

BL O/0525/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003552262

BY THOMAS ALI LTD

FOR THE FOLLOWING TRADE MARK:

SUPERHUMANS

IN CLASS 41

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 504784

BY ROBERT HOLCROFT PAGE

AND

IN THE MATTER OF APPLICATION NO. UK00003713283

BY THOMAS ALI LTD

TO REGISTER THE TRADE MARK:

WE ARE SUPERHUMANS

IN CLASS 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 431322

BY ROBERT HOLCROFT PAGE

BACKGROUND AND PLEADINGS

1. Thomas Ali Ltd (“TAL”) applied to register the trade mark **SUPERHUMANS** (“**262 Mark**”) in the UK on 5 November 2020. It was registered on 16 April 2021 for the following services:

Class 41 Education relating to breathing exercises and breathwork; education in the field of health and wellness through breathing exercises and breathwork; providing of training relating to breathing exercises and breathwork; health and wellness training through breathing exercises and breathwork; exercise classes and instruction relating to breathing exercises and breathwork; fitness classes, training and instruction relating to breathing exercises and breathwork; entertainment relating to breathing exercises and breathwork; providing of non-downloadable news, publications, recordings, education, programmes and other content relating to breathing exercises and breathwork; providing of non-downloadable news, publications, recordings, education, programmes and other content in the field of health and wellness through breathing exercises and breathwork; publishing of online, electronic, magnetic, optical, digital, downloadable and non-printed blogs, books, newspapers, magazines, articles, texts, newsletters, feeds, web pages, web sites and, recordings relating to breathing exercises and breathwork; publishing of online, electronic, magnetic, optical, digital, downloadable and non-printed blogs, books, newspapers, magazines, articles, texts, newsletters, feeds, web pages, web sites and, recordings in the field of health and wellness through breathing exercises and breathwork; production of radio, television and internet programmes relating to breathing exercises and breathwork; production of radio, television and internet programmes in the field of health and wellness through breathing exercises and breathwork; presentation of radio, television and internet programmes relating to breathing exercises and breathwork; presentation of radio, television and internet programmes in the field of health and wellness through breathing exercises and breathwork; performances and live performances relating to breathing

exercises and breathwork; advice, information and assistance relating to all the aforesaid; including (but not limited to) any of the aforesaid services provided online, and/ or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless communication networks.

2. On 22 October 2021, TAL also applied to register the trade mark **WE ARE SUPERHUMANS** (“**283 Mark**”) shown on the cover page of this decision in the UK. The application was published for opposition purposes on 26 November 2021. TAL seeks registration for the same class 41 services above.

3. On 13 April 2022, Robert Holcroft Page (“RHP”) applied to have the **262 Mark** declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b).

4. On 24 February 2022, RHP also filed an opposition against the application of the **283 Mark**, based upon section 5(2)(b) of the Act.

5. For both the invalidation and opposition proceedings, RHP relies on the following trade mark:



(Series of 2)

UK registration no. UK00003245732

Filing date 24 July 2017; registration date 13 October 2017.

Relying upon all goods and services for which the earlier mark is registered, namely:

- Class 9 E-books; publications in electronic form; publications in electronic form relating to education, training, business training, career counselling, mental and physical health; software downloadable from the Internet; compact discs; downloadable information provided on-line from databases or the Internet; films, videos, DVDs, CD ROMs; digital recording media; databases; audio and audio-visual recordings.
- Class 16 Printed matter; printed publications, books, booklets, leaflets, pamphlets, stationery, gift cards, printed information sheets, printed teaching materials, printed seminar notes, printed training materials, printed educational materials, printed vouchers, printed coupons, printed certificates, printed award certificates.
- Class 41 Training and instructional services; business training; life coaching; career counselling and coaching; physical education services; training in public speaking; Pilates instruction; publication services; publication of electronic publications; publication of educational materials; production of video records; production of video podcasts; public speaking services.
- Class 44 Counselling services; human healthcare services; therapy services; psychotherapy and occupational therapy services; counselling relating to holistic psychology and occupational therapy; counselling in the field of mental health and wellness; psychological and lifestyle counselling; physical therapy services; therapeutical Pilates services; reiki services; chiropractic services; hypnotherapy services; herbalism; alternative medicine services; acupuncture, homeopathy, complementary medicine, Chinese medicine, massage and therapy services; injury assessment and treatment services; speech therapy.

6. In both proceedings, RHP claims that there is a likelihood of confusion because of the high degree of similarity between the marks and the identity/similarity of the goods and services.

7. TAL filed counterstatement in both proceedings denying the claims made.

8. On 8 August 2022, the Tribunal wrote to the parties informing them of the consolidation of the invalidation action no. 504784 and the opposition no. 431322.

9. RHP is represented by Roome Associates Limited, and TAL is represented by Beck Greener LLP. Neither party requested a hearing, but RHP filed submissions during the evidence rounds and submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

10. 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 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.

DECISION

The Invalidation

11. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(2)(b)

12. Section 5(2)(b) 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.”

13. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply.

14. The opponent may rely on all of the goods and services it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

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

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

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

16. TAL's services are listed in paragraph 1 above, and RHP's goods and services are listed in paragraph 5 above.

17. When making the comparison, all relevant factors relating to the goods and 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 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."

18. Guidance on this issue has 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

19. 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 für Lemsysteme 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.”

20. 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.”

21. 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.”

22. 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. (as he then was) noted, as the Appointed Person, in *Sandra Amalia 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.”
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.”

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.”

23. Firstly, I note that the following limitation applies to all of TAL’s class 41 services; *including (but not limited to) any of the aforesaid services provided online, and/ or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless communication networks*. I consider that this limitation does not sufficiently limit TAL’s specification

because of the wording “including (but not limited to)”. Therefore, I will continue with my comparison without referring to the limitation as it does not have any impact on my assessment.

Education relating to breathing exercises and breathwork; education in the field of health and wellness through breathing exercises and breathwork.

24. “If someone gives you instruction in a subject or skill, they teach it to you”.¹ I therefore consider that TAL’s above services fall within the broader category of “training and instructional services” in RHP’s specification. They are identical on the principle outlined in *Meric*.

Providing of training relating to breathing exercises and breathwork; health and wellness training through breathing exercises and breathwork; exercise classes and instruction relating to breathing exercises and breathwork; fitness classes, training and instruction relating to breathing exercises and breathwork.

25. I consider that TAL’s above services fall within the broader category of “training and instructional services” in RHP’s specification. I consider them identical on the principle outlined in *Meric*.

Providing of non-downloadable news, publications, recordings, education, programmes and other content relating to breathing exercises and breathwork; providing of non-downloadable news, publications, recordings, education, programmes and other content in the field of health and wellness through breathing exercises and breathwork; publishing of online, electronic, magnetic, optical, digital, downloadable and non-printed blogs, books, newspapers, magazines, articles, texts, newsletters, feeds, web pages, web sites and, recordings relating to breathing exercises and breathwork; publishing of online, electronic, magnetic, optical, digital, downloadable and non-printed blogs, books, newspapers, magazines, articles, texts, newsletters, feeds, web pages, web sites and, recordings in the field of health and wellness through breathing exercises and breathwork.

¹ <https://www.collinsdictionary.com/dictionary/english/instruction> accessed 1 June 2023

26. I consider that all of TAL's above services fall within the broader categories of "publication services", "publication of electronic publications", and "publication of educational materials" in RHP's specification. I consider them identical on the principle outlined in *Meric*.

Production of radio, television and internet programmes relating to breathing exercises and breathwork; production of radio, television and internet programmes in the field of health and wellness through breathing exercises and breathwork.

27. RHP submits that TAL's above services are identical to "production of video records" and "production of video podcasts". I do not agree that they are identical, however, I note that all of the services are production services, which would be provided by production companies, which are used for entertainment, informative or educational purposes. Therefore they overlap in trade channels and purpose. However, the nature and method of use of the services differ with TAL's services in relation to the production of radio, television and internet programmes, specifically on breathing exercises and breathwork, and RHP's services in relation to the production of video and podcasts. I do not consider that the services are complementary, however, they may to some extent be in competition. I therefore consider that the services are similar to between a medium and high degree.

Performances and live performances relating to breathing exercises and breathwork.

28. RHP submits that TAL's above services are identical to "production of video records" and "production of video podcasts". However, I disagree. I consider that TAL's above services more likely overlap with RHP's "public speaking services". I consider that public speaking could be considered as a type of performance. I also consider that RHP's public speaking services could cover talks on a variety of subjects, including the topic of breathing and breathwork. I therefore consider that RHP's services overlaps in nature, method of use and purpose with TAL's above services. I consider that there could also be an overlap in user, and that the services may, to some extent, be in competition. However, they are not complementary, nor do I consider that there is an overlap in trade channels as TAL's services are more likely to be provided by entertainment undertakings and RHP's services would be provided

by public speaking undertakings. Consequently, the services are similar to a medium degree.

Presentation of radio, television and internet programmes relating to breathing exercises and breathwork; presentation of radio, television and internet programmes in the field of health and wellness through breathing exercises and breathwork.

29. I consider that TAL's above services would be provided by broadcasting companies which specialise in radio, TV and internet programmes, which would be used by the general public. I note that RHP's "production of video records" and "production of video podcasts" services would most likely provided by production companies, however, I note that there are some undertakings which both produce and present their own video records, podcasts, radio, TV and internet programmes. Therefore, there may be some overlap in trade channels. I do not consider that there would be an overlap in user, because RHP's services would be provided to broadcasting companies, and the user of TAL's broadcasting companies is the general public. The services do not overlap in method of use, nature and purpose. They are not in competition, nor complementary. Taking all of the above into account, I consider that the services are similar to a low degree.

Entertainment relating to breathing exercises and breathwork.

30. I note that RHP submits that TAL's above services are identical to "production of video records" and "production of video podcasts". I do not consider that they are identical, however, video records and video podcasts are types of entertainment. Therefore, I consider that there could be an overlap in trade channels and purpose. However, I do not consider that the services overlap in nature and method of use. I also do not consider that there would be an overlap in user because RHP's services would be provided to broadcasting companies whereas the user of TAL's services would be the general public. They are neither in competition nor complementary. I consider that the services are similar to a low degree.

Advice, information and assistance relating to all the aforesaid.

31. As the above terms range from being identical, to similar to a low degree, it is likely that TAL's above term also overlaps with RHP's above services. The users of the goods will all overlap. There may also be an overlap in trade channels as the same entity is likely to provide both the services and advice, information and assistance in relation to these services. However, the method of use, nature and purpose will differ. The services will neither be in competition nor complementary. I therefore consider there to be a low degree of similarity between the services.

The average consumer and the nature of the purchasing act

32. 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.”

33. The average consumer for the services will be members of the general public. RHP submits that these consumers would have a “general interest in their health and wellbeing”. I agree. However, I also consider that the users will include professionals such as TV studios and broadcasting undertakings.

34. The cost of purchase is likely to vary, with the cost being higher for the professional user. The frequency of the purchase is also likely to vary. The average consumer will take various factors into consideration such as the cost, accessibility, ease of use and

suitability for the user's needs. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the services.

35. The services are likely to be purchased from production companies or multimedia entertainment platforms which allows you to download publications, videos and recordings. Alternatively, the services may be purchased following a perusal of advertisements or inspection of a catalogue. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods and services given that a recommendation may have been given through word-of-mouth.


Comparison of the trade marks

36. 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 of the trade marks must be assessed by reference to the overall impressions created by the trade 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.”

37. 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.

38. The respective trade marks are shown below:

RHP's trade mark	TAL's 262 trade mark
 <p data-bbox="384 981 603 1016">("Series of 2")</p>	<p data-bbox="847 645 1350 701">SUPERHUMANS</p>

39. RHP's marks both consist of the distinctive and dominant word element "superhumans" presented in lower-case, with a device flying over the letter "m". I consider that a significant proportion of average consumers would recognise the device as a flying cape. The first mark is presented in colour (the word super in the colour red, the cape in the colour blue, and the word humans presented in the colour grey). The second mark is presented in black and grey.

40. In spite of the differences in colour between the marks, it was deemed that the two marks met the criteria to be registered as a series. In *LOGICA* Trade Mark BL O/068/03, Professor Ruth Annand, sitting as the Appointed Person, outlined the conditions that need to be met under Section 41(2) of the Act, which states that:

"A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark."

41. Consequently, the colour differences between the marks will not make any impact upon my assessment, especially as the colour and the stylisation plays a lesser role in the overall impression of the mark. I also consider that the eye is naturally drawn to the element of the mark that can be read, and therefore, the cape device will play a lesser role in the overall impression of the mark.

42. TAL's mark consists of the word "SUPERHUMANS". There are no other elements to contribute to the overall impression which lies in the word itself.

43. Visually, the marks coincide in the word SUPERHUMANS. I note that it is presented in lower case in RHP's mark, and upper-case in TAL's mark. However, registration of a word only mark covers use in any standard typeface. This acts as a visual point of similarity. However, RHP's mark also contains the addition of the cape device above the letter "m". This acts as a visual point of difference. Taking the above into account, I consider that the marks are visually similar to a high degree.

44. Aurally, both marks will be pronounced identically (SUE-PER-HUE-MANS). The cape device will not be articulated in RHP's marks.

45. Conceptually, both marks will be understood as referring to a human with super powers, or in other words, as RHP states, "beings who have enhanced qualities and abilities that exceed those found naturally in humans". I consider that this concept is reinforced by the cape device in RHP's marks. I therefore consider that the marks are conceptually identical.

Distinctive character of the earlier trade mark

46. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

47. 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 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 that has been made of it.

48. As highlighted above, RHP’s marks both consist of the word “superhumans” presented in lower-case, with a cape device flying over the letter “m”. One mark uses colour (red and blue) and the other is presented in black and grey. However, the use of colour does not add to the distinctiveness of the mark. I note that the word “superhumans” is a concept which will be recognised by the average consumer, as a human with super powers. This is neither descriptive nor allusive of RHP’s services. I therefore consider that the marks are inherently distinctive to a medium degree.

Likelihood of confusion

49. 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 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the 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 he has retained in his mind.

50. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to a high degree.
- I have found the marks to be aurally identical.
- I have found the marks to be conceptually identical.
- I have found the opponent's mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the goods and services to be members of the general public, and professionals such as TV studios and broadcasting undertakings, who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' services to be identical to similar to a low degree.

51. Both marks consist of the word SUPERHUMANS. Therefore, bearing in mind the principle of imperfect recollection, I consider that the average consumer would overlook the cape device, and the colourway in RHP's marks, as they play a lesser role in the overall impression of the marks. Taking all of the above factors listed in

paragraph 50 into account, I consider there to be a likelihood of direct confusion, even on the services which are similar to a low degree.

52. In the event that I am wrong in that regard, and for the sake of completeness, I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he was then), 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 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.”

53. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

54. I consider that the shared common use of the dominant and distinctive word, SUPERHUMANS, in both marks will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that the average consumer will see RHP’s marks (which includes the additional stylisation, use of colour and cape device) as alternative marks being used by the same or

economically linked undertakings, perhaps being an updated version of the same mark, and therefore indicative of re-branding.


55. The application for invalidation is successful in its entirety.

The Opposition

56. I note that the opposition against the **283 Mark** is also based upon section 5(2)(b), and the services for which the **283 Mark** is applied for are the same services that I have compared against RHP's goods and services, in paragraphs 23 to 31 above. Therefore, as RHP is relying upon the same marks for these opposition proceedings, the same goods and services comparison, average consumer, and distinctive character paragraphs, applies as above. I will therefore go straight to the marks comparison and likelihood of confusion paragraphs.

Comparison of the trade marks

57. The respective trade marks are shown below:

RHP's trade mark	TAL's 283 trade mark
 <p data-bbox="384 1899 603 1937">("Series of 2")</p>	<p data-bbox="866 1529 1329 1648">WE ARE SUPERHUMANS</p>

58. RHP's marks both consist of the distinctive and dominant word element "superhumans" presented in lower-case, with a device flying over the letter "m". I consider that a significant proportion of average consumers would recognise the device as a flying cape. The first mark is presented in colour (the word super in the colour red, the cape in the colour blue, and the word humans presented in the colour grey). The second mark is presented in black and grey. The colour differences between the marks will not make any impact upon my assessment, especially as the colour and the stylisation plays a lesser role in the overall impression of the mark. I also consider that the eye is naturally drawn to the element of the mark that can be read, and therefore, the cape device will play a lesser role in the overall impression of the mark.

59. TAL's mark consists of the words "WE ARE SUPERHUMANS". I consider that the dominant and distinctive element of the mark lies in the word SUPERHUMANS, and therefore plays a greater role in the overall impression of the mark. The words "WE ARE" play a lesser role.

60. Visually, the marks coincide in the word SUPERHUMANS. I note that it is presented in lower case in RHP's mark, and upper-case in TAL's mark. However, registration of a word only mark covers use in any standard typeface. This acts as a visual point of similarity. However, RHP's mark also contains the addition of the cape device above the letter "m", and TAL's mark contains the addition of the non-distinctive words "WE ARE" at the beginning of the mark. Therefore as the marks overlap in the distinctive a dominant word element SUPERHUMANS, I consider that the marks are visually similar to above a medium degree.

61. Aurally, RHP's marks will be pronounced as SUE-PER-HUE-MANS (the cape device will not be articulated). TAL's mark will be pronounced as WE-R-SUE-PER-HUE-MANS. Consequently, the beginnings of the marks differ aurally. However, as the marks overlap in the pronunciation of the word SUPERHUMANS, I consider that they are aurally similar to a medium degree.

62. Conceptually, RHP's marks will be understood as referring to a human with super powers, a concept which is reinforced by the cape device. TAL's mark will be

understood as saying that “we are” humans with super powers. I therefore consider that the marks are conceptually similar to a high degree.

Likelihood of confusion

63. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to above a medium degree.
- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to conceptually similar to a high degree.
- I have found the opponent’s mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the goods and services to be members of the general public, and professionals such as TV studios and broadcasting undertakings, who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties’ services to be identical to similar to a low degree.

64. Taking all of the factors into account, bearing in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind, I consider there to be a likelihood of direct confusion. This is particularly the case given that the marks share the dominant and distinctive word element SUPERHUMANS, which results in a relatively high visual similarity (being above a medium degree) between the marks, which will be encountered during a predominantly visual purchasing process. Albeit the beginning of marks tend to make more of an impact than the ends, as established above, TAL’s mark begins with the non-distinctive words “WE ARE”. Therefore, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the closeness between the marks, and the nature of the services’ purchase will lead the

average to fall foul of the effects of imperfect recollection. In other words, consumers of RHP's earlier marks will, upon seeing TAL's later mark displayed on identical services, or services which are similar to low degree, will erroneously believe that the mark is that of RHP (or vice versa). Therefore, taking all of the above into account, I consider there to be a likelihood of direct confusion, even on the services which are similar to a low degree.

65. The opposition based upon section 5(2)(b) is successful in its entirety.

CONCLUSION

Invalidation

66. The application for invalidation is successful and the Contested 262 Mark is hereby declared invalid in respect of all services for which it is registered.

67. Under section 47(6) of the Act, the registration is deemed never to have been made.

Opposition

68. The opposition based upon section 5(2)(b) is successful in its entirety and the application is refused.

COSTS

69. Robert Holcroft Page has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award Robert Holcroft Page the sum of **£1,050** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£200
---	------

Preparing the application for invalidity and considering the Counterstatement	£200
Preparing and filing written submissions and submissions lieu of a hearing	£350
Official Fees	£300 ²
Total	£1,050

70. I therefore order Thomas Ali Ltd to pay Robert Holcroft Page the sum of £1,050. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 6th day of June 2023

L FAYTER
For the Registrar

² The official fee for filing a TM26i is £200, and the official fee for filing a TM7 is £100.