

O/0529/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003785336

BY OSNS MEDIA LIMITED TO REGISTER THE FOLLOWING TRADE MARK:

Dopamine District

IN CLASSES 25 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600002531 BY TV AZTECA

Background and Pleadings

1. On 7 May 2022, OSNS Media Limited ('the Applicant'), filed an application to register the following trade mark:

Dopamine District

2. The application was published for opposition purposes in the Trade Marks Journal on 27 May 2022. Registration is sought in respect of the following goods and services:¹

Class 25: *Clothes; Clothing.*

Class 41: *Production of audio-visual recordings; Entertainment; Cinema entertainment; Musical entertainment.*

3. On 26 August 2022, the application was opposed by TV Azteca ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 (the Act'). The Opponent relies on the following earlier registration:

UK00917958191

DOPAMINE

Filing date: 18 September 2018

Date of entry in register: 2 February 2019

Registered for the following services:

Class 38: *Broadcasting of audiovisual and multimedia content via the Internet; Streaming of audio, visual and audiovisual material via a global computer network.*

¹ The Applicant filed for a number of amendments to its class 41 specification, however the amendments sought were unacceptable. The original specification has therefore been restored.

Class 41: *Production of television and radio programs; Production of plays; Film production services; Film distribution; Syndication of radio programmes; Television program syndication.*

4. The Opponent relies on all of its services in class 41 and the Opposition is directed against all of the class 41 services in respect of which the Applicant seeks registration of its mark.
5. The Opponent claims that:
 - the parties' services are identical and highly similar;²
 - the parties' marks are 'visually, phonetically and conceptually highly similar';³ and
 - that there is a likelihood of confusion between the marks.
6. The Applicant filed a Defence and Counterstatement in which it:
 - denies that the parties' marks are highly similar visually, phonetically and/or conceptually, arguing that the marks are dissimilar or similar to a low degree only;⁴
 - argues that the Applicant's class 41 services 'are either similar to a low degree or not similar' to the Opponent's services;⁵ and
 - that there is no likelihood of confusion between the marks.
7. The Opponent is represented by Lara Grant. The Applicant is represented by Briffa.
8. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Marks Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

² Opponent's Statement of Grounds, paragraph 15.

³ As above, paragraph 18.

⁴ Applicant's Counterstatement, paragraphs 8 and 12-13.

⁵ As above, paragraph 19.

9. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.
10. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Only the Opponent has filed written submissions in lieu of a hearing.
11. I will not summarise the Opponent's written submissions, but I confirm that I have read them and will refer to them in my decision where appropriate. The following decision has been made after careful consideration of the papers before me.

Decision

Section 5(2)(b) of the Act and related case law

12. Section 5(2)(b) of the Act states:

“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. In accordance with section 6 of the Act, the Opponent's mark is an earlier mark by virtue of its earlier filing date which fell before the filing date of the Applicant's mark (7 May 2022).

14. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged because the Opponent's mark had been registered for less than 5 years on the date on which the Applicant filed its Application for the registration of its mark. The Opponent is therefore entitled to rely upon all of the services that it seeks to rely upon.

15. The following principles are derived from the decisions of the Court of Justice of the European Union⁶ ("CJEU") in:

Sabel BV v Puma AG, Case C-251/95; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98; *Matratzen Concord GmbH v OHIM*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P

The principles:

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

⁶ 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.

(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 services

16. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the 'Nice Classification' means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.

17. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties' goods and services must be taken into account:

“[23] 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. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281⁷, identified the following factors for assessing similarity of the respective goods and services:

- (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 making an assessment between the competing services, I bear in mind the decision of the General Court ('GC') in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05:

"29. ... the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

20. In construing the terms used in the parties' specifications, I will follow the guidance of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

⁷ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

"... 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. The services to be compared are as follows:

Opponent's services	Applicant's services
Class 41: <i>Production of television and radio programs; Production of plays; Film production services; Film distribution; Syndication of radio programmes; Television program syndication.</i>	Class 41: <i>Production of audio-visual recordings; Entertainment; Cinema entertainment; Musical entertainment.</i>

22. Upon reversion to the Applicant's original specification, the parties were given the opportunity to file written submissions. No submissions were filed.

Applicant's services: *Production of audio-visual recordings*

23. In my view, the Applicant's broader term will encompass the Opponent's term *Production of television and radio programs*, television and radio programs being audio-visual recordings. The parties' services are therefore 'Merit' identical.

Applicant's services: *Entertainment*

24. I compare the Applicant's services to the Opponent's *Production of television and radio programs*. The Applicant's term 'Entertainment' will, to my mind, entail the provision of entertainment, which might include, *inter alia*: television and radio programmes. The Opponent's services, in my view, entail the creation of television and radio programmes. The respective services will overlap in purpose to the extent that television and radio programmes are created, generally speaking, for the entertainment of the viewer or listener. Users will, to my mind, be distinct; the Applicant's services will typically be consumed by the general public whereas the Opponent's production services will, in my view, be engaged by professionals in the field of broadcasting. Trade channels may also be shared in some circumstances; a broadcasting company might offer television and radio production services as well as providing entertainment by broadcasting programmes that it has created. The respective services will be similar in nature to the very broad extent that both entail acts of service, albeit those acts will differ; the Applicant's services entail the provision of entertainment whereas the Opponent's services entail the creation of entertainment, i.e. radio and television programmes. I do not find the services to be in a competitive relationship, neither being substitutable for the other. However, the respective services may be said to be complementary; the Applicant's services are necessary for radio and television entertainment to be created and the average consumer may presume both services to originate from the same undertaking. I find the parties' services to have a medium level of similarity.

Applicant's services: *Cinema entertainment*

25. I compare the Applicant's services to the Opponent's *Film production services*. The Applicant's services, in my view, entail the provision of cinema entertainment. The Opponent's services will entail the creation of films. The respective services will overlap in purpose to the extent that films are created, generally speaking, for the entertainment of the viewer. Users will, to my mind, be distinct; the Applicant's services will typically be consumed by the general public whereas the Opponent's production services will, in my view, be engaged by professionals in the film

industry. Trade channels may overlap somewhat; it is possible that the same undertaking may provide both film production services and distribute or show films in cinemas.. The respective services will be similar in nature to the very broad extent that both entail acts of service, albeit those acts will differ; the Applicant's services entail the provision of cinema entertainment (i.e. films) whereas the Opponent's services entail the creation of entertainment, i.e. films. I do not find the services to be in a competitive relationship, neither being substitutable for the other. However, the respective services may be said to be complementary; the Applicant's services are necessary for cinema entertainment to be created and the average consumer may presume both services to originate from the same undertaking. I find the parties' services to have a medium level of similarity.

Applicant's services: *Musical entertainment*

26. I compare the Applicant's services to the Opponent's *Production of radio programs*. The Applicant's 'musical entertainment' will, in my view, entail the provision of musical entertainment, e.g. musical performances. The Opponent's 'production of radio programs' will entail the creation of audio content for radio which will sometimes include music. The parties' services will overlap to the broad extent that, in instances where the Opponent's services cover the production of radio programs with musical content, both services will be ultimately concerned with music. However, I consider that the specific purposes of the respective services will differ; the Applicant's services are concerned with the *provision* of, i.e. the making available of, the musical entertainment for consumption, whereas the Opponent's services are concerned with the *production* of the radio programs featuring musical content. Users will likely be distinct; the Applicant's services will typically be consumed by the general public, whereas the Opponent's services will likely be engaged by professionals in the field of broadcasting. Trade channel overlap is, in my view, possible in some instances; e.g. a broadcasting company might produce radio programs as well as providing musical entertainment. The services will differ in nature in terms of the acts of service; provision of musical entertainment versus production of radio programs with musical content. I do not find the parties' services to be competitive, neither being substitutable for each other. I do, however, find complementarity in certain instances. The Opponent's

services will, in my view, be necessary for the Applicant's services where the musical entertainment takes the form of a radio program featuring musical content, and the average consumer may presume both services to originate from the same undertaking. In the light of the foregoing, I find the parties' services to have a low to medium level of similarity.

Average consumer and the purchasing act

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

28. It is my view that the average consumer of those of the Opponent's services that come into play in this opposition, and the Applicant's *Production of audio-visual recordings* will be the professional public. I consider that the purchasing act will, in many cases, be primarily visual in nature to the extent that consumers would likely first encounter the provider of the services in a trade directory or via a website. There will likely also be an aural aspect where recommendations are made by 'word of mouth'. In my view, a decision to engage the services will be a carefully considered one. A transaction would likely follow only after detailed discussion of the purchaser's needs with the service provider. I find that the average consumer would pay a high level of attention when engaging these services. Factors considered would include, *inter alia*, whether the service provider could meet the consumer's needs in terms of budget and timescales.

29. I now consider the average consumer of the following of the Applicant's services: *Entertainment; Cinema entertainment; Musical entertainment*. The average consumer will be a member of the general public. I consider that the purchasing act will be primarily visual to the extent that the purchaser will first encounter the Applicant's mark either on a website, TV or radio guide, or cinema or other venue.

The level of attention displayed during the purchasing act will likely differ depending on the particular entertainment being purchased. A decision to watch a program or film on television, for example, will be a frequent occurrence for the average consumer and, in many cases, a fairly low level of attention will be paid. A decision to purchase a cinema ticket would likely entail a level of attention of no more than average, such purchases having a relatively low price. On the other hand, a ticket to a musical performance might entail the purchaser paying a higher level of attention e.g. when purchasing tickets to operas or other theatrical shows, which may be fairly expensive. The level of attention paid by the average consumer will therefore be in the medium range.

Comparison of the marks

Opponent's mark	Applicant's mark
DOPAMINE	DOPAMINE DISTRICT

30. 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.”

31. 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.

32. The Opponent’s mark is a word mark⁸ consisting of the single word element ‘DOPAMINE’ rendered in a plain sans serif typeface. The overall impression of the mark resides in the mark in its entirety.

33. The Applicant’s mark is also a word mark. It consists of the two word elements ‘DOPAMINE’ and ‘DISTRICT’ rendered in a plain sans serif typeface. In my view, the words ‘dopamine’ and ‘district’ hang together as a unit because the word ‘dopamine’ qualifies the word ‘district’ e.g. ‘district of dopamine’. The overall impression resides in this unit.

Visual comparison

34. Both marks share the element ‘DOPAMINE’; the word appearing as the first element in the Applicant’s mark. The only point of difference is the presence of the word ‘DISTRICT’ in the Applicant’s mark, which is absent from the Opponent’s mark. The fact that the Applicant’s mark is twice as long as the Opponent’s is a point of noticeable difference. I find the marks to have a medium level of visual similarity.

⁸ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

‘ [...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).’

Aural comparison

35. The Opponent's mark will, in my view, be articulated as 'DOPE-UH-MEEN'. The Applicant's mark will be articulated as 'DOPE-UH-MEEN DISS-TRICT'. The Opponent's mark and the first word of the Applicant's mark are aurally identical. The marks differ aurally by virtue of the additional two syllables at the end of the Applicant's mark, which are absent from the Opponent's mark. I find the marks to be aurally similar to a medium degree.

Conceptual comparison

36. The Opponent has submitted that the average consumer will perceive the word 'dopamine' to refer to "a type of neurotransmitter and hormone, which plays a role in many important body functions, including movement, memory and pleasurable reward and motivation".⁹ It has submitted that 'district' will be understood as an area of a country or city, "especially one characterized [sic] by a particular feature or activity".¹⁰ The Opponent argues that the Applicant's mark 'Dopamine District' will be understood "as an area where to [sic] obtain dopamine, precisely when used in conjunction with the entertainment services at stake which are bound to provide pleasure". The Applicant has argued that "DOPAMINE is a chemical naturally produced in the body and is known as the 'feel-good hormone' because it gives a sense of pleasure."¹¹ It argues that the Applicant's mark will be understood as 'a physical place, or a mental or emotional state, associated with pleasure'.¹²

37. Although the word 'dopamine' does, as I understand it, refer to a chemical in the body associated with pleasure, in my view, the word is not used in common parlance. I consider that a large proportion of average consumers would be unfamiliar with the precise meaning of the word, although they might be aware that it is a real word as opposed to an invented one, and that it refers to 'something to do with the brain'. I also recognise that another group of average consumers will be unfamiliar with the meaning of the word and will therefore see it as an invented word. In my view, for the group of average consumers that I have identified as

⁹ Opponent's written submissions in lieu of a hearing, paragraph [20].

¹⁰ As above, paragraph [1].

¹¹ Applicant's Counterstatement, paragraph [14].

¹² As above.

being aware that it is a word relating to the brain in some way, the Opponent's mark will be perceived merely as referring to 'something related to the brain'. For the group of average consumers unfamiliar with the meaning of the word, the Opponent's mark will be seen as an invented word to which no concept will attach.

38. I now consider the Applicant's mark. The word 'dopamine' will be understood by the average consumer in the ways that I have set out above. The word 'district', to my mind, is a word with which the average consumer will be familiar and will be understood as referring to a particular area of a town or country, e.g. the business district, the Lake District. I consider that the mark 'Dopamine District' will, for the average consumer with an appreciation that 'dopamine' relates to 'something to do with the brain', convey the idea of a geographical area named 'Dopamine' i.e. a place named after a word that has 'something to do with the brain'. For the group of average consumers unaware of the meaning of 'dopamine', and who therefore see it as an invented word, my view is that 'Dopamine District' will convey the notion simply of a geographical area named 'Dopamine'. In the light of the foregoing, my view is that for the group of average consumers who are aware that 'dopamine' has something to do with the brain, the marks will have a medium level of conceptual similarity. I consider that, for the group of average consumers who perceive 'dopamine' as an invented word, the parties' marks will be conceptually dissimilar.

Distinctive character of the earlier mark

39. 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).”

40. Registered trade marks possess varying degrees of inherent distinctive character: perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.

41. ‘Dopamine’ is a word in the English language, albeit the word is not, in my view, used in everyday parlance. For a proportion of average consumers, it will be understood as relating to ‘something to do with the brain’. For another group of average consumers, it will be perceived as an invented word. In the case of each group of average consumers that I have identified, the mark neither describes nor alludes to the services in respect of which it is registered. However, for the group of average consumers who will understand that ‘dopamine’ refers to ‘something to do with the brain’, I consider that the mark will have a medium level of inherent distinctive character. For the group of average consumers who perceive ‘dopamine’ to be an invented word, I find the earlier mark to have a high level of inherent distinctive character.

42. No evidence has been adduced by the Opponent. I am therefore unable to form a view as to whether the Opponent's mark enjoys an enhanced level of distinctive character.

Likelihood of confusion

43. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat Inc*¹³. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹⁴, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the services at issue, leads them to conclude that the services are the responsibility of the same or an economically linked undertaking.

44. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [15]. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

45. I first consider the group of average consumers for whom the word 'dopamine' will be recognised as a word meaning 'something to do with the brain'. In my view, despite the fact that I have found the Applicant's services to be either identical or to have some level of similarity with the Opponent's services, the net effect of the visual, aural and conceptual differences between the marks is, in my view,

¹³ Case BL O/375/10 at [16].

¹⁴ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

sufficient to prevent this group of average consumers from mistaking one party's mark for the other. Although both parties' marks include the word 'Dopamine', I find that the average consumer will notice the presence of the 'District' element in the Applicant's mark owing to its occupying only slightly less space than that of the 'Dopamine' element. The fact that the Applicant's mark comprises five syllables as compared to the Opponent's mark being three syllables is an aural difference that will, to my mind, be readily perceived by the average consumer. Although the marks have, for the group of average consumers that I have identified in my conceptual analysis as being aware that the word 'dopamine' is 'something to do with the brain', some conceptual similarity deriving from the presence in both marks of 'dopamine', my view is that the pairing of 'dopamine' with the word 'district' adds a conceptual aspect to the Applicant's mark that exists over and above that conveyed by the word 'dopamine' solus in the Opponent's mark. The Applicant's mark will be understood as conveying a geographical area, e.g. a district named after a word that means 'something to do with the brain'. This points away from a likelihood of direct confusion. I find this to be the case even where the services will be purchased with a high level of attention. The medium degree of inherent distinctive character enjoyed by the earlier mark derives from the fact that the mark neither describes nor alludes to the services in respect of which it is registered. In my view, the Applicant's mark will have a medium level of distinctive character for the same reasons. However, the visual, aural and conceptual differences that I have identified, are, in my view, for this group of consumers, sufficiently marked to prevent one mark being confused for the other by imperfect recollection. I find that there is no likelihood of direct confusion for the average consumer who is aware that 'dopamine' is a word that 'has something to do with the brain'. I find this to be the case even where the parties' goods are identical.

46. I now consider the group of average consumers for whom 'dopamine' will be perceived as an invented word. For this particular group of consumers, I have found the earlier mark to have a high level of inherent distinctive character. I bear in mind *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C., as the Appointed Person, pointed out that the level of 'distinctive character' is likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

47. I consider that more consumers will be aware of the word ‘dopamine’ as a word in the English language as referring to ‘something to do with the brain’ (even if they do not know its precise meaning) than will not be so aware. The group of consumers for whom ‘dopamine’ is an invented word will, to my mind, be the smaller group. However, it is my view that, for the services for whom the average consumer is the general public (i.e. *entertainment; cinema entertainment; musical entertainment*), those who perceive ‘dopamine’ as an invented word will nevertheless be a significant proportion of average consumers. I consider that this group of average consumers is likely to confuse the marks by mis-remembering/mis-recalling the marks as each other, due to the impact of imperfect recollection. They are likely to mistake them for each other because the mind’s eye has recalled the highly distinctive element ‘Dopamine’ but failed to register the word ‘District’ in the Applicant’s mark. I find that there is a likelihood of direct confusion for this group of average consumers for the above-mentioned services. I find this to be the case even where the average consumer pays a medium level of attention when purchasing the services.

48. For the remainder of the Applicant’s services (*Production of audio-visual recordings*) the average consumer will be the professional public who will pay a higher level of attention during the purchasing act. I consider that members of this group of average consumers for whom ‘dopamine’ will be seen as an invented word

will be fewer and less significant a number. I find that there is no likelihood of direct confusion for these services.

49. I now consider whether there is a likelihood of indirect confusion. I note that in the recent case of *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.

50. In *L.A. Sugar Limited v Back Beat Inc*¹⁵ Mr Iain Purvis Q. C., as the Appointed Person, explained that [my words in parentheses]:

17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] 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.).

¹⁵ Case BL O/375/10

(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)".

51. My view is that the instant case does not fall within any of the categories identified above. It is acknowledged that these categories are not intended to be exhaustive. Nevertheless, I do not consider the element 'District' in the Applicant's mark to be a non-distinctive element because it contributes to the overall concept of either a place named after a word meaning 'something to do with the brain', or a place named after the invented word 'Dopamine'. Despite the fact that the earlier mark will have a medium-high level of distinctive for one group of average consumers, it is, in my view, difficult to conceive of the word 'district' being used as an 'add-on' to form a sub-brand or brand variation. I consider it unlikely to be commercially effective because 'Dopamine District' would unlikely be seen as a logical extension of the earlier mark. I do not consider there to be any other mental process, outside of the three categories identified by Mr Purvis, according to which the average consumer would presume the marks to derive from the same or economically-related undertakings. I can find no proper basis for a finding of a likelihood of indirect confusion between the parties' marks.

Conclusion

52. This was a partial Opposition directed against the Applicant's class 41 services only. The Opposition has succeeded in part. The Application is, subject to a successful appeal:

- Refused in respect of *Entertainment; Cinema entertainment; Musical entertainment*, Class 41.
- Allowed to proceed in respect of *Production of audio-visual recordings*, Class 41; and the unopposed goods, *Clothing*, Class 25.

53. The Opponent has enjoyed the greater measure of success and is entitled to a contribution towards its costs. I award the Opponent the sum of **£201** as contribution towards its costs, calculated as follows:¹⁶

Preparation of statement and consideration of the Applicant's statement:	£200
Official fee for 5(2)(b) only:	£100
Sub-total	£300
Less 33% to take account of the Applicant's success ¹⁷	-£99
Total:	£201

54. I therefore order OSNS Media Limited to pay to TV Azteca the sum of £201. 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 7th day of June 2023

Mx N. R. Morris

For the Registrar,

the Comptroller-General

¹⁶ Tribunal Practice Notice (TPN) 2/2016: Costs in proceedings before the Comptroller - GOV.UK (www.gov.uk)

¹⁷ The Opposition has failed in respect of one out of three opposed terms, i.e. approximately 33%.