

O-513-16

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1244702
DESIGNATING THE UK FOR THE MARK:**

REVELIAN

**IN THE NAME OF TALENTCORP PTY LTD
FOR GOODS IN CLASSES 9, 35, 41 and 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404866 BY
CHRISTOPHER KINGSLEY**

BACKGROUND AND PLEADINGS

1) International Registration No. 1244702 was registered with designation of the UK on 4 July 2014 by Talentcorp Pty Ltd (“the Applicant”) for the following mark (“the opposed mark”)

REVELIAN

The date of publication in the Trade marks Journal was 15 May 2015. The mark was designated for goods and services in classes 9, 35, 41 and 42, but only the following goods and services are opposed in these proceedings:

Class 9: *Application software; computer games programs; computer games software; computer game programs downloaded via the internet; computer programmes (programs) and recorded software distributed online; computer programs (downloadable software); computer programs for data processing; computer programs for playing games; computer programs for scientific data analysis; computer programs for measuring and analysing employee and organisation performance; computer software applications (downloadable); games software; interactive computer software.*

Class 41: *Gaming services; game services provided online; provision of games by means of a computer based system.*

2) The application is opposed in respect of the above goods and services by Mr Christopher Kingsley under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Mr Kingsley relies upon the following earlier marks and respective goods:

UK trade mark registration no. 1521191, which was applied for on 10 December 1992 and completed its registration process on 03 June 1994:

REBELLION

Class 9: *Computer games adapted for use with television receivers and video apparatus; computer software; computer programs*

EU trade mark registration no. 1002492, which was applied for on 25 November 1998 and completed its registration process on 26 February 2001:

REBELLION

Class 9: *Computer games adapted for use with television receivers and video apparatus; computer software; computer programs*

The significance of the dates is that (1) Mr Kingsley's marks constitute earlier marks in accordance with section 6 of the Act, and (2) they are both subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures having been completed more than five years before the publication of the Applicant's mark in the UK.

3) Mr Kingsley claims that because of similarity between the Applicant's marks and the earlier marks, and identity or similarity between the opposed goods/services and those of his earlier marks, there exists a likelihood of confusion; he also claims that the distinctiveness of the earlier marks is likely to have been enhanced by reason of their use by him or on his behalf. The Applicant filed a counterstatement, denying the grounds of opposition, putting Mr Kingsley to strict proof of use of the earlier marks in respect of the goods relied on, and to strict proof that the distinctiveness of the earlier marks has been enhanced as a result of their use by him or his licensees since 1992. The period during which genuine use of the marks must be proved ("the relevant period") is 16 May 2010 to 15 May 2015. The date as at which enhanced distinctiveness through use must be proved ("the relevant date") is the date the opposed mark was registered with designation for the UK: 4 July 2014.

4) Mr Kingsley is represented by Brand Protect Limited. The Applicant is represented by Keltie LLP. Both parties filed evidence. Neither side requested a hearing. Both sides filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

EVIDENCE SUMMARY

Mr Kingsley's evidence

5) In witness statements of 14 December 2015 and 25 July 2016 Mr Kingsley declares that he is a director of the companies Rebellion Development Limited, Rebellion A/S, and Rebellion Interactive Limited (for convenience Mr Kingsley refers to these companies together as "Rebellion", and I shall follow this practice in my decision). He states that he is the owner of both earlier marks in these proceedings and that he has licensed their use to Rebellion. Mr Kingsley's evidence is directed to establishing both use of the earlier marks and their enhanced distinctiveness through use. In the interest of procedural economy for the purposes of my decision I shall assume that Mr Kingsley has shown genuine use for the full range of goods relied upon and established a high degree of distinctiveness following enhancement through use of the earlier marks. I therefore need not consider further the evidence on these points.

The Applicant's evidence

Witness Statement of Vass Malanos

6) A witness statement of 29 March 2016 by Vass Malanos, Chief Financial Officer of the Applicant provides information about the activities of the Applicant under the REVELIAN trade mark. Insofar as this evidence may establish that the Applicant and Mr Kingsley currently operate in different sectors of the market, it is irrelevant to the issue of confusion. It is settled law that it is the inherent nature of the services of the specifications which I have to consider; current use and business strategy are irrelevant to this notional comparison (see the comments of the General Court in *Devinlec Développement Innovation Leclerc SA v OHIM* Case T- 147/03). This is because they may change over time. Consequently, I am required to consider the

likelihood of confusion “in all the circumstances in which the mark applied for might be used if it were to be registered” (See the comments of the CJEU in Case C-533/06, *O2 Holdings v Hutchison 3G UK* at paragraph 66).

Witness Statement of Benjamin Britter

7) A witness statement of 13 May 2016 by Benjamin Britter, Trade Mark Attorney with Keltie LLP (representative for the Applicant) provides by means of extracts from the official online databases of the Intellectual Property Offices of Canada, Australia, USA, Ireland and the EUIPO details of trade mark applications and registrations in the names of the Applicant and Mr Kingsley respectively, together with examination reports pertaining to the Applicant’s marks, issued by the relevant Trade Mark Offices. In its written submissions of 13 May 2016 the Applicant, while admitting that “decisions from jurisdictions outside of the UK are not decisive”, submits that there is probative value in the fact that in each case the respective Trade Mark Office – with English being a principle language – did not identify any conflict existing between the respective REVELIAN and REBELLION trade marks. In their submissions of 12 September 2016 Mr Kingsley’s representatives state that, at the time of writing, the REVELIAN applications were not registered in Canada and the EU.

8) I am not, of course, bound by decisions from jurisdictions outside the UK. Even in the case of a UK decision, however, the mere fact that, prior to the registration of a contested mark, the registrar might have considered arguments subsequently raised by the opponent *ex parte*, and decided that the mark was registrable, would not be a factor to which I could, or should, attach any great weight. This is because in *inter partes* proceedings the registrar must act as an independent tribunal and judge the matter purely on the basis of the arguments and evidence presented in those proceedings.

SECTION 5(2)(b) OF THE ACT

9) Section 5(2)(b) of the Act reads 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, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

10) 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.

(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 will wrongly 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

11) In the judgment of the Court of Justice of the European Union (“the CJEU”) 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”.

12) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 (“*Meric*”), the General Court (“the 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 the 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 (Case T-104/01 *Oberhauser v OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM — Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)”.

13) In its written submissions the Applicant admits that all the contested goods of the opposed mark are identical to the goods upon which the opposition is based. It is further admitted that the contested services of the opposed mark are similar to the goods upon which the opposition is based. I shall make my global assessment of the likelihood of confusion on that basis.

The average consumer and the purchasing process

14) 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*. 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.”

15) The competing specifications cover a broad range of goods and services. For computer programs, for example, the average consumer could be either a member of the general public or a business and, depending on price and exactly what is involved, a higher or lower degree of care could be used in their selection. The average consumer of computer programs for data processing, scientific data analysis, or measuring and analysing employee and organisation performance will usually consist of businesses or professionals. The purchasing process will normally involve a reasonably high degree of care and attention commensurate with its commercial or professional importance, though these items may also cover more routine commercial or professional programs for which the degree of attention may be no more than average.

16) The average consumer for computer games will be a member of the general public. While some games may be reasonably expensive, there are many which are either low cost, or even free. For the latter the level of care and attention may be somewhat lower than the norm, but the average consumer will still normally consider the goods from the point of view taste, technical compatibility, data storage capacity, etc.

17) Some commercial contracts for the purchase of expensive software may involve some oral negotiation, though they will also normally involve a higher degree of care and attention and, virtually invariably, also written dealings. With that proviso, I consider all the goods and services to be ones more likely to be selected by the eye (in stores, through websites, brochures, etc.) than by oral request, though I do not ignore the possibility of discussion with sales assistants, for example. The

purchasing process will be predominantly visual, but I will not ignore the aural aspects of the marks.

Comparison of the marks

18) 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 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.”

19) It would be wrong, therefore, to dissect the trade marks artificially, 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.

20) Since the goods relied on under both earlier marks are the same, and since the stylisation of the earlier mark UKTM 1521191 takes it a little further away from the opposed mark, the earlier mark EUTM 1002492 represents Mr Kingsley’s best case. I shall therefore confine my comparison to the earlier mark EUTM 1002492. The marks to be compared are shown below:

The opposed mark	The earlier mark EUTM 1002492
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REVELIAN	REBELLION
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21) Both marks consist of a single word which has no dominant components but is distinctive in itself as a whole.

22) Visually, the words REVELIAN and REBELLION appear of roughly even length, The words share six of their letters in the same order (though their sequence is broken by intervening letters), and their initial two letters and final letter are the same. These factors point to there being some similarity. However, the third letters – V and B respectively – are clearly different, and give the words noticeably different beginnings. Although the endings of both words contain the letters L, I and N in the same order (though interrupted by A and O respectively), the double LL of REBELLION again gives the word a noticeably different ending. Overall, there is at least a medium degree of visual similarity.

23) Since REVELIAN is an invented word, there is no orthodox pronunciation for it. People may well hesitate over its pronunciation. However, I consider that its initial RE and final LIAN will probably end up being pronounced in the same (or a very similar) way respectively as the initial RE and final LION of REBELLION. Again, however, the respective third letters – V and B – are clearly different sounds, and give the words noticeably different beginnings aurally. On balance, I consider that there is a somewhat higher than medium degree of aural similarity between them.

24) Mr Kingsley’s representatives, having first examined the respective derivations of the words “rebel” and “revel”, submit that the average consumer is aware of a link in their derivations and concludes that a “revelian” is, in the minds of the average consumer, a rebel. I strongly disagree. An etymologist, confronted by the word REVELIAN, may attempt to analyse it into components to yield a potential meaning. The average consumer will not; s/he will simply perceive REVELIAN either as an invented word, or as a totally unfamiliar one, the meaning of which is unknown to him or her. By contrast, the word REBELLION will be instantly recognised and its

meaning immediately understood. There is an obvious semantic gap between the immediately apparent conceptual content of REBELLION and the absence of such content in REVELIAN.

Likelihood of Confusion

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

26) I make my assessment on the basis that the contested goods of the opposed mark are identical, and the contested services similar, to the goods on which the opposition is based. I am also assuming a high degree of distinctiveness for the goods relied on (which can increase the likelihood of confusion). I have found that the goods include some which may be subject to a casual selection process because they include some which may be low cost or even free (which has the potential to increase the likelihood of confusion because the effects of imperfect recollection may be increased). I have found that there is at least a medium degree of visual similarity and a somewhat higher than medium degree of aural similarity between the competing marks.

27) I have also found that there is an obvious semantic gap between the immediately apparent conceptual content of REBELLION and the absence of such content in REVELIAN. I bear in mind that although conceptual differences may counteract visual and aural similarities¹, they do not always do so², and that, for there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the

¹ See the judgment of the CJEU in *The Picasso Estate v OHIM*, Case C-361/04 P at paragraph 20.

² See the judgment of the General Court in *Nokia Oyj v OHIM*, Case T 460/07 at paragraph 66.

public is capable of grasping it immediately³. In this case, however, REBELLION is a word which will be immediately recognised, and forms a strong conceptual hook which will tend to counteract imperfect recollection. Balancing all these factors, I do not consider that there will be a likelihood of confusion, even for the identical goods. It follows that there will be no confusion in respect of the services for which the degree of similarity is less than identity. Accordingly, **the opposition fails in its entirety.**

COSTS

28) Talentcorp Pty Ltd has been successful and is entitled to a contribution towards its costs. I hereby order Mr Christopher Kingsley to pay Talentcorp Pty Ltd the sum of £1,500. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£300
Filing evidence and considering the other side's evidence	£900
Written submissions	£300

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 3rd day of November 2015

Martin Boyle

For the Registrar,

The Comptroller-General

³ See the judgment of the CJEU in *Mühlens GmbH & Co KG v OHIM*, Case C-206/04P at paragraph 11, noting the judgment of the Court of First Instance at paragraph 49. See also Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* at paragraph 54.