character depicting the activity completed. The "I Can" books and certificates bear the name "gymbobs" and Tumble Tots.

Mr Cosgrave confirms that the name "gymbobs" has, since 1981, been promoted throughout the United Kingdom using a variety of goods. He refers to exhibit "WPC4", which contains T-shirts and a collection of pictures of T shirts and polo shirts, all bear the "gymbobs" name with cartoon characters. The exhibit also contains two pictures taken from fund raising publicity campaigns. Although not dated, the pictures include oversize representations of bank cheques, one dated "15 October 86", the other, "1 February 89", and include children wearing "gymbobs" T shirts. The final part of exhibit "WPC4" is three items of printed matter; an Autumn 1984 Tumble Tots schedule for Harrow/Ealing, an article from the Evening Post, dated 1 May 1985, reporting on the start-up of some Tumble Tots and "gymbobs" classes, and an undated promotional poster for "gymbobs" depicting cartoon children participating in "gymbobs" activities

Mr Cosgrave states that since 1984 he has attended and promoted the "gymbobs" name at exhibitions around the United Kingdom. He goes on to say that staff and parents of Tumble Tots and "gymbobs" children have received newsletters, and refers to exhibit "WPC5" containing articles from an "in-house" magazine. Pages 1-17 of the exhibit refer to Tumble Tots with no mention of "gymbobs". Pages 18, 21-23 and 26 all mention "gymbobs" but are undated. Pages 29-34 and 35-40 are newsletters called Tumble Talk, dated Autumn 95 and Winter 96. Both mention "gymbobs"

Mr Cosgrave confirms that he is aware of the activities of the applicants in the USA, and states that as far as he is aware they have not promoted the GYMBO mark in the UK. He concludes by giving his view on the likelihood of confusion should the applicants be allowed to promote their merchandise.

Applicants' evidence (Rule 50)

This consists of a Statutory Declaration dated 8 April 1997, completed by John Estil, UK Vice President of Gymboree (UK) Limited, a wholly owned subsidiary of the applicants, the Gymboree Corporation Inc. Mr Estil states that the applicants were founded in 1976 as an

5 “interactive parent/child play programme” with its first retail store clothing opening in 1986. He refers to exhibits “JE1”, the 1995 annual report for the Gymboree Corporation Inc, and “JE2”, a “fact sheet” describing the current trading position of the company, and dated “4/96”. Both bear the word “GYMBOREE” in plain block type or a stylised form, the annual report uses the word in conjunction with a clown cartoon figure.

10 Mr Estil makes particular reference to pages 2-5 of the annual report. This sets out the history of the Gymboree Corporation Inc, and lists by year the “key developments” from the inception of the first Gymboree play programme in 1976 through to the opening of the 300th store. He states that there are plans for the Gymboree Corporation to open “its first store in the United
15 Kingdom in 1996”. Mr Estil claims that the name Gymboree is a household name in the United States and is “synonymous with goods and services that enrich, support and celebrate childhood”, and having commenced in 1976, pre-dates Tumble Tots by at least three years.

20 Mr Estil proceeds to set out the worldwide scale of the Gymboree programmes, having approximately 400 franchise operations in the United States and 10 foreign countries although does not include the United Kingdom in this list countries. Later in the Declaration he states that there are no specific dates for the launch of Gymboree play programmes within the United Kingdom, although 7 stores will be opening in July/August 1997 with an intention to open a further 15 by the end of the year.

25 Mr Estil goes on to explain the basis and structure of the Gymboree play programmes and refers to exhibit “JES3”, literature produced by Gymboree. This consists of four printed sheets, the first is headed “GYMBOREE PLAY PROGRAMME” sets out the background and methods employed in the Gymboree programme, the second bears the same logo depicting
30 cartoon children participating in various activities, the third headed “Why we love Gymboree” sets out the philosophy, benefits and class structure of the programme, and the final headed “And play can last a lifetime” promoting the background and benefits of the Gymboree programme. None of these sheets are dated or indicate their source.

35 Mr Estil explains that GYMBO is the name given to a clown used as a form of mascot by the applicants, and is not only a character which represents the corporate image, but also signifies that certain goods or services are from or sponsored by the applicants. He state that the value of the sales of clothing and videos in the United States is around \$10 million and consequently is immediately recognisable by consumers. Mr Estil gives his view that this shows that there is
40 a very clear distinction between the use of the name “gymbobs” by the opponents to describe one of its classes, and the name GYMBO by the applicants as the name of a clown character.

45 Mr Estil continues by addressing the points made in the opponents' Evidence in Chief, giving his views on the opponens assertions relating to the similarity of “gymbobs” and GYMBO, and the use that the opponents have made of “gymbobs”. He contends that the opponents evidence shows that the use is almost always under the Tumble Tots umbrella and refers to a number of exhibits to support this view. He recognises that members of “gymbobs” are given T-shirts, badges, workbooks, certificates and the like, but only after the point of purchase, which he contends removes the opportunity for confusion.

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5 Mr Estil concludes his Declaration by confirming that the applicants have no intention of using
a device identical or similar to that associated with the “gymbobs” mark, and that the
opponents'
registration number 1548335 should not be a barrier to the acceptance of this application. He
refutes the opponents claim the GYMBO was not at the date of application adapted or capable
10 of distinguishing the applicants' goods, and states that there is nothing in the opponents'
evidence to substantiate this ground of opposition and asks that the opposition be dismissed.

Opponents' Evidence in Reply (Rule 51)

15 This consists of a Statutory Declaration dated 29 October 1997, completed by Veronica
Pereira. Ms Pereira begins by saying that the evidence filed by the applicants is not
appropriate to these proceedings because it does not relate to the mark applied for, nor show
any use beyond that in the United States (in the relevant period).

20 Ms Pereira comments that the word GYMBO is not being used as a trade mark but as the
name of a clown character used as part of the applicants corporate identity, and that the use is
only in conjunction with the Gymboree name. She acknowledges the applicants claim that
Gymboree is a significant undertaking in the United States, but comments that there is no
evidence to show that it has any reputation or use in the United Kingdom. Ms Pereira states
25 that the opponents are not claiming that the concept of the training programme is necessarily
unique to them, but that this is not the issue. It is the similarity of the trade mark applied for
to GYMBOBS, a name which is wholly distinctive of the opponents.

30 Ms Pereira continues by stating that should the applicants launch GYMBO in the United
Kingdom the opponents would consider this to be an infringement of their rights in
“gymbobs”. She comments that the applicants have admitted that they have no use in the
United Kingdom, and although they have stated that they intend to open 15 stores by the end
of 1997, the opponents are not aware of any stores having opened.

35 Ms Pereira goes on to question the manner in which the applicants use the name GYMBO,
denying that it is used as a trade mark. She argues that even if it were possible to show that
the name is used as a trade mark in relation to goods and/or services, such use would be the same
use as the opponents have made of “gymbobs”. Ms Pereira refutes and denies the assertion
40 that “gymbobs” is used by the opponents in a descriptive sense stating that it is cleverly coined
and a distinctive trade mark.

45 Ms Pereira next argues that the word GYMBO and GYMBOBS are similar, and refers to a
number of decided cases which she says support this view. She goes on to say that they are
phonetically similar and makes particular reference to the tendency to slur the ends of words
when spoken. Ms Pereira goes on to state that the opponents use the “gymbobs” in
conjunction with the Tumble Tots house brand did not prevent “gymbobs” being a trade mark
in its own right, and that the name was widely promoted, not simply upon goods “after the
point of purchase”.

50

5 Ms Pereira concludes by refuting the applicants suggestion that the opponents mark number 1548335 should not impede the progress of the application as she considers GYMBO to be close enough to be confusing. She denies that the name GYMBO can be distinctive of the applicants bearing in mind the opponents' earlier rights in "gymbobs" and that in her view the applicant has no bona fide intention to use GYMBO as a trade mark in the United Kingdom.

10 No further evidence was filed in these proceedings, and I now turn to consider the grounds of opposition.

15 I will deal first with the objections under Section 9 & 10 of the Act. At the hearing it was established that the opponents attack under Section 9 came under sub-section (2) of that section, with Ms Wren conceding that the objection under Section 10 was without foundation. I therefore propose to consider the matter only under Section 9(2), which states:

20 **9 (2)** For the purposes of this Section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the
25 extent of the registration.

30 At the hearing it was established that the opponents objection under Section 9 was based on the argument that if the opponents have used and built up a reputation in the mark "GYMBOBS", the use of a similar trade mark, in this case GYMBO, cannot be distinctive because it would not be adapted to distinguish given the opponents prior use. The essence of this argument is that if a mark is not the property of an applicant but of an opponent, it follows that it cannot be distinctive of the applicant's goods. This thought is, of course, expressed in a footnote in Kerly's Law of Trade Marks and Trade Names, Twelfth Edition, Chapter 10, at the foot of page 143, where it says:-

35 "2. Strictly, a mark that offends against Section 11 or Section 12(1) cannot be distinctive; but it is convenient to treat separately the objections under these sections and under Section 9 or Section 10."

40 No reported case is cited in illustration or support of this footnote, so it does not appear that it has ever played a decisive role in any particular opposition as an independent ground of refusal. For my part I consider that attacks under Sections 9 and 10 should relate to the inherent or absolute qualities of the mark, otherwise they add nothing useful to an attack under Section 11. This view is expressed in the following extract from a decision in an
45 Opposition case (NUCLEUS number 35350), unreported, dated 30 July 1996, in which the Registrar's Hearing Officer referring to the footnote quoted above said:-

50 "It is particularly convenient in cases such as this, of course, because here we have identical marks which have been used but which are in different proprietorship. The terms of Section 12(2) clearly envisage the possibility of identical marks in different proprietorship nonetheless being registrable, and it is therefore important to treat the

5 essential or inherent qualities of the mark as a separate matter from issues of
proprietorship since the outcome under Sections 11 or 12 could be that both are
registrable. (An adverse finding under Section 11 or Section 12, of course, would
make refusal mandatory. A retrospective finding that the mark was therefore not
10 distinctive under Section 9 might be interesting, but it could have no practical effect
other than perhaps to complicate an appeal against the Section 11 or Section 12
finding.)

15 The Trade Marks Act 1994 employs the term “absolute grounds of refusal” in relation
to Section 3 (equivalent to Sections 9 and 10 of the old Act), and “relative grounds of
refusal” in relation to Section 5 (equivalent to Sections 11 and 12 of the old Act), and
it seems clear enough that these provisions are to be applied separately from one
another.

20 All this confirms me in my belief that even under the old Act, issues such as seniority
or proprietorship are best dealt with under Sections 11, 12(3) and 17(1), and kept out
of considerations under Sections 9 and 10. Accordingly, I propose to deal with the
Section 11 ground as a separate matter from that under Section 9.”

25 Adopting the same approach, and noting the fact that the opponents have not mounted any
attack on the inherent properties of the mark applied for, I find formally that the opposition
under Section 9(2) does not succeed on the grounds on which it was brought.

30 I next turn to consider the grounds of opposition which are based upon Sections 11 and 12(1)
of the Act, which state:

35 **11.** It shall not be lawful to register as a service mark or part of a service 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 other scandalous design.”

40 **12(1)** Subject to the provisions of subsection (2) of this section, no trade
mark shall be registered in respect of any goods or description of goods that is
identical with or nearly resembles a mark belonging to a different proprietor
and already on the register in respect of:-

- 45
- a. the same goods
 - b. the same description of goods, or
 - c. services or a description of services which are associated with
those goods or goods of that description.

50 The reference in Section 12 to a near resemblance is clarified by Section 68(2)(b) of
the Act which says that references in the Act to a near resemblance of marks are
references to a resemblance so near as to be likely to deceive or cause confusion

5 The established tests for grounds of opposition based upon Sections 11 and 12 are set down in Smith Hayden & Co Ltd's application [Vol 1946] 63 RPC 101 as adapted by Lord Upjohn in the Bali trade mark case, which, adapted for the case in hand reads as follows:

10 (a) **(Under Section 11).** Having regard to the user of the opponents mark GYMBOBS is the tribunal satisfied that the mark applied for, the applicant's mark, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?"

15 (b) **(Under Section 12).** Assuming user by the opponents of their mark GYMBOBS in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicants use their mark GYMBO normally and fairly in respect of any goods covered by their proposed registration?@@

20 I will deal first with the grounds of opposition which are based on Section 12. In my comparison of the respective marks GYMBO and GYMBOBS I will adopt the established test propounded by Parker J in Pianotist companies application [VOL 1906] 23 RPC at page 777, which reads as follows:-

25 "You must take the two marks. You must judge of them both by their look and by their sound. You must consider the goods and services to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods or services. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods or services of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion -that is to say -not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods or services -then you may refuse the registration, or rather you must refuse the registration in that case."

30 The application is for the mark GYMBO, which the opponents contend is extremely similar to their mark, GYMBOBS. When placed side by side the similarity in the marks is quite apparent Both contain the word "GYM", the shortened form of the word "GYMNASIUM" as the first element, which is a reference to the type of service or goods it is used in connection with. However, it is neither likely or appropriate that the marks will be viewed and compared in such a way, and whilst it is inevitable that a comparison will refer to elements of the marks in question, the proper test to be applied is what is the overall impression created by the marks, and is that overall impression such that there is a risk of confusion or deception?

5 In her submissions Ms Wren argued that first impressions and imperfect recollection
were factors, and that I should consider the effect should the applicants use their mark
in a pluralised or possessive form. When making a visual comparison of the marks, it
is self evident that they are relatively short words. The opponents' mark consists of
10 seven letters and the applicants' mark five letters, the first five letters of the opponents'
mark. Taking this into account, I come to the conclusion that there is a sufficient
degree of visual similarity that there is a likelihood of confusion. In considering the
similarity of the sound of the two marks, it was well established the first syllable of a
word is the most important for the purpose of distinction. In the TRIPCASTROID
15 case 42 RPC 264, at page 279 lines 33-40, says:

15 “The termination of the new word is different. Though I agree that, if it were
the only difference, having regard to the way in which the English language is
often slurred at the termination of words, that might not alone be sufficient
20 distinction. But the tendency of persons using the English language to slur the
termination of words also has the effect necessarily that the beginning of words
is accentuated in comparison, and, in my judgment, the first syllable of a word
is, as a rule, far the most important for the purpose of distinction.”

25 It is clear that the applicants' mark is a significant part of the opponents' mark, and
being the first syllable and first five letters is the most important part when considering
the similarity in their sound. I accordingly take the view that the marks are
phonetically very similar.

30 Having determined that there is sufficient resemblance in the marks for there to be a
likelihood of confusion, I am required by the Pianotist test to consider the goods and
services to which they are applied. The applicants are seeking registration in Class 28
for a range of goods and the opponents have two registrations in Class 41 for services.
The matter therefore falls for consideration under Section 12(1)(c), namely, are the
35 services or description of services set out in the opponents' registrations likely to
be associated with the goods or goods of that description set out in the application.
Clarification of what is meant by “associated” is given in Section 68(2)(a), which
reads:-

40 For the purposes of this Act goods and services are associated with each other
if it is likely that those goods might be sold or otherwise traded in and those
services might be provided by the same business, and so with descriptions of
goods and descriptions of services.

45 In her submissions Ms Wren referred to the Registry Guide to the Cross Searching of
Trade Marks in the United Kingdom. This is used by the Registrar to determine
questions of similar and associated goods. It has a cross-search between the services
in Class 41 (into which the opponents' services fall), and the goods in Class 28 (into
which the applicants' goods fall), indicating that “leisure services/ sports training and
50 instruction services” should be considered as “associated” with “Sporting articles (as
appropriate)”. It is commonplace for the provider of certain, although not all sporting
or recreational facilities to trade in the specific equipment used in participating in that

5 activity. The nature of the activity must be considered, for example, the provider of facilities for playing golf will commonly have a shop selling various items for such as golf clubs, balls, tees, etc, whereas the operator of a gymnasium will not usually trade in the exercise equipment.

10 The specification of goods of the application does not specifically mention sporting apparatus. If such goods are included in the specification it will be in the “activity and games mats; components for making climbing structures, interlocking contoured units for making climbing structures, interlocking contoured units for use as play exercise apparatus for children, circular boards for developing balance, body awareness and
15 co-ordination; manually operated exercise apparatus climbing and exercise apparatus”. While these goods may be used in the provision of the services covered by the opponents registered trade marks, I take the view that the provider of such services does not usually trade in the equipment used in the provision of the service. No
20 evidence has been placed before me that there are any particular circumstances surrounding the opponents activities which leads me to a contrary view in this case. Therefore there is, in my view no likelihood of confusion between the services provided by the opponents under their registered trade marks and the goods to be sold under the applicants’ trade mark. Consequently the grounds of opposition based upon
25 Section 12(1) are dismissed.

I next turn to consider the ground raised under Section 11 of the Act where the opponents claim to have used the name “gymbobs” continuously since 1980/81. The exhibits submitted to establish this claim show that the opponents have used the registered trade mark “gymbobs”, usually in association with the name Tumble Tots,
30 but also to a significant extent on its own. However, this use relate mainly to the provision of the “Tumble Tots” and “gymbobs” classes. A number of exhibits relate to a trade in goods, but indicate that the only significant trade has been in items of clothing, and printed matter for promotional purposes or for use in the running of the classes. This is emphasised in the main Declaration executed by Ms Pereira in which
35 she refers to sales of merchandise under the “gymbobs” name and lists 3 items of printed matter and 6 items of clothing.

There are also a limited number of exhibits, namely “VP2, VP3, and VP5” to the main Declaration by Veronica Pereira, which show that the opponent has been trading in
40 goods. These contain examples of mail order catalogues produced by the opponents though these are either undated or dated later than the relevant date to these proceedings (and therefore cannot be given much, if any weight), relate mostly to the name Tumble Tots or promote the goods of other manufacturers, there is in my view little to show that the “gymbobs” name has been used to any extent on anything other
45 than clothing and a small range of printed matter. There is no evidence to show that the name “gymbobs” has been used on any form of gymnastic or exercise equipment.

While the opponents may have provided sufficient evidence for me to establish that they have a reputation in the name “gymbobs” for the provision of recreational
50 facilities and gymnastic and physical exercise tuition services for children, I have seen nothing in the actual use of the word “gymbobs” which would lead me to the view that

5 their reputation extends beyond that or that the public would be confused or deceived if they saw the opponents' trade mark on goods which were neither the same, similar or related to the opponents services. The opposition based on Section 11 of the Act is therefore dismissed.

10 The opposition having failed on all grounds the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435.

Dated this 14th day of October 1998

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**M Foley
Acting for the Comptroller
The Registrar of Trade Marks**

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