

O/791/18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003307495  
BY BOB GROUP LTD  
TO REGISTER THE FOLLOWING TRADE MARK:

**BoB**

IN CLASSES 35, 36 AND 41

AND

IN THE MATTER OF APPLICATION NO. UK00003312494  
ALSO BY BOB GROUP LTD  
TO REGISTER THE FOLLOWING TRADE MARK:

**BoB School**

AS A TRADE MARK IN CLASS 41

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO  
UNDER NO. 600000932 AND NO. 600000946 BY  
BRITISH UNIVERSITIES FILM & VIDEO COUNCIL

## **BACKGROUND AND PLEADINGS**

1. On 30 April 2018, Bob Group Ltd (“the applicant”) applied to register the mark **BoB** (“the Applicant’s First Mark”) in the UK. The application was published for opposition purposes on 18 May 2018. The applicant seeks to register the mark for the following services:

Class 35      The provision of business advisory and consultancy services.

Class 36      The provision of business investment services.

Class 41      The provision of business education and training services.

2. On 22 May 2018, the applicant applied to register the mark **BoB School** (“the Applicant’s Second Mark”) in the UK. The application was published for opposition purposes on 15 June 2018. The applicant seeks to register the mark for the following services:

Class 41      The provision of business education and training services.

3. The applications were opposed under the fast track opposition procedure by British Universities Film & Video Council (“the opponent”). The oppositions are based upon section 5(2)(a) of the Trade Marks Act 1994 (“the Act”).

4. The opposition against the Applicant’s First Mark is directed at the applicant’s class 41 services only. The opponent relies on its earlier UK Trade Mark No. 3109545 for the mark **BoB** (“the First Earlier Mark”). The First Earlier Mark was filed on 20 May 2015 and was registered on 28 August 2015. The opponent relies on the following services:

Class 38      Broadcasting of radio and television programmes but not including music programmes, music radio programmes and music TV programmes; Streaming of audio material on the Internet but not including streaming

of music; Streaming of video material on the Internet but not including streaming of music video material.

5. Although the opponent has stated in its Notice of Opposition that its opposition against the Applicant's Second Mark is directed against the applicant's "the provision of business education and training services" only, these are the only services covered by the Applicant's Second Mark. The application is, therefore, opposed in full. The opponent relies on its earlier UK Trade Mark No. 3052585 for the mark **BoB for Schools** ("the Second Earlier Mark"). The Second Earlier Mark was filed on 23 April 2014 and was registered on 14 November 2014. The opponent relies on the following services:

Class 38      Broadcasting of radio and television programmes; Streaming of audio material on the internet; Streaming of video material on the internet.

6. The opponent submits that the respective services are similar and that the marks are identical.

7. The applicant filed counterstatements denying the claims made.

8. The proceedings were consolidated. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

"The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

9. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

10. The applicant is represented by V Law Limited trading as Valemus Law and the opponent is unrepresented. Rule 62(5) (as amended) states that arguments in fast

track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate costs; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; only the applicant filed written submissions in lieu.

## **DECISION**

11. Section 5(2)(a) of the Act reads as follows:

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

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

(b) [...]

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

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or 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.”

13. The trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As these trade marks had not completed their registration process more than 5 years before the publication date of the applications in issue in these proceedings, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

### **Comparison of the marks**

14. It is a prerequisite of section 5(2)(a) of the Act that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

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

15. Both the Applicant’s First Mark and the First Earlier Mark are **BoB**. These marks are plainly identical. The Applicant’s Second Mark is **BoB School** and the Second Earlier Mark is **BoB for Schools**. There is an additional word in the Second Earlier Mark which creates a conceptual difference as the Applicant’s Second Mark creates the impression of a school called BoB, whereas the Second Earlier Mark is something called BoB which is intended for Schools. This is not a difference that is likely to go unnoticed by the average consumer. I do not, therefore, consider these marks to be identical. The opposition against the Applicant’s Second Mark will, therefore, fall at the first hurdle.

### **Comparison of services**

16. The competing services in respect of the Applicant’s First Mark and the First Earlier Mark are as follows:

The Opponent's Services	The Applicant's Services
<p><u>Class 38</u></p> <p>Broadcasting of radio and television programmes but not including music programmes, music radio programmes and music TV programmes; Streaming of audio material on the Internet but not including streaming of music; Streaming of video material on the Internet but not including streaming of music video material.</p>	<p><u>Class 41</u></p> <p>The provision of business education and training services.</p>

18. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, 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.”

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

- (a) The respective 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.

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

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

“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.”

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

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. 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 the responsibility for those goods lies with the same undertaking.”

24. 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.”

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

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

27. In its Notices of Opposition, the opponent states:

“The provision to the education community of streaming audio and video under the BoB brand has been associated exclusively with the services of the British Universities Film & Video Council for over a decade.”

28. In its Counterstatements, the applicant denies that there is any similarity between the parties’ services. The applicant reiterated this view in its written submissions.

29. The fact that the opponent provides audio and video streaming services to the education community specifically is not apparent from its specification. In any event, the provision of education and training services is ultimately different from broadcasting and streaming services. Broadcasting and streaming services in class

38 are technical telecommunications services. The provision of education and training services in class 41 involves services which develop people's skills and help them to learn. The intended purposes of the services are entirely different. The users will also be different. The users of educational services will be members of the general public looking to gain knowledge in a particular area or perhaps businesses that want to train their staff on a particular topic. The users of broadcasting and streaming services will be those involved in the production of material capable of being streamed or broadcast, such as television studios or radio stations. Even in the case of broadcasting and streaming services targeted at the education sector, where the users may include education providers, the users will still differ. I do not consider that there is any overlap in the trade channels for the services at issue and there is no complementary or competitive relationship between them. Without the benefit of any substantive submissions to assist me, I am not satisfied that there is any similarity between the services at issue.

30. As some degree of similarity is required for there to be a likelihood of confusion<sup>1</sup>, the opposition against the Applicant's First Mark must fail. The same points apply to the comparison of the services for which the Second Earlier Mark and the Applicant's Second Mark are registered/applied for. Consequently, even if I am wrong in my finding that the Applicant's Second Mark and the Second Earlier Mark are not identical, the opposition against the Applicant's Second Mark will still fail.

## **CONCLUSION**

31. The oppositions are unsuccessful and the applications will proceed to registration.

## **COSTS**

32. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Using that TPN as a guide, I award costs to the applicant on the following basis:

---

<sup>1</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Preparing a consolidated counterstatement and considering the opponent's statements	£200
--	------

Filing written submissions	£150
----------------------------	------

<b>TOTAL</b>	<b>£350</b>
--------------	-------------

33. I therefore order British Universities Film & Video Council to pay Bob Group Ltd the sum of £350. This sum is to be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 11<sup>th</sup> day of December 2018**

**S WILSON**

**For the Registrar**