O/511/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3419868

BY AERODROME LTD

TO REGISTER THE TRADE MARK:

LOST

IN CLASSES 9, 25, 38, 41, 43 AND 45

AND

OPPOSITION THERETO UNDER NO. 419191

BY

FELIX SAFRAN DE LAET

Background and pleadings

1. AERODROME LTD (“the applicant”) applied to register the trade mark below on 8 August 2019.

LOST

2. It was accepted and published in the Trade Marks Journal on 25 October 2019 for the following goods and services:

Class 9 Sound recordings; music recordings; video recordings; tapes; cassettes; CDs; compact discs; films; video cassettes; video recorders; CD ROMS; video game software; computer games software; computer software; video cameras; cameras; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; batteries; encoded magnetic cards, magnetic identity cards, credit cards, debit cards; spectacles, spectacle cases, sunglasses; video games; mouse pads; screen savers; publications in electronic form, typically supplied on-line from databases or from facilities provided on the Internet; headphones; stereo headphones; speakers; holograms, credit cards with holograms; digital music (downloadable); digital music downloadable from the Internet; downloadable music files; musical video recordings; downloadable musical sound recordings; musical recordings in the form of discs; digital music downloadable provided from mp3 internet web sites; digital physical instructional information downloadable from the Internet; streamable sound recordings; streamable videos; downloadable publications; application software; downloadable music sound recordings; downloadable videos; software for providing emoticons; telephone ring tones; video game;

sunglasses; mobile phone covers and cases; decorative magnets; fridge magnets; mobile applications; computer games.

Class 25 Clothing, namely, shirts, T-shirts, hoodies, sweatshirts, trousers, jogging suits, jeans, shorts, sports shorts, swimwear, beachwear, bikinis, swimming costumes, underwear, lingerie, boxer shorts, teddies, slips, camisoles, chemises, negligees, sleepwear, robes, pyjamas, pyjama sets, tracksuits, articles of outerwear, coats, jackets, jumpers and cardigans, pullovers, twinsets, knitwear, leggings, neckties, waistcoats; Clothing, namely, headbands and wristbands, skirts, wraps, jerseys, blouses, dresses, sweatshirts, bibs, stockings, ties, shawls, blazers, headbands and wristbands, overalls, halter tops, tank tops, crop tops, dresses, blazers, blouses, slacks, suits, vests, socks and hosiery, stockings, aprons, footwear, namely, boots, shoes, slippers, sandals, trainers, booties, workout shoes and running shoes, beach shoes, soles for footwear; headgear, namely, headbands, hats, caps, berets, earmuffs, top hats, visors, baseball caps, headbands, beanies; swimwear and costumes; fancy dress costumes; waterproof clothing, footwear and headgear.

Class 38 Broadcasting; data streaming; online streaming of events; streaming of audio and visual material on the internet; telecommunications, in particular providing user access to a global computer network; providing Internet-chatrooms; providing access to platforms via the Internet; providing access to portals via the Internet; transmission of sound and/or pictures; broadcasting services, namely, uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network; news agency services; webcasting services; providing digital program distribution of audio and video broadcasts over a global computer network; providing

access to a video sharing portal for entertainment and education purposes; electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means of a global computer network; electronic mail services; providing of access to on-line chat rooms and bulletin boards; telecommunication of information including web pages, computer programs, text and any other data; transmission of messages, data and content via the Internet and other computer and communications networks; transmission of messages, comments and multimedia content among users through online forums, chat rooms, journals, blogs, and list servers; providing on-line chat rooms for social networking; chat room services for social networking; providing access to digital music websites on the Internet or other computer network; delivery of digital music by telecommunications; web streaming being the transmission of data, information and audio-visual data via the Internet or other computer network; transmission of written and digital communications; operation of chat rooms; provision of on-line forums; advisory and consultancy services relating to the aforesaid.

Class 41 Entertainment services; experiential entertainment services; film production; sound recording and video entertainment services; provision of information on entertainment via pod cast; video performances; entertainment services provided by blogs; entertainment services provided by vlogs; television and radio entertainment services; entertainment services by stage production and cabaret; presentation, production and performance of shows, musical shows, concerts, videos, multimedia videos and radio and television programmes; digital music (not downloadable) provided from the Internet; sound recordings (not downloadable) provided from the Internet; video recordings (not downloadable) provided from the Internet; sound

recordings provided by on-line streams; video recordings provided by on-line streams; entertainment services provided by on-line streams; organizing and presenting displays of entertainment relating to sports; education; arranging and conducting of educational training events, arranging and conducting of colloquiums, congresses, conferences, seminars and symposiums for cultural and educational purposes; arranging of competitions, arranging of exhibitions for cultural or educational purposes, arranging of sporting contests, arranging and conducting of training workshops; publication of books and texts, other than publicity texts; publication of manuals; production of films, video tape film production, rental of sound recordings and video tapes; publishing reviews; compere services; motivational speaking for entertainment and educational purposes; entertainment in the nature of making personal appearances; on-line publication of electronic books and journals; television programming; provision of news and news information via a computer network and/or the Internet; Education services; entertainment services; entertainment services relating to modelling services; concert, musical and video performances; provision of non-downloadable content, namely, providing a website featuring non-downloadable classes, seminars, webinars, workshops; provision of non-downloadable content, namely, providing a website featuring vlogs relating to entertainment, sporting and educational matters; production of video and/or sound recordings; modelling services for artists; education services relating to sports; recording, film, video and television studio services; audio, film, video and television recording services; publishing; music publishing; sound recording, film and video production and distribution services; arranging and conducting of seminars, conferences and exhibitions; publication of books, magazines and other texts; organizing and presenting displays of entertainment relating to sports and sporting events; organizing

and presenting displays of entertainment relating to film; organizing and presenting displays of entertainment relating to television; ticket agency services (entertainment); ticketing and event booking services.

Class 43 Services for providing of food and drink; restaurant, café, bar and catering services; hotel services; advisory services relating to café, restaurant, bar, catering and hotel services; consultation in the field of the selection, preparation and serving of food and beverages in connection with the provision of food and drink; consultation in the field of restaurant, café, bar, catering; self-service restaurants; takeaway, cafe, cafeteria, canteen, coffee shop and snack-bar services; take away fast food services; wine bar services; catering services for the provision of food and drink; club services for the provision of food and drink; provision of information relating to bars and restaurants; provision of information relating to the preparation of food and drink; information services relating to all the aforesaid services.

Class 45 Exploitation of industrial property rights and copyright by licensing; Legal services relating to the exploitation of ancillary rights relating to film, television, video and music productions; social media network services.

3. Félix Safran DE LAET ("the opponent") opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against the applicant's Class 41 services. The opponent relies upon their EU trade mark[1], shown below, filing number 013975644, which has a filing date of 22 April 2015 and for which the registration procedure was completed on 3 September 2015.

[1] Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

LOST FREQUENCIES

4. The following services are relied upon in this opposition:

Class 41	Entertainment; Publishing of books, newspapers, magazines, journals, CD-ROMs, musical scores; Publishing of music and books and audiovisual media of all kinds; Editing and production of audiovisual or musical works on audio, video and digital data carriers; Publication of electronic books and journals on-line; Tuition; Radio, audiovisual and television entertainment; Arranging and conducting of colloquiums, conferences and congresses in the music field or for entertainment; DJ services, organisation of exhibitions and competitions for cultural, recreational or educational purposes in the music field; Organisation of shows, organisation of parties (entertainment); Production of dance shows and dances; Performances (Presentation of live -); Discotheque services; Booking of seats for shows; Theatrical agencies; Musical, film, television and radio recording studio services; Rental of photographic, cinematographic and sound equipment; Videotape editing; Photographic reporting; Photography; Production of films, radio or television programmes, rental of films, music recordings.

5. In its notice of opposition, the opponent argues that the applicant's Class 41 services are identical or similar to their Class 41 services, which they rely on as the basis for their opposition, and that the respective marks are similar.

6. The applicant filed a counterstatement saying that the opponent's claims "are not admitted", that the marks are visually, phonetically and conceptually dissimilar and that at least some of the services are dissimilar.

7. Neither party filed any evidence in this case.

8. No hearing was requested and so this decision is taken following a careful perusal of the papers. The applicant filed a written submission in lieu of a hearing. The opponent did not file a written submission.

9. The applicant is represented by Sheridans and the opponent is represented by Novagraaf UK.

DECISION

10. Section 5(2)(b) of the Act reads 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."

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

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

(a) a registered trade mark, international trade mark (UK) a European Union 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."

12. Given their respective filing dates, the trade mark upon which the opponent relies qualifies as an earlier trade mark as defined above. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely on all of the services that they have selected as the basis for their opposition.

Section 5(2)(b) – case law

13. Although the UK has left the EU, section 6(3)(a) of the European Union (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.

14. 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 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 to mind the earlier mark, 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 services

15. Given that the opponent does not contest the applicant's Class 9, 25, 38, 43 and 45 goods and services, the services at issue are as follows:

Opponent's services	**Applicant's services**
Class 41 Entertainment; Publishing of books, newspapers, magazines, journals, CD-ROMs, musical scores; Publishing of music and books and audiovisual media of all kinds; Editing and production of audiovisual or musical works on audio, video and digital data carriers; Publication of electronic books and journals on-line; Tuition; Radio, audiovisual and television entertainment; Arranging and conducting of colloquiums, conferences and congresses in the music field or for entertainment; DJ services, organisation of exhibitions and competitions for cultural, recreational or educational purposes in the music field;	Class 41 Entertainment services; experiential entertainment services; film production; sound recording and video entertainment services; provision of information on entertainment via pod cast; video performances; entertainment services provided by blogs; entertainment services provided by vlogs; television and radio entertainment services; entertainment services by stage production and cabaret; presentation, production and performance of shows, musical shows, concerts, videos, multimedia videos and radio and television programmes; digital music (not downloadable) provided from the Internet; sound recordings (not

Organisation of shows, organisation of parties (entertainment); Production of dance shows and dances; Performances (Presentation of live -); Discotheque services; Booking of seats for shows; Theatrical agencies; Musical, film, television and radio recording studio services; Rental of photographic, cinematographic and sound equipment; Videotape editing; Photographic reporting; Photography; Production of films, radio or television programmes, rental of films, music recordings.	downloadable) provided from the Internet; video recordings (not downloadable) provided from the Internet; sound recordings provided by on-line streams; video recordings provided by on-line streams; entertainment services provided by on-line streams; organizing and presenting displays of entertainment relating to sports; education; arranging and conducting of educational training events, arranging and conducting of colloquiums, congresses, conferences, seminars and symposiums for cultural and educational purposes; arranging of competitions, arranging of exhibitions for cultural or educational purposes, arranging of sporting contests, arranging and conducting of training workshops; publication of books and texts, other than publicity texts; publication of manuals; production of films, video tape film production, rental of sound recordings and video tapes; publishing reviews; compere services; motivational speaking for entertainment and educational purposes; entertainment in the nature of making personal appearances; on-line publication of electronic books and journals; television programming; provision of news and news information via a computer network and/or the

	Internet; Education services; entertainment services; entertainment services relating to modelling services; concert, musical and video performances; provision of non-downloadable content, namely, providing a website featuring non-downloadable classes, seminars, webinars, workshops; provision of non-downloadable content, namely, providing a website featuring vlogs relating to entertainment, sporting and educational matters; production of video and/or sound recordings; modelling services for artists; education services relating to sports; recording, film, video and television studio services; audio, film, video and television recording services; publishing; music publishing; sound recording, film and video production and distribution services; arranging and conducting of seminars, conferences and exhibitions; publication of books, magazines and other texts; organizing and presenting displays of entertainment relating to sports and sporting events; organizing and presenting displays of entertainment relating to film; organizing and presenting displays of entertainment relating to television; ticket agency services (entertainment); ticketing and event booking services.

16. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") 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."

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 uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for

industry, put the goods or services in the same or different sectors.

18. 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."

19. 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."

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

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

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court ("GC") stated that:

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

22. 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 the responsibility for those goods lies with the same undertaking."

23. Having chosen only to rely on their Class 41 services, the opponent makes no detailed comment as to the similarity of the contested services.

24. In its submission, the applicant discusses the nature of its business and argues that the goods and services that it is applying for are "intended for entirely different market verticals". However, the intentions of the parties are not relevant to my assessment as I must look at the services that are applied for/registered on a notional basis.

25. I will now make my comparison with reference to the applicant's services.

26. The applicant's "Entertainment services" are identical to the opponent's "Entertainment".

27. "On-line publication of electronic books and journals" is identical to the opponent's "Publication of electronic books and journals on-line."

28. "Experiential entertainment services", "sound recording and video entertainment services", "provision of information on entertainment via pod cast", "entertainment services provided by blogs", "entertainment services provided by vlogs", "television and radio entertainment services"; "entertainment services by stage production and cabaret", "entertainment services provided by on-line streams", "organizing and presenting displays of entertainment relating to sports", "motivational speaking for entertainment … purposes", "entertainment in the nature of making personal appearances", "entertainment services relating to modelling services", "provision of non-downloadable content, namely, providing a website featuring vlogs relating to entertainment … ", "organizing and presenting displays of entertainment relating to sports and sporting events", "organizing and presenting displays of entertainment relating to film", "organizing and presenting displays of entertainment relating to television" and "ticket agency services (entertainment)" are *Meric* identical to the opponent's "Entertainment" in that the services designated by the trade mark application are included in a more general category designated by the earlier mark.

29. If I am wrong about “provision of information on entertainment via pod cast” “ticket agency services (entertainment)” being *Meric* identical to the opponent’s “Entertainment”, then both those services are highly similar to the opponent’s service. There is complementarity in that entertainment is indispensable to the provision of information on entertainment and enertainment ticketing.

30. In comparing “video recordings (not downloadable) provided from the Internet”, “video recordings provided by on-line streams”, “Digital music (not downloadable) provided from the Internet”, “presentation … and performance of shows, musical shows, concerts, videos, multimedia videos and radio and television programmes”, “video performances” and “concert, musical and video performances” with the opponent’s “Entertainment”, I find that the applicant’s services are all forms of entertainment and I therefore find the respective services to be identical. If I am wrong, they are at least highly similar.

31. “Film production” and “production of films, video tape film production … ” are *Meric* identical to the opponent’s “Production of films, radio or television programmes, rental of films, music recordings” in that the services designated by the trade mark application are included in a more general category designated by the earlier mark.

32. “ … rental of sound recordings … ” is *Meric* identical to the opponent’s “ … rental of … music recordings” in that the service designated by the earlier mark is included in a more general category designated by the trade mark application.

33. “Production of … sound recordings” is *Meric* identical to the opponent’s “Production of … radio programmes … ” in that the service designated by the earlier mark is included in a more general category designated by the trade mark application.

34. The opponent's "Sound recordings (not downloadable) provided from the Internet" and "sound recordings provided by on-line streams" encompass the applicant's "digital music (not downloadable) provided from the Internet". In the absence of a fall back specification, I deem this service to also be identical.

35. "Education" and "Education services" are *Meric* identical to the opponent's "Tuition" in that that the service designated by the earlier mark is included in a more general category designated by the trade mark application.

36. "Arranging and conducting of educational training events, arranging and conducting of colloquiums, congresses, conferences, seminars and symposiums for cultural and educational purposes" is *Meric* identical to the opponent's "Arranging and conducting of colloquiums, conferences and congresses in the music field … " in that the services designated by the earlier mark are included in a more general category designated by the trade mark application.

37. "Arranging of competitions, arranging of exhibitions for cultural or educational purposes, arranging of sporting contests, arranging and conducting of training workshops" is *Meric* identical to the opponent's " … organisation of exhibitions and competitions for cultural, recreational or educational purposes in the music field" in that in that the services designated by the earlier mark are included in a more general category designated by the trade mark application.

38. "Publishing" is *Meric* identical to the opponent's "Publishing of books, newspapers, magazines, journals, CD-ROMs, musical scores" in that the services designated by the earlier mark are included in a more general category designated by the trade mark application.

39. "Publication of manuals" is *Meric* identical to the opponent's "Publishing of books … " Manuals are lengthy, detailed "how-to" publications produced in book form. As such, the service designated by the trade mark application are included in a more general category designated by the earlier mark.

40. “Music publishing” is *Meric* identical to the opponent’s “Publishing of music and books and audiovisual media of all kinds” in that the service designated by the trade mark application is included in a more general category designated by the earlier mark.

41. Arranging and conducting of … conferences … ” is *Meric* identical to the opponent’s “Arranging and conducting … conferences … in the music field or for entertainment” in that the services designated by the earlier mark are included in a more general category designated by the trade mark application.

42. “Ticketing and event booking services” is *Meric* identical to the opponent’s “Booking of seats for shows” in that the services designated by the earlier mark are included in a more general category designated by the trade mark application.

43. “Arranging and conducting of … exhibitions” is *Meric* identical to the opponent’s “ … organisation of exhibitions … for cultural, recreational or educational purposes in the music field” in that the services designated by the earlier mark are included in a more general category designated by the trade mark application.

44. I compare “Sound recording, film and video production and distribution services” with the opponent’s “Editing and production of audiovisual or musical works on audio, video and digital data carriers”. They are similar in nature in that they both deal with the video and audio production process, albeit the former also encompasses distribution. The users would be same, professional content makers, as would the trade channels. They are not in competition. There is an element of complementarity in that the applicant’s distribution services could be important to the opponent’s content production services. I think it likely that the average consumer may think the responsibility for the services lies with the same undertaking, given that content production companies sometimes also have distribution networks. Overall, I find the respective services to be highly similar.

45. “Publication of books and texts, other than publicity texts” and “Publication of books, magazines and other texts” are potentially similar to the opponent’s “Publishing of books, newspapers, magazines, journals … , musical scores.” The references to “books” are identical and newspapers, magazines, journals and musical scores are all forms of texts whereby the trade channels – book shops, news agents and supermarkets – coincide. The respective services are highly similar.

46. “Recording, film, video and television studio services” and “audio, film, video and television recording services” are highly similar to the opponent’s “Musical, film, television and radio recording studio services”.

47. The applicant’s “ … rental of … video tapes” is potentially similar to the opponent’s “ … rental of films … ”. The former is the rental of a particular format of video recording, while the latter is the rental of films, as in feature films. Films are one of the types of material that would feature on video tapes that were for rental, another example being documentaries. The broad purpose is the same, to hire out material on video, and the users are the same – the general public. The trade channels also coincide. They are in competition to the extent that one may choose to rent a film on video tape or may choose to rent it on a different format. There could be an element of complementarity in that the rental of video tapes would be important to films, but they are also available on other formats. Overall, I find the respective services to be highly similar.

48. I compare the applicant’s “production of video … recordings” and “ … production … of shows, musical shows, concerts, videos, multimedia videos and radio and television programmes” with the opponent’s “Editing and production of audiovisual or musical works on audio, video and digital data carriers”. There is similarity in that they all involve the production process and the “editing” referred to in the opponent’s term could be said to be a part of the production process. They also all involve sound and vision. Shows and concerts might be seen as live events, but such events could be

produced on the opponent's "data carriers". I find the respective services to be highly similar.

49. "Publishing reviews" is potentially similar to the opponent's "Publishing of … newspapers, magazines, journals … ". Reviews are articles which comment on and critique books, films and so on, and their route to publication is often newspapers, magazines and journals, so the trade channels coincide to that extent. While reviews will generally be found in newspapers and so on, there can be freestanding reviews websites, but, even here, the subject matter of the reviews can be common to both standalone websites and traditional publications. They have the same essential nature – the printed word (whether physical or online) and so they are all reading matter, and they have the same users. Overall, I find reasonably high similarity between the respective services.

50. I compare the applicant's "provision of non-downloadable content, namely, providing a website featuring vlogs relating to … sporting and educational matters" to the opponent's "Editing and production of audiovisual or musical works on audio, video and digital data carriers". They differ in nature, the one being the provision of finished content, the other being the editing and production of such content. The broad purpose, usable content, is the same. The users differ, finished content being used by the general public, editing and production services being used by content makers. The trade channels would also consequently differ. The services are not in competition, but there is complementarity in that editing and production services are very important to content providers and I think it likely that the average consumer may think the responsibility for the services lies with the same undertaking given that the providers of content often also make content. Overall, I find the respective services to be of medium similarity.

51. "Compere services" are potentially similar to the opponent's "DJ services … " The users are the same, organisers of events. The trade channels could coincide in that agencies which provide services for weddings, dinners, and so on, could feature both DJs and comperes on their books, albeit they would be categorised separately in a catalogue or on a website. Although the roles

have a core aspect – the spoken word versus playing music, the roles can overlap such as when a DJ also is also required to introduce people/acts and to make announcements during the course of an evening and therefore the roles can be in competition. The services are not complementary. Overall, I find these services to be of medium similarity.

52. "Television programming" is potentially similar to the opponent's "Production of … television programmes … " While the former is the scheduling of television programmes, the latter is the actual making of television programmes. Television programming is used by television stations as is the production of television programmes. The trade channels could coincide in that television channels would source such services from the same parts of the web. While the services are not in competition, there could be complementarity in that the production of television programmes is indispensable to their scheduling. One company could offer both production of programmes as well as expertise and technical proficiency in their scheduling. Consequently, I do think it likely that the average consumer may think the responsibility for the services lies with the same undertaking. Overall, I find the services to be of medium similarity.

53. "Provision of news and news information via a computer network and/or the Internet" is potentially similar to the opponent's "Publishing of … newspapers … " Provision of news via a computer system and the service of publishing the finished product differ in nature. The former is about news that has been formulated to the point where it can be finalised, ready for publication, the latter is about the actual publication process. The user groups are very similar: for the former, professional people – journalists and editors, for the latter, owners of newspapers and their employees. While they are not in competition, there is complementarity, in that the news provision service must have a conduit, whether that is physical or online publication. Given that it is entirely possible that the same company could both technically collate and physical publish the news, I think it likely that the average consumer – a professional person or newspaper owner - may think the

responsibility for the services lies with the same undertaking. I find these services to be of medium similarity.

54. "Provision of non-downloadable content, namely, providing a website featuring non-downloadable classes, seminars, webinars, workshops" and "arranging and conducting of seminars … ", "Education services relating to sports" and "Motivational speaking for … educational purposes" are potentially similar to the opponent's "Tuition". While in the context of motivational speaking, it could be argued that inspiring students to learn is one of the functions of tuition, these services at least all feature tuition as a component part, but they can also include information which is simply made available in a non-didactic manner. The trade channels would coincide where packaged learning can be obtained from the same source as the freestanding services of a tutor in a given subject and they could also be in competition. There is complementarity in that tuition is a necessary part of the applicant's services and I think it likely that the average consumer may think the responsibility for the services lies with the same undertaking due to the fact that educational providers often supply packaged educational services in general as well as tuition in particular. I find these services to be of medium similarity.

55. "Modelling services for artists" are dissimilar to the opponent's services.

56. Where the opponent's services have not been cited as potentially comparable to the applicant's services, that is because those comparisons would not put the opponent in a stronger a position than the ones I have referenced.

57. In addition to those of the applicant's goods and services which are not contested and which will proceed to registration, some degree of similarity between the services that I have analysed is required for there to be a likelihood of confusion[2], so the opposition must fail in respect of the following services in the applicant's specification:

[2] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Class 41 Modelling services for artists.

The average consumer and the nature of the purchasing act

58. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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."

59. In the case of entertainment, film, television, music, books and magazines, as well as ticket agencies and compere and DJ services, the average consumer will be a member of the public. While consuming some of the services could inolve a degree of consideration, such as when a subscription, with terms and conditions, is being purchased, or when the service being bought involves an evening out, many transactions will be one-off home-consumed purchases. The level of attention required will be medium.

60. Publishing services and the provision of news would be utilised by professional people involved in publishing and newspapers. Such people would enter into agreements that would require a reasonable level of scrutiny

as to the particulars of the service and the cost and would, on average, require a medium degree of attention.

61. Educational services, whether as packaged services or freestanding tuition, are such that the average consumer (either a member of the public as the end user, or a professional person at a school, college, or university) would consider the cost, the course content, and the credentials of the tutors. The average consumer would pay a medium degree of attention in this case.

62. Professional services, such as having television programmes made or utilising film studios, have professional people as consumers. Working for content providers, such as television channels, the average consumer would be responsible for potentially considerable costs and the contract entered into might be extremely detailed. The level of attention involved would be high.

63. Professional people would also be the customers for the organisation of shows, exhibitions and competitions. While some of these events would be one day affairs, many could be medium or long running, and all would involve significant costs and complex arrangements. I would say that such services would require a high level of attention on the part of the average consumer.

64. In all of the above scenarios, visual scrutiny of the services on offer will predominate, with verbal factors playing a lesser role.

Comparison of the trade marks

65. 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

66. 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.

67. The respective trade marks are shown below:

Opponent's trade mark	**Applicant's trade mark**
LOST FREQUENCIES	LOST

68. The opponent makes no specific comment as to the similarity of the marks.

69. In its submission, the applicant argues that the marks are aurally, visually and conceptually dissimilar.

70. Aurally, the applicant contends that its mark, being one syllable and one word by comparison with four syllables and two words results in a "far different" "phonetic effect". It also argues that the second word of the opponent's "LOST FREQUENCIES" is "clearly the dominate element of the mark from an

aural perspective." Visually, the applicant says that the viewer will be drawn to the longer and "more technical" second word in "LOST FREQUENCIES" which will outweigh the four-letter element "LOST" that is common to the two marks.

71. Conceptually, the applicant talks about the context of intended use for its mark, the term "LOST" being used as a means of the applicant's "immersive and experiential entertainment" business communicating a social and political message in relation to groups whose history has been lost. I note, however, that I must make my assessment of conceptual similarity on a notional basis. The applicant also asserts that the opponent's " … FREQUENCIES" "lend meaning to the technical aspect of sound reproduction through vibrations".

72. I now carry out my assessment of the marks.

73. The applicant's mark is a plain word mark, "LOST". The opponent's mark is a plain word mark, "LOST FREQUENCIES", in which neither word dominates the other, the two words forming a unit. There are no other elements that contribute to the overall impressions of the marks.

74. Visually, both marks are plain word marks. The applicant's mark consists of one four-letter word that is identical to the first word of the opponent's two-word mark, the second word of which has eleven words. The point of difference being much longer than the point of similarity, I find the marks to be of low to medium visual similarity.

75. Aurally, "LOST" and "LOST FREE-KWEN-SEES" are phonetically identical to begin with, but the opponent's mark has a second word which is entirely different phonetically. The point of difference being much longer than the point of similarity, I find the marks to be of low to medium aural similarity.

76. Conceptually, "LOST" conveys the concept of something that cannot be found. "LOST FREQUENCIES" imparts the idea of frequencies that cannot be found. Whilst both marks make reference to something that is lost, which

imparts a degree of conceptual similarity, the additional context of the opponent's mark means that this is not a strong one.

Distinctive character of the earlier mark

77. 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)."

78. Registered trade marks possess varying 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.

79. I must make an assessment of the inherent distinctive character of the earlier mark. The two words “LOST FREQUENCIES” are not invented and so the mark does not stand out strongly. For those of the opponent’s services that relate to radio, sound, the audiovisual, or to music, I find the mark to be mildly descriptive of the services for which the mark is registered and consequently I find it to be of low to medium inherent distinctive character for such services. This is because the words evoke thoughts of sound waves, all of which have a part to play in radio, sound, the audiovisual, and music. For those of the opponent’s services that do not fall into those categories, I find the mark to be of medium inherent distinctive character.

Likelihood of confusion

80. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or 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, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to 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 that they have retained in their mind.

81. I have found the parties’ marks to be visually and aurally similar to a low to medium degree and that the degree of conceptual similarity between the

marks is not strong. In terms of average consumers and the purchasing act, I have found that, for entertainment and allied services to the general public, the level of attention paid would be medium. It would also be medium for publishing services and the provision of news, and for educational services, all of these having both members of the public and professional people as typical consumers. I have also found that, for professional services, where the average consumer is a professional person – making films and television programmes, and organising shows, the degree of attention paid would be high. In all cases, visual considerations will predominate during the purchasing process. According to the services being considered, the inherent distinctiveness of the earlier mark ranges from low to medium, to medium. I have found the parties' contested services to be identical, highly similar, reasonably highly similar, of a medium level of similarity, or dissimilar.

82. I consider that there are sufficient differences between the marks to avoid them being mistakenly recalled as each other. While the applicant's one word mark and the first word of the opponent's mark are one and the same, the second word of the applicant's mark is eleven letters long, something which also gives specific context to the thing that is lost. That is a clear point of difference and there is no likelihood of direct confusion.

83. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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 recognised 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."

84. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

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

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

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one

of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

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

85. While the average consumer would notice the difference between "LOST" and "LOST FREQUENCIES", I now consider whether they would see one as a brand variation of the other, or whether there is some other reason why they would conclude that the services come from the same or an economically linked undertaking. "LOST FREQUENCIES" forms a wholistic unit i.e. these words are likely to be perceived and remembered cohesivey as "LOST-FREQUENCIES" (frequencies being the thing that is lost) rather than segmentally as "LOST plus FREQUENCIES" or "LOST/FREQUENCIES". As such, the word "LOST" in "LOST FREQUENCIES" does not perform an independent distinctive role within the mark. As noted in *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, I must guard against finding that there is a likelihood of indirect confusion merely due to the presence of a common element in the marks.

86. I am also conscious of the examples referred to in the *L.A. Sugar* case:

"17. Instances where one may expect the average consumer to reach such a conclusion [that the the later mark is another brand of the owner of the earlier mark] tend to fall into one or more of three categories:

(a) 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).

(b) 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.).

(c) 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).”

Looking at the examples given above, which I accept are not exhaustive, the scenario before me does not clearly fall within them. The common element is by no means strikingly distinctive, the additional word is not a qualifying word that one might expect to see in a sub-brand or brand extension, nor does this case involve a logical and consistent change of elements.

87. Further, when considering Iain Purvis Q.C.’s analysis of the average consumer’s mental process in the *L.A. Sugar* case, “LOST FREQUENCIES” and “LOST” would not prompt the average consumer to consider that what the marks have in common derives from them being part of the same or related undertakings. At most, one mark might be called to mind by the other (although I do not think that will be a common reaction) and that is not a sufficient basis for a finding of indirect confusion, it being mere association (as noted in the *Duebros Limited* case). Overall, I find no likelihood of indirect confusion between the marks in this case.

CONCLUSION

88. The opposition has failed. The application will proceed to registration, subject to appeal.

COSTS

89. The applicant has succeeded. In line with Annex A of Tribunal Practice Notice 2 of 2016, I award costs to the applicant as below.

Considering the opposition and preparing a counterstatement:	£200
Preparation of submissions:	£300
Total:	**£500**

90. I order Félix Safran DE LAET to pay AERODROME LTD the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of July 2021

JOHN WILLIAMS
For the Registrar