

O/456/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 155 304 FOR THE
TRADE MARK Watt.com IN THE NAME OF WATT TECHNOLOGIES LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO BY EUROSPOORT

Background and pleadings

1. Watt Technologies Limited (the applicant) applied to register the trade mark Watt.com under No 3 155 304 in the UK on 17th March 2016. It was accepted and published in the Trade Marks Journal on 8th April 2016 in respect of the following goods and services:

Class 09:

Computer hardware; Computer software; Computer peripherals;
Electronic data processing equipment; Computer networking and data communications equipment; Computer components and parts;
Electronic memory devices; Electronic control apparatus.

Class 38:

Telecommunications and broadcast communication services;
transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.

Class 41:

Teaching, education, training and entertainment services; Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line.

2. Eurosport (the opponent) partially oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The services opposed are:

Class 38:

Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks.

Class 41:

Entertainment services; production and distribution of television programs, shows and movies; provision of non-downloadable films and programs via video on demand services.

3. This is on the basis of its earlier European Union (formerly Community) trade mark WATTS under No 2 330942. The following services are relied upon in this opposition:

Class 38:

Television broadcasting by satellite or cable; broadcasting of television programmes and more generally of audio-visual and multimedia programmes, whether or not for interactive use.

Class 41:

Entertainment services; editing and publication of sound and/or visual media, of multimedia programmes; production of television programmes, audio-visual and multimedia programs, whether or not for interactive purposes; production and creation of information

programmes, and television entertainment, audiovisual and multimedia programmes, whether or not for interactive use.

4. The opponent argues that the respective services are identical or similar and that the marks are similar.
5. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier trade mark relied upon).
6. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.
7. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Evidence

Proof of use

8. The Opponent's evidence is an Affidavit from Vicky Adalbert, the Vice President Legal Counsel of the Opponent. The following information is contained therein:
 - Eurosport is a Pan-European television sports network which shows numerous sports across its network of channels.
 - One of its popular programmes is called WATTS, which airs in a number of European countries, including France, Germany and the UK. It is a programme featuring the best, worst and funniest moments in sporting events

and action. The programme was first broadcast on January 28th 2001 and continues to be shown both on television and via the internet.

- Exhibit VA1 shows selected pages from a programming schedule for the WATTS programme on the French channels Eurosport 1 and Eurosport 2 between November 2011 and November 2016. According to Ms Adalbert, this shows that WATTS has been in continuous use.
- Exhibit VA2 and VA3 is an audience sheet for WATTS programmes shown on the French Eurosport channels between November 2011-December 2013.
- Exhibit VA4 are screenshots and prints of the Eurosport French website which shows the trade mark WATTS in relation to the programme dated 2016.
- Exhibit VA5 is a list of clips dating from 2008-2016 which shows use of the trade mark WATTS. These are available in the UK from the website www.eurosport.com. Also included are pages printed from www.eurosport.co.uk/watts with descriptions in English.
- Exhibit VA6 are pages from the German site www.eurosport.de illustrating the use of WATTS in that territory between 2015-2016.
- Exhibit VA7 is an extract of the audience figures for WATTS programmes broadcast in the UK during 2011-2016.
- Exhibit VA8 provides details of total viewing figures in relation to WATTS programmes across Europe between 2011-2016. There is no breakdown according to country.

Relevant statutory provision: Section 6A:

9. "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 European Union 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 Union.

(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.”

10. Section 100 of the Act is also relevant and states that:

“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.”

11. In considering the issue of genuine use, the following is taken into account: 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 said:

“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 Bunderversvereinigung Kamaradschaft '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].”

12. The earlier trade mark is an EUTM. As such, the following is also taken into account: In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

13. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in

more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

14. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.
15. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:
 - i) The scale and frequency of the use shown
 - ii) The nature of the use shown
 - iii) The goods and services for which use has been shown
 - iv) The nature of those goods/services and the market(s) for them

iv) The geographical extent of the use shown

16. It is noted from the evidence that in respect of use, the opponent has provided details on the scale and frequency, the nature, the services, the duration and the geographical reach. There is clearly genuine use established in respect of WATTS. Having said that, it has not established use across the full range of services relied upon. In this respect, I bear in mind the following guidance: in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

17. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

18. Bearing in mind the aforementioned guidance and the evidence filed, it is considered that genuine use has been established in respect of the following:

Class 41:

Entertainment services, namely television programmes; production of television programmes, whether or not for interactive purposes; production and creation of information programmes, and television entertainment, whether or not for interactive use.

19. It is true that it has been found that there is no genuine use in respect of the Class 38 services. This is because these are in respect of broadcasting. It is considered that it is Eurosport itself that is the broadcaster and this has not occurred under the WATTS trade mark; rather this is merely the name of the television programme broadcasted by Eurosport. In respect of production and creation of programmes (which remains), it is considered that although a broadcaster will also likely produce programs, a particular program may well have its own individual creation and production team. As such, it is considered fair for these (and closely similar terms) to survive, where broadcasting does not.
20. The opposition will therefore be assessed in respect of the Class 41 services only.

DECISION

Section 5(2)(b)

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of services

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

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

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

24. I also take into account the following:

In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for*

Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court 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”.

In *Sanco SA v OHIM*, Case T-249/11, the General Court 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-0-255-13:

“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.

Comparison of Class 38:

25. The later services are: telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks.
26. In respect of the first term: telecommunications and broadcast communication services, it is considered that it includes activities such as television broadcasting. It is accepted that those involved in broadcasting particular content can also produce it. There is also a complementary relationship in that broadcasting is indispensable for the use of entertainment, namely a television programme. As such, it is considered that there is a medium degree of similarity between this and the earlier terms.
27. As regards the contested: transmission and streaming of data content via computer and global information networks, it is considered that there is an overlap with the earlier services as television programmes can be made available for access online. Indeed, this is demonstrated in the evidence where episodes of WATTS can be viewed in this manner. They are similar, to a medium degree.

Comparison of Class 41:

28. The earlier services are: entertainment services, namely production of television programmes; production of television programmes, whether or not for interactive purposes; production and creation of information programmes, and television entertainment, whether or not for interactive use.
29. The later services are: entertainment services; production and distribution of television programs, shows and movies; provision of non-downloadable films and programs via video on demand services.
30. The following term appears in both specifications and are identical: production of television programmes. Further the later production of shows is identical (shows often being used as an alternative term for programme). Production of

movies is self evidently highly similar to the earlier term. Further the distribution of television of programmes, shows and movies are likely to coincide with the earlier terms as regards end user, channels of trade and producer. They are also complementary. They are highly similar.

31. The later term is entertainment services at large. This is broader than the earlier term. However, whatever the exact subject matter or medium of the entertainment, their purpose will coincide: to entertain. As such, the later term is identical in terms of for example, television programmes and similar (to varying degrees, dependent on exact nature) in respect of other forms of entertainment.

32. The remaining later term is provision of non-downloadable films and programs via video on demand services. It is hardly a leap that those producing television programmes would also wish to make use of on demand services. Often this merely means viewing a programme at a later and/or convenient date. The purpose will coincide, namely to entertain. They are similar to a medium to high degree.

Comparison of marks

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

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their

relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

35. The respective trade marks are shown below:

WATTS	Watt.com
Earlier trade mark	Contested trade mark

36. The earlier trade mark is comprised of the sole element WATTS. The later trade mark is Watt.com. As the .com will merely refer to a website, it is considered that the distinctive and dominant component is WATT, although the .com element is not negligible within the overall impression.

37. Visually, the marks coincide in WATT and differ in the remaining features: the S and .com respectively. They are visually similar to a medium degree.

38. Aurally, the earlier trade mark is one syllable, the latter is three. However, they coincide in respect of the first part of the marks. They are similar to a medium degree.

39. Conceptually, it is possible that the earlier trade mark will be understood as a surname. However, it is probable that it will be understood as referring to the standard unit of electrical power. The same is true of the later trade mark and though the .com has some impact, it does not (crucially) have the effect of creating a conceptual gap. If watts and watt are understood as referring to a unit of power, then even with the inclusion of .com, the marks are conceptually highly similar.

Average consumer and 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 Schuhfabrik Meyer, Case C-342/97*.

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.”

42. In respect of the Class 41 services, the average consumer is likely to be the general public. The level of attention one would expect to be displayed is likely to be mixed, from a casual choice of programme on the one hand, to a more considered choice of entertainment for a particular event on the other

hand. Either way, the services are not likely to be a highly considered purchase.

43. As regards the applicant's Class 38 services, the average consumer will again include the general public. Choosing a particular broadcasting package usually involves a degree of choice dependent upon the interests/needs of the user and so one would expect a reasonable degree of attention to be displayed.

Distinctive character of the earlier trade mark

44. 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).”

45. There are no UK viewing figures in evidence. As such, it is impossible to gauge the position of WATTS in respect of the UK public. The matter must therefore be judged on a prima facie basis. The earlier trade mark has more than one potential meaning: a surname and as a unit of power. Neither is meaningful in respect of the goods or even allusive. It is distinctive to an average degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

46. 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.

47. The marks have been found to be similar to a medium degree visually and aurally and to a high degree conceptually. The level of attention displayed will not be higher than the norm and the effect of imperfect recollection must also be factored in. Further, it is considered that the meaning of WATT (and WATTS) is highly likely to provide the conceptual hook that will stick in the mind of the relevant consumer. Finally, the services are similar to at least a medium degree (with some being found to be identical). It is concluded that there is a likelihood of direct confusion.

48. In addition, it is possible that some consumers will recall the difference provided by the addition of “.com” in the contested trade mark. In this regard, the following guidance is taken into account:

In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted 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).”

49. It is considered that the scenario in these proceedings is akin to that described in b) above. That the “.com” will simply denote that this is a brand extension from the earlier trade mark. In such a circumstance, there is also a likelihood of direct confusion.

50. The partial opposition therefore succeeds entirely in respect of the contested services in Classes 38 and 41. The application may therefore proceed in respect of all the uncontested services of the application. The application proceeding to publication therefore reads as follows:

Class 09:

Computer hardware; Computer software; Computer peripherals; Electronic data processing equipment; Computer networking and data communications

equipment; Computer components and parts; Electronic memory devices; Electronic control apparatus.

Class 38:

Operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.

Class 41:

Teaching, education and training services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line.

COSTS

51. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of Opposition and Accompanying Statement plus Official Fee - £500

Filing Evidence - £500

TOTAL - £1000

52. I therefore order Watt Technologies Limited to pay Eurosport the sum of £1000. The above sum should be paid within fourteen days of the expiry of

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the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of September 2017

Louise White

For the Registrar,