

O/230/12

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NO 2590276**  
**BY**  
**MIXPIXIE LIMITED**  
**TO REGISTER THE TRADE MARK**



**IN CLASS 09**  
**AND**  
**IN THE MATTER OF OPPOSITION THERETO**  
**UNDER NO 102566**  
**BY**  
**RAINBOW SRL**

## BACKGROUND


1) On 04 August 2011 MixPixie Limited (“the applicant”) applied to register the following mark, in respect of the list of goods shown below:




*Class 09: Personalised music tapes, cassettes, videos, recordings, recording apparatus, music centres (audio apparatus).*

2) The application was published on 02 September 2011 in the Trade Marks Journal. A notice of opposition was subsequently filed by Rainbow Srl (“the opponent”). The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the applicant’s goods.

3) Two earlier marks are relied upon, both of which are International registrations designating the European Community (IR (EC)). The relevant details of those IRs are:

Mark details	Goods relied upon
<p><b>IR (EC): 0945033</b></p>  <p><b>Date of International registration: 25 June 2007</b></p> <p><b>Date of designating the EC: 25 June 2007</b></p>	<p><b>Class 09:</b></p> <p>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, 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; data processing equipment and computers; video games, video game discs, video game machines for use with televisions, video game software, children's educational software, apparatus for transmitting and reproducing sound or images, audio cassette recorders, audio tape recorders,</p>

	DVD players, compact disc cases, video cameras, computer game programs, computer screen saver software, walkie-talkies; prerecorded video and audio tapes, prerecorded audio and video DVD and pre-recorded audio and video CD-ROMs, optical discs, moving pictures; animated cartoons.
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Mark details	Goods relied upon
<p data-bbox="188 636 440 674"><b>IR (EC):</b> 1006791</p>  <p data-bbox="188 1055 746 1122"><b>Date of International registration:</b> 20 April 2009</p> <p data-bbox="188 1162 740 1229"><b>Date of designating the EC:</b> 20 April 2009</p>	<p data-bbox="809 636 952 674"><b>Class 09:</b></p> <p data-bbox="809 712 1398 1688">Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, 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; data processing equipment and computers; video games, video game discs, video game machines for use with televisions, video game software, children's educational software, apparatus for transmitting and reproducing sound or images, audio cassette recorders, audio tape recorders, DVD players, compact disc cases, video cameras, computer game programs, computer screen saver software, walkie-talkies; prerecorded video and audio tapes, prerecorded audio and video DVD and pre-recorded audio and video CD-ROMs, optical discs, moving pictures; animated cartoons.</p>

4) The opponent claims that the applicant's mark is confusingly similar to its earlier marks and that the applicant's goods are identical or highly similar to the goods on which the opposition is based.

5) The dates of designation in the EC of IR 0945033 and IR 1006791 are 25 June 2007 and 20 April 2009 respectively. As the aforementioned dates are less than five

years before the publication date of the contested mark (04 August 2011), the earlier marks are not subject to proof of use.

6) The applicant filed a counterstatement denying the ground of opposition and requesting the opponent to provide proof of use. However, for reasons given above, the opponent is not required to provide such proof.

7) Only the opponent filed evidence. Neither party requested to be heard. Only the opponent filed written submissions in lieu of a hearing. I therefore make this decision after conducting a thorough review of all the papers and giving full consideration to all submissions and evidence submitted.

### **Opponent's evidence**

8) The opponent's evidence consists of a witness statement, dated 10 January 2012, in the name of Sarah Margaret Ward, a Registered Trade Mark Attorney at A.A. Thornton & Co., the representatives for the opponent.

9) Exhibits SMW1 and SMW2 consist of print-outs from the OHIM database showing details of IR (EC) 0945033 and IR (EC) 1006791 respectively.

## **DECISION**

### **Section 5(2)(b)**

10) This section of the Act states:

“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.”

11) IR (EC) 0945033 has not yet been granted protection because it is currently under opposition at the Office for Harmonization in the Internal Market (OHIM) and will only become an earlier trade mark, within the meaning of Section 6 of the Act, if, and when, it proceeds to protected status in the EC. In view of this, I will limit my analysis to the likelihood of confusion between the applicant's mark and the earlier IR (EC) 1006791 that has protected status in the EC (including the UK).

12) The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

### **Comparison of goods**

13) In making an assessment of the similarity of the goods, all relevant factors relating to the goods in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro- Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

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

*“(a) The respective uses of the respective goods or services;  
(b) The respective users of the respective goods or services;  
(c) The physical nature of the goods or acts of service;  
(d) The respective trade channels through which the goods or services reach the market;  
(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;  
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”*

15) The General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05 held:

*“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”*

16) I also bear in mind the comments of the court in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* (“Thomson”) [2003] RPC 32, where it was held at paragraph 31:

*“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use.”*

17) Although these comments were made in relation to devising a fair specification consequent to an attack of revocation on the grounds of non-use, the principle that it is the public and circumstances of the relevant trade that should underpin consideration as to the terms used in a specification nevertheless holds good. The exercise is not one of lexical analysis in a vacuum, but by reference to how the average consumer may perceive matters in the relevant trade.

18) I also take into account the guidance in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* ("*Beautimatic*") [2000] FSR 267, where it was held that words should be given their ordinary (rather than an unnaturally narrow) meaning.

19) Turning to the instant case, it is not entirely clear to me whether the term '*Personalised*' at the beginning of the applicant's specification qualifies the term '*music tapes*' only, or whether it is intended to qualify all of the terms which follow. I will bear this in mind in my comparison of the respective goods such that I will take into consideration the effect, if any, that the personalisation and non-personalisation of the applicant's goods has on the similarity between those goods and the goods covered by the opponent's earlier mark. When considering the respective goods at issue, I will bear in mind that '*personalised*' may refer to the content of the goods, an example being a music tape which has been tailored and pre-recorded to a consumer's request, or that it may refer to the packaging being personalised, or both.

20) '*Recording apparatus, music centres (audio apparatus)*' (whether personalised or not) in the application are identical to '*apparatus for recording, transmission or reproduction of sound or images*' covered by the opponent's earlier mark, as the former falls within the ambit of the latter (*Meric*).

21) '*Recordings*' in the application are identical to '*pre-recorded video and audio tapes, pre-recorded audio and video DVD and pre-recorded audio and video CD-ROMs*' as the latter falls within the former (*Meric*). If the applicant's '*recordings*' are personalised in some way, the respective goods are still identical since the opponent's aforementioned goods may also be so personalised.

22) Applying the guidance in *Beautimatic*, I consider that the natural meaning of the term '*videos*' is such that it includes both pre-recorded and blank videos i.e. all kinds of videos. It follows that '*Videos*' in the application are identical to '*pre-recorded video tapes*' as the latter falls within the former (*Meric*). If the '*videos*' are personalised to the specific request of the consumer, the respective goods are still identical since the opponent's goods would also include pre-recorded personalised video tapes.

23) Applying the same reasoning as that given above, I also find that the term '*Cassettes*' would include both pre-recorded and blank cassettes (*Beautimatic*). Accordingly, '*Cassettes*' in the application are identical to '*pre-recorded audio tapes*' covered by the opponent's earlier mark as the latter falls within the former (*Meric*). If the '*Cassettes*' are personalised in some way, the respective goods are still identical since the opponent's goods would include pre-recorded personalised audio tapes.

24) '*Personalised music tapes*' in the application are identical to '*pre-recorded audio tapes*' as the former falls within the latter (*Meric*).

### **Average consumer and the purchasing process**

25) It is necessary to consider these matters from the perspective of the average consumer of the goods at issue (*Sabel BV v. Puma AG*). I have concluded that the respective goods are identical and it follows that the average consumer will be identical.

26) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods. The average consumer for the goods at issue, on the most part, will be the general public however, insofar as '*recording apparatus*' is concerned, these goods may also be purchased by professional musicians and/or recording studios. The goods are those which are sold through retail outlets, both online and on the high-street. '*Music tapes, cassettes, videos and recordings*' can be said to be a fairly inexpensive purchase, whether they are personalised or not. The attention paid during the purchase of such goods will not be of the highest order but neither would it be as low as when purchasing everyday consumable goods. On the most part a reasonable level of attention will be paid during the purchasing act. I would expect '*recording apparatus*' and '*music centres (audio apparatus)*' to vary greatly in price, however, in general, they are likely to be reasonably costly; the attention paid to their purchase will therefore be reasonably high but will not be at the highest level. Where any of the aforementioned goods are personalised the purchaser may engage in some sort of process in order to personalise the goods and this may result in the consumer employing a higher degree of attention than might otherwise be afforded.

27) In relation to '*recording apparatus and music centres (audio apparatus)*', these are goods which the consumer may wish to 'test out' in terms of the quality of the sound produced and their functionality. In order to do this, the consumer will inevitably need to see and touch the goods and hence the purchasing act will be primarily visual. I would also expect the visual aspect to be of primary importance in the purchase of '*Personalised music tapes, cassettes, videos, recordings*' as these are goods which will be displayed on shelves/racks in retail outlets or on retailer's web pages. However, I do not discount that aural consideration may play a part in the purchasing process of all of the goods, particularly so in relation to '*(personalised) recordings*' where the consumer may not necessarily be able to see the product before purchasing it.



## **Comparison of marks**

28) For ease of reference, the respective marks are:

Opponent's mark	Applicant's mark
 The logo for the opponent's mark consists of the word "PoppiXie" in a stylized, rounded font. The letter "X" is replaced by a large, white, multi-lobed device element that extends above and below the other letters.	 The logo for the applicant's mark consists of the words "mix pixie" in a lowercase, sans-serif font. The word "mix" is in grey and "pixie" is in pink. A pink device element, resembling a fairy or pixie, is positioned at the end of the word "pixie".

29) In making a comparison between the marks, I must take account of the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). However, I must not engage in an artificial dissection of the marks, as the average consumer normally perceives a mark as a whole and does not analyse its details.

### **Distinctive and dominant components**

30) The opponent's mark consists of the words 'Pop' and, what is likely to be perceived as, the word 'pixie'. In the word 'pixie' the letter 'x' has been substituted with a device element. The said device is enlarged such that it extends above and below the other letters which form the mark. Although positioned towards the end of the mark, the device is larger in size compared to the other letters within the mark, and it is possessed of distinctive character in its own right. Nonetheless, the letters 'pi' and 'ie' either side of the device play a pivotal role as they combine with the said device to form the distinctive word, 'pixie'. The word 'Pop' has descriptive connotations in relation to the goods at issue (the goods may contain or relate to popular music). Nonetheless it cannot be out-rightly disregarded as it is positioned at the beginning of the mark, has a large and prominent initial letter 'P' which catches the eye and is presented in the same colour scale and font as the word 'pixie'. Furthermore, the two words 'Pop' and 'pixie' are pushed together such that they appear to 'hang together' as a phrase, 'Pop pixie'. Taking into account all of the aforementioned factors, I conclude that there is no one element which is more dominant than another in the overall impression of the mark.

31) The applicant's mark consists of the words 'mix pixie' and the device element of, what is likely to be perceived as a pixie, at the end of the mark. The word 'mix' may be allusive of mixed music when used in relation to the goods at issue. The word pixie is positioned in the middle of the mark, forms a significant proportion of the mark as a whole and is a distinctive element. The device of the pixie is positioned at the end of the mark and, whilst not dominant, is clearly visible and distinctive. The mark is applied for in colour however, colour is immaterial where the earlier mark is registered in black and white (*Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2011] FSR 1(High Court)). That said, differences in colour scaling can be taken into account. In light of the difference in colour scaling between the word 'mix' and 'pixie', the latter appears more dominant than the former.

Considering the mark as a whole and bearing in mind the aforesaid, it is the word 'pixie' which is the dominant and distinctive element overall.

### **Visual Comparison**

32) A clear point of similarity between the respective marks is that both contain the letters 'pi' and 'ie'. In the applicant's mark, there is a letter 'x' in between these letters such that the word 'pixie' is formed. The letter 'x' is stylised so that one of the strokes of the 'x' extends up above the preceding letter 'i' and below the following letters 'ie', finally tailing faintly upwards towards the device of, what appears to be a pixie, which is absent from the opponent's mark. In the opponent's mark, there is a device element in between the letters 'pi' and 'ie' which appears to be a stylised representation of wings, perhaps intended to be those of a pixie. Whilst there are points of difference with regard to the element present between the letters 'pi' and 'ie' in the respective marks, this does not detract from the clear point of similarity in that the word 'pixie' will be visually perceived in both.

33) The word 'pixie' is preceded by a three letter word in both of the respective marks, however, the words differ; in the opponent's mark, the word is 'Pop' and in the applicant's it is 'Mix'. In the opponent's mark, the letters which form the word 'Pop' and 'pi' and 'ie' are all presented in the same bold cartoon-like type face. The words in the applicant's mark are presented in a fairly standard type-face with the exception of the letter 'x' in each word where one stroke in each 'x' is elongated and stylised. As I have already stated, the colour in the applicant's mark is immaterial, however, I bear in mind the effect of the colour scaling. In this regard, it is clear that the word 'pixie' and the device of the pixie are darker and bolder than the word 'mix', however as the word 'pixie' is larger than the device it is the word 'pixie' which has the greater visual impact in the mark overall with the smaller device element serving to reinforce it's meaning. Taking all of these factors into account, I find there to be a moderate degree of visual similarity between the marks.

### **Aural Comparison**

34) From an aural perspective the applicant's mark consists of three syllables and is likely to be pronounced as MICS PIC-SEE. The device element will not be vocalised.

35) The opponent's mark also consists of three syllables which are likely to be pronounced as POP PIC-SEE.

36) The pronunciation of the first word in each mark will therefore differ however the pronunciation of the second word, and thus two out of the three syllables in each mark, will be identical. Taking these differences and similarities into account I find that the marks are phonetically similar to a moderately high degree.

### **Conceptual Comparison**

37) *Collins English Dictionary (Collins)* defines the word 'pixie' as:

*“(in folklore) a fairy or elf.”*<sup>1</sup>

38) ‘Pixie’ is a word which I believe the average consumer will be very familiar with to the extent that they will immediately grasp the concept of a fairy or elf in line with the dictionary definition.

39) In the opponent’s mark, the word ‘pixie’ is preceded by the word ‘Pop’; in the applicant’s mark it is preceded by the word ‘mix’. These words can both be used as descriptors in the music industry.

40) *Collins* defines ‘Pop’ as:

*“ 1. a) music of general appeal, especially among young people, that originated as a distinctive genre in the 1950s. It is generally characterized by a heavy rhythmic element and the use of electrical amplification.  
b) (as modifier): pop music; a pop record; a pop group.  
2. Informal a piece of popular or light classical music.  
3. adjective Informal short for [popular](#).”*<sup>2</sup>

41) *Collins* defines ‘Mix’ as:

*“Music: the sound obtained by mixing.”*<sup>3</sup>

42) In the context of the goods at issue, I consider that it will be these respective ‘musical’ meanings that will be immediately evoked in the mind of the average consumer. A ‘musical’ concept is therefore common to both marks. Both marks contain ‘pixie’ as their second word which will be perceived as a fairy or elf. In the opponent’s mark the word ‘Pop’ qualifies the word ‘pixie’, the resultant concept of which is a pop pixie i.e. a pixie involved in pop music (in a similar fashion to the phrase ‘pop star’ or ‘pop group’). In the applicant’s mark, the word ‘pixie’ follows the word ‘mix’ resulting in the concept of a mix pixie i.e. a pixie somehow involved in/related to mixing.

43) The device element of the pixie in the applicant’s mark only serves to reinforce the concept of a fairy or elf. In the opponent’s mark, in the context of the letters ‘pi’ and ‘ie’, the device element may be perceived as fairy wings which also reinforces the ‘pixie’ concept. Even if I am wrong and the device would not be perceived as fairy wings, I do not consider that there is any other immediate concept portrayed by the device element which would detract from the concept of that of a fairy or elf. Taking into account all these factors, I find that the marks share a reasonably high degree of conceptual similarity.

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<sup>1</sup> [‘pixie or pixy’](#) 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 18 May 2012, <from

[http://www.credoreference.com/entry/hcengdict/pixie\\_or\\_pixy](http://www.credoreference.com/entry/hcengdict/pixie_or_pixy)>

<sup>2</sup> [‘pop\\_2’](#) 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 29 May 2012, <from [http://www.credoreference.com/entry/hcengdict/pop\\_2](http://www.credoreference.com/entry/hcengdict/pop_2)>

<sup>3</sup> [‘mix’](#) 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 29 May 2012, <from <http://www.credoreference.com/entry/hcengdict/mix>>

44) In summary, I have found that the respective marks share a moderate degree of visual similarity, a moderately high degree of aural similarity and a reasonably high degree of conceptual similarity. These factors combine to result in the marks being similar to a moderately high degree overall.

### **Distinctive character of the earlier mark**

45) I must consider the distinctive character of the opponent's mark. The more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91). No evidence of use has been filed by the opponent, so I have only to consider the inherent level of distinctiveness.

46) The words 'Pop' and 'pixie' have meanings which are capable of immediate grasp by the average consumer, as I have already indicated. In relation to the goods at issue, which include, inter alia, '*music tapes, cassettes, videos, recordings*', the descriptive connotations of the word 'Pop', as meaning 'popular music' are immediately apparent. However the mark does not consist solely of the word 'Pop'. When considering the mark as a whole, the word 'Pop' appears to qualify the following word 'pixie'. 'Pop pixie' is not descriptive of the goods. Furthermore, the device element which substitutes the letter 'x' in 'pixie' is, in itself, a distinctive element. Taking into account all of these factors, and viewing it as a whole, I find that the earlier mark enjoys a moderately high degree of inherent distinctive character.

### **Likelihood of confusion**

47) In determining the likelihood of confusion, I must take the global approach advocated by case law (*Sabel BV v. Puma AG*). I must also take account that the average consumer only rarely has the chance to make a direct comparison between marks, relying instead upon the imperfect picture of them that he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

48) I have found that the respective marks share a moderate degree of visual similarity, a moderately high degree of aural similarity and a reasonably high degree of conceptual similarity, resulting in a moderately high degree overall. I have concluded that the applicant's goods are identical to the opponent's goods and that the opponent's mark has a moderately high degree of inherent distinctive character. On the most part the average consumer will be the general public, however, where the goods are '*recording apparatus*' these may also be purchased by professional musicians and recording studios. The purchasing act will be primarily visual but aural considerations have not been discounted, particularly so where the goods concerned are '*(personalised) recordings*'. On the whole a reasonable level of attention will be paid during the purchasing act with the exception of '*recording apparatus*' and '*music centres (audio apparatus)*' where the level is likely to be higher, but not at the highest level. If the consumer embarks on a personalisation process of the goods, this may result in the consumer employing a higher degree of attention than might otherwise be afforded.

49) I have concluded that the dominant elements of the applicant's and opponent's marks are 'pixie' and 'Pop pixie and device' respectively. In doing so, I have considered all elements present in both marks and their overall impressions. I have stated that 'Pop' may play a descriptive role in relation to the goods however it cannot be discounted in the determination of the likelihood of confusion. This is due to its prominence, given that it is at the beginning of the mark and is presented in the same font as, and is pushed together with, the word 'pixie', forming the phrase 'Pop pixie'. In reaching this conclusion I have borne in mind the comments of the General Court in *CM Capital Markets Holding, SA v OHIM* Case T-563/08 where it was stated:

*"Owing to their weak, or even very weak, distinctive character, descriptive elements of a trade mark are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them (see, to that effect, el charcutero artesano, paragraph 53 and the case-law cited, and Case T-7/04 Shaker v OHIM – Limiñana y Botella (Limoncello della Costiera Amalfitana shaker) [2008] ECR II-3085, paragraph 44 and the case-law cited). That does not mean, however, that the descriptive elements of a mark are necessarily negligible in the overall impression conveyed by that mark. It is necessary, in particular, to examine whether other elements of the mark are likely to dominate, by themselves, the relevant public's recollection of that mark (see paragraph 36 above)."*

50) Taking into account all factors, and the overall impressions conveyed by the marks, it is my conclusion that the similarities outweigh the differences when used in relation to identical goods and I find that confusion is likely to occur. This is so, despite the differing device elements which, although visually different, both serve to reinforce the 'pixie' concept. The overriding concept of a 'pixie' is consistent in both marks and the terms 'Pop' and 'Mix' are both terms which may be used to indicate the kind of music or video footage contained in the goods. The consumer is likely to perceive both marks as variants of the same 'pixie' mark provided under the same, or linked, commercial undertaking(s) where one mark is used to denote a range of goods relating to, for example, popular music and the other to denote those relating to mixed music, or other mixed content. Therefore, whilst I do not think that direct confusion will take place in the sense that the consumer will mistake one mark for the other, I nonetheless consider that indirect confusion is likely to occur. The consumer will believe that the goods emanate from the same or linked undertaking.

51) The ground of opposition based upon Section 5(2)(b) of the Act is, therefore, successful in its entirety.

## **COSTS**

52) The opposition having been successful, Rainbow Srl is entitled to a contribution towards its costs. I take account that no hearing has taken place but that the opponent filed written submissions in lieu. As the opponent's evidence merely

consists of print outs of the earlier rights relied upon and a short witness statement referring thereto, I do not consider that costs should be awarded for the preparation and filing of the same. I award costs on the following basis:

Preparing notice of opposition (including the official opposition fee) and considering other side's counterstatement	£500
Written Submissions	£300
TOTAL	£800

53) I order MixPixie Limited to pay Rainbow Srl the sum of £800. This sum to 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 6<sup>th</sup> day of June 2012**

**Beverley Jones  
For the Registrar,  
the Comptroller-General**