

O-268-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3099839
BY REBEL MINDS LTD**

TO REGISTER THE TRADE MARK

Rebel Minds

IN CLASSES 9 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404641**

BY JASON AND CHRIS KINGSLEY

BACKGROUND

1. On 18 March 2015 Rebel Minds Ltd (the applicant) applied to register the mark shown on the cover page of this decision for the following goods and services:

Class 9

Computer software for the collection, editing, organising, modifying, transmission, storage and sharing of data and information; computer software for communication with users of handheld computers; software for mobile telephones; telephony software applications; software for tablet computers.


Class 42

Software consultancy services; Advice relating to the development of computer systems; Creating and maintaining websites for others; designing and implementing websites for others; providing hosting services for websites for others; creating customized web pages featuring user-defined information, personal profiles and information; computer consultancy in the field of IT project management; Services for designing computer software; Software as a service [SaaS]; Creating bespoke mobile applications and websites.

2. The application was accepted and published for opposition purposes on 3 April 2015.

3. The application is opposed by Jason and Chris Kingsley (the opponents). The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (the Act) and is directed against all of the goods and services in the application.

4. The opponents rely upon the following UK and European Union Trade Mark (EUTM) registrations:

Mark	Dates	Goods and services relied upon
UK 1521191 	Filing date: 10 December 1992 Date of entry in the register: 3 June 1994	Class 9: Computer software Class 28: Electronic games
EUTM 1002492 REBELLION	Filing date: 25 November 1998 Date of entry in the register: 26 February 2001 Seniority date: 10 December 1992	Class 9: Computer software Class 42 : Computer programming, computer programming design and consultancy; software development; creating and maintaining web sites; installation, customisation and maintenance of computer programs; computer systems analysis; design, drawing and commissioned writing, all for the creation, development, compilation and production of computer games; computer software and games research, analysis, design and development;

		licensing of computer software and games; advisory, consultancy and information services relating to all of the aforesaid services.
EUTM 10311678 REBEL	Filing date: 4 October 2011 Date of entry in the register: 11 October 2013	Class 9: Software for motion pictures Class 42: Consultancy for computer games; creating and maintaining web sites; advisory, consultancy and information services relating to all of the aforesaid services.

5. For the sake of completeness, I should say that, in their Notice of Opposition the opponents identify the class 9 goods upon which they rely (in relation to the aforementioned marks) as 'software'. However, the opponents' specifications do not cover 'software' per se, but include, more specifically, 'computer software' (in respect of UK 1521191 and EUTM 1002492) and 'software for motion pictures' (in respect of EUTM 10311678). Given that the opponents can only rely on the goods (and services) included in the original wording of the specifications, it is to these goods (and services) that I must limit my considerations.

6. The applicant filed a counterstatement in which it denies the basis of the opposition and puts the opponents to proof of use.

7. During the course of the evidence rounds the opponents filed evidence and the applicant filed written submissions. Whilst neither party asked to be heard, the opponents filed written submissions in lieu of attendance at a hearing. I will bear all of these submissions in mind and refer to them, as necessary, below.

DECISION

8. The opposition is based upon Section 5(2)(b) of the Act which reads:

“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,

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

9. An earlier trade mark is defined in Section 6(1) of the Act, which states:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

[...]

(2) Reference in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. As can be seen from the details given above, the opponents' marks are earlier marks for the purposes of section 6 of the Act. Given its date of filing, EUTM 10311678 is not subject to proof of use and the opponents can rely on all the goods and services they have identified for this mark in these proceedings without needing to prove any use they may have made. On the other hand, both UK 1521191 and EUTM 1002492 had been registered for more than five years at the date the application was published so they are subject to the proof of use provisions contained in section 6A of the Act. I note that in relation to UK 1521191 in their Notice of Opposition the opponents rely on electronic games (in class 28) but they subsequently claim that they have used the mark on computer games, which fall in their class 9 specification and are not goods relied upon by the opponents in these proceedings. However, as I will explain below, in view of my findings in relation to the evidence filed by the opponents, it is not necessary for me to deal with this aspect of their claim.

Proof of use

11. The relevant period for the opponents to prove use of their marks is the five-year period ending with the date of the publication of the application, i.e. 4 April 2010 to 3 April 2015.

12. The relevant sections of the Act read as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. Section 100 of the Act is also relevant and reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. In considering whether genuine use of the opponents’ marks has been made during the relevant period in respect of the goods and services they seek to rely on, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use of a mark has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].



(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Preliminary point

15. The evidence consists of a witness statement from Chris Kingsley, one of the opponents and Director of Rebellion Development Limited. It is accompanied by 34 exhibits amounting to 394 pages. I note in passing that despite the guidance provided in Tribunal Practice Notice (TPN) 1/2015, which came into effect before they filed their evidence, the opponents did not seek directions from the Tribunal prior to filing this evidence.

16. EUTM 1002492 is relied upon for a broader range of goods and services than EUTM 10311678 which is not subject to proof of use. However, having read all the evidence, I do not believe that it will assist. This is because, as I will explain below, the evidence, as presented, will not allow the opponents to retain the broader specification. Consequently, I do not intend to produce a full summary of the evidence but I will, instead, focus on the main points which emerge from it, which are as follows:

- The opponents established their computer games business Rebellion Developments Limited in 1992. The opponents' first computer game was developed in 1993. Since then the opponents have developed sixty-four computer games;
- Print-outs taken from various Internet sources, including Wikipedia, refer to the opponents' business as 'Rebellion/Rebellion Development Ltd' and describe it as a 'computer games company' and/or 'computer games developer/video game developer'. A print-out from Wikipedia lists over 50 video games developed by Rebellion between 1993 and 2015. All the pages are dated outside the relevant period;
- The word Rebellion appears in the website address www.rebellion.co.uk and in the twitter profile @Rebellion. Print-outs from this website and from the twitter profile feature both  and REBELLION, either alone or accompanied by a '@' sign. On the same website under the heading 'REBELLION-WHO WE ARE' the following text appears: "The UK-based computer games super developer was established in 1992 by brothers Jason and Chris Kingsley". All the pages are either undated or dated outside the relevant period;
- Rebellion computer games can be purchased in a physical format, i.e. CD/DVD. Alternatively, the software game can be downloaded from the Internet. In either case, Mr Kingsley states, "the purchaser would buy a license" in relation to Rebellion's copyright rights. The evidence shows Rebellion games available for purchase from various websites, including Amazon's sites in the UK, France, Germany and Italy. Games are sold in cases with the packaging featuring  and indicating the appropriate gaming platform, i.e. PlayStation, Microsoft Windows, etc... Where sold online, screen-shots from the relevant websites indicate that the games are

‘developed by’ Rebellion. This evidence is, once again, outside the material dates. Whilst there are no turnover figures provided, Mr Kingsley’s account is corroborated by evidence of customers’ reviews from the UK Amazon site dated within the relevant period and from 2013 sales reports showing sales of Rebellion’s games in, inter alia, EU countries¹;

- Undated print-outs from www.tiga.org show that Rebellion won two awards at the TIGA Games Industry Awards in 2014. TIGA is defined as ‘the non-profit trade association representing the UK’s games industry’.

17. With the exception of a number of reviews and the sale reports, all the 394 pages of exhibits are either undated or dated outside the relevant period (either before or after). It is therefore apparent that the opponents did not focus their attention on providing evidence to show use of their earlier marks during the material dates. Even if the individual pieces, when considered together, were sufficient to prove genuine use of both marks it would not have assisted the opponents. This is because, where shown, use of these marks is limited to games software. There is no evidence of use in relation to electronic games in class 28 which are essentially computerised games incorporated in a hand held device and, with the exception of some limited evidence of licensing of games software, there is no evidence of use in relation to any of the other class 42 services relied upon by the opponents. The opponents’ argument that the evidence shown should be taken as establishing that they have also used the marks in relation to most of the class 42 services, simply because the development of games software involves *computer programming, computer programming design and consultancy; software development; installation, customisation and maintenance of computer programs; computer systems analysis; design, drawing and commissioned writing, all for the creation, development, compilation and production of computer games; computer software and games research, analysis, design and development*, cannot be accepted. This is because these activities are parts of the opponents’ own games software development rather than services provided to others and could not be relied upon as such. Accordingly, for the purpose of this opposition, irrespective of what goods and services the opponents have identified, they would be able to rely only on ‘games software’ and (at best) ‘licensing of games software’ in relation to the marks which are subject to proof of use.

The opponents’ best case

18. The registration EUTM 10311678 for the mark REBEL is, in my view, closer to the applied for mark than the other two marks subject to proof of use. Further, as this mark is not subject to proof of use, it can be relied upon for all the goods and services the opponents have identified. For those reasons, I consider that this mark offers the opponents the best prospect of success in these proceedings; if the opponents do not succeed in relation to this mark, in my view, they will be in no better position in relation to the other marks. I will therefore limit my considerations to this mark.

¹ Whilst the evidence includes 2014-2015 sales reports, which Mr Kingsley submits shows sale of games and licenses for Rebellion branded games, there is no summary of sales by country in relation to these figures and it is therefore impossible to say whether these games (and licenses) were sold in the UK or in other EU countries.

Section 5(2)(b) case law

19. 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.

Comparison of goods and services

20. In comparing the respective specifications, all the relevant factors should be taken into account. In *Canon*, Case C-39/97 the Court of Justice of the European Union (CJEU) stated at paragraph 23:

“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”.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

22. Other factors which may be considered include the criteria identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons limited (Treat)* [1996] RPC 281 for assessing similarity between goods and services:

- (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.”

23. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

24. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

25. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch) Floyd J (as he then was) stated:

“12. There are sound policy reasons for this. Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of “dessert sauce” did not include jam, or because the ordinary and natural description of jam was not “a dessert sauce”. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

26. Bearing in mind the above general guidance, I go on to compare the respective goods and services.

Applicant’s goods and services	Goods and services relied upon by the opponents
<p>Class 9 <i>Computer software for the collection, editing, organising, modifying, transmission, storage and sharing of data and information; computer software for communication with users of handheld computers; software for mobile telephones; telephony software</i></p>	<p>Class 9 <i>Software for motion pictures</i></p> <p>Class 42 <i>Consultancy for computer games; creating and maintaining web sites; advisory, consultancy and information</i></p>

<p><i>applications; software for tablet computers.</i></p> <p>Class 42 <i>Software consultancy services; Advice relating to the development of computer systems; Creating and maintaining websites for others; designing and implementing websites for others; providing hosting services for websites for others; creating customized web pages featuring user-defined information, personal profiles and information; computer consultancy in the field of IT project management; Services for designing computer software; Software as a service [SaaS]; Creating bespoke mobile applications and websites.</i></p>	<p><i>services relating to all of the aforesaid services.</i></p>
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27. The applicant makes a number of comments in relation to the similarity of the competing goods and services which I do not intend to summarise here, but I will bear them in mind. As pointed out by the opponents, the applicant's comments contain some inconsistencies. Whilst I should apply greater caution in reading those submissions when the position is ambiguous, it is not for me to make a better case for the applicant where its position is clear. In relation to the mark EUTM 10311678 (to which I limit my assessment), the applicant submits that there is no similarity between the respective goods in class 9 but accepts that the parties' class 42 services are similar. The applicant also states that where there is similarity, the degree of similarity is low. In carrying out my own assessment of the similarity of the goods and services, I will proceed on the basis that all the applied for services are similar at least to a low degree to the opponents' services but I will state where I find that the services are similar to a higher degree.

Class 9

28. *Motion pictures* are a sequence of images of moving objects photographed by a camera and shown in rapid succession so that they appear to be moving. In the absence of evidence or clear submissions from either party as to the nature of the software, in my view, *software for motion pictures* allows users to create and edit videos, films and animations. In order to perform its function, the software will need to capture, collect, process and store images. As such, *software for motion pictures* of the earlier mark is highly similar if not identical to the applied for *computer software for the collection, editing, organising, modifying, transmission, storage and sharing of data and information*.

29. *Handheld computers* are computers of a size that can conveniently be held. In the absence of evidence or submissions from either party as to the nature of the goods, *computer software for communication with users of handheld computers* allows computers to communicate with handheld computers. Communication is the

exchange of information and information can be exchanged in various formats; the software will therefore allow data, which can be in the form of, for example, files, texts, audio and video, to be transmitted from one computer and received by another. While the purpose of the respective software is different, the nature and the trade channels are the same and there is a connection to the extent that videos, films and animations created by the use of software for motion pictures may also be shared and communicated. I find that there is a complementary relationship and a low degree of similarity between *computer software for communication with users of handheld computers* and *software for motion pictures*.

30. The applied for *software for mobile telephones, telephony software applications* and *software for tablet computers* are broad categories and as such would encompass *software for motion pictures* of the earlier mark. When applying the guidance in *Meric*, these goods are identical.

Class 42

31. As the applied for *software consultancy services, advice relating to the development of computer systems, services for designing computer software* and *creating bespoke mobile applications* may all relate to computer games they encompass *consultancy for computer games* of the earlier mark and are, on the principles in *Meric*, identical.

32. The applied for *creating and maintaining websites for others, designing and implementing websites for others, creating customized web pages featuring user-defined information, personal profiles and information* and *creating bespoke websites* are encompassed by the broad term *creating and maintaining web sites* of the earlier mark and, once again, are identical on the *Meric* principle.

33. The Oxford English dictionary defines 'web hosting' as *the activity or business of providing storage space and access for websites*; the applied for *providing hosting services for websites for others* are therefore services aimed at making websites accessible on the Internet. In my view, there is a clear complementary relationship between these services and the earlier mark's services of *creating and maintaining web sites*. I find that there is at least a medium degree of similarity between these services.

34. Given my findings above, in relation to the remaining services of the application, i.e. *computer consultancy in the field of IT project management* and *software as a service [SaaS]*, I find that there is at least a low degree of similarity with the services of the earlier mark.

The average consumer

35. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue; I must then determine the manner in which these goods and services will be selected in the course of trade.

36. 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.”

37. Whilst the average consumer of the parties’ goods may be either a member of the general public or a business user, the average consumer of the parties’ services will be, most likely a business user. The parties’ software goods are most likely to be purchased primarily visually after examination of information in a store or on the Internet and in advertisements and reviews in both hard copy and on-line, although I do not discount aural considerations in the form of, for example, interaction with a sales assistant and orders placed by phone. The same can be said for the parties’ services, although, as oral recommendations from one person or business to another are also likely, aural considerations must, once again be borne in mind. As to the degree of care and attention with which the goods and services will be selected, it will vary from no more than average, e.g. members of the general public selecting apps for their phone, to higher than average, e.g. for the provision of a software consultancy service for a business.

Comparison of marks

38. 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 them must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU 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.”

39. It would be wrong, therefore, artificially to dissect the 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.

40. The respective marks are shown below:

Applicant's mark	Opponents' mark
Rebel Minds	REBEL

Overall impression

41. The applied for mark consists of two words Rebel and Minds with the first letter of each word in upper case and the remaining letters in lower case. The words combine to create a phrase that 'hangs together' so they are perceived as a unit and together they form the dominant and distinctive element of the mark. As to the opponents' mark, it consists of the single word REBEL presented in capital letters; it has no dominant elements, its distinctiveness lying in its totality.

Visual similarity

42. Visually, the marks are similar to the extent that they coincide in the (first) word REBEL/Rebel. Although the marks employ different casing, notional and fair use of the respective marks could include use in lower case, upper case or a combination of the two, so the difference in casing matters not. The applied for mark also contains the word Minds which has no equivalent in the opponents' mark. Taking all matters into account, the respective marks are similar to a medium degree.

Aural similarity

43. The above analysis follows through to my assessment of aural similarity. The similarities and the differences are the same, thus, I find that the level of aural similarity is medium.

Conceptual similarity

44. Both parties make submissions on the conceptual similarities of the competing marks. The opponents submit:

"24. Conceptually, the application is to do with the state of an anarchic mind. The application also has to do with a person who is thinking about being a rebel or leading a rebellion. There is little conceptual difference between a "rebel mind" and a "rebel". Conceptually, the sign as applied for and the earlier trade mark have a similar meaning".

45. The applicant states:

"24. While the first word element is shared, since the Application Mark also includes the word element MINDS, which when read in conjunction with REBEL creates a highly distinctive mark that is distinguishable from the Earlier Right. .."

46. I agree with the opponents as, in my view, the significance produced by the marks is highly similar. Oxford English Dictionary defines a rebel as *a person who resists authority, control, or convention*. The word Minds refer to a person's

intellectual faculties and the qualifying effect of the word Rebel upon the word Minds triggers the same idea of someone who thinks as a rebel and, therefore, is a rebel. Whilst the opponents' mark refer to one person (singular) and the applied for mark uses a plural form, this does not create a conceptual difference or, if it does, it is minimal. The marks are conceptually similar to a reasonably high degree.

Distinctive character of the earlier mark

47. The distinctive character of the earlier mark must be assessed. This is because the more distinctive it is, based either on its inherent qualities or because of the use made of it, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). The distinctive character of a mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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).”

48. I have no evidence of use to consider in relation to the word mark REBEL so I only need to make a finding in respect of its inherent distinctiveness.

49. The applicant submits that “the term REBEL is descriptive in relation to games software as this describes a popular ethos in the gaming community and would also be considered laudatory”. The specification relied upon does not include games software but include *consultancy for computer games*. In any event, the applicant provide no evidence to support its claim that the word is laudatory. Accordingly, I find that the word REBEL is neither descriptive nor allusive in relation to any of the goods and services of the earlier mark. In my view, the earlier mark is endowed with an average degree of distinctive character.

Likelihood of confusion

50. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in my decision I found that:

- the goods and services are similar to various degrees, from low to identical;
- the average consumer of the parties' goods and services is either a business user or a member of the general public. The level of attention paid will range from no more than average to higher than average and the selection process is likely to be primarily visual although aural considerations must not be overlooked;
- in the applied for mark Rebel qualifies Minds to produce a phrase that 'hangs together' as a unit;
- the competing marks are visually and aurally similar to a medium degree and conceptually similar to a reasonably high degree;
- the earlier mark has an average degree of inherent distinctive character.

51. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

52. In assessing the similarity between the marks, I take into account that each mark has to be considered as a whole without dismemberment. In keeping with my findings that the applied for mark consists of a coherent composite phrase forming a unit, I also bear in mind the comments of Professor Ruth Annand, sitting as the Appointed Person in O-476-14, where she stated:

“...On the contrary, the CJEU makes clear in *Bimbo* that “hanging together” is not the determinative criteria in assessing a composite mark: the decisive question being whether the composite mark forms a unit having a different meaning as compared to its components taken separately (*Bimbo*, para. 25).

Mr. Malynicz referred me to 2 earlier decisions of Mr. Geoffrey Hobbs Q.C. sitting as the Appointed Person in *CARDINAL PLACE Trade Mark*, BL O/339/04 and *CANTO Trade Mark*, BL O/021/06, as similarly expressing the same point that marks must be compared as wholes, considering the blend of meaning given by the composite mark against the single term.”

53. Whilst the applied for mark consists of the composite phrase Rebel Minds that ‘hangs together’, the addition of the element Minds in the applied for mark results in no change of meaning compared to the common component Rebel when considered separately. The perception and recollection triggered by the respective marks is similar to a reasonably high degree. Taking all matters into account, I find that even where there is a low degree of similarity between the parties’ goods and services and the level of attention paid by the average consumer is higher than average, there will be indirect confusion, as the average consumer will assume that the goods and services are the responsibility of the same undertaking or of undertakings with economic connections.

CONCLUSION

54. The opposition has succeeded.

Costs

55. As the opponents have been successful, they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. However, I take into account that the opponents filed a large volume of unfocused and irrelevant evidence, evidence which I noted earlier exceeded the limits set out in TPN 1/2015 and which was filed without the opponents first seeking directions from the Tribunal. Bearing all of the above in mind, I have not awarded the opponents any costs in relation to the preparation of their evidence. Using the TPNs mentioned as a guide, I award costs to the opponents on the following basis:

Official fees: £100

Preparing a statement and considering the other side's statement: £200

Written submissions: £200

Total: £500

56. I order Rebel Minds Ltd to pay Jason and Chris Kingsley (jointly) the sum of £500 as a contribution towards their costs. This sum is to 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 26th day of May 2016

**Teresa Perks
For the Registrar
The Comptroller - General**