

**O-098-18**

**INTERIM DECISION**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3177884 BY  
RANDOLPH LTD  
TO REGISTER:**

**campus elysium**

**AS A TRADE MARK IN CLASSES 16, 35, 41 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 408318 BY ELYSIUM LEISURE LIMITED**

## **BACKGROUND & PLEADINGS**

1. On 2 August 2016, Randolph Ltd (“the applicant”) applied to register the trade mark **campus elysium** for the goods and services shown in paragraph 10 below. The application was published for opposition purposes on 21 October 2016.

2. On 20 January 2017, the application was opposed in full by Elysium Leisure Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon United Kingdom trade mark registration no. 3021920 for the trade mark **ELYSIUM**, which was applied for on 13 September 2013 and registered on 10 January 2014. The opponent indicates that it relies upon all the goods and services in its registration, shown in paragraph 10 below.

3. The applicant filed a counterstatement which consists, in essence, of a denial of the ground upon which the opposition is based. The counterstatement contains a number of comments which I will, where necessary, deal with at the appropriate point in this decision.

4. In these proceedings, the opponent is represented by Sanderson & Co; the applicant represents itself. Although neither party filed evidence, both filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the opponent elected to file written submission in lieu of attendance at a hearing. I shall refer to these submissions, as necessary, later in this decision.

## **DECISION**

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

6. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

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

7. In these proceedings, the opponent is relying upon the United Kingdom trade mark registration shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. In its counterstatement, the applicant states:

“...there’s no evidence provided by [the opponent] to suggest that they have any services or products branded as “Elysium” ...We place it upon [the opponent] to prove that they have products or goods or services branded as “Elysium”, and that customers have mistakenly purchased our products when they have intended to purchase a product from [the opponent]”.

8. As the opponent's earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act. That being the case, even if the applicant is correct, it does not matter that the opponent has not yet used its trade mark upon or in relation to the goods and services for which it is registered and upon which it relies. The opponent can, nonetheless, rely upon its earlier trade mark in relation to all the goods and services for which it stands registered without having to prove it has made genuine use of it upon or in relation to such goods and services.

### **Section 5(2)(b) – case law**

9. The following principles are gleaned from the decisions of the courts of the European Union 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

### Comparison of goods and services

10. The competing goods and services are as follows:

Opponent	Applicant
<p><b>Class 9</b> - Audio, music and video recordings; downloadable audio, music and video recordings.</p> <p><b>Class 25</b> - Clothing for men, women and children; footwear and headgear.</p> <p><b>Class 35</b> - Public relations services; advertising, marketing and promotional services.</p> <p><b>Class 37</b> - Construction, maintenance and repair services.</p> <p><b>Class 38</b> - Telecommunication services; Internet access services.</p> <p><b>Class 41</b> - Educational and training services; IT and computer training services; studio services for music and the visual arts; production of audio and music recordings, and recordings of the visual arts; music publishing and recording</p>	<p><b>Class 16</b> - Paper and cardboard; Printed matter; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paintbrushes; Typewriters and office requisites [except furniture]; Instructional and teaching material [except apparatus]; Plastic materials for packaging; Printers' type; Printing blocks.</p> <p><b>Class 35</b> - Advertising; Business management; Business administration; Office functions.</p> <p><b>Class 41</b> - Education; Providing of training; Entertainment; Sporting and cultural activities.</p> <p><b>Class 42</b> - Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of</p>

<p>services; nightclub and entertainment services.</p> <p><b>Class 42</b> - IT and computer services; software development, programming and implementation; IT and computer consultancy and advisory services; Internet café services.</p> <p><b>Class 43</b> - Provision of food and drink; bar, cafeteria and restaurant services; hotel services; booking of hotel accommodation.</p>	<p>computer hardware and software.</p>
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### The correct approach to the comparison

11. In its counterstatement, the applicant stated:

“Finally, the two businesses operate in completely different business environments, and the possibility of confusion between the two “brands” is highly irrelevant...”

12. This is not a point which assists the applicant for the reasons explained by the Court of Justice of the European Union (“CJEU”) in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, in which the Court stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

13. As I explained earlier, it is not necessary for the opponent to have made genuine use of its earlier trade mark. In those circumstances, what I must do in approaching the comparison is compare the words as they appear in the competing specifications in light of the guidance provided in the case law which appears below.

14. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court 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”.

15. 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 enquiry 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.



16. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) 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."

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

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

18. 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 ("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”.

19. 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-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.”

20. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more

general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated:

“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.”

22. In its submissions filed during the evidence rounds, the opponent states that the goods and services in the application are “identical to or similar to those of [its] registration” and it provides a table of what it describes as “A non-exhaustive comparison of goods and services” (paragraph 13). It further states that where the goods/services are not identical, “the relevant consumers, channels of trade, purpose and nature are such that there is varying degrees of similarity” (paragraph 14). In its submissions filed in lieu of a hearing, it refers to “the fact that the goods/services could be competitive and/or complementary and that they might be used and purchased alongside each other...” (paragraph 5).

23. Returning to the table mentioned above, the opponent has listed the applicant’s goods and services and indicated what it considers to be “Examples of identical terms in prior mark” and “Examples of similar terms in prior mark.” Although I note that the opponent describes these examples as “non-exhaustive”, I think it is not unreasonable for me to proceed on the basis that having conducted an analysis, the opponent considers the examples it has provided to represent its best case. I shall proceed on

that basis and will, for the sake of convenience, deal with the matter on a class-by-class basis.

## **Class 16**

24. I begin by noting that the opponent's table makes no mention of the following goods in the application:

Bookbinding material; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paintbrushes; Typewriters and office requisites [except furniture]; Plastic materials for packaging; Printers' type; Printing blocks.

25. That, I assume, is because having applied the relevant case law, the opponent, like me, was unable to identify any similarity between these goods and any of its goods and services. That leaves the following goods in this class to consider:

Paper and cardboard; Printed matter; photographs; Instructional and teaching material [except apparatus].

26. In relation to "Paper and cardboard; Printed matter; photographs" the opponent identifies "advertising, marketing and promotional services" in class 35 of its registration as being similar. Other than the very general comments mentioned earlier, the opponent does not specifically explain why it considers that to be the case. Although the users of the competing goods and services may be the same, that level of generality tells one very little. While the nature of a good is, of course, different to the provision of a service, goods and services may have similarities in terms of, inter alia, their intended purpose and they may be in competition with, or complementary to, one another. Having applied the relevant case law, I am unable to detect any competitive relationship between the services the opponent identifies and the applicant's goods. While the opponent may utilise the applicant's goods in the provision of its services, as the case law explains, the purpose of examining whether there is a complementary relationship between goods

and services is, inter alia, to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. I think it most unlikely that a consumer would assume that a provider of the opponent's services would also conduct a trade in the applicant's goods. In short, absent a precise indication of why the opponent considers such goods and services to be similar, having applied the relevant case law, I am unable to identify any meaningful degree of similarity between the opponent's goods and services and the applicant's "Paper and cardboard" and "photographs". I shall return to the applicant's "printed matter" in a moment.

27. The applicant's specification also includes "Instructional and teaching material [except apparatus]". In relation to this term, the opponent identifies its "Educational and training services" in class 41 as being similar. The fact that the same average consumer may elect to either attend an educational class or study at home from written materials, results in similarity in the users and intended purpose of the goods and services at issue; there is also a competitive relationship in play. In addition, as the consumer will be familiar with the fact that those providing educational services also provide written materials to support such services, it results in a complementarity relationship between such goods and services. In my view, the examples I have provided result in a medium degree of similarity between the goods and services at issue.

28. Returning to "printed matter", this is a broad term which would include printed matter for educational purposes. It would, as a consequence, also be similar to the opponent's "Educational and training services" in class 41 to a medium degree. I shall return to this point when I consider the likelihood of confusion.

29. Before I consider the applicant's services, I remind myself of the comments of Jacob J in *Avnet* i.e. as to how I should approach specifications of services (para. 21 above refers).

## **Class 35**

30. The term “advertising” appears in both parties’ specifications and is identical. In relation to the applicant’s “Business management; Business administration; Office functions”, the opponent identifies all its services in class 35 i.e. “Public relations services; advertising, marketing and promotional services” as being similar. While the dividing line between exactly what services fall within the definition of “business management” and “business administration” are, in my view, very difficult to identify, the average consumer is most likely, in my view, to approach these terms in, broadly speaking, the following way: “Business administration services” will be performed to organise and run a business, whereas “Business management services” are aimed at setting the common goals and the strategic plan for a commercial enterprise. Finally, “Office functions” services are aimed at performing day-to-day operations that are required by a business to achieve its commercial purpose.

31. In my view, the terms “Business management” and “Business administration” in the application are so broad and nebulous in nature as to include the opponent’s “public relation services” and “marketing and promotional services” and are, as a consequence, to be regarded as identical on the *Meric* principle. However, if bearing in mind the guidance in *Avnet* that is regarded as too liberal an interpretation of the those terms, as a professional undertaking which provides business management and business administration services is also, in my view, likely to provide advice on public relations, advertising, marketing and promotion (perhaps as a part of a suite of services), the competing services are to be regarded as complementary in nature as the average consumer is likely to assume that these services originate from the same professional undertaking, resulting, in my view, in a medium degree of similarity between them.

32. That leaves “office functions” in the application to consider. Approaching this term on the basis indicated above with the guidance in *Avnet* in mind, I do not consider there to be any meaningful degree of similarity between these services and any of the opponent’s goods and services.

## **Class 41**

33. The opponent's specification in this class includes "Educational and training services" and "nightclub and entertainment services" which are identical to the applicant's "Education", "Providing of training" and "Entertainment" services respectively. The final phrase in the applicant's specification is "Sporting and cultural activities". In relation to these terms, the opponent regards its "production of audio and music recordings, and recordings of the visual arts" in class 41 to be identical and its "studio services for music and the visual arts" in class 41 and its "music and video recordings" in class 9 to be similar. However, as both "sporting" and "cultural" activities may also constitute entertainment, such services are, in my view, encompassed by the term "entertainment" in the opponent's specification and are, as a consequence, to be regarded as identical on the *Meric* principle.

## **Class 42**

34. The opponent states that with the exception of its "Internet café services", the remainder of its services in class 42 are identical to (i) "Design and development of computer hardware and software" in the application and similar to the remaining services in the application i.e. (ii) "Scientific and technological services and research and design relating thereto; Industrial analysis and research services". In my view, "IT and computer services" in the opponent's specification is broad enough to include the services in category (i) which are, as a consequence, to be regarded as identical on the *Meric* principle. The services in category (ii) are also very broad and would include such services conducted in relation to information technology, computing, software development, programming and implementation (i.e. in the opponent's specification). Although the precise nature of the competing services may differ, as they may, inter alia, have a similar intended purpose and be provided to the same consumers, I agree with the opponent that as matters stand, the competing services are similar and, in my view, to at least a low degree. I will return to this point later in this decision.

35. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

36. Where there is no similarity in the competing goods and services there can be no likelihood of confusion. In view of my findings above, the opposition to the following goods and services fails and is dismissed accordingly:

**Class 16** - Paper and cardboard; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paintbrushes; Typewriters and office requisites [except furniture]; Plastic materials for packaging; Printers' type; Printing blocks.

**Class 35** - Office functions.

### **The average consumer and the nature of the purchasing act**

37. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods and services I have found to be either identical or similar. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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.”

## **Class 16**

38. The average consumer of those goods in this class I have found to be similar i.e. “Printed matter” and “Instructional and teaching material [except apparatus]”, is a member of the general public selecting on their own behalf or a business user selecting on behalf of a commercial undertaking. As to how such goods will be selected, whilst not discounting aural considerations (perhaps in the form of oral requests to sales assistants both in person and by telephone), my own experience suggests that they will, for the most part, be self-selected from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue: I see no reason why a business user would not select the goods in much the same way, with intermediaries such as wholesalers also likely to feature in the process. The cost of the goods and the degree of care the consumer will display when selecting such goods is likely to vary considerably. Compare, for example, the selection by a member of the general public of an inexpensive note book (and what is likely to be the relatively low degree of care that will be paid to its selection), with the not insignificant cost of a legal textbook and, given the importance of such a textbook to the future success of its recipient, the above average degree of attention that will be paid by the same average consumer to its selection. When considered from the perspective of a business user buying on a commercial basis, where, for example, larger sums may be in play, I would expect an above average degree of attention to be paid during the selection process.

### **Class 35**

39. Although the average consumer of those services I have found to be either identical or similar i.e. “Advertising; Business management; Business administration” may be a member of the general public, it is, in my view, much more likely to be a business user. Absent evidence to assist me, I would expect such a consumer to select such services having inspected, for example, trade publications and promotional material (in hard copy and on-line) and by consulting colleagues and business contacts for guidance. While there is likely to be an aural component to the selection process, I would still expect visual considerations to dominate. As to the degree of care with which such services may be selected, given the obvious importance of such services to the well-being of any commercial undertaking (whether to maintain or improve its market position), and as not insignificant sums may be in play and contracts for such services negotiated over a period of time, the average consumer is, in my view, likely to pay a fairly high degree of attention when selecting them.

### **Class 41**

40. The average consumer of all the services in this class is either a member of the general public or a business user. Such services are, in my experience, likely to be selected by both consumer groups from visual media (such as prospectuses, promotional material and websites), by telephone, word-of-mouth recommendations from family and colleagues and from advertisements on, for example, radio. As before, while aural considerations will feature in the process, visual considerations are, in my view, likely to be the more significant mode of selection. The degree of care paid during the selection process will, once again, vary. Contrast, for example, the average degree of care a member of the general public may display when deciding whether to attend a local live performance based on a flyer it had received, to the high degree of attention that is likely to be paid by the same consumer to the selection of an educational establishment (such as a university) or to a business user wishing to engage a training provider for its staff.

## **Class 42**

41. Given the technical nature of the services at issue, the average consumer is, in my view, much more likely to be a business user than a member of the general public. Absent evidence to assist me, I would expect such a consumer to approach the selection of the technical services at issue in much the same way as the services in class 35 paying, at least, a fairly high degree of attention during that process.

### **Comparison of trade marks**

42. 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 them, 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.”

43. 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 they create. The trade marks to be compared are:

<b>Opponent's trade mark</b>	<b>Applicant's trade mark</b>
ELYSIUM	campus elysium

44. As the opponent's trade mark consists exclusively of the word ELYSIUM presented in block capital letters, that is the overall impression it will convey and where its distinctiveness lies.

45. The applicant's trade mark consists of two words presented in lower case. My conclusion that the first word and its meaning i.e. "the grounds and buildings of a university" (collinsdictionary.com) will be well-known to the average consumer is unlikely to be controversial. The two words combine to create a unit in which both words will, for the most part, make a roughly equal contribution to the overall impression the trade mark conveys. However, given the well-known meaning of the word "campus" and its relevance to, in particular, educational goods and services, it is, in those circumstances, the word "elysium" which is likely to make the greater contribution to the overall impression the trade mark conveys.

46. As to the second word, absent evidence to assist me, I think the average consumer's approach to this word is likely to fall into a number of categories i.e. some will be familiar with the word and its meaning i.e. from Greek mythology "the dwelling place of the blessed after death" (collinsdictionary.com), some will be familiar with the word but not its meaning and others will be completely unfamiliar with the word.

47. As to the distinctiveness of the two words, even if the average consumer is familiar with the word "elysium" and its meaning, as it is neither descriptive of nor non-distinctive for any of the goods and services for which the applicant seeks registration, it is distinctive. As I mentioned above, given the well-known meaning of the word "campus" in relation to educational goods and services, in relation to such goods and services it is the word "elysium" which is likely to make by far the greater contribution to the trade mark's distinctive character. However, in relation to those goods and services which do not relate to education, both words will make a roughly equal contribution to the trade mark's distinctive character.

48. I will now compare the competing trade marks from the visual, aural and conceptual standpoints. The competing trade marks are seven and thirteen letters long respectively; the last seven letters are identical. The word ELYSIUM/elysium constitutes the entirety of the opponent's trade mark and the second part of the applicant's trade mark. The first word in the applicant's trade mark is, however, completely alien to the opponent's trade mark. Bearing in mind the similarities and differences, and reminding myself that as a general rule the beginnings of trade marks tend to have more visual and aural impact than their endings (*El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02), I find the competing trade marks to be visually similar to a medium degree.

49. As to the aural comparison, the opponent's trade mark will be articulated as the four syllable word E-LY-SI-UM whereas the applicant's trade mark will be verbalised as the six syllable combination cam-pus e-ly-si-um. Although the first two syllables differ, as the final four syllables will be articulated in an identical fashion, it results in a medium degree of aural similarity.

50. Finally, the conceptual comparison. If the average consumer is familiar with the word ELYSIUM/elysium and its meaning (and, in my view, a not insignificant number of average consumers will), the conceptual message conveyed by that word will be identical. If the average consumer is unfamiliar with the word and/or its meaning, the conceptual position in relation to that word will be neutral. In its Notice of Opposition, the opponent stated:

“6...As the word “campus” has no bearing on the meaning of the word ELYSIUM it does nothing to create a conceptual difference. If CAMPUS is perceived it will likely only be thought of as a potential geographical indication (e.g. at a university) where ELYSIUM goods or services may be obtained.”

51. If the average consumer is familiar with the word “elysium” and its meaning, I agree the word “campus” does nothing to modify the meaning of the word. However, irrespective of whether the average consumer is aware of the meaning of the word

“elysium”, the addition of the word “campus” creates a unit which introduces an additional concept i.e. of a specific campus named elysium.

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

52. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In 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 goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

53. As the opponent has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In its submissions filed in lieu of a hearing, the opponent argues that its earlier trade mark “has strong inherent distinctive character” (paragraph 6). I have already commented upon the meaning of the word ELYSIUM above. Even if I assume the average consumer is familiar with the word, it is, as I have already explained, neither descriptive of nor non-distinctive for the goods and services for which the opponent’s trade mark is registered. It is, as a consequence, a trade mark possessed of a fairly high degree of inherent distinctive character. If the average consumer is unfamiliar with the word and its meaning and treats it as an invented word, the degree of inherent distinctive character is even higher.

## Likelihood of confusion

54. 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 goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

55. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C591/12P, on the court's earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive

significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

56. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

57. Having found no similarity in relation to some of the applicant’s goods and services, I went on to categorise the remaining goods and services in the application as either identical or similar to at least a low degree. I further concluded that there was a medium degree of visual and aural similarity between the competing trade marks and for what is likely to be a not insignificant number of average consumers, an identical conceptual message conveyed by the word ELYSIUM (which, although part of a unit, has a meaning that is not altered by the presence of the word “campus” in the applicant’s



trade mark). Those conclusions, when combined with the at least fairly high degree of distinctive character the opponent's earlier trade mark enjoys is, in my view, likely to result in an average consumer paying even a high degree of attention during the selection process (but who is still prone to the effects of imperfect recollection) to mistake one trade mark for the other i.e. there is a likelihood of direct confusion. That conclusion is even stronger in relation to, inter alia, goods and services relating to education, in relation to which the word "elysium" is likely to make the greater contribution both to the overall impression conveyed and the trade mark's distinctive character.

58. However, even if I am found to be wrong in that regard, the similarity between the competing trade marks and the degree of distinctive character the word "elysium" possesses, is still likely, in my view, to lead the same average consumer mentioned above to conclude that the identical and similar goods and services at issue come from the same or related undertakings i.e. there is a likelihood of indirect confusion.

59. For the avoidance of doubt, in reaching the above conclusions, the correspondence between the parties (attached to the applicant's counterstatement) and which the opponent indicates was "entered into without prejudice" has played no part in my deliberations. Similarly, although the opponent has addressed the points below in its submissions, I should also make it clear that the applicant's comments regarding: (i) the nature of the opponent's business and its company name i.e. Elysium Leisure Limited, (ii) the names of the opponent's venues, (iii) its claimed use of its own trade mark (since November 2013), (iv) the fact that it owns the company name Campus Elysium Ltd, (v), that other companies have the word ELYSIUM in their title and (vi) the applicant's view on why the opposition was lodged, are not relevant to the matters before me and have also played no part in my considerations. Finally, as I mentioned earlier, the applicant states:

"We place it upon [the opponent] to prove that they have products or goods and services branded as "Elysium", and that customers have mistakenly purchased

[the applicant's] products when they have intended to purchase a product from [the opponent].”

60. As I have explained, it is not necessary for the opponent to have used its earlier trade mark for it to be able to rely upon it in these proceedings. Assuming it has not, it would not be possible for it to provide the type of evidence the applicant seeks. However, even if the opponent had used the trade mark upon which it relies, the absence of confusion is rarely conclusive for the reasons explained below. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

61. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

## **Conclusion in relation to the specifications as filed**

62. The opposition to the following goods and services fails and is dismissed accordingly:

**Class 16** - Paper and cardboard; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paintbrushes; Typewriters and office requisites [except furniture]; Plastic materials for packaging; Printers' type; Printing blocks.

**Class 35** - Office functions.

63. The opposition against the following goods and services succeeds regardless:

**Class 16** - Instructional and teaching material [except apparatus].

**Class 35** - Advertising; Business management; Business administration.

**Class 41** - Education; Providing of training; Entertainment; Sporting and cultural activities.

**Class 42** - Design and development of computer hardware and software.

64. As matters stand, the application also succeeds in relation to "printed matter" in class 16 and "Scientific and technological services and research and design relating thereto; Industrial analysis and research services" in class 42. If, however, the applicant were to offer a revised specification which positively limited its printed matter in class 16 to goods which one would not regard as being educational in nature (scrapbooks for example) and its services in class 42 to a purpose completely unrelated to the opponent's services in class 42, it may be possible for the application to proceed to registration for limited specifications in these classes.

**Next steps**

65. With the above in mind, the applicant is allowed 14 days from the date of this interim decision to offer revised specifications in classes 16 and 42. Any such revised specifications offered should be copied to the opponent who will then be allowed a period of 14 days from the date that it receives a copy of the revised specifications to provide comments. At the conclusion of that period, I will review any submissions the parties may make and issue a supplementary decision, in which I will deal with costs and set the period for appeal.

**Dated this 14<sup>th</sup> day of February 2018**

**C J BOWEN**

**For the Registrar**