

O/192/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2571980
BY ATTACOM LTD FOR THE TRADE MARK:**

RIVA

AND

OPPOSITION THERETO (NO 102098) BY KOSS COROPORATION

The background and the pleadings

1) Application 2571980 is for the word RIVA and was filed by Attacom Ltd (“Attacom”) on 11 February 2011. The application was published for opposition purposes on 25 March 2011 for the following goods and services:

Class 09: Computer software; computer software development tools; computer software for use as an application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications, integrating text, video, photo and audio content and functionality into websites, software applications, and devices, and for allowing data retrieval, upload, download, access and management; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information over the Internet and other communications networks; computer software for assessing consumer purchasing patterns and preferences; digital music, downloadable from the Internet or via other communications networks; downloadable telephone ring tones; music recordings; audio/visual recordings; electronic publications, downloadable from the Internet and other communications networks; information, advisory and consultancy services relating to all the aforesaid.

Class 35: Marketing, advertising and promotion services; marketing, advertising and promoting the goods and services of others via the Internet and other communications networks; providing and rental of advertising space; radio advertising; television advertising; sales promotion (for others); arranging newspaper subscriptions (for others); market research and information services; marketing studies; business research; assessment of consumer purchasing patterns and preferences; provision of databases and directories containing data relating to videos, images, musical recordings and other entertainment, as well as consumer purchasing patterns and preferences; publication of publicity texts; dissemination of advertising matter; updating of advertising material; office functions; electronic data storage; data processing; organisation, operation and supervision of loyalty and incentive schemes; production of television and radio advertisements; opinion polling; statistical information; online retail store services featuring online delivery of digital media, namely images, movies, musical and audiovisual works and related merchandise; the bringing together, for the benefit of others, of a variety of audio recordings including musical recordings, audio/visual recordings, advertising, still images, moving images, data, computer software and entertainment products, enabling customers to conveniently view, rent or purchase those goods via the Internet and other communications networks, by mail order or retail shop; information, advisory and consultancy services relating to all the aforesaid.

Class 38: Providing access to computer, electronic and online databases; telecommunications services, namely electronic transmission of data, messages and information; providing online forums for communication on topics of general interest; providing online communications links which transfer web site users to other local and global web pages; facilitating access to third party web sites via a universal login; providing access to non-downloadable software to enable sharing of multimedia content and comments among users; providing online chat rooms, e-mail services and electronic bulletin boards; audio, video, text and multimedia broadcasting via the Internet and other communications networks, namely uploading, posting, displaying, tagging, and electronically transmitting data, information, audio and video; transmission of electronic media, multimedia content, videos, movies, musical recordings, pictures, images, text, photos, user-generated content, audio content, and information via the Internet and other communications networks; music broadcasting; digital radio broadcasting; webcasting services; providing an online network service that enables users to transfer personal identity data to and share personal identity data with and among multiple websites; providing access to computer databases in the fields of social networking, social introduction and dating; providing telecommunications services to enable individuals to share information, photos, audio and video content about themselves, their likes and dislikes and daily activities, to get feedback from their peers, to form virtual communities and to engage in social networking; information, advisory and consultancy services relating to all the aforesaid.

Class 41: Entertainment and educational services featuring electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, advertising content, audio content, and related information via the Internet and other communications networks; provision of information via blogs featuring information in the field of electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, advertising content, audio content, and related information; digital video, audio and multimedia entertainment publishing services; online digital publishing services; photo sharing and video sharing services; production and presentation of radio programmes; entertainment by means of radio; provision of musical entertainment; music library services; entertainment services, namely, conducting contests; providing information regarding news, cultural and academic matters from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, via the Internet and other communications networks; information, advisory and consultancy services relating to all the aforesaid.

Class 42: Application service provider (ASP) services; application service provider (ASP) featuring software to enable or facilitate the uploading,

downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic media or information over communication networks; hosting an interactive website and online non-downloadable software for uploading, downloading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, videos, movies, films, photos, audio content, animation, pictures, images, text, information, and other user-generated content; hosting an interactive website and online non-downloadable software that enable users to post, search, watch, share, critique, rate, and comment on, messages, comments, multimedia content, videos, movies, films, photos, audio content, animation, pictures, images, text, information, and other user-generated content via the Internet and other communications networks; providing online non-downloadable software tools; hosting of digital content online; hosting computer software applications of others; hosting multimedia content for others; hosting a website featuring messages, comments, multimedia content, videos, movies, films, photos, audio content, animation, pictures, images, text, information, and other user-generated content online; scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer services in the nature of customized web pages featuring user-defined or specified information, personal profiles, audio, video, photographic images, text, graphics and data; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information and to transfer and share such information among multiple websites; scientific and technological services and research and design relating thereto; industrial analysis and research services; profiling entertainment tastes and preferences based on consumer selection, rating, commenting, sharing and critique of entertainment provided via the Internet and other communications networks; design and development of computer hardware and software; encoding and encryption services for the transmission of data; information, advisory and consultancy services relating to all the aforesaid.

Class 45: Social introduction, networking and dating services; personal and social services rendered by others to meet the needs of individuals, namely, online social networking and introduction services; security services for the protection of property and individuals; providing information regarding social and political matters from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, via the Internet and other communications networks; information, advisory and consultancy services relating to all the aforesaid.

2) Koss Corporation (“Koss”) opposes the registration of the above application. Its opposition was filed on 24 June 2011 and is based on a single ground under

section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Koss rely on one trade mark which consists of the word STRIVA which was filed (as a Community Trade Mark (“CTM”)) on 30 June 2009 and which completed its registration procedure on 22 November 2009. The mark is registered in respect of:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

Class 38: Telecommunications.

Class 41: Education; providing of training; entertainment; sporting and cultural activities.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

3) In view of its filing date, Koss’ trade mark constitutes an earlier trade mark as defined by section 6 of the Act. The earlier mark was not registered until November 2009 and, so, the use conditions set out in section 6A of the Act do not apply; the earlier mark may be relied upon for its specification as registered.

4) The applicant filed a counterstatement denying the ground of opposition. The applicant accepts that there is a “medium degree of similarity” between the goods/services, but makes various submissions on why the respective marks are not similar enough to cause confusion.

5) Neither side requested a hearing. Neither side filed evidence or submissions. I will though, bear in mind the comments the parties have made in their respective statements/counter-statements.

SECTION 5(2)(B)

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

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite

possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

The average consumer

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

9) There is a large breadth of goods and services covered by both the applied for mark and the earlier mark. In terms of the applied for mark the goods include various types of computer software and digital products such as audio/visual recordings, ringtones and publications. Software products are unlikely to be casually selected and may be used by both the general public and businesses. Although the care and attention deployed in their selection may not be of the highest possible degree, it will certainly be more than routine. The other types of goods are more general public purchases, they do not strike me as things likely to be purchased with an above average degree of care and attention, but neither will they be completely casual purchases either. If there is one product for which a slightly less than average degree of care and consideration will be paid in its selection then that would be ringtones on account of their cost and frequency of purchase.

10) In terms of the applied for services, these range from marketing, advertising and other business services and, also, retail services connected with the sale of items similar to that assessed in the previous paragraph. The former are likely to represent fairly considered purchases the latter less so, but still of an average degree. Finally, there are services relating to telecommunications, computer application provision, social networking services and entertainment services based on such activities. These strike me as more general public services and ones for which at least an average degree of care and attention will be deployed. Some services, such as the selection of a social introduction service, will have an above average degree of care and attention paid to their selection.

11) In terms of the goods and services of the earlier mark, much of the same applies. The earlier marks' class 9 goods cover the class heading and a consequent wide range of goods. Many are technical in nature and will have a good deal of care and attention applied to their selection. Some goods (such as recording discs) will have a slightly less than average degree of care and attention. In terms of telecommunications, this is a fairly important choice with a higher degree (although perhaps not the highest) of care and attention being deployed. The same applies to education services. In terms of entertainment and sporting and cultural activities, the degree of care and attention will vary depending on the exact activity involved. Generally speaking, only an average degree of care and attention will be deployed. That leaves the class 42 services which strike me as being quite technical in nature; a good deal of care will be taken when selecting an appropriate service provider.

Comparison of goods/services

12) Koss claims that the goods and services are either identical or highly similar. It does not say why. Attacom denies that there is identity or a high degree of similarity but concedes there is a "medium degree" of similarity. Given this concession, I will highlight where, if any, there is an identical or highly similar relationship with Attacom's goods and services and accept that the rest, as conceded, have a medium degree of similarity.

13) In terms of the class 9 goods applied for, I see no direct counterpart in the earlier mark given that it does not list computer software or any type of digital media. I do not see that any of the applied for goods fall within the ambit of any broad terms in the applied for mark. I agree with Attacom that there is, at best, only a medium degree of similarity with any of the goods and services of the earlier mark.

14) In terms of the class 35 services, there are clearly no identical services in play given that the earlier mark is not registered in class 35. There is nothing which stands out as being highly similar in any of the terms of the earlier mark. I agree with Attacom that there is, at best, only a medium degree of similarity with any of the goods and services of the earlier mark.

15) In terms of the class 41 services applied for, there are some direct counterparts in the earlier mark due to it being registered for education and entertainment at large. The following services are types of education/entertainment and must, therefore be considered to be identical:

Entertainment and educational services featuring electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, advertising content, audio content, and related information via the Internet and other communications networks; digital video, audio and multimedia entertainment publishing services; entertainment by means of radio; provision of musical entertainment services; entertainment services namely, conducting contests;.

16) The rest of the services in class 41 boarder on entertainment, relate to entertainment or education or facilitate the same, therefore, on account of the purpose, nature etc. of the services I agree with Koss that these services are highly similar.

17) In terms of the class 42 services applied for, I note that the earlier mark is registered in respect of: "Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software" which clearly includes the following services in its ambit and which must, therefore, be considered as identical:

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software;

18) I also consider the following services to be highly similar to the earlier mark's class 42 services (particularly design and development of hardware and software):

Application service provider (ASP) services; application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic media or information over communication networks;

19) In terms of the remaining class 42 services, including the hosting services, then any link with the earlier mark's terms are less strong and I agree with Attacom that there is, at best, only a medium degree of similarity with any of the goods and services of the earlier mark.

20) That leaves the applied for class 45 services for which there is no identical counterpart. There is, in my view, no obvious degree of high similarity so, I agree

with Attacom that there is, at best, only a medium degree of similarity with any of the goods and services of the earlier mark.

Comparison of the marks

21) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are: STRIVA and RIVA, neither of which separate into component parts.

22) Koss points to the fact that both marks contain the letters RIVA, the only difference being the additional ST at the beginning of STRIVA. Attacom points to the differing lengths of the marks, the significant impact that the letters ST have in the comparison and that the beginnings of marks are generally given more focus. Reference is also made to conceptual differences that I will detail shortly.

23) As Koss states, the letters RIVA appear in both marks and in the same order. The letters represent the totality of Attacom's mark, whereas in Koss' mark the letters represent the final four letters of the mark. Koss' mark additionally includes the letters ST at the beginning. This creates both similarities and differences. The parties differ on the impact the letters ST in Koss' mark has on the overall degree of similarity. From a visual perspective, I consider the impact of the letters ST to be reasonably significant. A longer mark is created. The letters ST will not be overlooked or missed. The marks are short and the difference is at the beginning of the marks which, in the case before me, creates a quite noticeable difference; whilst both these factors are just rules of thumb, the rules of thumb operate well here. I consider the degree of visual similarity to be minimal, it is of a quite low degree.

24) Both the words STRIVA and RIVA can be pronounced in a number of ways. STRIVA can be pronounced as STRIE-VUH, STRIE-VAH, STREE-VUH, STREE-VAH, STRI-VUH or STRI-VAH and RIVA as RIE-VUH, RIE-VAH, REE-VUH, REE-VAH, RI-VUH, RI-VAH; variations on a theme may also be applicable. In my view the most likely pronunciations will be: RIVA as REE-VUH and STRIVA as STRIE-VUH. Whilst it may be counterintuitive to find that the RIVA part of the respective marks will be pronounced slightly differently by the same average consumer, this is how I see it based on the normal way in which letters and words are pronounced. With these pronunciations I consider the net effect of the similarities and the differences to result in only a low degree of similarity. I must, though, countenance the possibility that the average consumer may pronounce the RIVA element of the respective marks in the same way which, inevitably, increases the degree of aural similarity. However, I still consider that the addition of the letters ST to the beginning of Koss' mark creates a quite noticeable aural

difference and, at best, the degree of aural similarity will be of only a low to moderate degree.

25) In terms of concept, Koss do not identify any particular conceptual difference or similarity. Attacom, on the other hand, claim a conceptual difference. Attacom stated in its counterstatement that STRIVA is reminiscent of the word STRIVE and that RIVA has various meanings including: a girl's name, a surname, a pet's name, a chocolate wafer bar, a character from Star Trek. Attacom, though, provided no evidence to support its claims. For a conceptual meaning to be relevant it must be one capable of immediate grasp¹. Such an assessment must, of course, be made from the perspective of the average consumer. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

“36.By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

26) Without evidence to support its claims, I cannot hold that RIVA is a word with a particular conceptual significance known by the average consumer. None of the meanings put forward are so obviously known that I can accept Attacom's claims.

¹ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

The average consumer will, therefore, perceive RIVA as an invented word. The same applies to the word STRIVA. Although evocative meanings can be relevant in the assessment², I am not satisfied that the average consumer would immediately grasp STRIVA as being evocative of the word STRIVE; STRIVA will also be perceived as an invented word. The impact of this is that there is neither a conceptual difference or conceptual similarity.

The distinctiveness of the earlier mark

27) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No use of the STRIVA mark has been presented so I have only the inherent characteristics of it to consider. From this perspective, STRIVA, as already observed, will be perceived by the average consumer as an invented word. It is the type of mark entitled to a high degree of distinctive character.

Likelihood of confusion

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

29) Koss' best prospect of success lies with its identical or highly similar goods/services. In view of the interdependency principle such a factor can counteract against a lesser degree of similarity between the marks. I must also bear in mind the earlier marks' high degree of distinctive character. In terms of the identical or highly similar goods, I have not assessed the purchasing process for them as being casual; the process involves either an average degree of care and attention or a slightly above average one. This means that the effects of imperfect recollection are not heightened, although, it is still an important factor to bear in mind. The concept of imperfect recollection is also important on account of neither mark having a meaningful concept, and, therefore, there is no conceptual trigger for the recollection of the mark. I have borne all these factors in my mind but my decision is that there is no likelihood of STRIVA being misrecalled or misremembered as RIVA. The additional letters ST in the mark is sufficient, on both a visual and aural level (and even when the RIVA element is pronounced in the same way in the respective marks), for confusion not to arise and for the average consumer to be able to distinguish between the respective marks. **There is, therefore, no likelihood of direct confusion.**

² See for example, the judgment of the GC in Case T-189/05 *Usinor SA v OHIM*

30) Irrespective of this finding, I must also determine whether there is a likelihood of “indirect confusion”. This will occur when, despite the average consumer appreciating that the marks are not the same, the degree of similarity between the marks is put down to the responsible undertakings being the same or being related. This is often referred to as the “same stable” argument. I see no reason why the average consumer will believe that the goods and services sold under the respective marks come from the same stable. The element RIVA does not stand out in any way (in STRIVA) and there is no signal to the consumer that the marks are linked as in a variant brand. Even if the average consumer identifies the common letters RIVA this will be put down to co-incidence and not economic connection. **There is no likelihood of indirect confusion.** For the sake of completeness, I should add that for the goods/services which are not identical or highly similar then the same findings apply even when I acknowledge my earlier finding that some of the goods may be purchased with a slightly less than average degree of care and attention. The degree of similarity between the marks is still not sufficient, when all the other factors are considered, for confusion (of either variety) to arise. **The opposition fails.**

Costs

31) Attacom has been successful and is entitled to a contribution towards its costs. The tribunal normally works from the scale of costs set out in TPN 4/2007. I see no reason to depart from it in the present proceedings. Having assessed the matter from the perspective of the published scale, I hereby order Koss Corporation to pay Attacom Ltd the sum of £300. This represents a contribution towards its costs in preparing a statement and considering Koss’ statement; given that no evidence was filed, nor did the parties request a hearing or file written submissions, no further costs are applicable. This sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 10th day of May 2012

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