

O-577-17

TRADE MARKS ACT 1994

IN THE MATTER OF THE APPLICATION UNDER NO. 3172104
BY FOXPRO EVENTS LTD
TO REGISTER THE TRADE MARK:



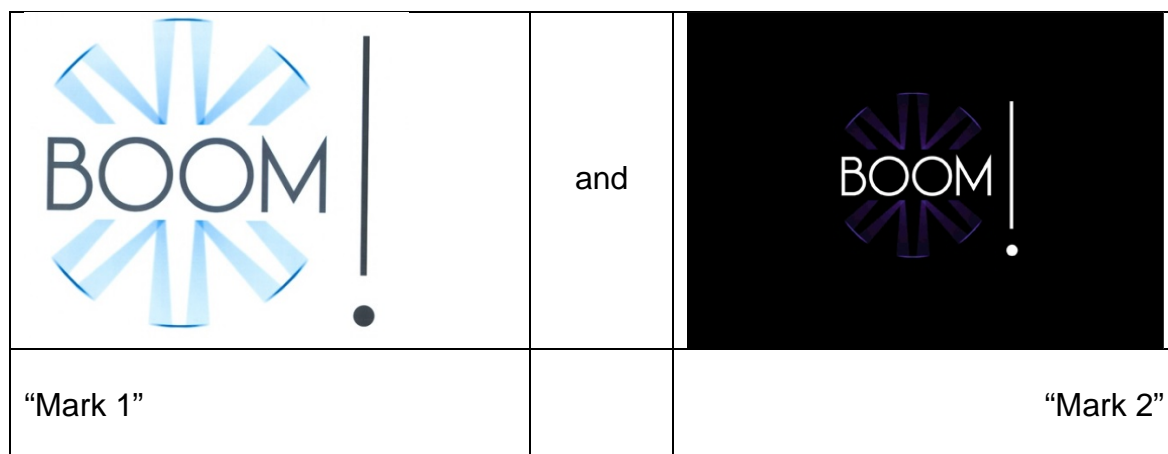
FOR SERVICES IN CLASS 41

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 407363
BY BOOM! SPIN LTD

BACKGROUND AND PLEADINGS

1. On 29 June 2016, Foxpro Events Ltd (“the Applicant”) applied to register as a trade mark the figurative mark shown on the front page of this decision, in respect of the following services in class 41: *Entertainment party planning; Entertainment.*
2. The application was published for opposition purposes in the Trade Marks Journal on 15 July 2016. It is opposed by BOOM! Spin Ltd (“the Opponent”). The Opponent is the proprietor of a UK trade mark registration (No. 2596099) for a series of two trade marks as shown below:



3. The Opponent applied for its marks on 27 September 2011 and obtained registration on 13 January 2012 in respect of the following services in class 41: *Education; providing of training; entertainment; sporting and cultural activities.*¹
4. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and the Opponent requests that the application be refused in its entirety. The notice of opposition states that *“the use of identical wording along with the use of an exclamation mark following the word in an identical fashion as our current trade mark all place on the backing of a similar, energetic looking graphic we believe will confuse consumers that the logo might be from the same companies.”*

¹ The Opponent’s registration is also in respect of goods in classes 3, 25 and 32, but these are not relied on in this opposition.

5. The Applicant filed a Form TM8 notice of defence denying a likelihood of confusion. Its counterstatement reads as follows: *“Further to the indication that this logo is not being used in the entirety of the opponent’s publications, I strongly believe that the BOOM Spin Ltd logo is somewhat different to the Foxpro Events Ltd logo. The Foxpro Events Ltd logo has very bold text and a sharp star-shaped surround, whereas the BOOM Spin Ltd logo has very skinny text and a light broken circular surround. Furthermore, BOOM Spin Ltd advertises their operations as indoor cycling classes, whereas Foxpro Events Ltd exclusively manages and promotes nightclub events to university students only - so there can be no confusion as to the services offered.”*
6. The Registry noted that the Form TM8 included a single page document which constituted evidence. The Registry advised the Applicant that if it wished to file evidence, it should do so at the appropriate time and in the correct format (about which the Registry gave brief guidance). A period for the Applicant to file evidence was provided later in the proceedings, but the Applicant did not avail itself of that opportunity. In these proceedings, therefore, neither the Applicant nor the Opponent filed evidence or submissions.
7. Each party is self-represented in these proceedings.

DECISION

8. The Opponent’s claim is based on section 5(2)(b) of the Act, which states:

“... 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 on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. Since the Opponent's registered trade mark has a date of application for registration earlier than that of the Applicant's trade mark it is an "earlier trade mark" under Section 6(1)(a) of the Act.
10. Since the Opponent's trade mark had not been registered for five years or more when the Applicant's mark was published for opposition, the earlier trade mark is not subject to the proof of use provisions under section 6A of the Act. This means that, in these opposition proceedings, the Opponent is able to rely on its earlier mark in relation to all the services at issue, without having to prove genuine use (or else proper reasons for non-use).
11. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

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.

12. The principles are that:
 - (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 the respective services

13. As I have said, the earlier mark is not yet subject to proof of use, so the Opponent is entitled to rely on it for the services as registered, irrespective of the services actually provided by the Opponent. The comparison I have to make is therefore a notional one taking into account the services as registered (earlier mark) and applied for (application). The competing specified services are as follows:

| Applicant's services in Class 41 | The Opponent's registered services in class 41 |
|--|--|
| <i>Entertainment party planning; Entertainment</i> | <i>Education; providing of training; entertainment; sporting and cultural activities</i> |

14. Both parties have specified "entertainment". Those services are plainly identical.
15. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*², the General Court stated that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application, or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark. That principle holds true for services as well as for goods.
16. I find that specification of "entertainment" amongst the Opponent's services is a general category wide enough to include "entertainment party planning" services as specified by the Applicant. I therefore find that those services are identical in line with the principle set out in *Gérard Meric*.

² Case T- 133/05; see paragraph 29 of that judgment.

The average consumer and the purchasing process

17. As indicated by the principles from case law above, it is necessary to determine who is the average consumer for the respective services and how the consumer is likely to select the services.
18. In *Hearst Holdings Inc*³, 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 relevant person is a legal construct and ... the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical....”
19. I find that each of the respective services is such as will be used by the general public.
20. The average consumer’s level of attention is likely to vary according to the category of goods or services in question⁴. I find that purchasing entertainment or entertainment party planning services is likely to be done only on a fairly irregular basis, for special occasions. The average consumer will be concerned to ensure that the provider is suitable to meet its entertainment needs; such services will vary in price according to their content and scale, but the services will entail a cost likely not incurred frequently and I would expect at least an average degree of care to be taken when selecting the services at issue.
21. Visual considerations will be a particularly important part of the selection process as the average consumer will encounter the marks for example, on the outside of a venue, or on the pages of a website, or on marketing material. However, in my experience, such services are also, very likely to be the subject of word-of-mouth recommendations, so the sound of the trade mark will also be an important feature of the selection process.

³ *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)

⁴ *Lloyd Schuhfabrik Meyer*, Case C-342/97

Comparison of the marks

22. It is clear from *Sabel* 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.
23. The Court of Justice of the European Union (CJEU) stated in *Bimbo* 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.”*
24. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

| | |
|--|---|
| Applicant's contested mark: | |
|  | |
| Opponent's Mark 1: | Opponent's Mark 2: |
|  |  |

25. The overall impression of the Applicant's mark derives from the colourful presentation of the word BOOM in capital letters, along with an exclamation mark, and all framed within a device suggestive of a cartoonish explosion. None of these aspects is negligible and all contribute to the impact of the mark. However, since the familiar onomatopoeic word BOOM and the exclamation mark are large and prominently foregrounded in the centre of the device, that word and punctuation mark play a dominant role in the overall impression of the mark.
26. Both Mark 1 and Mark 2 of the Opponent's registered series of trade marks also involve the word BOOM in capital letters, along with an exclamation mark, and all framed within a radiating device, here in the form of a sort of six branched star. The voiceable word BOOM, together with the extra-long exclamation marks have the greatest impact in the overall impression. The device in Mark 1 is not negligible, but it is paler and less

prominent than the clear central word and the large exclamation mark. In Mark 2 the purple star device is barely visible against the black rectangular background, whereas the word and punctuation mark, presented in white, stand out clearly.

Visual similarity

27. The Applicant's mark presents the word BOOM! where the stylised characters are thick and rendered in different colours – orange B, blue O, red O, pink M, yellow exclamation mark. The characters also slant a little to the right. The word occupies most of a jagged bubble device. The device, which involves about a dozen spiky jags and is shaded grey by tightly spaced black dots, is suggestive of a cartoonish explosion or loud sound.
28. The Opponent's Mark 1 also presents the word BOOM in uppercase, but the stylisation of the characters is markedly different from that in the Applicant's mark – the characters are skinny, black and upright. The word divides the star device or occupies its centre, and the word occupies only around 30% of the device, although the out-sized exclamation mark is as tall as the whole device and sits to its right. The star device itself is a pale blue against white, sketchily circumscribing a broken circle and involving six white tapering legs radiating in a sort of star form.
29. Given the shared presence of the word BOOM in capital letters along with the exclamation mark, which components I have found dominant and distinctive in the marks, and given the shared presence of a discernible device which in some degree supports the notion of a boom sound, I find that the Applicant's mark and the Opponent's Mark 1 are visually similar to at least a medium degree.
30. The Opponent's Mark 2 also presents the word BOOM in uppercase, and the stylised characters are skinny and upright. The font colour of the characters is white and the word again divides or occupies the centre of a circular star device. The out-sized exclamation mark is as tall as the star device, but in this case the star device is purple in colour and is not easily discernible against the black background of the rectangle that forms the larger part of the mark. The poorly contrasting colour of the star device, together with its size relative to the whole, means that its impact in the mark overall is reduced. The impact of the white characters is diminished by their being a smaller part of the larger whole, but

since the word and exclamation mark stand out in the centre of the black rectangle, and those white parts are dominant and distinctive, I find that the Applicant's mark and the Opponent's Mark 2 are visually similar to a medium degree.

Aural similarity

31. In all marks only the letters BOOM will be pronounced, and all three marks are aurally identical.

Conceptual similarity

32. All marks derive their central concept from the word BOOM along with its exclamatory punctuation mark. The word is readily understood as a noun signifying a loud, deep, resonant sound, or possibly as a verb expressed in the imperative form urging one to make such a sound. The concept of the sound is very clearly reinforced in the Applicant's mark by the pictorial aspect of the device that suggests a cartoonish explosive noise. In the Opponent's Mark 1, the device is more abstract and less familiarly iconic, but may possibly be seen as reinforcing the concept in the word and exclamation mark. In the Opponent's Mark 2, the same device in purple is far less perceptible, so I find adds nothing to the concept. Nonetheless, since I find that the concept lies in the word and exclamation mark, the shared presence of those components in all three marks makes them conceptually identical.

Distinctive character of earlier trade mark

33. The distinctive character of an earlier mark must be considered. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public.⁵ The more distinctive the earlier mark, either by inherent nature or by use, the greater may be the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik*⁶, the CJEU stated that:

⁵ *Rewe Zentral AG v OHIM (LITE)* [2002]ETMR 91

⁶ Case C-342/97 above

“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).”

34. The level of distinctiveness of a mark may be enhanced through use, but since the Opponent has filed no evidence in these proceedings, I have only the inherent characteristics of its trade marks to consider. The meaning conveyed by the Opponent’s trade marks will be well-known to the average consumer. The Opponent’s marks contain nothing descriptive of the services for which they are registered in class 41 – namely: *Education; providing of training; entertainment; sporting and cultural activities*. I therefore find that the Opponent’s series of trade marks has at least an average level of inherent distinctiveness for all its services.

Assessment of likelihood of confusion

35. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more

distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

Earlier in this decision I concluded that:

- the competing services are identical ;
- the average consumer of the services at issue is a member of the public;
- although the services at issue may be selected by predominantly visual means, aural considerations will also play an important part in the selection process;
- the average consumer will pay at least a normal degree of attention to the selection of the services;
- the greatest impact in the overall impression conveyed by the Opponent's series of trade marks derives from the word BOOM with an exclamation mark;
- while the overall impression conveyed by the Applicants' trade mark stems from its cartoonish whole, its distinctiveness is weighted in favour of the five characters BOOM!;
- the competing trade marks are visually similar to a medium degree (at least, for Mark 1) and are aurally and conceptually identical;
- the Opponent's earlier trade marks have at least an average degree of inherent distinctive character.

36. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average

consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

37. I have noted that the Applicant's counterstatement refers to Opponent's advertising its operations as indoor cycling classes whereas the Applicant "*exclusively manages and promotes nightclub events to university students only - so there can be no confusion as to the services offered.*" I have also noted that the Opponent is not required to have evidence of use in the UK of the trade mark on its specified services since the Opponent has a period of five years from registration to make use of its trade mark for the purposes registered. For that reason, the task of comparing the services had to be made on the basis of notional and fair use⁷ of the services in the parties' respective specifications.

38. In *O2 Holdings Limited*⁸, the CJEU stated that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM*⁹ it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

"...Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, ... cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors ..."

39. Weighing all of the above, I find a likelihood of confusion on the part of the average consumer. The opposition therefore succeeds.

⁷ See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. at paragraph 78.

⁸ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06; see paragraph 66.

⁹ (Case T-116/06)

COSTS

40. The Opponent has been successful and is entitled to a contribution towards its costs. When the parties chose to have a decision from the papers, the Registry advised the parties that if they wished to request an award of costs they would need to complete a pro-forma and return it within 14 days. It was made clear that if the pro-forma was not completed and returned, no costs would be awarded, other than official fees arising from the action and paid by the successful party. It does not appear that either party submitted a completed pro-forma.
41. In the circumstances I award the Opponent the sum of £100 (one hundred pounds) as a contribution towards the cost of the proceedings, which is simply the reimbursement of the official fee for its notice of opposition.
42. I therefore order Foxpro Events Ltd to pay BOOM! Spin Ltd the sum of £100 (one hundred pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of November 2017

Matthew Williams
For the Registrar,
the Comptroller-General