

**O-080-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3188874  
BY MIMI PARTNERS LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES  
3, 14, 25, 26, 38 & 41:**

**MIMI**

**AND**

**OPPOSITION THERETO (NO. 408310) BY  
ROBERT PERCHTOLD**

## **Background and pleadings**

1. Mimi Partners Limited (“the applicant”) applied to register the trade mark **MIMI** on 3 October 2016. Although it was accepted and published in the Trade Marks Journal (on 21 October 2016) for a longer list of goods and services, only those which are relevant to these proceedings are set out below:

**Class 41:** Production of radio and television shows and programmes; film production services; education, teaching and training; entertainment services; presentation of movies; film distribution; provision of non-downloadable films and television programs via a video-on-demand service; arranging and conducting of workshops and seminars; arranging and conducting of congresses; organization of exhibitions for cultural and educational purposes; publication of electronic books and journals online.

2. Robert Perchtold (“the opponent”) opposes the registration of the mark for the above class 41 services under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of his earlier European Union (formerly Community) Trade Mark 10801058 which was filed on 12 April 2012 and registered on 1 November 2012. The mark and the services on which the opponent relies are set out below:



**Class 41:** Education, training and entertainment services; Childcare by means of education, Providing of training and entertainment promotions; coaching; Social training courses; Anti-violence training; Experiential education; Leisure education; Conflict management training; Consultancy and support during personal, family, school and professional problems by means of educational support, including educational aids, education, training and professional consultancy; Support with schoolwork; Offers provided by musical schools; Early musical education; Conducting music workshops; Conducting training courses for young offenders, including conducting individual discussions and working in small groups.

3. The opponent argues that the respective services are identical or highly similar and that the marks are similar, all of which leads to a likelihood of confusion. It is clear that the opponent's mark constitutes an earlier mark in accordance with section 6 of the Act. Furthermore, the earlier mark was registered less than five years before the date on which the applicant's mark was published with the consequence that the earlier mark is not subject to the proof of use provisions set out in section 6A of the Act.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. The applicant has represented itself during the proceedings. The opponent is represented by WP Thompson. Neither side filed evidence, although, the opponent did file written submissions (both at the evidential stage and in lieu of a hearing) which will not be summarised but will be referred to as and where appropriate in this decision. The applicant relied only on the arguments it made in its counterstatement. No hearing was requested, so this decision is taken following a careful perusal of the papers.

### **Section 5(2)(b)**

6. Section 5(2)(b) of the Act reads as follows:

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

(a)....

(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”.

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

7. The following principles are derived from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*

*Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of services**

8. Even if the services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa, as set out in *Gérard Meric v OHIM*, Case T-133/05, where the General Court (“GC”) stated:

“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”.

9. In terms of similarity, I note the guidance given by the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, Case C-39/97, where it was stated at paragraph 23 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”.

10. Further guidance was provided by Jacob J (as he was then) in *British Sugar Plc v James Robertson & sons Limited* [1996] R.P.C. 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

11. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC provided the following guidance in relation to complementary:

“It is true that goods are complementary if 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”.

12. I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE*, where he warned against applying too rigid a test:

“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*.”

13. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) explained how specifications ought to be interpreted; he stated:

“... 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.”

14. The applicant seeks registration for the following services:

Production of radio and television shows and programmes; film production services; education, teaching and training; entertainment services; presentation of movies; film distribution; provision of non-downloadable films and television programs via a video-on-demand service; arranging and conducting of workshops and seminars; arranging and conducting of congresses; organization of exhibitions for cultural and educational purposes; publication of electronic books and journals online.

15. The opponent's specification in class 41 on which he relies reads:

Education, training and entertainment services; Childcare by means of education, Providing of training and entertainment promotions; coaching; Social training courses; Anti-violence training; Experiential education; Leisure education; Conflict management training; Consultancy and support during personal, family, school and professional problems by means of educational support, including educational aids, education, training and professional consultancy; Support with schoolwork; Offers provided by musical schools; Early musical education; Conducting music workshops; Conducting training courses for young offenders, including conducting individual discussions and working in small groups.

16. In its counterstatement the applicant makes a number of submissions based on what appears to be the general focus of the earlier mark's specification, being more educational based and being aimed at the needy. In contrast to this, it says the focus of the applied for mark relates more to film and distribution thereof. The applicant makes reference to the judgment of Jacob J (as he then was) in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 as follows:

“specifications for services should be scrutinized carefully and they should not be given a wider construction covering a vast range of activities”.

however, Jacob J also went on to say that:



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

17. Notwithstanding the applicant’s arguments, I must undertake a notional assessment of the specifications based on the terms for which the marks are registered/applied. To that extent, I note, as the opponent highlights, that the earlier mark covers entertainment, training and education services at large. The fact that the other terms in the specification may be more specific does not mean that its broader terms must be similarly limited in scope. Furthermore, and as stated earlier, the earlier mark is not subject to proof of use.

18. The opponent states in his written submissions that because his specification in class 41 covers entertainment services, and, also, education and training services, some of the applied for services are identical, namely:

i) Education, teaching and training;

ii) Entertainment services;

iii) Arranging and conducting of workshops and seminars; arranging and conducting of congresses.

19. The opponent’s submission is clearly correct in relation to terms i) and ii) given the identical terminology used. In relation to term iii), I accept that these services can be (and often are) for education purposes and, as such, fall within the ambit of the opponent’s specification and are identical on the *Merit* principle. If they are not identical, they must be highly similar at least on a complementary level. That complementarity is also applicable in relation to “[o]rganization of exhibitions for cultural and educational purposes”. Whilst identity has not been claimed, the fact that the exhibitions could be for cultural purposes (which could cover cultural activities for entertainment and education) and for education specifically, there is a clear overlap, at least on a complementary basis, and a shared end purpose, to the entertainment and/or educational services of the earlier mark.

20. That then leaves a number of other terms in the applied for mark for which the opponent claims similarity:

Presentation of movies; provision of non-downloadable films and television programs via a video-on-demand service

21. I think it could have been argued that the services are identical (to entertainment) on the *Merit* principle. However, the opponent has claimed only similarity. The services are, in my view, highly similar, as the end purpose is related to film based entertainment and one may be used to obtain or facilitate the other, so creating a complementary relationship.

Film distribution; Production of radio and television shows and programmes; film production services

22. Whilst I agree with the opponent's position that these services are not identical to those of the earlier mark, I still consider, in line with the opponent's submission, that they are similar to the opponent's entertainment services to the extent that there is a complementary relationship between them. This is because the services are closely allied and are clearly important or indispensable for each other, and the nature of the relationship is one where the consumer would understand all of them to be under the control of a single entity. I consider there to be a medium degree of similarity.

Publication of electronic books and journals online.

23. I regard such services as clearly aligned to educational services providing a complementary relationship, one where the consumer would expect the same undertaking to be responsible for both. The publication of the book/journal could also be to educate or inform, so creating a similarity of purpose. I consider there to be a medium degree of similarity.

## **Average consumer and the purchasing act**

24. 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 services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

25. 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.”

26. First, in terms of the various entertainment services, I believe these to be everyday services selected by members of the general public. The average consumer could access or obtain various forms of entertainment from service providers via websites and entertainment outlets. They may also encounter the marks of relevant service providers in magazines, brochures, leaflets etc. The level of attention is likely to be average. Although I consider the selection of these services to be more of a visual act, the aural impact of the marks is still an important factor in the overall assessment. In terms of the more specialist production/distribution type services, this is more likely to be a service used by a business user as opposed to a member of the general public, applying a slightly higher level of care.

27. The choice of an educational service would normally, in my view, necessitate a slightly higher than average level of attention. The average consumer would be looking for a particular area of study/topic/qualification. The services could be accessed not


only by members of the public, but also by business users. These kinds of services are likely to be found using local and educational authorities, brochures, personal recommendations, websites and specialised educational providers. I again consider that the visual impact of the marks has slightly more importance, but the aural impact is not to be ignored. I think all of this applies in equal measure to the various exhibition type services and, also, the publication services.

### **Comparison of marks**

28. 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 CJ EU 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.”

29. 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. The respective trade marks are shown below:

	<p style="text-align: center;"><b>MIMI</b></p>
<p style="text-align: center;"><b>Earlier trade mark</b></p>	<p style="text-align: center;"><b>Contested trade mark</b></p>

30. The mark applied for is “MIMI”, a word only mark presented in block capital letters that does not contain any figurative elements or stylised components. The whole word “MIMI” is the only thing which contributes to its overall impression.

31. The opponent’s mark contains a number of elements. Notwithstanding the applicant’s submission that the earlier mark could be interpreted as ‘MiM’, I consider that the main verbal element consists of what I believe consumers will see as the word “MiMi”. Whilst it is stylised and forms part of an overall figurative element, the word itself is easily discernible and is the part of the mark which, in my view, has greatest relative weight. The words “kinder-und Seniorenstiftung” appear below this and are presented in much smaller font which reduces their impact. Although these words cannot be ignored, they have least weight in the overall impression. The figurative element (which is flower-like) and stylisation creates a particular visual impact which plays a reasonably important role in the mark.

32. Visually, the fact that the competing marks contain the letters MIMI/MiMi provide some similarity. However, there are some visual differences. The way in which the earlier mark is stylised creates a visual difference. The applicant also highlights the decorative “heart shaped balloon” (which to me looks like a flower), which, again, creates a further difference. Finally, there is the strapline in the German language presented beneath the word “MiMi” in the earlier mark. The applicant submits that all of this creates an impression that is not reproduced in its mark. Whilst this point is noted, the task is to assess similarity. Weighing the similarities and differences between the marks, and bearing in mind their overall impressions, I consider there to be a moderate (between low and medium) level of visual similarity.

33. Aurally, the earlier mark will be articulated as MEE-MEE (or close variations thereof), as it is unlikely that the average UK consumer would verbalise the German words that play only a minor role in the mark. The applied for mark will be articulated in the same way, meaning that the marks are aurally identical. Even if the strapline were to be articulated, given that this element carries less weight in the overall impression of the mark, there would still be a reasonably high degree of aural similarity.

34. Conceptually, both marks share the word “MIMI”, with both the applicant and the opponent agreeing that this will be seen as a girl’s name. Whilst there may be some consumers who would not know this, the fact that both parties assert the same meaning, I am content that this is how the average consumer will evaluate it. The applicant points to the strapline, however, given that it is in German and that it only plays a minor role in the mark, I do not consider that this contributes to the conceptual meaning of the mark. Therefore, I am of the opinion that the element MIMI/MiMi in both marks creates a high degree of conceptual similarity.

### **Distinctive character of the earlier trade mark**

35. The degree of distinctive character the earlier mark possesses must be assessed. A greater likelihood of confusion is said to exist if there is a high degree of distinctiveness shown in the inherent qualities of the mark or as a result of the use that has been made of it. 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).”

36. I can only consider the inherent distinctiveness of the earlier mark as the opponent has not filed any evidence. The other elements of the earlier mark beyond “MiMi” may add to its distinctiveness, however, this does not assist the opponent because it is the distinctiveness of the common element that is the vital aspect to consider<sup>1</sup>.

37. In terms of the word MiMi, this, as stated earlier, will be perceived as a female forename. Names are not generally considered the most distinctive of trade marks, however, the name does not strike me as a common one and I believe it has a medium level of distinctiveness.

### **Likelihood of Confusion**

38. In order to determine if a likelihood of confusion exists, it is necessary to make a global assessment by considering all the relevant factors. Some of the services are identical. As the opponent points out in his submissions, this has the capacity to counteract a lesser degree of similarity between the marks. I acknowledge that a slightly higher level of attention may be afforded to some of the identical services (educational/production services for example), however, the mark still shares the dominant component MIMI/MiMi and this is the element that would remain in the minds of the consumer. This resonance (notwithstanding the more visual significance of

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<sup>1</sup> See, for example, the decision of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

marks in this area), may result in the get-up of the earlier mark being overlooked and forgotten through the effects of imperfect recollection. This leads, in my view, to a finding of direct confusion between the competing marks in relation to the identical services I am considering. In relation to the non-identical services, I come to the same view, for similar reasons. The relationship between the similar services is not such that the consumer would no longer be confused.

39. I accept that the decision on direct confusion is an evenly balanced one. However, irrespective of the above, and even if there was no direct confusion (because the average consumer more precisely recalls the marks and appreciates that one has additional figurative and stylistic elements not shared by the other), there is still indirect confusion to consider. This was explained by Mr Iain Purvis Q.C. (as the Appointer Person) in *L.A. Sugar Limited v By Back Beat Inc* (BL O/375/10) where he stated:

“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).”

40. I note the submission by the applicant that the “respective marks are entirely different” and that the visual differences contained “would not go unnoticed by the relevant consumer.” However, whilst this may avoid direct confusion, it does not follow that this avoids indirect confusion. In my view, the common element MIMI/MiMi, bearing in mind its level of distinctiveness, will still indicate to the average consumer that the services (both identical and similar) are the responsibility of the same or economically linked undertaking. **Therefore, even if there is no direct confusion, there is a likelihood of indirect confusion. The opposition succeeds.**

### **Conclusion**

41. Subject to appeal, the application is refused registration in respect of the class 41 services. This decision has no bearing on the other applied for goods and services.

### **Costs**

42 The opponent has succeeded and is entitled to a contribution towards his costs. My assessment, based on the published scale, is as follows:

*Official fee - £100*

*Preparing a statement and considering the other side’s statement - £300*

*Two sets of written submissions - £600*

43. I therefore order Mimi Partners Limited to pay Robert Perchtold the sum of £1000. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 2<sup>nd</sup> day of February 2018**

**Oliver Morris**

**For the Registrar,**

**The comptroller general**