

**O-456-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3436254**

**IN THE NAME OF DAMIAN HOBAN FOR THE TRADE MARK**

**BOLT**

**IN CLASS 38 & 41**

**AND**

**THE OPPOSITION THERETO UNDER NUMBER OP600001265**

**BY BOLT LEARNING LIMITED**


## Background and pleadings

1. Damian Hoban (the applicant) applied to register the trade mark number UK00003436254 for BOLT on 14 October 2019. It was accepted and published in the Trade Marks Journal on 25 October 2019 in respect of the following services:

*Class 38: Communication services by electronic means; providing telecommunication services for gaming.*

*Class 41: Betting services; consultancy, information and advisory services relating to gaming and gambling.*

2. Bolt Learning Limited (the opponent) opposes the application in full under the fast track opposition procedure, based on Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK trade mark no.

UK00003368918 for the trade mark  with an application date of 22 January 2019, and a registration date of 20 September 2019. The following services are relied upon in this opposition:

*Class 35: Business consultancy relating to the administration of information technology; Business consultancy services; Business management consultancy, also via the Internet; Business management consulting services in the field of information technology; Consultancy relating to personnel management; Human resources consultancy; **all of the aforementioned services offered in the field of delivering education and training services.***

*Class 38: Video conferencing services, for the purpose of running Webinar learning and training interventions; video-on-demand transmission, for the purpose of communicating content with trainees and users; wireless broadcasting, for the purpose of communicating*

*content with trainees and users; teleconferencing services, for the purpose of running Webinar and teleconference type learning and training intervention; all of the aforementioned services offered in the field of delivering education and training services.*

3. The opponent argues that the respective services are identical or similar and that the marks are similar. The opponent submits it has clients in the gambling industry. The opponent argues it has overlapping services with the applicant and that both parties “exist in the technology space”. The opponent submits it provides online games as part of its training which could cause confusion.
4. The applicant filed a counterstatement denying any similarity between its mark and that of the opponent, stating “The applicant’s Trade Mark is significantly different to that of the opponent’s mark. The marks are conceptually, visually and aurally different so that the applicant’s mark does not infringe the rights of the opponent’s mark. Therefore, the applicant denies the opponent’s claim”.
5. In these proceedings the opponent has represented itself; the applicant is represented by Francis McEntegart of McLegal (UK) Limited.
6. 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:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

8. 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 cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; neither party elected to file written submissions.

### **Proof of use**

9. As previously stated, the registration upon which the opposition has been based registered on 29 September 2019. As this registration was under five years old at the date on which the application was filed, namely 14 October 2019, proof of use is not relevant in these proceedings under Section 6A of the Act.

### **Preliminary issues**

10. The TM7F filed by the opponent and deemed admissible by the Office followed three previous attempts by the opponent, and three subsequent communications from the Office deeming those attempts inadmissible. On the accepted TM7F document dated 16 March 2020, the opponent indicated the specific services covered by the earlier mark on which the opposition has been based, as is required. However, instead of using a continuation sheet, the opponent has opted to add the services upon which it relies into the box provided on the TM7F.

11. The version of the opponent's TM7F available to me shows the final visible line of the box as half obscured. I find this easy enough to decipher from the text showing. It is clear to me that this reads "teleconferencing services for the purpose of running Webinar and teleconference type learning and training". However, I can read no further text in this box. I note this particularly as the services "teleconferencing services for the purpose of running Webinar and teleconference type learning and training" do not exist within the opponent's specification per se, but that they exist within the

context of the opponent's longer term, namely "*teleconferencing services, for the purpose of running Webinar and teleconference type learning and training intervention*" (my emphasis).

12. Whilst it appears highly likely that the opponent intended on adding the full term into the box, or indeed did enter this full term into the box, but that it is not visible on the version filed, it is not my prerogative to make assumptions about the services upon which the opponent intended to rely and fill in the gaps on their behalf. However, it is my view that this issue could have been raised with the opponent earlier in these opposition proceedings (although I note that the Office had already given the opponent significant guidance and opportunity to file the form correctly).

13. In this instance, I will consider, if necessary, the impact that including opponent's services *teleconferencing services, for the purpose of running Webinar and teleconference type learning and training intervention* as a basis for this opposition will have on the outcome of this opposition. However, I will only go on to further consider if these may be used as a valid basis for opposition, taking into account any prejudice dismissing or allowing this term to stand will cause to each party, should it become necessary to do so within my final assessment of the likelihood of confusion.

14. I note also that the opponent's class 35 & 38 both end with the limitation; *all of the aforementioned services offered in the field of delivering education and training services*. Although this limitation has not been specified by the opponent, I will consider the opponent's services relied upon within the context of this limitation, as it is only to these areas that the opponent's protection extends.

## **DECISION**

15. **Section 5(2)(b)**

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”.

## 16. Section 5A

Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

## The Principles

17. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

*The principles*

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

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

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

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

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

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

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

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

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

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

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

## **Comparison of goods and services**

18. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International



Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

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

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

20. In addition, it was established by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, that the following criteria is also relevant for an assessment of similarity of goods and services:

- i. The respective users of the respective goods or services;
- ii. The respective trade channels through which the goods or services reach the market;
- iii. 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;

21. The case law provides further guidance on how the wording of goods and services as registered and filed should be interpreted within the comparison. 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."

22. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

*"...the applicable principles of interpretation are as follows:*

- 1. General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*
- 2. In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

3. *An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

4. *A term which cannot be interpreted is to be disregarded.”*

23. An explanation of when terms may be viewed as identical has also been provided by the courts. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 fur 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”.

24. With these factors in mind, the services for comparison are below:

<b>Opponent’s services</b>	<b>Applicant’s services</b>
<p><i>Class 35: Business consultancy relating to the administration of information technology; Business consultancy services; Business management consultancy, also via the Internet; Business management consulting services in the field of information technology; Consultancy relating to personnel management; Human resources consultancy; <b>all of the aforementioned services offered in</b></i></p>	<p><i>Class 38: Communication services by electronic means; providing telecommunication services for gaming.</i></p> <p><i>Class 41: Betting services; consultancy, information and advisory services relating to gaming and gambling.</i></p>

***the field of delivering education and training services.***

*Class 38: Video conferencing services, for the purpose of running Webinar learning and training interventions; video-on-demand transmission, for the purpose of communicating content with trainees and users; wireless broadcasting, for the purpose of communicating content with trainees and users; teleconferencing services, for the purpose of running Webinar and teleconference type learning and training intervention; all of the **mentioned services offered in the field of delivering education and training services.***

\*Bold wording added by me\*

**Communication services by electronic means**

25. I find that the above services filed by the applicant in class 38 cover several of the opponent's services in their entirety. For example, I find that the opponent's *Video conferencing services, for the purpose of running Webinar learning and training interventions; all of the mentioned services offered in the field of delivering education and training services* falls directly within the meaning *communication services by electronic means*. I therefore find the above services identical to those covered by the opponent within the meaning of *Meric*.

### **Providing telecommunication services for gaming**

26. Several of the opponent's services offered under class 38 include 'telecommunication services', such as video conferencing services, wireless broadcasting and teleconferencing services. Within its TM7F, the opponent refers to the fact that both parties "exist within the technology space". In the case of the opponent, these services are limited both by purpose, and by field. The applicant's telecommunication services have been limited by field, to those for gaming.
27. I find the nature of the applicant's services above to be the same as the nature the opponent's services in this sector, namely that they are all telecommunication services. I find there may also be an overlap in respect of the method of use of these services and those covered by the opponent.
28. As mentioned, both the applicant and the opponent have gone some way to help define the services covered. The opponent protects its various class 38 services for the purpose of running webinars, running teleconferences, and for learning, training and communicating, all in the field of delivering education and training services, defining the intended purpose of the services. On the other hand, the applicant states the application of the services is *for gaming*. It is my view that primary intended purpose of the applicant's services is to provide, as a telecommunication service, the means for playing and/or communicating via a game, be it a computer game or otherwise. Superficially, there may be some overlap in the intended purpose of the services offered by the opponent and the above services of the applicant, namely that they may both broadly include the purpose of communicating or interacting with another party without the need to be next to one another physically. However, I find this to be too vague a definition upon which to conclude the services share an intended purpose, and instead it is my view that the intended purpose differs as set out above.
29. It is my understanding that in some instances, telecommunication companies will utilise the skills and knowledge they have to offer multifaceted

services in this area. I believe also that various telecommunication services may share the same channels of trade, and similar technology may have various applications across a variety of industries. However, without further submissions on this point, I find it unlikely that those offering or specialising in telecommunication services in the field of delivering education and training services will frequently also offer or specialise in telecommunication services for gaming, or that the same trade channels will be used for services in both industries. I find it likely that both industries will have entirely different needs and requirements and will likely look in different places to fulfil them. Without further submissions from either party on this point, I cannot reach a finding that the different types of telecommunication services referenced by the parties will *usually* be offered within the same trade channels, although I consider this may on occasion be the case.

30. The intended user of the opponent's services in class 38 are those in the field of delivery of education and training and training intervention services. In contrast, the intended user of the applicant's services are those within the gaming industry, or gaming community. I note the opponent's comments within its TM7F that they have clients within the gambling industry (although it should be noted that in my view the gambling industry is not *synonymous* with the gaming industry), and I do find that there may be occasions where the user of the services conflict, for example, businesses within the gaming industry may wish to deliver their own training and education to their staff or customers. However, I do not find these occasions will be so frequent or intentional that it can be said the intended user of the applicant's services coincide with those of the opponent. I note that both the opponent's and applicant's services may also coincide on the basis that they are both offered to the general public, but I find this a superficial overlap only. Ultimately, I find the intended users of the applicant's services above differ to the intended user of the opponent's services. Furthermore, I cannot see any reason that the services offered are either complementary or in competition with one another.

31. Based on the similarity between the nature and method of use of the services, and with consideration to the superficial similarity in respect of the intended purpose and user of the services, as well as the differences mentioned above, I find the applicant's *Providing telecommunication services for gaming* to be similar to the opponent's goods to a low degree.

32. For the avoidance of doubt, I do not find the opponent's class 35 services to be similar to the applicant's services above, as I find they differ in respect of the key factors as set out by the case law.

**Betting services:**

33. I find the above services to be dissimilar to the opponent's earlier services. I find the nature, intended purpose differ, I find it unlikely these services would share the same trade channels as the opponent. I do not find the services to be complementary, or in competition with one another. I note again the opponent's submissions about its clients in the gambling industry, but to my mind, this is not sufficient for a finding of similarity between the services as registered and filed.

**consultancy, information and advisory services relating to gaming and gambling.**

34. Both parties offer consultancy services of some description. However, unlike the telecommunications services above, which I find to be an industry in and of itself (albeit with different sectors within the same), consultancy services may be offered by any and all industries, in respect of any and all topics. In my view, to offer consultancy services is to offer specialist or expert advice or opinion, and so at most there may be a conflict in respect of nature. However, I find that the remaining factors will differ in respect of these services, and I find the opponent's offering of specialist advice or opinion in business, business management, HR, and personnel management to differ to the applicant's services above.

35. As some similarity must exist between the services in order for a likelihood of confusion on this ground, it can be assumed that there will be no likelihood of confusion found in respect of the dissimilar services<sup>1</sup>. I will therefore consider the rest of this decision in the context of the services for which some similarity has been found.

36. I note at this stage that the inclusion (or exclusion) of the opponent's services *teleconferencing services, for the purpose of running Webinar and teleconference type learning and training **intervention***; does not make a material difference to my findings on the similarity of the services, and so I do not spend further time considering whether this term may be relied upon by the opponent within the opposition.

### Comparison of marks

37. 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

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<sup>1</sup> *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)



all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

38. 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.

39. The respective trade marks are shown below:

	BOLT
Opponent's trade mark	Applicant's trade mark

40. The most dominant and distinctive element of the opponent's mark is held in the word 'bolt'. However, I do find the stylisation, particularly of the letter 'b', and the colour choice also forms part of the overall impression of the opponent's mark. I note the use of the ® symbol in the corner of the mark. However, I believe due to both its size, and the fact that if it is noticed it will be recognised by the consumer as referring to the fact the word is a registered trade mark, that this will be disregarded by the consumer entirely.

41. I find the dominant and distinctive element of the applicant's mark to be held in its entirety, namely the word BOLT. It is well established that the choice of uppercase or lowercase lettering in a word mark does not add to its overall impression, and its registration as a word mark allows for use in the mark in any case.

## Visual comparison

42. Visually, both marks consist of the letters B-O-L-T. As mentioned above, the use of uppercase in the applicant's word mark is irrelevant, and so the dominant and distinctive elements of both marks visually coincide. However, the stylisation to the B used in the opponent's is a point of difference to the applicant's mark visually, and overall, I find the marks visually similar to between a medium and high degree. The fact that the opponent's mark is represented in colour makes no difference to the assessment as to whether there is a likelihood of confusion. The Court of Appeal has stated on two occasions following the CJEU's judgment in *Specsavers*, that registration of a trade mark in black and white covers use of the mark in colour.<sup>2</sup> This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).<sup>3</sup> Thus a black and white version of a mark should normally be considered on the basis that it could be used in any colour. Notional and fair use of the applicant's mark would include use in the same colour as the opponent's mark.

### **Aural comparison**

43. Aurally I find the marks to be identical, both consisting of the single recognisable English word 'BOLT'. The English speaking consumer will be aware of the pronunciation of this word as one syllable only.

### **Conceptual comparison**

44. Conceptually both marks are made up of the same word in the English language. It is my view that the consumer will recognise the words BOLT and attribute one of its common meanings. I find it likely the meanings attributed by the consumer will either to 'bolt' (to move away quickly), or a 'bolt' (for example, of lightening), or a 'bolt' (as used in construction for securing one item to another). Although I find there may be various meanings attributed to the

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<sup>2</sup> Paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

<sup>3</sup> See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

marks, I find in all instances these will be identical for both marks. I therefore find the marks conceptually identical.

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

45. 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.

46. 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.”

47. The applicant's services, namely *Communication services by electronic means* and the opponent's identical services will be targeted at a wide range of consumers, including members of the general public. However, I also believe that a significant portion of the relevant consumer of these services may be business and professionals. Prior to engaging in these services, the consumer will generally consider the cost, capability and functionality of the service, and may often enter into a contract for the provision of these services over a period of time. I find therefore that the average consumer,

being a member of the general public, will pay at least a medium level of attention when purchasing these services. Where these services are sold to the professional consumer, the scale of the purchase, and the impetus to make the correct purchase for the business needs will also increase. In the case of professional consumers, I believe the level of attention paid will range from slightly above medium to fairly high.

48. It is my view that the findings above also apply in respect of the applicant's more specific services in class 38 namely *providing telecommunication services for gaming*. I believe that the average consumers of these services will often be members of the generally public, specifically those from the gaming community. However, I find again that the average consumers of these services may also include professionals in this sector, including the game developers looking for these services to offer in conjunction with, or for the production of the games themselves.

49. I believe all of the above services will be primarily purchased on visual inspection, with visual marketing materials used for advertisement and at the point of purchase. However, in respect of these services, I also believe that verbal recommendations and sales techniques such as pitches may apply, and so the aural considerations are also relevant.

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

50. 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).”

51. The opponent’s mark is made up of the English word BOLT, and is registered in florescent blue with stylised lettering. I do not find the word BOLT to be descriptive or allusive of the services offered by the opponent, and I find it is the most distinctive element of the mark, and the element that gives the opponent’s mark an average level of inherent distinctive character. I find that the colour and stylisation help to elevate the inherent distinctive character of the earlier mark to a slightly above average degree.

52. No evidence has been filed within this fast track opposition, and so a finding of enhanced distinctive character based on the use of the mark will not apply.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

53. Prior to reaching a decision on this matter, I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 17 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, who is deemed to be reasonable well informed 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. I must consider the level of attention paid by the consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that a likelihood of confusion may be increased where the earlier mark holds a high degree of distinctive character, either inherently, or due to the use made of the same, and that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks. I must also consider that both the degree of attention paid by the consumer and how the goods or services are obtained will have a bearing on how likely the consumer is to be confused.

54. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. Direct occurs where the consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings<sup>4</sup>.

55. I found that the applicant's mark is aurally and conceptually identical to the opponent's marks, and I found the marks visually similar to between a medium and high degree. I found the common element BOLT shared by the two marks renders the earlier mark distinctive to at least an average degree. I found the consumers of the marks will be both the general public and the professional public, who will pay from a medium to a high degree of attention when purchasing the goods. I found that to these consumers the visual comparison will be of most importance, but that the aural comparison will also play an important role. I note here also that the applicant's mark has been filed as a word mark, and so the protection of the mark if registered will extend beyond the plain black and white uppercase text used in the application.

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<sup>4</sup> *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10,

56. Considering all the factors set out above, it is my view that the differences between the marks themselves are small enough that where the services are identical, the consumer is likely to be directly confused when paying a medium to slightly above medium degree of attention to the services. This is particularly true in respect of these services due to the aural identity of the marks, with consideration of fact that verbal recommendations or verbal marketing may play a key role in the consumers decision to purchase the services.

57. When the consumers degree of attention is towards the higher end, it is my view that they will likely notice the differences between the marks in question even where the services are identical, and so they will not be directly confused. In addition, when paying a high degree of attention, I find it unlikely that consumers will make a purchase from an aural recommendation alone and will likely spend more time researching the services they are purchasing and viewing visual materials in respect of the same. However, in these instances, it is my view that the existence of the common distinctive element, namely BOLT, will result in the consumer believing that the two marks derive from the same economic undertaking, with the opponent's mark simply representing an updated version of the applicant's original, or vice versa. I believe this will result in indirect confusion in respect of the identical services. Furthermore, if I am wrong about a finding of direct confusion between the marks covering the identical services in respect of the consumers paying a medium to slightly above medium degree of attention, it is my view that should the differences be noticed, indirect confusion will occur.

58. In respect of the services with the low similarity, namely *Providing telecommunication services for gaming* I find my conclusion requires additional consideration. As mentioned above, the marks are highly similar. The interdependency principle as set out in *Canon* states that a higher degree of similarity between the marks may offset a lower degree of similarity between the goods or services. In this case, I consider that the similarity

between the marks is high, and the similarity between the services is low. However, in this instance, it is not simply that the similarity between the marks is high overall. In this case, the most dominant and distinctive BOLT element of the opponent's mark is near enough completely reproduced within the applicant's. I find that this complete reproduction of the most dominant element, with no addition to the later mark and only a small additions to the earlier mark is likely to result in the relevant consumer believing that the same economic undertaking is responsible for offering the different services under slightly different versions of their mark, ultimately resulting in a likelihood of indirect confusion in this case.

### **Final Remarks**

59. The opponent has achieved partial success on the bases of its opposition on grounds 5(2)(b) of the Act, and the application will be refused for the following goods:

*Class 38: Communication services by electronic means; providing telecommunication services for gaming.*

60. The opposition has failed in respect of the following services:

*Class 41: Betting services; consultancy, information and advisory services relating to gaming and gambling.*

### **COSTS**

The opponent and the applicant have both achieved success in equal measure, and so I order each party to bear its own costs in these proceedings.

**Dated this 18th day of September 2020**

**Rosie Le Breton  
For the Registrar**