

O-217-16

In the matter of UK Trade Mark Applications No.3067556 (series of 2 devices) and 3067549 ('MR SMITH') in Class 41 in the name of BML Group Limited (the Applicant)

and

Consolidated Oppositions Nos. 403339 and 403375 by Mister Smith Entertainment Limited (the Opponent)

and

In the matter of an Appeal to the Appointed Person by the Applicant against the Decision of the Hearing Officer O-467-15 for the Registrar, The Comptroller General dated 7 October 2015

DECISION

1. On 7 August 2014, BML Group Limited (the Applicant) applied to register the word mark MR SMITH under No. 3067549 and a series of two marks under No. 3067556:



2. The services for which these applications were made were restricted during the proceedings to the following:

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.

3. The Opponent opposed both applications on the basis of its earlier (then Community, but now EU) Trade Mark No.10829968 comprising the word mark MISTER SMITH ENTERTAINMENT registered in respect of the following services in Class 41:

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

4. Following the Applicant's restriction of the services applied for, the Opponent restricted its grounds of opposition to the single ground under section 5(2)(b) of the Trade Marks Act 1994, alleging that the respective services are identical or similar and the marks are similar.
5. Neither side filed evidence. Neither side requested a hearing, instead filing written submissions. On the basis of those written submissions, the Hearing Officer reached her decision (O-467-15, dated 7th October 2015) as she put it 'following a careful perusal of the papers'. The Hearing Officer found for the Opponent, holding that there was a likelihood of confusion.
6. This finding is the subject of the appeal before me. The Applicant filed a detailed 'Statement of Case on Appeal incorporating Statement of Grounds of Appeal' – a mixture of grounds of appeal, submissions and complaints about the Decision, some of them specific and some more general. That document aside, neither side filed any further submissions for the purposes of this Appeal. Both sides agreed that no hearing was necessary and invited me to decide the Appeal on the papers.

Standard of Review

7. This appeal is by way of review such that the usual principles set out in *Reef Trade Mark* [2003] RPC 5 and other cases (including *BUD Trade Mark* [2003] RPC 25 and *Fage UK Ltd v Chobani UK Ltd* [2014] ETMR 26) apply. I have reminded myself of those principles.

The Appeal

8. The grounds of appeal are diffuse and in places expressed in intemperate terms. For example there is a summary which accuses the Hearing Officer of making findings which were "(i) unsupported by any evidence (ii) unjustified as being the basis for any fair determination of the matters before her (iii) prejudicial and damaging to

the Appellant (iv) entirely (or, at least, insufficiently) unexplained by her....'. Under that fourth point, the Hearing Officer was accused of making findings 'which were "plucked from the air" and being on a "frolic of her own". Doing the best I can, I summarise the main complaints as follows:

- 8.1. As to the law, it is said that the Hearing Officer 'paid mere lip service to the authorities to which she was referred' on the issue of comparison of the goods or services and that she 'failed to apply the principles of such authorities' to the facts of this case. As for comparison of the marks, the Hearing Officer cited relevant and important passages from *Sabel v Puma* and *Bimbo SA v OHIM*, but it is said she went on 'to ignore such guidance'.
- 8.2. On the facts, the principal complaint appears to be that the services applied for were distinct from those for which the earlier mark is registered. In particular, the Appellant appears to assert that the services applied for cannot be categorised as 'entertainment' because they are gambling services and regulated as such.
- 8.3. As for the comparison of the marks, on the facts, the Hearing Officer is accused of having ignored the RAF roundel type device in the '566 mark.
- 8.4. There is an overarching complaint that, because the Opponent did not file evidence, the Opposition should have failed because the Opponent failed to discharge the burden of proof on it.

9. I have, however, reviewed every aspect of the Decision of the Hearing Officer in order to discern whether any error of principle can be discerned. In what follows I have adopted the same headings as used in the Hearing Officer's Decision, and in the same order.

Comparison of Services

10. The Hearing Officer directed herself by reference to paragraph 23 of *Canon* (Case C-39/97) and by reference to the list of factors identified by Jacob J. in the *Treat* case [1996] RPC 281.
11. The Hearing Officer then examined the earlier services and correctly identified that they comprise the class headings in class 41, supplemented by "film production;

film distribution”. As for the services applied for, the Hearing Officer correctly identified that they are merely examples of activities which fall under the general heading of ‘entertainment’. On this basis, the Hearing Officer found that the services were identical.

12. Not only is there no error (let alone of principle) in this analysis, it is correct. Furthermore, although evidence is sometimes required to establish similarity of goods or services, in this case the Hearing Officer did not require any evidence to be filed to make the finding she did that the services in question were identical. The Appellant’s criticism in this regard was unfounded.

Comparison of marks

13. The Hearing Officer directed herself by reference to paragraph 23 of *Sabel v Puma* (Case C-251/95) and paragraph 34 of Case 591/12 *Bimbo SA v OHIM*, and then reminded herself that:

“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.”

14. In respect of the marks in issue, the Hearing Officer then found:
 - 14.1. The word “Entertainment” in the earlier mark was likely to be viewed as descriptive, and that “Mister Smith” will be the most memorable aspect of the sign;
 - 14.2. For “Mr Smith” there is no standalone dominant or distinctive element, and the distinctiveness comes from the whole;
 - 14.3. For the series logo marks, MR SMITH catches the eye first and so is visually dominant, with the combination MR SMITH being distinctive. She also held that the remaining badge element was not negligible, with the result that the correct comparison to be made is between the marks as a whole.
15. The Hearing Officer then proceeded to assess the degree of visual, aural and conceptual similarities and concluded, having explained her reasoning:

- 15.1. the marks were visually similar, only to a low degree;
- 15.2. the marks had a high degree of aural similarity;
- 15.3. the marks were considered to be conceptually similar to a high degree.

16. I could detect no error (let alone of principle) whether in her direction as to the law or in her assessments. The Hearing Officer did not ignore the guidance in the authorities. On the contrary, she applied the applicable principles correctly. She did not ignore the roundel device.

Average Consumer and the purchasing act

17. The Hearing Officer directed herself under this heading by reference to *Lloyd* (Case C-342/97) and paragraph 60 of the *Betty Boop* case (*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). She then found that entertainment services (i.e. the relevant services) “*can be accessed in various 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.*”

18. I could detect no error (let alone of principle) in her self-direction or in her assessments.

Distinctive Character of the earlier trade mark

19. The Hearing Officer directed herself by quoting paragraphs 22 and 23 of *Lloyd* (Case C-342/97), and assessed the degree of distinctiveness of the earlier mark as being average (the Opponent made no claim to enhanced distinctiveness, so she was considering the prima facie situation). She went on to remind herself of the guidance provided by Mr Iain Purvis Q.C. as the Appointed Person in his decision (O-075-13) in *Kurt Geiger v A-List Corporate Limited* at paragraphs 38-40. She then made the finding that:

“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

20. Under this heading, the Hearing Officer set out the familiar list of principles (a) to (k) used both by Hearing Officers and in the Courts, drawn from 8 well-known CJEU judgments. She then stated her conclusions:

“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.”

21. It seems to me that this is an impeccable and succinct application of the relevant principles of law to the facts which the Hearing Officer had found in earlier paragraphs of her Decision. There is no error here (let alone of principle).

22. Accordingly, I dismiss the Appeal. The criticisms made of the Decision and of the Hearing Officer had no substance whatsoever.

Costs

23. The Hearing Officer ordered the Applicant, BML Group Limited, to pay the Opponent, Mister Smith Entertainment Limited, the sum of £700, which will become payable within fourteen days of my decision.

24. I order BML Group Limited to pay the additional sum of £300 to the Opponent, Mister Smith Entertainment Limited, within 14 days of this decision. Although the

Opponent did not attend a hearing or file any submissions on this Appeal, the Opponent's representatives still had to consider the lengthy, diffuse and intemperate Statement of Case on Appeal, consider whether they should forego a hearing, and correspond on matters relating to the Appeal.

25. Accordingly, within 14 days of this decision, BML Group Limited must pay to Mister Smith Entertainment Limited the total of £1,000, by way of contribution to its costs of the Opposition and this Appeal.

JAMES MELLOR QC
The Appointed Person
27th April 2016