

O-739-19

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION № 3329651

BY TAYLOR BLOXHAM Ltd

TO REGISTER



AS A TRADE MARK IN CLASSES 16, 35 & 40

AND OPPOSITION THERETO (UNDER № 414516)

BY MOVIEBOX (BIRMINGHAM) LTD

Background and statements

1. Taylor Bloxham Ltd (the applicant) applied to register the trade mark shown above in the UK on 6th August 2018. It was accepted and published in the Trade Marks Journal on 24th August 2018 in respect of the following goods/services:

Class 16: Printed matter; printed promotional material; business cards; flyers; leaflets; postcards; booklets; catalogues.

Class 35: Distribution of advertising, marketing and promotional materials.

Class 40: Printing services; print finishing services.

2. MOVIEBOX (Birmingham) Ltd (the opponent) claims that the applicant's trade mark is identical or similar to its own registered UK trade mark (3133714) shown below, and that the respective goods/services are identical or similar.



3. They oppose the trade mark on the grounds of Section 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act). The following goods and/or services are relied upon in this opposition:

Class 16: ... printed materials, namely, posters

Class 35: ... advertisement ...

4. The applicant filed a counter-statement denying the opponent's claims.

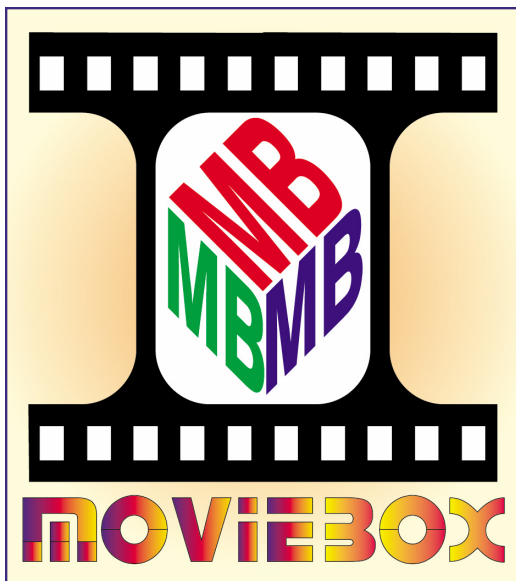
5. Both sides have supplied written submissions which I have considered carefully. The opponent's submissions were supplied as evidence in the form of a witness statement by Kamraan Ahmed, but the witness statement clearly contains submissions and not evidence, and I have treated it as submissions. Neither party chose to be heard.

Identical marks - Section 5(1)

6. Section 5(1) of the Act is as follows:

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

7. In order to succeed under section 5(1), the trade marks (shown below) must be identical.



Earlier trade mark



Contested trade mark

8. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

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

9. In this case the two trade marks are manifestly not identical, so the opposition under section 5(1) fails.

Identical marks & similar goods/services - Section 5(2)(a)

10. Section 5(2)(a) of the Act is as follows:

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

11. This ground of opposition also depends on the trade marks being identical. It fails for the same reason as section 5(1) — ie. the trade marks are not identical.

Section 5(2)(b)

12. Section 5(2)(b) of the Act is as follows:

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

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

The principles

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

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

14. Some of the contested goods (ie. printed matter) are identical to the goods on which the opposition is based (ie. printed material). For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods and services listed above. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier trade mark. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods and services are only similar.

The average consumer and the purchasing act

15. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

16. 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.”

17. The average consumer for the applicant’s goods and services is likely to be the general public. The applicant says that the end user of its products and services are businesses who are contacting the applicant specifically for help with promotional material or advertisements. But I have to make this decision on the basis of how the trade mark applied for *could* be used, not how the applicant intends to use it. The consumers are likely to make the purchasing decision predominantly on the basis of a visual appreciation of the mark. I see no reason to suppose that they will pay more or less than normal attention to the mark when deciding to purchase the applicant’s goods/services.

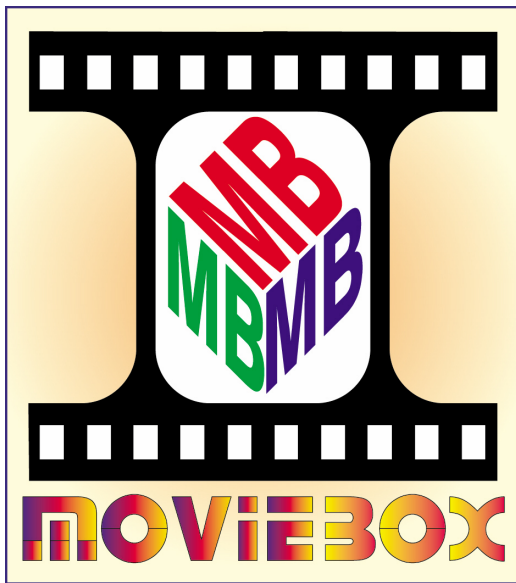
Comparison of marks

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

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

19. 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.

20. The respective trade marks are shown below:



Earlier trade mark



Contested trade mark

21. The applicant's trade mark consists of two white letters, **mb**, in lowercase, against the background of a pale green triangle. The letters carry marginally more weight in the overall impression of the mark because they are central and of a prominent size, although the green triangle is also visually striking. The opponent's trade mark also features the letters MB, but in uppercase and in three different colours (green, red and blue). The opponent's trade mark includes the image of a film roll, and the word MOVIEBOX, as well as the box shape formed by the repetition of the letters MB. The various elements of the opponent's trade mark contribute a roughly equal weight to the overall impression of the mark.

22. Visually the two trade marks are quite different. When printed on white paper, as I suspect it often would be, the applicant's trade mark involves the use of only one colour (ie. pale green). In contrast, the earlier trade mark uses several deeper colours (including black), and also a graduated colour for the letters of the word MOVIEBOX. Visually, the applicant's trade mark is dominated by the shape of a

triangle, whereas the earlier trade mark does not have any triangular element. The device of a filmstrip frame and the word MOVIEBOX have no counterpart in the application. Consequently I find that the degree of visual similarity is very low, the only similarity arising from the letters which are presented very differently.

23. The aural aspects of the two trade marks are closer. Undoubtedly the applicant's trade mark would be referred to aurally as "MB" because this is the only pronounceable element of the trade mark — the distinction between upper and lower case being lost in pronunciation. I think the earlier trade mark would be referred to as either "MB" or "Moviebox", and probably not "MB Moviebox", since most people would assume that the letters MB are an acronym of MOVIEBOX and avoid the repetition. If the reference is only to MB, the trade marks are aurally identical; if only MOVIEBOX is pronounced, they are aurally dissimilar; and if the earlier trade mark is articulated as MB MOVIEBOX, there is a medium degree of aural similarity.

24. Conceptually, the applicant's trade mark is very simple — indeed it isn't really a concept at all. It's just two letters inside a triangle. The opponent's trade mark is more complex. The central device of a filmstrip frame and the word MOVIEBOX convey the impression of movies/films. The 3-fold repetition of the letters MB in a cubic pattern is clearly intended to convey the idea of a box. As the only point of similarity is the letters MB, which have no concept, I find that there is no conceptual similarity between the two trade marks.

25. As the degree of visual similarity of the two trade marks is very low, and there is no conceptual similarity, and the degree of aural similarity varies from low to medium to high (depending on how the opponent's trade mark is vocalised), I find that the overall degree of similarity is low.

Distinctive character of the earlier mark

26. 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).”

The distinctiveness of the common element is key

27. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

28. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

29. There is no evidence of enhanced distinctiveness acquired through use, so I am only able to consider the inherent nature of the earlier trade mark. As explained in *Kurt Geiger v A-List Corporate Limited* (above), it is the common element that particularly matters here, and that is just the two letters **MB**. In my view, the distinctiveness of this common element is below average.

The difference between direct and indirect confusion

30. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

31. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

32. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

33. In the light of the above caselaw, and as I have found that the two trade marks are only similar to a low degree, and the only common element is below average in terms of distinctiveness, I consider that there is no likelihood of confusion between them. Even in relation to indirect confusion, I think it is extremely unlikely that a typical consumer would think that the applicant’s business was connected with that of the opponent. The fact that they both contain the two letters MB may, at a stretch, give rise to what Mr Mellor QC (in *Duebros Limited v Heirler Cenovis GmbH*)

described as 'mere association'. But that is not enough for a finding of indirect confusion.

34. As the opposition has failed in respect of identical goods, the opponent is not in any better position in relation to the other goods and services of the application.

Costs

35. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £350 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and filing a counterstatement	£200
Written submissions	£300
Total	£500

36. I therefore order Moviebox (Birmingham) Ltd to pay Taylor Bloxham Ltd the sum of £500. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of December 2019

Stephen Probert
For the Registrar