

O-886-21

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3334167

BY CAVELL COO

TO REGISTER

BAMN
BY ALL MEANS NECESSARY

AS A TRADE MARK IN CLASSES 16, 21, 25 AND 41

AND

OPPOSITION THERETO

UNDER NO. 415401

BY RICKY WONG

Background and pleadings

1. On 26 August 2018, Cavell Coo (“the applicant”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes on 9 November 2018.
3. Ricky Wong (“the opponent”) filed a notice of opposition on 11 February 2019. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed only against the goods in Classes 25 and 41 in the application, namely:
 - Class 25 Clothing; Headwear; Footwear.
 - Class 41 Music entertainment services
4. The opponent bases its claim on the following United Kingdom (“UK”) trade mark registrations:

Mark 1: BAMN

Registration no. 3315162

Filing date: 4 June 2018

Registration date: 31 August 2018

Goods relied upon:

Class 25 Clothing; Headwear; Footwear.

Class 41 Audio, video and multimedia production, and photography;
Arranging and conducting of entertainment events

Mark 2: By Any Means Necessary

Registration no. 3317620

Filing date: 13 June 2018

Registration date: 7 September 2018

Goods relied upon:

Class 25 Clothing; Headwear; Footwear.

Class 41 Audio, video and multimedia production, and photography;
Arranging and conducting of entertainment events

5. Given their dates of filing, the trade marks upon which the opponent relies qualify as earlier trade marks in accordance with section 6 of the Act.
6. The opponent argues that there is a likelihood of confusion because the respective marks are similar and the goods and services are identical or similar. The applicant filed a counterstatement denying the grounds of opposition.
7. Both parties are unrepresented. The opponent filed written submissions. Only the applicant filed evidence.
8. Although the UK has left the European Union ("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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

9. The evidence comes in the form of the witness statement of Mr Cavell Coo dated 28 July 2020, together with 5 exhibits. According to Mr Coo, he first used the contested mark in 2014 "in the form of music". Mr Coo claims that he wrote a song titled BAMN, which he performed on many occasions since 2014 and released albums under that title or "BAMN By All Means Necessary" on mediums such as Spotify and YouTube. Mr Coo also claims that he offers t-shirts with prints titled "BAMN By All Means Necessary" for sale through his website.
10. It appears to me that the applicant's intention behind filing the evidence was to substantiate a claim of an earlier right. However, I must clarify for the applicant's sake that such evidence is of no assistance to the issues before me. This is

because any claim of an earlier right can be helpful only if it is launched, in a separate proceeding, to challenge the validity of an earlier mark.¹ As long as the earlier mark is valid, which is the case here, I must assess a likelihood of confusion based on the identity/similarity of the respective marks and the goods and services.

DECISION

Section 5(2)(b)

11. The opposition is based upon section 5(2)(b) of the Act, which read as follows:

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

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

Case law

12. The following principles are gleaned from the judgments of the European Union (“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 C3/03, *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:

¹ TPN 4/2009 para 5 (If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark).

(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 the 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 goods and services

13. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“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”.

14. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) held that the goods can be considered as identical when the goods and services designated

by the earlier mark are included in a more general category designated by the trade mark application or vice versa.

15. The competing goods and services are as follows:

Applicant's goods and services	Opponent's goods and services
Class 25 Clothing; Head wear; Footwear.	Class 25 Clothing; Headwear; Footwear.
Class 41 Music entertainment services.	Class 41 Audio, video and multimedia production, Arranging and conducting of entertainment events.

16. I find that all of the applicant's goods and services are identical to the opponent's specification for the following reasons:

The terms clothing, headwear and footwear are identically contained in both specifications. In relation to the services in Class 41, the applicant's music entertainment services are covered by the broad term "arranging and conducting of entertainment services" in the opponent's specification. The services are, therefore, identical under the *Meric* principle.

The average consumer and the nature of the purchasing act

17. It is necessary for me to determine who the average consumer is for the respective parties' goods and services.

18. 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”.

19. The average consumer of the competing goods and services is a member of the general public.

20. The goods are likely to be purchased reasonably frequently and, although they will vary in price, they are unlikely to be highly expensive. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative or a purchase is made further to a word-of-mouth recommendation. When making a purchase, factors such as size, material, colour, cost (which will vary according to the item) may be considered. These factors suggest that the average consumer will pay a medium level of attention when making their selection.

21. The Class 41 services also seem to be services aimed at the general public. These are likely to be selected with a medium degree of attention. In terms of selection process, the services are likely to be selected primarily by visual means from advertisements on paper or online and from catalogues or brochures. However, word of mouth recommendations and orders will also play a part in the selection process.

Distinctiveness of the earlier marks

22. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

23. 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. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

24. As the opponent filed no evidence, I have only the inherent position to consider. The earlier mark BAMN appears to be an invented word with no meaning. On that basis, I find that the mark is distinctive to a high degree. In relation to the second earlier mark “By Any Means Necessary”, the mark does not have any allusive character in relation to the opponent’s goods and services. I, therefore, conclude that the earlier mark possesses a medium degree of distinctive character.

Comparison of marks

25. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 between the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

26. The CJEU stated in 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.”

27. It would be wrong, therefore, artificially to 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.

28. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
Mark 1: BAMN Mark 2: By Any Means Necessary	BAMN By All Means Necessary

29. I will first consider the position in relation to the earlier mark BAMN. The overall impression and distinctiveness of the mark lie in the word BAMN.

30. In the applicant's mark, the average consumer is likely to see the letters B-A-M-N as an acronym for the words "By All Means Necessary". The overall impression and the distinctiveness of the applicant's mark lie in the combination of all the elements it comprises.

31. Visually, the opponent's mark is wholly contained in the applicant's mark. As readers' eyes are more likely to be drawn to the first part of the mark, the presence of BAMN at the beginning of the applicant's mark is likely to have a significant impact on the average consumer. In terms of difference, the applicant's mark contains the additional words "By All Means Necessary". Considering all these factors, I find that the marks are visually similar to a medium degree.

32. In an aural comparison, BAMN in the respective marks will be given an identical pronunciation. The aural difference between the marks is introduced by the remaining verbal elements in the applicant's mark, which will be pronounced conventionally. Given that those words constitute at least two-thirds of the applicant's mark, I find that the marks are aurally similar to a medium degree.

33. I now turn to the conceptual comparison. In the applicant's mark, the average consumer would see BAMN as a reference to the abbreviation for "By All Means Necessary". In contrast, the opponent's mark does not give a message of what BAMN stands for. It is more likely to be seen as an invented word. In *AMS Advanced Medical Services GmbH v OHIM*, while considering the conceptual

similarity between the earlier mark “AMS Advanced Medical Services” and the later mark “AMS”, the Court held that consumers who have seen the earlier mark could attribute the same meaning to the later mark.² I see no reason why the consumers who have seen the earlier mark BAMN when encountered with the later mark “BAMN By All Means Necessary” would not attribute the same meaning to the common element BAMN. On that basis, I find that the marks are conceptually identical.

Likelihood of confusion

34. The factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). They must be considered from the perspective of the average consumer and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

35. Confusion can be direct (which occurs when 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 goods/services down to the responsible undertaking being the same or related).

36. The difference 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

² T-425/03

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”.

37. Earlier in the decision, I concluded that the respective marks are visually and aurally similar to a medium degree and conceptually identical. I found that the average consumer is likely to purchase the respective goods and services with a medium degree of attention. I also found that the goods and services are identical, and the earlier marks are inherently distinctive to either high or medium degree.
38. Applying these conclusions, I find that there is a likelihood of direct confusion. The presence of the common string of letters BAMN that constitutes the entirety of the opponent’s mark is sufficient for the average consumer to mistake one mark for the other. When selecting identical goods and services, the average consumer is only likely to consider the additional words “By All Means Necessary” as abbreviating the opponent’s mark BAMN.
39. Since the opponent has succeeded in relation to the mark I have considered, it is in no better position than its other mark. However, for the record, I would briefly consider the second earlier mark “By Any Means Necessary”.
40. Visually, I do not consider that there is any material difference between the phrases “By Any Means Necessary” and “By All Means Necessary”. The applicant’s mark, however, contains the letters BAMN which appears at the beginning of the mark. Weighing up the similarities and differences, I find that the marks are visually similar to a medium degree.

41. In terms of aural comparison, the marks coincide in the pronunciation of the words “By Means Necessary”. The aural difference is introduced by the word BAMN and the words any/all. Considering these factors, I find that the marks are aurally similar to a medium degree.
42. In a conceptual comparison, as mentioned earlier in the decision, BAMN in the applicant’s mark would be seen as a reference to the abbreviation for “By All Means Necessary”. The phrases “By All Means Necessary” and “By Any Means Necessary” essentially signify that a person is going to do whatever it takes to accomplish an aim. On that basis, I find that the marks are conceptually identical. If I am wrong and there is a slight conceptual difference introduced by the words all and any in the respective marks, then the marks are conceptually similar to a high degree.
43. My findings set out in paragraph 16 applies to the comparison of the goods and services.
44. Applying these conclusions, I find that there is a likelihood of direct confusion. The central issue of imperfect recollection applies here as well as there is no material difference between “By All Means Necessary” and “By Any Means Necessary”. Moreover, BAMN in the applicant’s mark is only likely to be seen as a reference to the abbreviation of the opponent’s mark. The average consumer who applies a medium degree of attention to the selection of the identical goods and services is likely to misremember the differences and mistake one mark for the another.

Conclusion

45. The opposition has succeeded in full. As this opposition is directed only against the goods and services in Classes 25 and 41, the application will be refused only in relation to those goods and services. The application will proceed to registration in relation to the unopposed goods in Classes 16 and 21.

Costs

46. The opponent has been successful and is entitled to an award of costs. The opponent was not professionally represented and submitted a completed cost proforma to the Tribunal on 2 December 2021, outlining the number of hours spent on these proceedings. I set out below my assessment on the claim made. However, it should be noted that a costs award is intended to be a contribution towards costs rather than full compensation. I will make the award of costs on the basis of £19.00 per hour, which is the minimum rate of compensation allowed under The Litigants in Person (Costs and Expenses) Act 1975 (as amended). The opponent claims that it has spent the following amount of time on the proceedings:

- Notice of opposition and considering the Form TM8 filed by the applicant: 6 hours

This seems to be a reasonable amount of time.

- Considering and commenting on the other side's evidence: 18 hours

I note that the opponent has not provided any written comments on the applicant's evidence. The official records indicate that the opponent had requested a Case Management Conference ("CMC") to challenge the registry's preliminary view to allow a retrospective extension of time to the applicant to file the evidence. However, I note that a decision was later made in the applicant's favour. In any event, I am of the view that it is excessive to claim 18 hours for considering the applicant's evidence which I think was light. 4 hours seems to be a reasonable amount of time.

- Preparing for a hearing: 4 hours.

As no hearing was requested, I decline to award any costs in that regard.

I, therefore, award the opponent a total of £290 (£190 (10 hours at £19 per hour) + £100 (official fee)).

47. I order Cavell Co to pay Ricky Wong the sum of £290. 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 8th day of December 2021

Karol Thomas
For the Registrar