UGANDA REGISTRATION SERVICES BUREAU

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THE TRADEMARKS ACT, 2010

IN THE MATTER OF TRADEMARK APPLICATION No. 51486 "TORONTO RAPTORS" IN CLASS 41 BY NBA PROPERTIES, INC.

AND

IN THE MATTER OF AN OPPOSITION OF REGISTRATION BY MONSTER ENERGY COMPANY

BEFORE: AGABA GILBERT, ASST. REGISTRAR TRADEMARKS

1- On the 15th December 2014, NBA Properties Inc. (herein the Applicant) applied for registration of the trademark "TORONTO RAPTORS" for services in class 41 namely: Education; providing of training; entertainment; sporting and cultural activities; entertainment and educational services in the nature of ongoing television and radio programs in the field of basketball and rendering live basketball games and basketball exhibitions; the production and distribution of radio and television shows featuring basketball games, basketball events and programs in the field of basketball; conducting and arranging basketball clinics and camps, coaches clinics and camps, dance team clinics and camps and basketball games; entertainment services in the nature of personal appearances by a costumed mascot or dance team at basketball games and exhibitions, clinics, camps, promotions, and other basketball- related events, special events and parties; fan club services; entertainment services, namely providing a website featuring multimedia material in the nature of television highlights, interactive television highlights, video recordings, video stream recordings, interactive video highlight selections, radio programs, radio highlights, and audio recording in the field of basketball; providing news and information in the nature of statistics and trivia in the field of basketball; online non-downloadable games, namely, computer games, video games, interactive video games, action skill games, arcade games, adults' and children's party games, board games, puzzles, and trivia games; electronic publishing services, namely publication of magazines, guides, newsletters, coloring books, and game schedules of others on- line through the Internet, all in the field of basketball; providing an online computer database in the field of basketball.

2- The application was published in the gazette dated 13th November 2015 whereupon Monster Energy Company (herein the Opponent) opposed the registration on the ground that the Toronto Raptor's mark is confusingly similar to the Opponent's own registered mark numbers 32685 and 32686 which the Opponent calls the claw mark.

3- Further that the Toronto Raptor's mark is not distinctive.

4- The Opponent is the registered proprietor of the trademark comprised in this symbol  which hereinafter I shall refer to as the scratch mark which is not meant to describe it but merely to name it. The scratch mark is registered to the Opponent for goods in classes 5 and 32 for nutritional supplements and beverages respectively.

5- The main issue as I see it is whether the Applicant's mark resembles the Opponent's mark as to likely to cause confusion.

Resembling Trademarks

6- Section 25(2) of the Trademarks Act provides that:

> *"Subject to section 26, a trademark relating to services shall not be registered in respect of services or description of services that is identical with or nearly resembles a trademark belonging to a different owner and already on the register in respect of—*
>
> *(a) the same services;*
>
> *(b) the same description of services; or*
>
> *(c) goods or a description of goods which are associated with those services or services of the description."*

7- The rationale is obviously that identical or resembling marks will cause confusion when allowed on the register and upon use.

8- On the matter of assessing similarity of trademarks case law is well settled. In the **PIANOTIST Co. Ltd 23 RPC 77** Parker J said:

> "You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

13- The Opponent states that the scratch mark is a device of three vertical wavy lines of the letter "M" representing Monster in the Opponent's name.

14- Aurally, there is not much to compare as the Opponent's mark contains not element to speak of.

Visually, however, the Opponent argues that the scratch mark is comprised in the Applicant's representation. Rodney Cyril Sacks for the Opponent states that the Applicant is *"attempting to register a mark that includes a claw design device which is confusingly similar to the Opponent's unique claw Icon device which is central to and the principal feature of the Opponent's claw Icon marks"* see para 8 of Mr. Sacks' statutory declaration.

15- In my opinion in this particular case, if there is an argument to be made on visual similarity it depends on conceptual similarities which are the crux of the Applicant and Opponent's arguments. The Applicant argues that their mark evokes the qualities of a raptor, an animal, to-wit quick, lethal and intelligent. On the Opponent's part, their evidence is to the effect that the scratch mark does not have any particular meaning although it is *"aggressive, edgy and with its jagged edges suggest a feeling that the package or product to which it is applied is being ripped open"* see para34 of Mr. Sacks' statutory declaration.

16- However, to make their argument of a conceptual similarity, the Opponent submitted that the scratch mark invokes a concept of a beast which seems to be at variance with their evidence. This nonetheless, points to the fact that what the scratch mark and the thick lines on the basketball comprised in the Opponent's and Applicant's marks respectively convey is a matter of perception. This perception is also informed by the overall impression created by the whole mark in the mind of a reasonable consumer.

17- Of course the Opponent and the Applicant may have intended the mark to communicate what they claim each of their marks mean, however, the relevant factor is the perception of the mark by a reasonable consumer.

18- Latham J in **Jafferjee v Scarlett [1937] HCA 36; 57 CLR 115** said:

> "Sometimes it is important to consider what has been described as the "idea of the mark," that is, the idea which the mark will naturally suggest to the mind of one who sees it. Lord Herschell's committee (quoted in *Kerly* on *Trade Marks,* 6th ed. (1927), at p. 270) put the point very clearly in the following passage :—" Two

marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same..."

19- And in **Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd [1952] HCA 15; 86 CLR 536 at 538**; Dixon, Williams and Kitto JJ stated that:

> "To refuse an application for registration on this ground *[that the marks convey the same idea]* would be to give the proprietor of a registered trademark a complete monopoly of all words [and symbols] conveying the same idea as his trademark. The fact that two marks convey the same idea is not sufficient in itself to create a deceptive resemblance between them, although this fact could be taken into account in deciding whether two marks which really looked alike or sounded alike were likely to deceive."(addition mine)

20- Although the Cooper Engineering Co. Pty Ltd case related to deceptive marks, the principle still holds true in my opinion. For example, use of letters to create a word mark should not result in exclusive right to use letters for another word mark. Therefore, even if the scratch mark for the respondent and the thick lines on the basketball comprised in the Applicant's mark evoke similar ideas, it would not by itself be sufficient to deny the Applicant the right to register their mark especially due to the combination of many elements in the Applicant's mark.

21- It is true that in some instances the overall impression created by a mark depends heavily on the features of the mark making it possible that in some instances, an element corresponding to an earlier mark retains an independent distinctive role in a composite mark without necessarily constituting a dominant element of the mark - **Medion AG v Thomson multimedia Sales Germany & Austria GmbH, C-120/04.**

22- In Case **C-591/12P, Bimbo SA v OHIM paragraph 34** it was held that it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case.

23- Since the average consumer perceives the mark as a whole and does not proceed to analyse its various details (**Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [1999] ETMR 690),** it is my considered opinion, that the thick lines on the basketball comprised in the Applicant's composite mark do not weigh significantly in the overall perception of

the mark as to create resemblance with the Opponent's scratch mark. Due to the dominating impact of the words "TORONTO RAPTORS", the way the words surround the basketball, and the basketball itself in the middle of the representation of the mark, the relevant consumers will most likely perceive the thick lines on the basketball as mere flourishes.

24- Even if consumers were to associate said thick lines of the basketball in the Applicant's mark to the Opponent (which is highly unlikely), mere association *perse* will not suffice to create confusion.

25- All in all the marks do not resemble.

Similarity of goods/services

26- A rounded assessment of the marks in issue includes evaluation of interdependence between the relevant factors, and in particular a similarity between the trademarks and between these goods and services. In **Case C-39/97 Canon Kabushiki Kaisha V Metro-Goldwyn-Mayer Inc., formerly Pathe Communications Corporation** it was held that:

> "a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa."

27- Under section 25(2) of the Trademarks Act, registration of a trademark will be refused if there is an identical or resembling mark on the register in respect of goods associated with the services for which registration is sought.

28- The Opponent is the registered proprietor of the scratch marks TM 32685 and 32686 for nutritional supplements and beverages in classes 5 and 32 of the Nice classification respectively. The Applicant is seeking to register their mark for services in class 41 as listed in paragraph 1 hereinabove.

29- The Opponent however, submitted that the goods for which their mark is used are associated with the services for which the Applicant is seeking registration.

30- According to the statutory declaration of Rodney Cyril Sacks for the Opponent, para 5, 10, 11 and 12, the Opponent uses the scratch mark on printed matter, stickers, decals and sign boards being goods in class 16 as well as clothing and head gear in class 25. That the use of the mark on goods in class 16 and 25 is through sponsoring sports personalities and events which is a service covered under class 41.

31- In reply, evidence of Michael Potenza para 11, 16, 17 and 18, for the Applicant is to the effect, that use cited by the Opponent is not use in Uganda, that there are no other registrations of the Opponent's mark apart from registrations for goods in class 5 and 32, and that the use exhibited by the Opponent is only to promote the Opponent's energy drinks and not necessarily use of the mark as provided in class 41.

32- In accordance with section 25(2) Trademarks Act, in as far as there is no registration of the scratch mark by the Opponent for goods in class 16 and 25, evidence of use of the scratch mark on goods in those classes is not relevant in these particular circumstances.

33- On the other hand, the Opponent further argues that they sponsor musicians and artists and other events at which events they give away branded merchandise and therefore, the description of services is associated with the Opponent's goods.

34- In assessing the similarity of goods or services Lord Evershed, M.R. stated in **Lyons & Coy. Ld.'s [1959]RPC 120 at 128** that:

> "In all cases of this kind regard will be had to such matters as the nature and composition of the goods, to their respective uses and functions, and, to the trade channels through which respectively they are marketed or sold; and in different cases one (but not always the same one) of these characteristics may have greater significance or emphasis than the others. The matter falls to be judged, "in a business sense".

35- And according to Case C-39/97 **Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer** it was held that:

> "...all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia,* their nature, their end users and their method of use and whether they are in competition with each other or are complementary."

36- The Applicant is seeking registration of the mark for services in class 41 whereas the Opponent is relying on registration for goods in class 5 and 32. According to the explanatory notes for class 41 of the Nice Classification, this class covers mainly services rendered by persons or institutions in the development of the mental faculties of persons or animals, as well as services intended to entertain or to engage the attention. I find these notes instructive.

37- The goods in respect of which the Opponent's scratch mark is registered are nutritional supplements and beverages and therefore, not the same or of the same description with the Opponent's services.

38- The Opponent's argument is that promotion of his goods through entertainment activities associates his goods with the Applicant's services and thus the application should be rejected under section 25(2) Trademarks Act.

39- Association in the context of section 25 of the Trademarks Act is not defined in the Act. That said, according to the Macmillan dictionary "associate" means inter alia to connect with something. And in **Boston Scientific Ltd v OHIM,** Case T-325/06, the General Court (GC) stated that:

> "...there is a close connection between them [good and services], 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".

40- It follows therefore, that the connection (association) between goods and services in most cases will, be defined by the function of the service with respect to the relevant goods. Thus the determination of this matter will lie with whether customers of the Opponent will think that the responsibility or source of the Opponent's services is the Applicant or vice versa. In the present case I think this is not the case.

41- A review of the Applicant's services shows that they are applying for protection of a mark in respect of education; training; entertainment; sporting and cultural activities in the field of basketball with this service activities taking on various forms.

42- The nature, composition and functions *(per Lyons & Coy. Ld.'s)* of beverages and nutritional supplements (Opponent's goods) cannot be said to be education, training, entertainment or sporting and cultural activities (Applicant's services). I therefore, do not think that there is such a close connection between the Applicant's services in basketball with the Opponent's goods such that consumers would think that the goods and services originate from the same source.

43- At any educational, training, entertainment, sporting or cultural event; beverages may be consumed including beverages with the Opponent's mark but this does not imply that the event and the beverage or nutritional supplement sold there shares the same channels of trade. My finding is that the Applicant's services are not similar to the Opponent's goods.

44- For the above reasons the opposition fails. The Applicant shall proceed to register their mark subject to the prescribed fees.

45- The Opponent shall bear the cost of these proceedings.

Dated this 5th day of February 2021

AGABA GILBERT
Asst. REGISTRAR TRADEMARKS