

O-467-15

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS
NUMBERS 3 067 556 AND 3 067 549 IN THE NAME OF BML
GROUP LIMITED TO REGISTER THE FOLLOWING TRADE



MARKS:

AND "MR SMITH"

AND IN RESPECT OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NUMBERS 403 339 AND 403 375 BY
MISTER SMITH ENTERTAINMENT LIMITED

Background and pleadings

1. BML Group Limited (the applicant) applied to register the trade marks:



(as a series of two) and MR SMITH under numbers 3 067 556 and 3 067 549 respectively in the UK on 7 August 2014. They were accepted and published in the Trade Marks Journal on 5 September 2014 and 24 October 2014 respectively, initially in respect of a wider range of services proper to Class 41. This was restricted to the following during the proceedings:

Online betting, gaming and gambling services; online casino services; none of the aforementioned services relating to or for use in connection with film production and film distribution.

2. Mister Smith Entertainment Limited (the opponent) oppose the trade marks on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier Community Trade Mark 108 299 68 MISTER SMITH ENTERTAINMENT. The following services are relied upon in this opposition:

Class 41:

Education; providing of training; entertainment; sporting and cultural activities; film production; film distribution.

3. The opponent argues that the respective services are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. Neither side filed evidence in these proceedings.
6. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

DECISION

Section 5(2)(b)

7. Sections 5(2)(b) of the Act is as follows:

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

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

Comparison of goods and services

8. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

9. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

10. The earlier services are:

Class 41:

Education; providing of training; entertainment; sporting and cultural activities; film production; film distribution.

11. The later services are:

Class 41:

Online betting, gaming and gambling services; online casino services; none of the aforementioned services relating to or for use in connection with film production and film distribution.

12. The earlier services are comprised of the class headings for Class 41 plus film production and film distribution. These are of course extremely broad terms encompassing all of the activities which fall into that class. This includes the later services which are merely examples of activities which can be classed as entertainment. The limitation included by the applicant in respect of film production and film distribution do not assist its case as the clash with the earlier entertainment at large remains. The services are considered to be identical.

Comparison of marks

13. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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, to assess the likelihood of confusion.”

14. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of

the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

15. The respective trade marks are shown below:

<p>Mister Smith Entertainment</p>	<p>MR SMITH</p> 
<p>Earlier trade mark</p>	<p>Contested trade marks</p>

16. As regards distinctive and dominant components, the earlier trade mark includes the word “entertainment” which is very weak and likely to be viewed only in a descriptive manner. It is likely therefore that “Mister Smith” will be the most memorable aspect of the sign. In respect of the later word only trade mark, there is no stand alone dominant and distinctive element; this comes from the whole. In the logo mark, MR SMITH catches the eye first and so is visually dominant. The combination MR SMITH is also distinctive. However, the remaining badge device element is not negligible within the sign and so the correct comparison to be made is as between the marks as a whole.

17. Visually, the earlier sign and later word only sign coincide in respect of the element SMITH. They differ in respect of the presentation of MR and Mister; the addition of Entertainment in the earlier sign and the badge device in the later logo mark. They are visually similar, only to a low degree.

18. Aurally the matter is somewhat different as Mr and Mister will be pronounced in the same manner. Though the earlier mark includes Entertainment, they are clearly aurally similar. The degree of aural similarity is pitched as being high.
19. Conceptually, all of the signs will be understood as referring to a man named Mr Smith. The addition of entertainment in the earlier sign adds only further context; entertainment provided by Mister Smith. There is no conceptual gap provided by the additional descriptor. The marks are considered to be conceptually similar to a high degree.

Average consumer and the purchasing act

20. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

21. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

22. The services which have been found to be identical are in respect of entertainment. These can be accessed in a variety of ways, including online, face to face and aurally. While the purchase of such services will involve a certain degree of consideration, it will not be to the highest degree. The average consumer is the public at large. It is concluded that an average degree of attention is likely to be displayed.

Distinctive character of the earlier trade mark

23. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

24. The opponent makes no claim as to enhanced distinctiveness so the matter is to be considered *prima facie*. The earlier mark is comprised of a title of a person, a surname and the (at least partial) descriptor “entertainment”. In combination it is perfectly distinctive. The degree of distinctiveness is pitched as being average.

25. As regards distinctiveness, the following guidance is also helpful: in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after

that has been done can a proper assessment of the likelihood of confusion be carried out”.

26. The point in common between the respective marks here is Mr Smith irrespective of exact presentation (i.e. Mister or Mr) and it is this which provides distinctiveness in respect of all of the signs.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

27. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

28. It is true that there is only a low degree of visual similarity between the signs. However they are aurally and conceptually similar to a high degree. Further, the services have been found to be identical and so the interdependency principle is in play here. The marks all coincide in respect of the element Mr/Mister Smith which is distinctive. The additional element "entertainment" in the earlier trade mark and the later device element in the contested logo mark do not materially lessen the impact of this element which is clearly the most memorable aspect in all of the respective marks. Though the purchase of these services is likely to be reasonably considered, this does not override the impact of the degree of similarity between the marks. It is considered that confusion between the marks is likely. The oppositions therefore succeed in their entirety.

COSTS

29. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition Fee x 2 - £200

Preparing a statement and considering the other side's statement: - £200
Preparing written submissions - £300

TOTAL - £700

30. I therefore order BML Group Limited to pay Mister Smith Entertainment Limited the sum of £700. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of October 2015

Louise White

For the Registrar,