

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

**IN THE MATTER OF APPLICATION NO 1516818
BY MARVEL CHARACTERS, INC
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 42892 BY GRUPPO LA PERLA SPA**

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

**IN THE MATTER OF application No. 1516818
by Marvel Characters, Inc to register a trade mark in class 25**

And

**IN THE MATTER OF opposition thereto under No. 42892
by Gruppo La Perla SpA**

DECISION

On 2 August 1995, Marvel Characters, Inc, applied under Section 17(1) of the Trade Marks Act 1938 to register the following series of trade marks:



The application was made in Class 25 and after examination proceeded to advertisement with a disclaimer to the exclusive use of a letter "M" for the specification of goods comprising:

Casual wear; T-shirts; sweatshirts; shirts; shorts; slacks; trousers; jeans; overalls; jackets; coats; dresses; suits; costumes; swimwear; rainwear; sleepwear; underwear; outer clothing; hats; scarves; ties; cravats; socks; hosiery; shoes; sneakers; trainers; beach shoes; slippers; all included in Class 25.

The application, numbered 1516818 was advertised for opposition purposes on 26 July 1993, and on 2 August 1995, Gruppo La Perla SpA filed notice of opposition to the application. The grounds of opposition are in summary:

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1. Section 9 & 10 Because the mark is not distinctive nor capable of distinguishing the goods with which the applicants are connected in the course of trade from goods with which no such connection subsists.

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2. Section 11 By virtue of the use made of the trade mark MARVEL the opponents have acquired a substantial goodwill and a reputation and use of the same or similar mark by the applicants will lead to deception and confusion.

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3. Section 12(1) The mark applied for is confusingly similar to the opponents' registered mark and to the trade marks of other proprietors and its use in relation to the same or similar goods is likely to deceive or cause confusion.

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Details of the registered marks cited in the grounds of opposition are shown in an annex to this decision.

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4. Section 68 Because the intended use of the trade mark is not use as a trade mark.

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The opponents ask that the Registrar refuse the application in the exercise of his discretion and that costs be awarded in their favour.

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The applicants filed a counterstatement in which they deny all of the grounds of opposition, and ask that the Registrar exercise his discretion in their favour and register the application. The applicants also ask that they be awarded costs.

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Both sides filed evidence in these proceedings. The matter came to be heard on 1 November 1999, when the applicants were represented by Ms Fiona Crawford of Elkington & Fife, their trade mark attorneys, and the opponents were represented by Mr David Roberts of Keith W Nash & Co, their trade mark attorneys.

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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 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)

This consists of a Statutory Declaration dated 27 November 1996, made by Giorgio Gualandi, a Director of Gruppo La Perla SpA (the opponents), a position he has held for seven years.

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Mr Gualandi begins by saying that on 18 March 1991, his company purchased the assets of Marvel S.p.A., (an Italian company) from the receiver. He says the assets obtained included the company's national and international registrations for the trade mark MARVEL, and included an application to register the mark in the United Kingdom but which did not proceed to registration. Mr Gualandi says that prior to receivership, Marvel S.p.A. had used the trade mark MARVEL in the United Kingdom in relation to women's clothing. He says that records of sales are not available, being either incomplete or lost which he surmises may be due to the upheaval caused by the receivership.

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He refers to exhibit ABC1 which he says is an example of the mark used by Marvel S.p.A. and which consists of a swing tab bearing the word MARVEL contained within a scrolled border. There is no indication of the date from which it originates, and apart from the text on the reverse giving instructions for cleaning a garment, nothing to say what goods it was used in connection with. Mr Gualandi says that to the best of his knowledge and belief, Marvel S.p.A. used this mark in the United Kingdom from at least 1989 in relation to women's underwear, socks, lingerie, nightwear, beachwear and swimsuits. He goes on to say that since 1991 his company has used the trade mark shown in exhibit ABC1 in relation to the same goods throughout the United Kingdom, and sets out details of the sales which are as follows:

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Year	Turnover (Italian Lire)	Number of pieces
1992	83,704,000 (£34,876)	2164
1993	185,850,000 (£77,437)	3420
1994	229,378,000 (£95,574)	3931
1995	50,586,000 (£21,077)	804

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The figures in brackets are a conversion to £ sterling based on Mr Gualandi's statement that the current exchange rate is approximately 2,400 Italian Lire

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Mr Gualandi next refers to exhibits ABC2 and ABC3. The first of these exhibits consists of two pictures of women wearing items of lingerie which he says appeared in AMICA magazine published in April 1992, although does not say whether this magazine was available in the United Kingdom. Mr Gualandi says that the second exhibit is a copy of an advertising brochure circulated to the trade in, inter alia, the United Kingdom, in 1994, and which contains the same type of pictures as exhibit ABC2. Both of the exhibits show the same MARVEL trade mark described earlier.

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Applicants' evidence (Rule 50)

5 This consists of a Statutory Declaration dated 18 November 1997, and executed by Pamela G Bradford, Vice President of Marvel Comics, Inc, a position she has held since 1995. Ms Bradford confirms that she is also Vice President and General Counsel of Marvel Entertainment Group Inc., the original applicants.

10 Ms Bradford says that the mark was first used in January 1990 in respect of comic books and magazines in illustrated form, and since that date has been licenced and used, inter alia, in the United Kingdom, in respect of a wide range of goods. She says that the first use in relation to clothing was in the United States in January 1992, and refers to exhibit PGB1 which consists of copies of United States trade mark registration certificates for the MARVEL COMICS & M device mark covering various items, including clothing, and Ms Bradford goes on to set out the particulars of these registrations and to confirm that the mark has been used in the United Kingdom in respect of clothing since at least 1993.

15 Ms Bradford goes on to list some of the companies having a current licence to use the mark in the United Kingdom in respect of clothing, although does not say when, or if indeed whether any trade has been conducted by these licensees.

20 Ms Bradford next refers to exhibit PGB2 which consists of a tie which she says was placed on sale in the United Kingdom in 1993 by Tie Rack. The tie is decorated with a representation of what I recognise to be the comic strip character, the Incredible Hulk, and bears a label with the MARVEL COMICS and M trade mark and the name Tie Rack.

25 Ms Bradford refers to exhibit PGB3 which she describes as a brochure of LCG/Outer Limits Limited and which she says can be dated from the copyright notice which shows a date of 1993. The MARVEL COMICS and M trade mark is shown on the front and back cover of the brochure, which is also endorsed "apparel from the marvel universe". The brochure shows a tee-shirt type top and matching pants bearing various comic strip characters and the MARVEL COMICS and M trade mark. The back cover lists two United Kingdom companies for sales enquiries, and is endorsed "printed in England".

30 Ms Bradford says that WW Group Limited (one of the UK licensees referred to earlier) commenced use of the MARVEL COMICS and M trade mark in June 1995 in respect of leisure wear, nightwear, hats and accessories, and in the period up to August 1997 achieved sales totalling £668,962. She refers to exhibit PGB4 which consists of a clothing label bearing the MARVEL COMICS and M trade mark which she says is used by WW Group Limited, and to exhibit PGB5 which consists of two brochures from Pugh Berry Embersons, a division of WW Group Limited. The brochures are dated spring/summer 1997 and spring summer 1998 and show a range of hats, one of which clearly bears the MARVEL COMICS and M trade mark.

35 Ms Bradford next says that Alan M Clothing Co Limited, another of the named UK licensees commenced use of the MARVEL COMICS and M trade mark in September 1996 in respect of, inter alia, socks and slipper socks, and that sales to date amount to approximately £40,000.

45 Ms Bradford goes on to set out details of the applicants use of the trade mark MARVEL which

she says has been used in the United Kingdom in relation to publications since the early 1940's, and the mark MARVEL COMICS in relation to magazines and comic books since at least 1961. She refers to exhibit PGB6 which is a copy of an advertisement published in the Trade Marks Journal relating to application number 949054 to register the mark MARVEL in respect of
5 magazines being printed publications, drawing attention to the basis of the acceptance. Ms Bradford says that the marks MARVEL and MARVEL COMICS have continued to be used in the United Kingdom in relation to books, comic books and magazines to the present day, concluding that the public is unlikely to associate the MARVEL COMICS and M mark with any other company.

10 Ms Bradford refers to the use of the mark in the United States, saying that has been use in connection with clothing since at least 1966. She says that advertisements for MARVEL T-shirts and sweat shirts have appeared since that date in publications sold in the United Kingdom, and refers to exhibits PGB7 and PGB8. These consists of an extract from a comic dating from 1966
15 including an advertisement for MARVEL COMICS T-shirts, and advertisements dating from 1984 to 1989 promoting, inter alia, T-shirts, sweat shirts and hats available from MARVEL COMICS.

20 Ms Bradford says that her company is not aware of any confusion between its mark and that of the opponents when used in the United Kingdom in relation to clothing, or in the United States where there has been simultaneous and concurrent use of the respective marks in relation to clothing from at least 1992.

25 Ms Bradford refers to the opponents statement of grounds and evidence in which they say that they are the proprietor of UK trade mark registration number 1479261 for the mark MARUEL, and application number 1388709 for the mark MARVEL, which Ms Bradford notes was not registered because it was considered laudatory. She notes that the opponents do not have a UK registration for the mark MARVEL and suggests that the application to register MARUEL was filed without any intention to use the mark to acquire monopoly rights to use the unregistered
30 name MARVEL.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

35 **Decision**

I will deal first with the objections under Section 9 & 10 of the Act. Although Section 9 has been included in the grounds of opposition I do not consider it necessary to determine whether the application meets the requirements of that section, as to do so would not make any material
40 difference to this decision. The application was found to be acceptable under Section 10 which poses a lower test than Section 9, and it follows that if a mark fails to qualify for registration under Section 10 it must also fail under Section 9. I therefore need only consider whether the mark qualifies for registration under Section 10 of the Act, which reads as follows:

45 **10 (1)** In order for a trade mark to be registerable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing 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 the limitations, in relation to use within the extent of the registration.

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(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which:-

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(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

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(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

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Mr Roberts did not make any specific submissions in relation to these objections, although in addressing the other grounds did give his views on the distinctiveness (or otherwise) and prominence of the various elements of the mark. Ms Crawford in accepting the laudatory meaning of the word MARVEL argued that its use in conjunction with the word COMICS was as a verb and pointed away from its otherwise laudatory meaning, and in any case, the word COMICS had no relevant meaning in relation to clothing. A word which is directly descriptive does not cease to be so simply because its use may be grammatically incorrect (*Charm* (1928) 45 RPC), and while the word COMICS does not have any meaning for the relevant goods, it is only part of the mark, and arguably, less significant than another, objectionable element. That said, I consider that there is substance to Ms Crawfords' submissions.

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There is also the matter of the background which has been accepted as being "a" letter M. Under the Registrar's practice as set out in the Chapter 9 of the Registry's Work Manual (1989), where a mark gives the impression of a letter but not clearly defined, the mark was considered to be acceptable under Section 10 on disclaimer of "a letter". I consider this approach to be equally applicable to marks where a letter is but one element of a mark, although the question of whether the letter is sufficiently distinctive to carry the mark is a matter of degree depending on its significance in the overall mark. In this case, although the letter has been accepted as "a letter", and by inference, acceptable under Section 10, it is used as a background to other words and is not in my view sufficient in itself to impart a capacity to distinguish. However, taking the mark as a whole, and mindful of the decision of Lawrence J in the *Diamond T* trade mark case (1921) 38 RPC, I come to the view that the mark satisfies the requirements of Section 10, and the opposition founded on this section fails accordingly.

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

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause

confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any other scandalous design.”

5 **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:-

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

20 The reference in Section 12(1) 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

25 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:

30 **(a)** **(Under Section 11).** Having regard to the user of the opponents mark MARVEL is the tribunal satisfied that the mark applied for, MARVEL COMICS and device, 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?”

35 **(b)** **(Under Section 12).** Assuming use of the opponents’ mark MARUEL 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 MARVEL COMICS and device normally and fairly in respect of any goods covered by their proposed registration?

40 I will deal with the matter under Section 12(1) first. The opponents have one trade mark registration, number 1479261 for the mark MARUEL, and have cited a further 5 marks owned by other proprietors, although three have gone off record and Mr Roberts agreed that they could be dispensed with, leaving numbers 1109517 for the mark MARVELUX and 1324119 for the mark COMIX.

45 At the hearing Ms Crawford referred to the Declaration of Mr Gualandi filed as part of the opponents’ evidence, and which refers to an application to register the word

MARVEL as a trade mark made by a company, Marvel S.p.A. in March 1991. The opponents subsequently acquired the assets of this company which they say included the application to register MARVEL, although as that application was refused registration it has no bearing on these proceedings other than to raise a question as to the opponents' intentions in filing an application to register the mark MARUEL in October 1991.

Ms Crawford alleged that the opponents have not used this mark, and had no bona fide intention of doing so because it was registered as a ghost mark in place of the refused MARVEL registration, and therefore, should be disregarded. She accepted that this was supposition but sought to gain aid from the NERIT/MERIT trade mark case (1982) FSR 72 CA. In that case there was ample evidence that the word NERIT had been registered without any bona fide intention to use it for any purpose other than to protect the unregistrable word MERIT, whereas there is no evidence of a similar nature here. While the circumstances of this case, and in particular, the absence of any use of the mark MARUEL after a number of years could be taken as an indication that the registration had been obtained to prevent use of MARVEL by other traders, in the absence of any evidence this would, as Ms Crawford accepted, be nothing more than speculation. Under the provisions of Section 72 of the Trade Marks Act 1994, registration is prima facie evidence of the validity of the mark, and any question as to whether a mark should remain on the register should be resolved through the provisions of Section 46 or Section 47, as appropriate.

I will therefore go on to consider the respective marks, and will adopt the established test propounded by Mr Justice Parker in the Pianotist trade mark case (1906) 23 RPC at page 777, which reads as follows:-

"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."

Mr Roberts' main line of argument was that the word MARVEL is the most prominent element of the applicants' mark, and he sought to compare this element with the words MARUEL and MARVELUX. The other mark COMIX is said to be likely to be open to confusion with the word COMICS, another element of the applicants' mark. At first sight there is a visual resemblance, although given that MARVEL and COMICS are both ordinary and well known words in the English language, it seems to me that there is little likelihood of them being pronounced in the same way, that is, unless the letter U in MARUEL were to be mistaken for a letter V.

5 The opponents' case is essentially based upon the argument that there may be confusion
through imperfect recollection, and relies upon the proposition that the combination of
elements in the applicants' mark will be insufficient to indicate a different trade origin to
the public, and that individual words will be picked out of the applicants' mark and
through poor recollection will be confused with the marks cited in the grounds of
opposition. In some composite marks there will be a distinguishing or essential feature
by which the mark will be recognised, although I do not consider that to be the position
in this case. It is well established that for the purposes of comparison it is the marks as
a whole that should be considered (see *Erectiko v Erector* 52 RPC 151) which I consider
10 supports the view that there is little or no likelihood of confusion.

15 The marks MARUEL and COMIX are registered in respect various items of clothing,
which are the same goods as covered by the application. Ms Crawford submitted that
such goods are not bought blind and will be seen and tried for size and suitability prior to
purchase. The selection of clothing is a personal matter and in most cases will be a
conscious and careful selection based on seeing and trying-on the garment. While this
does not completely remove the possibility of confusion, it does significantly reduce the
likelihood.

20 The remaining mark MARVELUX is registered in respect of linings materials in the piece
for shoes and slippers which are likely to be sold to footwear manufacturers for
incorporation in their own goods rather than to the general public. This is a very specific
area of trade and I would consider that those engaged in the manufacture of footwear
would know and be well used to dealing with and differentiating between particular
25 traders and their marks. Mr Roberts argued that it was nowadays not unusual to see a
trade mark for a type of material (mentioning Gore Tex) used alongside the trade mark
of a manufacturer of a product made of or incorporating such a material. There is no
evidence to substantiate this and I am unable to determine whether, and to what extent
this is the practice of the trade.

30 Taking all of the above into account, I find that I am led to the conclusion that there is no
real likelihood of confusion between the two trade marks for the reasons outlined, and
consequently, the grounds founded under Section 12(1) fail.

35 I will next turn to the grounds founded under Section 11 of the Act. At the hearing Mr
Roberts stated that the opponents' case was essentially one of passing off, although there
is no specific mention of this in the statement of case. It is well settled that the question
of whether a mark offends against Section 11 is not the same as whether the use of the
mark will lead to passing off (see *Hack's application* (1941) 63 RPC 91). I therefore have
40 two matters to determine and will begin with the question of passing off. A helpful
summary of the elements of an action for passing off can be found in *Halsbury's Laws of
England* 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with
reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd - v -
Borden Inc* [1990] RPC 341 and *Erven Warnik BV - v - J. Townend & Sons (Hull) Ltd*
45 [1979] AC 731 is (with footnotes omitted) as follows:

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

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

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of "passing off", and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.

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

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

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

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

5 (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

10 (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

15 The opponents state that they have used the mark MARVEL since at least 1991, and that from at least as early as 1989 it was used by Marvel S.p.A., their predecessors in title, but that there are no records of sales made by that company because they are “incomplete or lost”. Nonetheless, the opponents are able to confirm that Marvel S.p.A. had used the
20 mark in relation to women’s underwear, socks, lingerie and nightwear, beachwear and swimsuits, in effect, the same range of goods that the opponents say they have used the mark in connection with since 1991.

25 It is well established that the matter must be judged at the date of the application, which is in this case 26 October 1992. That there are no details of the sales made by Marvel S.p.A. means that I am unable to consider the extent of the use made of the mark, and consequently, any reputation or goodwill it may well have acquired. The evidence shows that the opponents have used the mark MARVEL in relation to items of lingerie, but none of the exhibits bear a date which substantiates a claim to use of the mark since 1991. The
30 earliest turnover and unit sales figures are shown as relating to 1992, although do not say whether this relates to the financial or calendar years, or the period from which trade commenced, which given that the sales are small even for a limited product line could well be after the relevant date. Based on the evidence before me I am unable therefore to conclude that at the relevant date the opponents had any use, let alone any goodwill or
35 reputation in the mark MARVEL.

40 Although the applicants’ primary business is that of the publisher of magazines, an area of trade quite distinct from that of the opponents’ business as a clothing retailer, they say that have traded in clothing and are seeking to register their mark in respect of such goods. The evidence shows that the opponents have traded in items of lingerie and insofar as such goods are covered by the application, the respective fields of activity are the same. That said, in his submissions Mr Roberts referred to the high quality of the opponents’ goods, which is no doubt reflected in their cost and the care taken in their selection.

45 Self evidently, the marks MARVEL COMICS and M device, and MARVEL are not identical marks. The applicants’ mark is a modern looking logo, whereas the opponents

mark is represented in a standard script placed inside a scrolled border. While they share a common element, when compared as a whole, and when in particular, account is taken of the manner in which the applicants' mark is represented, I do not consider it likely that one element, the word MARVEL will be picked out of the applicants' mark and lead a potential purchaser to the belief that the goods are those of the opponents.

Given this, and my previous findings above, I do not see how the opponents will suffer damage as a result of the applicants using their mark in connection with items of clothing, and the grounds founded on passing-off fail accordingly. Having reached this conclusion I return to consider the "Bali" test referred to earlier, and come to the view that use of the applicants' mark in a normal and fair manner in connection with any goods covered by the registration proposed will not be likely to cause deception and confusion amongst a substantial number of persons, and consequently, the objection founded under Section 11 fails accordingly.

The opponents say that the intended use of the trade mark is not use of a trade mark within the meaning of Section 68 of the Act, the relevant definition reads as follows:

"trade mark means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person".

In his submissions Mr Roberts referred to the use of the trade mark shown in exhibit PGB3, noting that the clothing shown is decorated with characters from the applicants' comic books, and arguing that the mark as shown on the clothing will be associated with the character or the comic book rather than be seen as a trade mark of the applicants. The trade mark when used on the clothing is small in relation to the characters or other matter decorating the clothing and in some instances can be seen to include the letters "TM", and although placed on the garments rather than in the traditional label form, I see no reason why it could not serve as a trade mark of the applicants. There is also an example of use of the mark shown in PGB2 which is a tie decorated with a Marvel comics character, and which bears a label with the mark with the ® symbol, which is, in my view, clearly use as a trade mark.

To succeed under Section 68 the opponents would have had to convince me that the applicants did not propose to use the mark applied for, or that their proposed use is not as a trade mark. The evidence shows that since the filing of the application there has been actual use of the mark applied for on a number of goods for which the applicants seek to register the mark. As I am satisfied that this use is as a trade mark within the meaning of Section 68 and I have no doubt that there was an intention so to do, the objection founded under Section 68 fails accordingly.

There remains the matter of the Registrar's discretion. I see nothing in the evidence filed in this case that persuades me that I should exercise discretion in favour of the opponents. The applicants having been successful are entitled to an award of costs in their favour and

I therefore direct the opponents pay to the applicants the sum of £635 as a contribution towards their costs.

5 **Dated this 3 Day of December 1999**

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15 **Mike Foley
Principal Hearing Officer
For the Registrar
The Comptroller General**

Annex

	No.	Mark	Class	Journal/Page	Specification
5	1417261	MARUEL	25	6017/1729	Panties; petticoats; brassieres; gowns; stockings; sports overalls; windcheater; neckerchiefs (foulards); hats; scarves; gloves; belts; bathrobes; boots; sandals; sabots and slippers; all included in Class 25.
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15	1109517	MARVELUX	24	5324/1750	Lining materials in the piece for shoes and for slippers.
20	1324119	COMIX	25	5765/1472	Articles of outer clothing; shorts, boxer shorts; parts and fittings for all the aforesaid goods; all included in Class 25.