

O-077-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3390363

BY ROBERT MARRINER-DODDS

TO REGISTER

Carbon 2185

&

CARBON 2185

**AS A SERIES OF TWO TRADE MARKS
IN CLASSES 9, 14, 16, 18, 25, 28, 41**

AND

THE OPPOSITION THERETO UNDER NUMBER OP000416912

BY KALA ELLIOTT

Background and pleadings

1. On 8 April 2019, Mr Robert Marriner-Dodds (“the applicant”) applied to register the series of two trade marks in the UK, as shown on the cover page of this decision. It was accepted and subsequently published in the Trade Marks Journal for opposition purposes on 19 April 2019. The application relates to the following goods and services:

Class 9: Games software; Virtual reality game software; Downloadable computer game programs; Recorded computer game software; Video games [computer games] in the form of computer programs recorded on data carriers; Video games on disc [computer software]; Computer software platforms; Computer programs for video and computer games; Computer games programmes downloaded via the internet [software]; Cases for smartphones and tablets; Liquid crystal protective films for smartphones; Mouse mats; Sunglasses; Headphones; Spectacle cases; Video films; Cinematographic films; Downloadable movies.

Class 14: Jewellery; Medallions; Key rings and key chains; Necklaces [jewellery, jewellery (Am.)].

Class 16: Writing instruments; Stationery; Disposable paper products; Printed matter; Posters; Stickers [stationery]; Books; Comics; Magazines [periodicals].

Class 18: Luggage, Bags, Wallets; Garment carriers; Carriers for suits, shirts and dresses; Luggage covers; Keycases; Saddlebags; School knapsacks; Folio cases; Backpacks.

Class 25: Clothing; Footwear; Headgear; Underwear; Leather belts [clothing].

- Class 28: Games and accessories for games; Handheld computer games; Electronic games; Hand held units for playing video games; Toys; Card games; Role playing games; Board games; Electronic board games; Toy figurines; Toy action figurines; Plastic character toys; Collectable toy figures.
- Class 41: On-line gaming services; Games services provided via computer networks and global communication networks; Provision of on-line computer games; Provision of games by means of a computer based system; Game services provided on-line from a computer network; Providing a computer game that may be accessed network-wide by network users; Internet games [non-downloadable]; Information relating to computer gaming entertainment provided online from a computer database or a global communication network; Providing online information relating to computer games and computer enhancements for games; Production of television and cinema films; television series; Providing films and series online; Organising and conducting events for entertainment purposes; Arranging and conducting of shows, competitions and awards ceremonies, games and performances for entertainment purposes; Arranging and conducting competitions for video gamers and computer game players; Arranging online computer and video game competitions for interactive game players; Amusement and theme park services; Amusement centres and Entertainment services; Providing interactive gaming areas; Organization of exhibitions for cultural or educational purposes; Education and training services relating to computer games and other forms of online entertainment; Online publications, namely online magazines containing information, news and commentaries in the field of computer games.

2. On 8 July 2019, the application was opposed by Ms Kala A Elliott (“the opponent”). It is a partial opposition, based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”); directed against the following:

Class 41: Production of television and cinema films; television series; Providing films and series online; Organising and conducting events for entertainment purposes; Arranging and conducting of shows, competitions and awards ceremonies, games and performances for entertainment purposes; Information relating to computer gaming entertainment provided online from a computer database or a global communication network; Education and training services relating to computer games and other forms of online entertainment; Online publications, namely online magazines containing information, news and commentaries in the field of entertainment. Information relating to entertainment provided on-line from a computer database or the Internet; Live entertainment; Live entertainment services.

3. The opponent relies upon its United Kingdom Trade Mark registration **UK00003074408**, filed on 27 September 2014; for which the registration process was completed on 6 March 2015. The opponent relies upon all of the services under said registration, as follows:

CARBON

Class 41: Entertainment; Cultural activities; Education; Provision of television entertainment services; Black history education; Black comedy and entertainment shows; Black cultural activities; Black film screenings; Black theatre performances; Provision of on-line electronic publications and digital music which are not downloadable; Information relating to entertainment provided on-line from a computer database or the Internet; Live entertainment; Live entertainment services; Music entertainment services; Musical entertainment; Musical entertainment services;

Organisation of competitions (education or entertainment); Organisation of entertainment and cultural events; Organisation of events for Black cultural and African Caribbean and Black British audiences for entertainment and sporting purposes; Organising and presenting displays of entertainment relating to style and fashion; Production of Black entertainment shows featuring dancers and singers; Booking of entertainment halls; Arranging for ticket reservations for shows and other entertainment events; Presentation of Black, African, African Caribbean, works of visual art or literature to the public for cultural or educational purposes; On-line articles featuring fashion, beauty, politics, business, finance tailored to a Black British, Afro Caribbean, African, and Black Mixed and or Ethnic audience: Online publications added on a frequent periodic basis in the fields of Black, entertainment, education and cultural activities events and news.

4. The applicant filed a counterstatement and submissions, in which it: asserts that many of the services the opponent relies upon “appear not to be relevant to the application in suit”; concedes that some of the applied-for services are similar to those of the opponent’s registered mark (though it denies that there is a likelihood of confusion in respect of these); and further, that there is no likelihood of confusion in relation to the remaining services.

Procedural Background

5. In these proceedings the opponent is a Litigant in Person; and the applicant is represented by IP21 Ltd.
6. The opponent filed a notice of opposition and statement of grounds. The applicant filed a notice of defence and counterstatement and written submissions. Neither side filed evidence. A hearing was neither requested nor considered necessary. I therefore give this decision after careful review of all the papers before me.

DECISION

Section 5(1) and Section 5(2)(a)

7. Section 5(1) of the Act reads as follows:

“(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.”

8. 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 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.”

9. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

10. In order for claims under Section 5(1) and Section 5(2)(a) of the Act to succeed, the competing trade marks are required to be identical. The question of when a mark may be considered identical to another was addressed in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, where 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 an average consumer.”

11. While the competing trade marks share the common word “CARBON”, they are clearly not identical according to settled caselaw: the contested mark does not reproduce the earlier mark without any modification or addition. In addition to the word “CARBON”, the contested mark includes the numerical element “2185”. This element has no counterpart in the earlier mark. I do not consider that the average consumer would disregard this difference; which contributes to the respective impressions of the competing marks and cannot simply be overlooked. It is not so insignificant that it would go unnoticed by the average consumer. Accordingly, I find that the marks are not identical and the claims under Sections 5(1) and 5(2)(a) of the Act cannot succeed.

Section 5(2)(b)

12. I turn now to consider the opposition under section 5(2)(b) of the Act, which provides as follows:

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

(a) ...

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

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

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

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

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.”

14. The opponent’s trade mark registration, having been registered on 6 March 2015, qualifies as an earlier trade mark under section 6 of the Act. Further, given that it had not been registered for more than five years at the date the contested application was filed (8 April 2019), it is not subject to the proof of use provisions contained in section 6A of the Act.¹ The opponent is, as a consequence, entitled to rely upon its earlier mark in relation to all of the services indicated without having to prove that genuine use has been made of them. Therefore, I must make the assessment based upon the full width of the services relied upon by the opponent, regardless of whether or not the marks have actually been used in relation to those services. This is because the opponent is entitled to protection across the breadth of what it has registered on a ‘notional’ use basis.

Section 5(2)(b) – case law

15. 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

¹ As these proceedings commenced after 14 January 2019, when the Trade Mark Regulations 2018 came into force, the relevant period for proof of use purposes is the five years prior to and ending on the date of application of the contested application.

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 the services

16. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon*, the CJEU 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”.

17. 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 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 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.

18. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301,

paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. 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 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”.

20. 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.”

21. 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.

22. I have confined my comparison to the terms pleaded by the opponent in the notice of opposition and statement of grounds. In relation to the services opposed, the applicant submits that: (i) some of those “services ... are not present in the application”; (ii) “some of the services of the present application are similar [to a degree] to those covered by the opponent’s registration”; and (iii) the remaining services... are dissimilar to the opponent’s services”. I shall therefore approach my comparison in order of this categorisation.

23. Upon examination of the opponent’s pleadings, against the applicant’s specifications, I found that the following terms do not appear in the latter (as pleaded by the opponent):

Online publications, namely online magazines containing information, news and commentaries in the field of entertainment; Information relating to entertainment provided on-line from a computer database or the Internet; Live entertainment; and Live entertainment services.

24. There is a conspicuous lack of precision in the opponent’s pleading of these terms. For example, in the first term of said pleadings, the opponent specifies *Online publications, namely online magazines containing information, news and commentaries in the field of entertainment*”; whereas (taking the most comparable term) the applicant’s specification is ; *Online publications, namely online magazines containing information, news and commentaries in the field of computer games* [emphasis added].

25. The purpose of the Notice of Opposition and Statement of Grounds inter alia is to assist the opponent to define and clarify the grounds upon which they rely; and allow the applicant to reply. I also note that the opponent missed further opportunity, by way of filing submissions, to ensure that its case was pleaded with sufficient clarity and precision. It is not within my jurisdiction to interfere with, or decide the opposition on terms inaccurately pleaded in the statement of opposition. Accordingly, in considering this opposition, I have duly disregarded the terms at paragraph 21 herein, as erroneously pleaded by the opponent.

26. The services for which the applicant concedes a degree of similarity, namely: “Production of television and cinema films; television series; Organising and conducting events for entertainment purposes; Arranging and conducting of shows, competitions and awards ceremonies, games and performances for entertainment purposes;” and Information relating to computer gaming entertainment provided online from a computer database or a global communication network”; are all entertainment services of one kind or another. Therefore, applying the *Meric* principle, these services are identical to the opponent’s term “entertainment”.

27. In the alternative, if my finding on the identity of “Production of television and cinema films; television series” and “entertainment” is challenged, I draw further comparisons as follows. In its submissions on a separate term, the applicant argues that: *“providing films and series online” is a distinct service from that of the “production of television entertainment services”. Whilst many businesses which provide films and series online also produce content, we submit that there is no expectation by the relevant average consumer that the content producer and online [sic] provider are **always** the same”* [emphasis added].

28. Although the content of the programmes/series being produced is not specified, my view is that these may be entertainment in nature; as generally it can be said that television and cinema films are produced for entertainment purposes. I also considered this term of the applicant’s, against the opponent’s term (Provision of television entertainment services; black comedy and entertainment shows); which encompasses a wider scope and could include production of the services at issue. I am further persuaded by the applicant’s submission, that a content provider and a content producer may be one and the same (albeit not always). In other words, there is a close connection between these services, in the sense that one is indispensable or important for the use of the other. For example, the *provision* of television entertainment services relies entirely on the *production* of entertainment material. I also note that there is some overlap in their intended purpose and intended market; and they would potentially compete with each other. These factors could potentially lead the relevant public to attribute a

common origin to both services. Accordingly, I also find that there is similarity between the terms on the basis that they are complementary. Therefore, I consider that if the terms are not *Merit* identical, they are at least highly similar.

29. Similar reasoning applies to my alternative analysis of the applicant's specification: "Information relating to computer gaming entertainment provided online from a computer database or a global communication network", should my finding on its identity also be called into question. The said term is also comparable with the opponent's "Information relating to entertainment provided on-line from a computer database or the Internet". Whilst the applied-for service is limited in scope, the opponent's service allows for a wider remit in stipulating information relating to entertainment, which could also include information on computer gaming entertainment. There is similarity in the services' use and nature (by reason of the wide scope of the opponent's term) insofar as each delivers entertainment information to consumers. Further, it is clear (as per the respective terms) that these services share channels of trade. I find that the services may be complementary in the sense that content is important and indispensable to information relating to entertainment and that that content may be computer gaming in nature. An element of competitiveness could also arise where the content of the information being relayed is similar. Weighing all these factors, I find the services are similar to a high degree.

30. The applicant submits that the remaining contested services: "Providing films and series online; Education and training services relating to computer games and other forms of online entertainment"; are dissimilar to the opponent's services. I do not agree. Both terms are contained within the broader terms of the opponent's specification, namely "Entertainment" and "Education" respectively; and are therefore identical or at least highly similar.

31. In conclusion, of the contested class 41 terms, I have found that the following are identical or at least highly similar to terms ("Entertainment"; "Education"; "Provision of television entertainment services; black comedy and entertainment shows"; and "Information relating to entertainment provided on-line from a

computer database or the Internet”) in the opponent’s specification: “Production of television and cinema films; television series”; “Organising and conducting events for entertainment purposes”; “Arranging and conducting of shows, competitions and awards ceremonies, games and performances for entertainment purposes”; “Information relating to computer gaming entertainment provided online from a computer database or a global communication network”; “Providing films and series online”; “Education and training services relating to computer games and other forms of online entertainment”. Therefore these terms will constitute the basis of my later analysis on the likelihood of confusion.

Average consumer and the purchasing act

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 47.

33. 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.”

34. In its written submissions the applicant contends as follows in relation to the average consumer:

- (a) “Likewise, consumers of information relating to computer gaming entertainment will desire to trust the provide (sic) of such information before purchasing it. The average consumer of such information will be aware that the public realm (including sources such as the worldwide web) is full of information about games, some of it more useful than others. Thus, the consumer is likely to research the sources on offer before making a purchase.
- (b) “The average consumer of those services is likely to invest significant time and effort into researching the most suitable provider of those services before commissioning them.
- (c) “Thus in our submission the average consumer of the services relevant in this opposition is likely to be keenly aware of differences between marks.”

35. I have previously established that the respective service specifications are at least highly similar or identical. In light of the broad nature of the term entertainment and education, as well as the fact that there is no evidence as to the content of the applicant’s entertainment material; I conclude that the average consumer of the services will more likely be the general public. However, I do not rule out the possibility of a professional consumer; for example, in the form of an entertainment executive purchasing material for a television network; or an educational institution procuring courses for its curricula (in relation to education services).

36. The selection of said services will be primarily a visual process; with the average consumer searching online or seeing the marks in directories or other printed material. However, I do not ignore the aural impact of the marks and the potential for the marks to be spoken, for example, when making purchases via telecommunication systems, or by word of mouth recommendations.

37. The degree of attention paid during the purchasing process will vary according to the service on offer, consumer characteristics (being professional or the public in general) and cost considerations. Consumers of entertainment services will generally pay a medium degree of attention during their selection; with a professional consumer likely paying a higher degree of attention. Where the services are educational, the consumer is likely, more often than not, to be interested in acquiring particular knowledge or skills; and as such they will approach the selection with an elevated level of care. Professional consumers in this area are likely to pay an even higher level of attention in the selection process. On these considerations, I conclude that the degree of consumers' attention will likely range from medium to fairly high.

Comparison of the marks

38. 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.”

39. 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.

40. The respective trade marks are shown below:

CARBON	Carbon 2185 CARBON 2185
Earlier trade mark	Contested trade mark

Overall Impression

41. In comparing the marks there is no difference between the variation in the casing; because a word trade mark registration protects the word itself, irrespective of the font capitalisation or otherwise. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa.²

42. The opponent's earlier mark consists of the word CARBON. There are no other elements in the mark to contribute to its overall impression, which lies in the word itself.

43. The applicant's mark consists of two elements; the word CARBON and the number/s 2185. The applicant suggests that the said number "alludes to the year 2185 – in the distant future"; and that said element alters "the distinctive character of the mark because of the nature of the year's distance into the future". I do not agree. The additional numeral element 2185 is not, in my view, so significant as to alter the distinctive character of CARBON; and further, I consider that it would not be perceived as a date. However, it does play a part in the overall impression of the mark, though the word CARBON plays a more dominant role.

² *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

Visual Comparison

44. Visually, the marks coincide in that they share the word element 'CARBON', which is the only element in the opponent's mark; and the first element in the applicant's. The point of visual difference is the addition of the numerical element 2185 at the end of the applicant's mark, but the identical element is the first element. Therefore the marks are considered to be visually similar to at least a medium degree.

Aural Comparison

45. Aurally, the marks overlap in the identical pronunciation of the word CARBON. They differ in the presence of the number element in the applicant's mark, which has no counterpart in the opponent's mark. In this case, therefore, the marks can be said to be aurally similar to at least a medium degree.

Conceptual Comparison

46. In addition to its proposition that the numerical element would be perceived as a future date, that applicant submits that its "mark relates to a cyberpunk roleplaying game. *Wikipedia* reports that cyberpunk relates to 'a subgenre of science fiction in a dystopian futuristic setting that tends to focus on a 'combination of low-life and high tech' featuring advanced technological and scientific achievements, such as artificial intelligence and cybernetics, juxtaposed with a degree of breakdown or radical change in the social order'".

47. I note that this information was not formalised into evidence (at the evidence rounds); and so, could not be taken into consideration. Nevertheless, even if I were prepared to take judicial notice of this evidence, I do not consider that the submissions made by the applicant will be obvious to consumers without a degree of analysis, which is not usually undertaken when a mark is first encountered; or to consumers who are not already familiar with the brand. I also find that the average consumer would not instinctively or immediately attach a concept to the numeral element, either on its own, or in tandem with CARBON.

Notwithstanding this finding, as well as my conclusion that the numerical element would not be read as a year, I accept that it will be recognised as a number, which has no counterpart in the opponent's mark. The presence of the numerical element, therefore, acts as a point of conceptual difference between the marks. The marks share a concept centred around the word "CARBON", which is defined as: a chemical element that is found in all living things, and can also exist as diamonds or coal. I consider that a significant section of the relevant public would be familiar with the word, though they might not know or recall its precise dictionary meaning. I conclude that the relevant public will attribute a meaning to "CARBON", whether or not they are familiar with its actual dictionary definition. Whatever meaning the average consumer attaches to it, is likely to be consistently ascribed to both marks. I consider that the conceptual similarity in the word CARBON is more significant than the relative conceptual difference presented by the numerical element. In light of these considerations, I find that the marks are conceptually similar to at least a high degree.

Distinctive character of the earlier trade mark

48. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion³. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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.

49. "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 for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings" -

³ *Sabel BV v Puma AG*, Case C-251/95 [para. 24]

Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

50. Trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, however, the opponent has not pleaded that its mark has acquired enhanced distinctiveness through use and has not filed any evidence to support such a claim. Consequently, I have only the inherent position to consider.

51. CARBON is a dictionary word, rather than an invented word. Invented words generally have the highest level of inherent distinctiveness. Accordingly, as a dictionary word which does not describe or allude to the services for which it is registered, CARBON has at least an average degree of inherent distinctive character.

Conclusions on Likelihood of Confusion

52. The applicant submits that “the differences between the marks as discussed and the level of attention the average consumer of the services concerned is likely to give mean that there is no likelihood of confusion between the mark of the present application and the mark of the opponent’s registration”.

53. 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer for the 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 they have retained in their mind.

54. Confusion can be direct (where the average consumer mistakes one mark for the other), or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related).

55. The distinction between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he 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.

“17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

56. These examples are not exhaustive, but provide a helpful focus for my analysis on the likelihood of confusion. I have found the respective marks to be visually and aurally similar to at least a medium degree. The marks are conceptually similar to high, rather than identical, degree, given that the word CARBON is a dictionary word, to which the average consumer would attach meaning; and that the presence of the numeral element 2185 in the applicant’s mark acts as a point of conceptual difference (albeit of relative lesser dominance) between them. I have identified the average consumer to be a member of the general public, who will purchase the services primarily by visual means (although I do not discount an aural component). I have concluded that the average consumer will pay at least a medium degree of attention when selecting the services; though professional consumers are expected to exhibit a higher degree of care in the selection process. On the services relevant to these proceedings, I have found that they are either at least highly similar or identical. I have found the opponent’s mark to have at least an average degree of inherent distinctive character.

57. Notwithstanding the principle of imperfect recollection, I consider that the visual difference between the marks is sufficient to avoid them being mistakenly recalled as each other. I do not consider that the presence of the numerical element 2185, in the applicant’s mark will be forgotten by the average consumer. Therefore, I am satisfied that there is no likelihood of direct confusion.

58. On the other hand, considering all of the above factors in conjunction with the comments of Mr Purvis QC, I conclude that the average consumer will view the marks as variants from the same brand group or a brand extension; and that the services bearing these marks will come from the same, or an economically linked, undertaking. This is particularly the case given the identity or high degree of similarity between the services; the visual and aural similarities between the marks; the dominance of the word CARBON, to which the average consumer would attach meaning; and the fact of its, at least average degree of, inherent distinctive character. The addition of the numerical element 2185 (in the later mark) is likely to be viewed as an alternative mark, or brand extension being used by the same business. Therefore I consider there to be a likelihood of indirect confusion in respect of those services I have found to be highly similar or identical.

Conclusion

59. As I have found that there is a likelihood of confusion in respect of a proportion of the particulars pleaded under the class 41 services, the opposition is partially successful. Subject to appeal, the application is refused for the following class 41 services:

- (i) Production of television and cinema films; television series;
- (ii) Organising and conducting events for entertainment purposes;
- (iii) Arranging and conducting of shows, competitions and awards ceremonies, games and performances for entertainment purposes;
- (iv) Information relating to computer gaming entertainment provided online from a computer database or a global communication network;
- (v) Providing films and series online; and
- (vi) Education and training services relating to computer games and other forms of online entertainment.

60. The application may proceed to registration for the goods and services that were not opposed, namely:

- Class 9: Games software; Virtual reality game software; Downloadable computer game programs; Recorded computer game software; Video games [computer games] in the form of computer programs recorded on data carriers; Video games on disc [computer software]; Computer software platforms; Computer programs for video and computer games; Computer games programmes downloaded via the internet [software]; Cases for smartphones and tablets; Liquid crystal protective films for smartphones; Mouse mats; Sunglasses; Headphones; Spectacle cases; Video films; Cinematographic films; Downloadable movies.
- Class 14: Jewellery; Medallions; Key rings and key chains; Necklaces [jewellery, jewellery (Am.)].
- Class 16: Writing instruments; Stationery; Disposable paper products; Printed matter; Posters; Stickers [stationery]; Books; Comics; Magazines [periodicals].
- Class 18: Luggage, Bags, Wallets; Garment carriers; Carriers for suits, shirts and dresses; Luggage covers; Keycases; Saddlebags; School knapsacks; Folio cases; Backpacks.
- Class 25: Clothing; Footwear; Headgear; Underwear; Leather belts [clothing].
- Class 28: Games and accessories for games; Handheld computer games; Electronic games; Hand held units for playing video games; Toys; Card games; Role playing games; Board games; Electronic board games; Toy figurines; Toy action figurines; Plastic character toys; Collectable toy figures.

Class 41: On-line gaming services; Games services provided via computer networks and global communication networks; Provision of on-line computer games; Provision of games by means of a computer based system; Game services provided on-line from a computer network; Providing a computer game that may be accessed network-wide by network users; Internet games [non-downloadable]; Providing online information relating to computer games and computer enhancements for games; Arranging and conducting competitions for video gamers and computer game players; Arranging online computer and video game competitions for interactive game players; Amusement and theme park services; Amusement centres and Entertainment services; Providing interactive gaming areas; Organization of exhibitions for cultural or educational purposes; Online publications, namely online magazines containing information, news and commentaries in the field of computer games.

COSTS

61. The opponent has been only partially successful as far as the terms are concerned which were specified in the notice of opposition, but has actually been totally successful in the terms which were listed in the notice of opposition and which do fall in the applicant's class 41 specification. The opponent is, in principle, entitled to a contribution towards the costs of the proceedings, based upon the scale of costs published in Tribunal Practice Notice 2/2016. I note that the opponent (a Litigant in Person) was advised by the Tribunal by letter dated 8 October 2020 that: "If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party". The said letter further advised: "If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed ...". Nevertheless it is apparent that the opponent has elected not to submit said costs proforma.

62. I also note that the applicant has filed material which is without prejudice save as to costs and which has been the subject of a confidentiality order.⁴ [REDACTED]

[REDACTED]

[REDACTED] Seeing as the applicant has lost, in so far as the services which are specified in the application and which were opposed are concerned, there is no reason to award it any costs.

Dated this 3rd day of February 2021

**Denzil Johnson,
For the Registrar**

⁴ I therefore direct under Rule 58(3)(d) of the Trade Mark Rules 2008 that all reference to the confidential material (in my decision on costs) is redacted in the version of this decision made available to the public.