

O-283-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3110091
BY YOUR LEISURE KENT LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 41 AND 43:**



**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 405417 BY MARTIN EARL**

Background and pleadings

1. On 22 May 2015, Your Leisure Kent Limited (“the applicant”) applied to register the following trade mark for a range of services in classes 41 and 43:



2. The application was published for opposition purposes on 11 September 2015. It is opposed by Martin Earl (“the opponent”). The opposition, which is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against the following services in the application:

Class 41 Provision of leisure facilities; provision of sports facilities; provision of sports coaching services; provision of sports club services; organising of sports competitions and sports events; gymnasiums, provision of health club and gymnasium services, gymnasium club services; provision of fitness and exercise facilities; exercise classes, physical fitness instruction for adults and children; provision of swimming facilities; provision of gymnastic facilities; provision of instruction in gymnastics; organising gymnastics events; tennis instruction; provision of tennis court facilities; theatre productions; production of shows; provision of theatre facilities; organising of theatre productions and shows; booking of seats for shows; booking of theatre tickets; entertainment services for children; children’s adventure playground services; provision of play facilities for children.

3. The opponent relies upon his UK trade mark registration no. 2399009 for the following trade mark:



4. The mark was applied for on 10 August 2005 and its registration procedure was completed on 17 February 2006. Given its date of filing, the opponent's mark qualifies as an earlier trade mark under s. 6 of the Act. The mark's specification was restricted following a successful revocation action by the applicant; now relies upon the following services for the opposition:

Class 41 Transferring and dissemination of entertainment information and data via computer networks and the Internet; all included in Class 41.

5. In his notice of opposition (amended following the revocation proceedings), the opponent claims that there is a likelihood of confusion because the marks are highly similar and because the services are similar. The opponent also states in his notice of opposition that he has used his mark in relation to all of the services relied upon. This statement is made because the earlier mark is subject to the proof of use provisions contained in s. 6A of the Act.

6. The applicant filed a counterstatement denying the basis of the opposition, which was also subsequently amended. I note that the amended counterstatement supplements rather than replaces the first. The applicant asserts that there is no likelihood of confusion because the trade marks are similar to a low degree and there is no similarity between the services at issue.¹

7. The applicant initially put the opponent to proof of use for the services relied upon in class 41. That request was withdrawn in the amended counterstatement. As a consequence, the opponent may rely upon all of the services he has identified.

¹ Second counterstatement, paragraph 19.

8. The opponent is a litigant in person. The applicant has been professionally represented throughout by Stone King LLP.

9. Both sides seek an award of costs.

10. No hearing was requested and neither party filed written submissions in lieu, although the applicant filed written submissions during the evidence rounds, which I will refer to as I consider necessary. This decision is taken following a careful reading of the papers.

Sections 5(1), 5(2)(a) and 5(2)(b)

11. Sections 5(1), (5(2)(a) and 5(2)(b) of the Act read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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”.

Sections 5(1) and 5(2)(a)

12. In order to get an objection under the above sections off the ground, the competing trade marks must be identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer”.

13. Applying the above principle to the comparison at hand, I have no doubt that the presence of, at least, the arrow device in the earlier mark will be noticed by the average consumer. The marks are not identical and the opposition under ss. 5(1) and 5(2)(a) is dismissed accordingly.

Section 5(2)(b)

14. 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 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 services

15. When making the comparison, all relevant factors relating to the services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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.

17. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] 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) (IP TRANSLATOR)* [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”.

18. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

19. 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”.

20. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services. 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”.

22. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes,”

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

23. In addition, I bear in mind the guidance given by Mr Alexander in the same case, where he warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

24. The opponent claims that:

“the provision of information about goods or services is inextricably linked to the provision of the goods or services themselves. The applicant has in fact constructed a website for the very purpose of informing consumers about its sports, fitness and leisure services as well as its own facilities and is highly confusing to users”.

25. In addition, he comments on the similarity of the services at issue by describing the “core services” of his own business which, he says, are “those which relate to the provision of an internet-based directory and information site [...] of sports, cultural and leisure facilities, how to play instructions, histories and general information, and for users to have the opportunity to gather further information from third party suppliers, such as buying theatre tickets and equipment”. The opponent also describes the type of information which, he claims, is provided by the applicant on its website.

26. The actual use by the parties is not relevant because, as proof of use has not been requested, the comparison must be made on the basis of notional use of the marks across the full width of the specifications. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider

notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place”.

27. This approach has recently been endorsed by the Court of Appeal in *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84).

28. So far as the applicant’s use of the applied-for mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. There is no evidence before me of the applicant’s use of the mark but, in any event, it is clear from the case law cited above that my assessment must take into account only the applied-for mark (and its specification) and any potential conflict with the earlier trade mark. Any differences between the services provided by the parties, or differences in their trading styles, are irrelevant unless those differences are apparent from the applied-for and registered marks.

29. The applicant has made a number of submissions regarding the services at issue, which I will bear in mind. I note that the applicant seeks to rely on comments made by the hearing officer in the related revocation proceedings (BL O/202/16), stating that “[t]he Registrar held that the principal purpose of the Opponent’s services was to allow users to find information relating to unrelated third party undertakings which provide health club, sporting, gymnastic, recreation and tourist facilities, fitness studios/gyms and physical education services”.² Decisions made by other hearing officers are neither binding upon me nor of particular persuasive value. Moreover, the services upon which the opponent relies were not subject to any challenge in the revocation proceedings.

² Submissions, paragraph 21. The paragraph reference for the hearing officer’s comments is not given but they appear to be drawn from paragraph 21 of the earlier decision.

The comments paraphrased by the applicant were in the context of stating what the evidence did or did not show regarding use by the opponent in relation to the (different) services at issue. In those circumstances, it would clearly be inappropriate for me to treat the hearing officer's findings in relation to one set of services as determinative in relation to the services in the instant proceedings.

30. I also note the applicant's submissions that "[u]se of a trade mark for specific services should not be sufficient to maintain protection for other services which fall within the same Class just because they have been categorised within the same Class", citing *Reckitt Benckiser (España), SL v OHIM*, Case T-126/03 in support of that statement.³ In a case where the opponent has been put to proof of use of the mark, that may be so. However, the opponent in this case was not put to proof and so the notional assessment, discussed above, applies. The extent of any similarity between the services is a matter for me to determine.

31. The earlier mark is registered for "transferring and dissemination of entertainment information and data via computer networks and the Internet; all included in Class 41". I have noted the applicant's comments regarding the specification and whether it is properly classified.⁴ I have some reservations over whether the services should more properly be elsewhere but, by dint of being in class 41, the opponent's services are entertainment services (as opposed to communication services, which would be proper to class 38, or the unspecified services in class 35 referred to by the applicant). The term, as I understand it, would include the transfer and dissemination of entertainment information by means such as a website featuring, for example, celebrity news, television news, and reviews and schedules for theatre, film and music. I have no submissions from the parties on the meaning of "entertainment" but, although both are activities enjoyed in one's spare time, I do not consider that its ordinary and natural meaning would extend to "sport". I see no reason why the specification would be limited

³ Submissions, paragraph 22.

⁴ *Idem*.

to the provision of information provided by third parties; in my view, the specification would also cover content created by the opponent.

Provision of leisure facilities; provision of sports facilities; provision of sports coaching services; provision of sports club services; organising of sports competitions and sports events; gymnasiums, provision of health club and gymnasium services, gymnasium club services; provision of fitness and exercise facilities; exercise classes, physical fitness instruction for adults and children; provision of swimming facilities; provision of gymnastic facilities; provision of instruction in gymnastics; organising gymnastics events; tennis instruction; provision of tennis court facilities

32. All of the above services are concerned with the provision of sporting and exercise facilities, instruction and events. I accept that the applicant may provide information about its own services, as submitted by the opponent. That does not alter the core nature of the services applied for, which are essentially sports or exercise services, not an information service. Nor is the core nature of the services affected if the use of the sporting or exercise services is facilitated by the use of the internet or a website (e.g. by allowing online booking of classes). The nature and purpose of the services at issue are, therefore, different, one being concerned with online entertainment news and information, the other with sport and exercise. The methods of use of the services and their channels of trade will differ, and they are not in competition. The users of the services may be the same, at a very superficial level, since they may both be members of the general public but that is insufficient to engage overall similarity between the services. The opponent has submitted that the services are “inextricably linked”. However, not only are the subjects of entertainment information and provision of sports facilities/instruction vastly different but neither is important or essential to the other such that the relevant public would consider the responsibility for the services lies with the same undertaking. The services are not complementary. I find that the services are not similar.

Theatre productions; production of shows; provision of theatre facilities; organising of theatre productions and shows

33. These services are concerned with organising and putting on theatrical performances, as well as providing facilities for those productions. The core nature and purpose of the services is therefore different from the nature and purpose of the services in the earlier specification, which are principally concerned with providing information (though I acknowledge that the subject matter of the opponent's services may relate to theatre). The method of use is different and, while there may be an overlap in users of the services at a superficial level, neither service is an alternative to the other and so they are not in competition. Although access to information such as reviews and theatre listings may be important for consumers of theatre productions, I do not consider that the services have a complementary relationship: the services may be used together but the average consumer is unlikely to think that the same undertaking is responsible for them. Indeed, in the case of reviews, independence of the review is a defining feature. The services are not complementary as defined in the case law. There is no meaningful similarity between the services.

Booking of seats for shows; booking of theatre tickets

34. The applicant submits that these services:

“can be conducted in an on-line environment but [...] are completely different in nature and purpose to disseminating entertainment information on-line because they have an end product, namely a ticket to an event. In the case of the Opponent's services, the transfer of information does not result in any further product being created”.⁵

35. I am not persuaded by this argument. In my view, the opponent's specification would include the activity of ticket agencies in disseminating information about

⁵ Submissions, paragraph 18.

forthcoming events. Even if the dissemination service does not offer the ticket booking facility itself, it would not, in my experience as an average consumer of the services, be uncommon for booking sites to be signposted by way of, for example, links to external websites. Although the nature and purpose of the services are not identical, there is an overlap in terms of their channels of trade, method of use and users. The precise services at issue are unlikely to be in direct competition but the relationship between them means that the average consumer could well assume that the same undertaking has responsibility for the services at issue. There is a low degree of similarity between these services.

Entertainment services for children

36. The opponent's specification would cover entertainment information services relating to children's entertainment. The applicant's "entertainment services for children" is a very broad term which would cover a wide range of both real-world and online entertainment services (for children). I see no reason why it would not encompass the services covered by the earlier specification. The services are identical, based on the principle outlined in *Meric*.

37. The specification of the application is much wider than that of the earlier mark and could, notionally speaking, cover services which are not similar to the services of the opponent's mark. As matters stand, no fall-back specification has been provided and I will proceed on the basis that these services are identical, though I will return to this point when I address the likelihood of confusion.

Children's adventure playground services; provision of play facilities for children

38. I can see no meaningful similarity between the above services and those of the opponent. The nature, purpose, method of use and channels of trade are different. The only similarity would be at a very superficial level, insufficient to create overall similarity, in that the users might intersect, both being members of the general public, and that

information about playgrounds and play facilities may be available online. These services are not similar.

39. If the services are not similar, there can be no likelihood of confusion.⁶ In view of my findings, above, the opposition is hereby dismissed in respect of all of the applicant's services, save for "entertainment services for children" and "booking of seats for shows; booking of theatre tickets". The remainder of this decision is concerned only with these identical and similar services.

Average consumer and the nature of the purchasing act

40. 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*.

41. 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".

⁶ If the goods/services are not similar, there can be no likelihood of confusion. See, for example, *Waterford Wedgwood plc v OHIM*, C-398/07 P (CJEU).

42. The average consumer of the services at issue is a member of the general public. The services may vary in cost across the category but, in general, are not likely to be terribly expensive. The average consumer will, however, wish to ensure, for example, availability of tickets for selected shows or seating areas in the theatre, or that the entertainment service is age-appropriate or relates to the consumer's particular interest. I consider that the purchase will be made with an average degree of attention.



43. In terms of the nature of the purchasing process, this is likely to be primarily visual, following exposure to the mark on websites, in advertisements, whether online or in print, and (for the applicant's services) on signage of premises. There is potential for the marks to be encountered aurally, through use over the telephone or in oral recommendations, so I do not rule out that there may be an aural component.

Comparison of trade marks

44. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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”.

45. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

Opponent's trade mark	Applicant's trade mark
	

46. The opponent submits that “The dominant distinctive element of the earlier trade mark is the words “YOUR LEISURE”. [...] The applicants [sic] trade mark, whether used in plain word form or together with its graphic element, is highly similar to the earlier mark”.

47. The opponent's reference to use of the marks “in plain word form” or with devices is noted. However, the marks at issue in these proceedings are both figurative marks which incorporate a device and it is those marks, as wholes, which I must compare.

48. The earlier mark consists of the words “YOUR LEISURE” in capital letters, in green. To the left of the letters is a device of two arrows next to one another, in white on a square blue background. There is a thin green border around the blue square. The words “YOUR LEISURE” form a unit which will be seen as one element of the mark. Notwithstanding the relatively low distinctiveness of the words, they will, due to their relative size, dominate the overall impression. The device is far from negligible but plays a lesser role. The colour plays only a weak role.

49. The application consists of the letters “OUR” and “eisure” above one another. The letters are in different stylised typefaces. To the left of them is a device consisting of two, slightly curved, upright lines. I think it reasonably clear that the device will be seen as replacing the letter “Y” in “YOUR” and the letter “l” in “leisure” and that the mark will be perceived as comprising the words “YOUR leisure”. As with the earlier mark, I consider that the words “YOUR leisure” dominate the overall impression, with a lesser, though not negligible, role being played by the device. The stylisation of the typeface has a weak role.

50. I note that the applicant refers in its submissions to use of the application in different colours (orange and grey).⁷ However, the mark is recorded as applied for in grey scale. In relation to the colour aspect, I note that Kitchin LJ stated in *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96]:

“A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours”.⁸

51. Given that the application is neither in colour nor subject to a colour claim, and whilst I acknowledge that, strictly speaking, it is not in black and white but rather in grey scale, I see no reason why the above guidance should not apply. That means that the application could be used in any colour and that use in specific colours (of which I have no evidence) is not relevant.

52. The applicant accepts that the marks are similar but submits that any similarity is of a low degree and that there are “striking” visual differences.⁹ Both marks contain—and are dominated by—the words “YOUR LEISURE”/“YOUR leisure”. A difference is introduced by the not insignificant device element in each mark. I consider that there is a medium degree of visual similarity.

⁷ Submissions, paragraph 9.

⁸ See also *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd and Specsavers Optical Superstores Ltd v Asda Stores Ltd and The Registrar Of Trade Marks (Intervening)* [2014] EWCA Civ 1294 at [5].

⁹ Submissions, paragraphs 7-8.

53. The applicant, sensibly, accepts that the marks are aurally identical.¹⁰

54. From a conceptual perspective, the words “YOUR LEISURE”/“YOUR leisure” convey the concept of leisure activities enjoyed by or tailored for an individual. Although the meaning is not particularly distinctive in relation to the services at issue, it is the same for both marks. The device in the earlier mark may be perceived as arrows or even a fast-forward sign. It does not, however, change the concept created by the words, which is shared by the marks. Bearing in mind my assessment of the overall impression, the marks, if not conceptually identical, are conceptually similar to a high degree.

Distinctive character of the earlier trade mark

55. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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 determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd*, 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

¹⁰ Submissions, paragraph 10.

Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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)".

56. The opponent has claimed in his statement of grounds that the earlier mark has an enhanced level of distinctive character. However, he has not filed any evidence in support of this assertion. As there is no evidence on the point, I have only the inherent position to consider. Invented words usually have the highest degree of distinctive character; words which are descriptive of the goods relied upon normally have the lowest. The earlier mark consists of a device and two dictionary words. The words are highly allusive of the services. I consider that the mark has a below average degree of inherent distinctive character.

Likelihood of confusion

57. 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 trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must

also bear in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks but relies instead upon the imperfect picture of them he has retained in his mind.

58. Confusion can be direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). Indirect confusion was explained by Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*, Case BL-O/375/10, where he stated that:

“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”).

59. The marks are visually similar to a medium degree, aurally identical and have at least a high level of conceptual similarity. The earlier mark has a lower than average degree of inherent distinctiveness. The services will be purchased with an average level of attention. In terms of the services which are only similar and not identical, the similarity is of a low degree. This matters because a low degree of similarity between services might be sufficient to counteract a higher degree of similarity between the marks. I do not consider that to be the case here. I consider that the level of similarity between the marks, as wholes, is sufficient to create a likelihood of direct confusion through imperfect recollection, both where the services are identical and where they have only a low degree of similarity. Additionally, there is a likelihood of indirect confusion in the sense that consumers who are aware of the differences between the marks may nevertheless believe that the applicant’s mark is a variant mark used by the same undertaking that uses the earlier mark.

Conclusion

60. The opposition succeeds in relation to “entertainment services for children” and “booking of seats for shows; booking of theatre tickets”, for which the application will be refused.

61. The opposition has failed in respect of the following services, for which the application will proceed to registration:

Provision of leisure facilities; provision of sports facilities; provision of sports coaching services; provision of sports club facilities; organising of sports competitions and sports events; gymnasiums, provision of health club and gymnasium services, gymnasium club services; provision of fitness and exercise facilities; exercise classes, physical fitness instruction for adults and children; provision of swimming facilities; provision of gymnastic facilities; provision of instruction in gymnastics; organising gymnastics events; tennis instruction; provision of tennis court facilities; theatre productions; production of shows; provision of theatre facilities; organising of theatre productions and shows; children's adventure playground services; provision of play facilities for children.

62. I indicated at paragraph 37 that the applicant's "entertainment services for children" covers a very wide range of services, some of which are potentially dissimilar to the services covered by the earlier mark. Given that the application is to be refused in part, paragraph 3.2.2 of Tribunal Practice Notice ("TPN") 1/2011 applies. It states:

"In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing

Officer will take that rewording into account and the proposed wording being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer will indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services".

63. This practice reflects the comments of Mann J in *Giorgio Armani SpA v Sunrich Clothing Ltd* [2010] EWHC 2939 (Ch) in relation to partial refusals of registration. He stated that:

"[...] the proper scope of registration [...] is the [potential area of dispute]. In some cases it will not be a real area of dispute because the answer is obvious - it might be possible to isolate the permissible part by blue pencilling

that which is not admissible, or it might be obvious that a plain express qualification ("save for [the goods in respect of which the opposition succeeded]") will do the trick, in which case there is no real area of dispute there either. On the other hand, it might be that the answer to that part of the case is more disputed - particular formulations might be objected to as falling on one side of the line or the other. Procedures ought to allow for all these possibilities".

64. The Tribunal's letter of 5 April 2017 invited the applicant to file a fall-back specification. No fall-back position has been offered. There is nothing in the parties' submissions to suggest that the applicant's interest lies in services which are materially different from the services covered by the earlier mark and which are not already set out in the specification applied for. In such circumstances, I do not consider it appropriate to provide the applicant with a further opportunity to consider the position.

Costs

65. As the applicant has been largely successful, it is entitled to a contribution towards its costs. Neither party filed evidence. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Considering the Notice of Opposition and filing a counterstatement:	£200
Written submissions:	£300
Total:	£500

66. I order Martin Earl to pay Your Leisure Kent Limited the sum of **£500**. 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 19TH day of June 2017

Heather Harrison

For the Registrar

The Comptroller-General