BL O/1139/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF TRADE MARK APPLICATION 3627830

AND TRADE MARK APPLICATION 3627829

BY

JETBRAINS S.R.O.

WITH OPPOSITIONS NO. 427595 & 427599 THERETO

BY

GROUPE CANAL+ SA

Background and pleadings

1. On 16 April 2021, JetBrains s.r.o. (the "Applicant") applied to register the trade marks UKTM 3627830 and UKTM 3627829, as shown on the cover of this decision. The contested applications were accepted, and both were published for opposition purposes in the Trade Marks Journal on 16 July 2021. Registration of the marks is sought in respect of the following goods and services, identically replicated in each:

Class 6 *Art objects of metal, metals in foil or powder form for 3D printing*.

Class 9 *Software, digital publications, downloadable electronic books*.

Class 14 *Key chains, Watch straps of synthetic materials, non-metal key rings, non-metal key chains, articles of jewelry made of precious metals or precious metal alloys, pins*.

Class 16 *Printed matter, art prints, printed publications, stickers, posters*.

Class 17 *Rubber, artificial resins (semi-finished products), decoration articles made of rubber, plastic filaments for 3D printing*.

Class 19 *Works of art of stone, artificial stone, clay*.

Class 20 *Works of art of wood, wax, plaster or plastic, model figures of synthetic resin, models of synthetic resin*.

Class 21 *Cups, glasses, works of art of glass, porcelain or ceramic*.

Class 25 *Clothing, t-shirts, footwear, headgear*.

Class 28 *Toys, playthings*.

Class 30 *Coffee, tea, artificial coffee, cocoa-based beverages, coffee-based beverages, tea-based beverages*.

Class 35 *Retail Services related to art objects of metal, metals in foil or powder form for 3D printing, software, digital publications, downloadable*

electronic books, key chains, Watch straps of synthetic materials, non-metal key rings, non-metal key chains, articles of jewelry made of precious metals or precious metal alloys, printed matter, art prints, printed publications, rubber, artificial resins (semi-finished products), decoration articles made of rubber, plastic filaments for 3D printing, works of art of stone, artificial stone, works of art of wood, wax, plaster or plastic, model figures of synthetic resin, models of synthetic resin, cups, glasses, works of art of glass, porcelain or ceramic, clothing, t-shirts, footwear, headgear, toys, playthings, coffee, tea, artificial coffee, cocoa-based beverages, coffee-based beverages, tea-based beverages; marketing.

Class 40 *Printing, 3D printing, metal printing*.

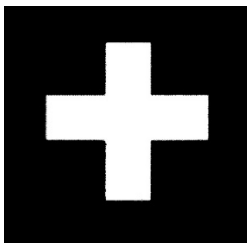
Class 41 *Education, entertainment, art gallery services, arranging and conducting of seminars and conferences, arranging and conducting of exhibitions for cultural and educational purposes, providing on-line electronic publications (not downloadable*).

Class 42 *Science and technological services, computer software design, maintenance of computer software*.

Class 43 *Restaurant services, cafes, bar services, snack-bars*.

2. On 18 November 2021, Groupe Canal+ SA (the "Opponent") opposed both applications under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), on the basis of one earlier United Kingdom Trade Mark (UKTM), being a comparable International Registration:

UKTM No. 801025864



Filing date: 15 September 2009

Registration date in France: 2 December 2010

Receiving date: 26 April 2021

3. For the purposes of this opposition, the Opponent relied upon only some of the goods and services for which the earlier mark is registered, namely the full list of those goods and services registered in classes 9, 14, 16, 25, 28, 35, 41 and 42 (for full list see **Goods and services comparison**).

4. The opposition is aimed against all of the goods and services in the contested applications. The Opponent's submissions can be summarised as the following:

UKTM 3627830

- There are clear visual similarities between the earlier mark and the contested device consisting of a white '+' on a black square background.
- If described aurally, the earlier mark and contested device would be described as 'plus', which has no relevance to the goods and services in question.
- The contested goods and services are identical or similar to those of the earlier mark, and are likely to be sold through the same trade channels and marketed in the same manner.
- Based on the similarity between the marks and the identity/similarity between the goods and services, it is entirely possible that a consumer would be confused as to the origin of the contested mark. As such there is a very real risk the contested mark would be considered an extension of the Opponent's earlier mark.
- The minor differences between the marks would be overcome by the principle of interdependency.

UKTM 3627829

- The submissions largely mirrored those filed in relation to 3627830, with the additional submissions that the elements JetBrain and TECHLAB did not detract from the independent distinctive role the device plays in the contested mark.

- The contested device would be the first element to be pronounced (before the word elements), and would be pronounced as 'plus'.

5. On 20 January 2022, the Applicant filed a counterstatement. The Applicant requested that the Opponent be put to strict proof of use for all of the goods and services which it relied upon under the earlier mark. The Applicant submitted that both contested marks are visually and conceptually dissimilar to the earlier mark, with the contested mark 3627829 being aurally dissimilar from the earlier mark, also. The Applicant admitted that a certain number of the contested goods and services were either identical or similar to those of the earlier mark, however, the Applicant rejected the Opponent's position that all of the goods and services applied for were identical or similar.

6. Following the filing of the counterstatement, the parties were informed by correspondence on 22 February 2022 that the oppositions would be consolidated under Rule 62(1)(g) of the Trade Marks Rules 2008.

7. Both parties provided submissions. The Opponent also filed evidence for the purpose of establishing proof of use. The submissions and evidence of each party shall be summarised to the extent that it is considered necessary at the appropriate time.

8. No Hearing was requested.

9. Both parties are professionally represented. The Applicant is represented by Keltie LLP, and the Opponent is represented by D Young & Co LLP.

Proof of use

10. The relevant statutory provisions are as follows:

Section 6A:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) 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."

11. Further, Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

12. Considering the above, it is incumbent on the Opponent to establish proof of use of its earlier comparable mark UKTM No. 801025864 in the 5-year period ending on the date of application of the contested marks, i.e., between 17 April 2016 and 16 April 2021. Due to the earlier mark being an International Registration ("IR") which designated the European Union ("EU") before being converted into a United Kingdom ("UK") comparable mark on IP Completion Day (i.e., 31 December 2020), the location of proven use will change during the relevant period. As per the Tribunal Practice Notice (TPN) 2/2020, the evidence of use can include use in the EU (which would include the UK) between 17 April 2016 and 31 December 2020, after which it must

rely exclusively on evidence of use in the UK between 1 January 2021 and 16 April 2021.

Opponent submissions and evidence

13. On 22 June 2022, the Opponent filed evidence containing the witness statement of Clément Hellich Praquin, the Corporate General Counsel of Canal+, together with exhibits CHP1 – CHP21. Accompanying the witness statement of Clément Hellich Praquin was the witness statement of Emma Broxholme, a translator at Priory Translations Ltd. The witness statement of Clément Hellich Praquin explained that Canal+ is a leading French audio-visual media group that was launched in 1984. The witness statement explained that Canal+ owns a large number of composite trade marks, each of which uses the earlier mark as the key dominant feature, e.g.:

The witness statement explained that some of the attached evidence would not be individually dated, as it not general practice in the film industry to do so. However, the witness statement explained that the evidential use would be from the period 2015 – 2020. I interpret this to indicate that the Opponent does not intend to file UK-specific evidence for the period post IP Completion Day

14. The witness statement referred to nine websites operated by Canal+, all of which were in the French language, including canal-plus.co.uk which actually reverted to canal-plus.com and subsequently appeared in the French language. 'CANAL+' was evident on each of the nine websites. The witness statement referred to use of the '+ device' on the Opponent's apps, which are available on android and iTunes, and also its store fronts, its product packaging, and its promotional material. In the evidence, the '+ device' appeared both in conjunction with the word 'CANAL', and also on its

own, particularly on certain devices such as hubs. The witness statement explained that the Opponent company CANAL+ had turnover of 533 million euros in 2014 (see exhibit CHP5, which attributes this figure to STUDIOCANAL), and offers 5,000 films "in one of the world's largest libraries". The witness statement included at exhibit CHP9 third party articles from 2012 – 2017, which reviewed the earlier mark's goods and services. The majority of the articles referred to a period of time before the relevant period. Those articles that were from within the relevant period included references to CANAL+ possessing television channels, as well as CANAL+ winning 3 awards at the 5th Edition of the *Social Media Awards November 2016* (evidence in CHP11). The articles also made reference to *Apple* having bought 10 episodes of the French series '*Calls'*, which "…will be co-produced by CANAL+". Exhibit CHP10 similarly consisted of articles regarding CANAL+ services, and also contained references from outside of the relevant period of time. The two articles from within the relevant period of time (*BeIN Sports,* June 2018 and *La Correspondance de la Presse,* 10 February 2017) referred to 'Canal Plus' and 'Canal+' being an on-demand television and film service. The witness statement referred to the social media presence of CANAL+, which included having 2.9 million subscribers on *Twitter* and 200,000 followers on *Instagram,* both in relation to 2019. The witness statement explained that between 2015 and 2020 the number of subscribers to CANAL+ increased from 11.2 million to 20.3 million. Of these subscribers, 2.5 million were equipped with 'LE CUBE' decoders.

- Exhibit CHP1 – information taken from Wikipedia relating to the origin of Canal+ and its various channels.

- CHP2 – printouts from Wayback Machine and web.archive.org, dated 2013 – 2019. The '+ device' appears either before or after wordings, e.g., '+LE CUBE', and 'CANAL+', 'RUGBY+', 'CINE+' etc., (changing depending on the genre of programme on the channel).

- CHP3 – printouts from Wayback Machine showing examples of '+ device' on apps. However, none of the printouts appear to be dated from within the relevant period.

- CHP4 – images of store windows and products displaying either CANAL+, or the '+ device' solus. The exhibit is not dated, and the witness statement does not indicate when or where the images were taken.

- CHP7 – a guide on how to use the Opponent's product 'Cube S', which is a decoder to stream television. The '+ device' appears on the product itself, and is referred to in the text as 'CANAL+'. It was issued in June 2015, outside of the relevant period.

- CHP8 – samples of CANAL+ television programme schedule for 2015 – 2016. The programme is entitled *GRILLE DE NOEL CANAL+ 2015/2016*. The accompanying translation explains the programme covers the Christmas schedule, which would logically end before April 2016, and is therefore outside of the relevant period.

- CHP12 – extracts from fuseproject.com, indicating awards that 'CANAL+ le cube s' won in 2016.

- CHP16 – examples of subscription agreements to CANAL+.

- CHP18 – information pertaining to a partnership between CANAL+ and 'Deezer', a third-party music streaming service, that was available via 'CANAL+ LE CUBE'.

- CHP20 – a selection of images of merchandise items, displaying 'CANAL PLUS' or the '+ device' solus. The exhibit has not been dated, nor is a date mentioned in the witness statement. Further, no location as to where the items were available was provided. The products included an umbrella, notepad, keyring and USB stick. Some of the images had the appearance of stock images or draft designs, rather than actual products:

- CHP21 – purchase order details of certain merchandise items from 2017 - 2019. The items included a cap, football, rugby ball, umbrella, and two styles of t-shirt, one of which had the word ‘STAFF’ on it.

Opponent submissions in lieu of a Hearing

15. On 10 October 2022, the Opponent filed its submissions, firstly recapping the proceedings to date before stipulating what is required and expected in order to satisfy a proof of use request. The Opponent contended that the evidence is not required to prove reputation or extensive use, rather genuine commercial use in accordance with the essential function of a trade mark would be sufficient. The Opponent contended that the evidence showed continuous use of the mark over three decades, and indicated that it is a leading global brand in “… *premium content production, the creation of thematic and free-to-air channels, as well as the bundling and distribution of pay-TV services in France and other major markets around the globe. The Opponent also provides broadcasting services for the general public as well as internet services accessible on smartphones, tablets and PC’s as well as various media such as TV sets*.” The Opponent submitted that the French [language] channels would naturally be broadcast to a Francophile public, regardless of their country of domicile, and would therefore be accessed from countries such as Belgium. The Opponent argued that when combined, the countries of France and Belgium represented a substantial part of the EU. The Opponent argued that the distinctive character of the ‘+ device’ would not be altered by its use in composite marks. The Opponent argued that the evidence of composite marks which include the ‘+ device’ would therefore satisfy the condition of genuine use.

16. The Opponent also provided submissions as to the similarity of the marks at issue. The Opponent contended that the earlier mark is visually similar to a very high degree

with the “white + device” in each of the contested applications. The Opponent argued that the word ‘TECHLAB’ in the contested mark 3627829 is descriptive and lacked distinctive character, and therefore did not serve to differentiate the marks. As to the aural comparison, the Opponent argued that the contested mark 3627829 is similar to the earlier mark given the distinctiveness of the device within it, which would be pronounced as ‘plus’, which is the same way it would be pronounced in both the earlier mark and other contested mark 3627830. From a conceptual perspective, the Opponent argued that both of the contested marks were similar to the earlier mark, or at least closely connected, on the basis that they both evoked a complex ‘+ device’. In relation to application 3627829 specifically, the Opponent submitted that the focus of attention would be on the ‘+ device’ over the words ‘JETBRAINS’ and ‘TECHLAB’, given that the device is the most dominant and meaningful element of the mark. Further, the Opponent claimed that the ‘+ device’ retained an independent and distinctive role within the contested mark 3627829. Furthermore, the Opponent claimed that the consumer would simply understand the words ‘JETBRAINS’ and ‘TECHLAB’ in the contested mark 3627829 to be an extension of the Opponent’s brand, or that the owner of the contested mark and earlier mark were in some way economically linked.

17. In relation to the goods and services at issue, the Opponent contended that the broad range of its goods and services encompassed those of the contested applications. The Opponent argued that the respective services would be marketed in the same way, through the same retail outlets or online shops, and would have the same end users. As such, the goods and services would be viewed by consumers as being in direct competition with one other. According to the Opponent, the relevant consumer is the general public at large, who rarely has the opportunity to compare the marks side by side, and must instead rely on imperfect recollection. Finally, the Opponent referred to the principle of interdependency, whereby any differences between the marks at issue would be offset by the high degree of similarity between the goods and services at issue.

Applicant submissions in lieu of a Hearing

18. On 11 October 2022, the Applicant filed its submissions, arguing that despite the voluminous evidence filed by the Opponent, it is “manifest that [it] has not used its

Earlier Trade Mark in relation a vast majority of the goods and services relied upon in the proceedings". The Applicant provided detailed submissions for each of the exhibits that the Opponent had submitted. These submissions shall not be summarised here but will rather be called upon if they provide assistance during my own assessment of the evidence of proof of use. That having been said, it is clear the Applicant argued in general terms that the evidence of use related to a mark that was a significant variation of the earlier mark, with additional elements that altered the distinctive character of the earlier mark. The Applicant contended that in light of the evidence, a 'fair specification' of the Opponent's goods and services would be:

Class 9	Set top boxes.
Class 35	Subscription services to a television channel.
Class 41	Television entertainment on any media namely television set and the Internet.

19. The Applicant also provided submissions in relation to the comparison of the marks at issue, and argued that because the earlier mark is a device only mark there can be no aural similarity with either of the applications. The Applicant submitted that the earlier mark is a white plus "in the form of a Swiss or Greek cross depicted against a black square background", whereas the device in the contested marks is a white "reticle device against a black rounded rectangle or 'squircle' … with the width of the arms [being] markedly narrower than the length of the arms, thus giving the impression of a reticle rather than a Swiss or Greek cross". The Applicant argued that with this in mind the marks appear very different to the eye, and are also conceptually dissimilar. In relation to contested mark 3627829 in particular, the Applicant submitted that neither the distinctive and dominant word 'TECHLABS' nor the highly distinctive word 'JetBrains' are present int the Opponent's earlier mark, and therefore the contested mark is visually, conceptually and aurally dissimilar to the earlier mark.

20. The Applicant acknowledged that a certain number of the goods and services at issue are identical or similar to those of the earlier mark, however, the Opponent's proof of use has not supported the position that it can rely on goods and services in

class 14, 16, 18[1], 25, 28 or 42. The Applicant provided further submissions as to the identity/similarity, or lack thereof, of the goods and services at issue. These submissions shall not be summarised fully here, rather they shall be introduced into the decision wherever I consider them to provide assistance and clarity. The Applicant requested the option to provide a "fall back" specification for the opposed applications on a preliminary basis, with the option to offer an alternative in due course. The fall-back option was to add the following limitation to class 9, 35 and 42: *relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education*. As the Applicant has not requested a pause of the proceedings, or expressly requested via TM21 the opportunity to amend the contested goods and services, the affects (if any) of this proposition shall be dealt with in the body and conclusion of the decision.[2]

Decision

21. 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

22. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

> "114……The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm*

[1] The Opponent did not specify a reliance on class 18.
[2] TPN 1/2011; 3.3.2

Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other

goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

23. In *Awareness Limited v Plymouth City Council*, *PLYMOUTH LIFE CENTRE*, BL O/236/13, Mr Daniel Alexander Q.C (as he then was), as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use […]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public".

24. In *CATWALK* Trade Mark, BL O/404/13, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person stated that:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in Matsushita Electric Industrial Co. v. Comptroller- General of Patents [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:
>
> > [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors.

> The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use"

Form of use

25. In *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (CJEU) found that:

> "32. … the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.
>
> …

> 35. Nevertheless, … a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".

26. Whilst the Opponent's evidence does not consist exclusively of examples of the earlier mark being used either in conjunction with another mark or as part of a composite mark, it is nevertheless clear to me that the majority of the evidence is not of the earlier mark being used independently. The earlier '+ device' mark invariably appears either before or after the word 'CANAL', or in more stylised combinations such as:

27. The examples above certainly do not constitute instances of independent use of the earlier mark, however, it is self-evident that the earlier mark is as large, if not larger in some instances, as the additional elements it is being used in conjunction with, which often serve as nothing more than stylised indicators of the subject matter of a particular television channel, e.g., *cinema* or *rugby*. According to the *Colloseum* judgment, such examples would be acceptable for demonstrating use so long as the earlier mark continues to be perceived as an indicator of trade origin. In my opinion, the consumer would most likely perceive the '+device' as the true indicator of origin because, as mentioned previously, the additional elements it is used in conjunction with are often merely stylised descriptive elements which could even be dismissed as such, or would be dismissed instead as pure decoration. This applies also to those instances where the '+ device' appears with the term 'CANAL', as it is a basic French word that translates to CHANNEL, which I argue even a consumer with little-to-no grasp of the French language would understand descriptively, given its similarity in letterings and soundings to the English equivalent. If I am considered to be wrong on this, and the use of 'CANAL' and stylised descriptive words such as *cinema* or *rugby* are instead perceived as a distinctive elements, this does not detract from the reality that the earlier mark is clearly used.

28. In *Nirvana Trade Mark,* BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test of use in a differing form from the trade mark as registered:

> "33. …. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period…
>
> 34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

29. The instances where the earlier '+ device' mark appears in use is no different from the form in which it is registered. In answer to the questions as presented in paragraph 34 of the *Nirvana* decision: (a) The distinctive character of the earlier mark is a white cross/plus sign on a black background, and this representation is constant throughout the use; (b) the difference between the mark as registered and mark in use is that it appears with additional descriptive and/or decorative elements; (c) I do not consider the use of additional descriptive words or decorative elements to alter the distinctive character of the '+ device'. This is the case even if the additional elements are considered to be distinctive in their own right, as they do not alter, affect, manipulate or interfere with the registered form of earlier mark. I therefore find the evidence to include examples which can be considered for assessing whether genuine use has been proven.

Genuine use

30. The relevant statutory provision Section 6A, 1A identifies that the relevant period for proving genuine use is the period of 5 years ending with the date of application for registration of the contested mark, or the date of priority claimed for that application.

The relevant period for the earlier mark UKTM No. 801025864 has been established as being 17 April 2016 and 31 December 2020 in the EU, and between 1 January 2021 and 16 April 2021 exclusively in the UK. A number of the exhibits and submissions pertain to a period before 17 April 2016, and for the purposes of genuine use they shall not be considered in this instance. In addition, it is noted that none of the evidence pertains to the particular period of time when the mark would have had to have been used exclusively in the UK, i.e., after January 2021. In other words, the evidence is limited to use in the EU before IP Completion Day.

31. It is clearly established that the burden of furnishing the Registrar with sufficient proof lies with the proprietor of the earlier mark,[3] and that the evidence must represent the Opponent's best case.[4] The assessment of genuine use is multifactorial and must be restricted to analysing the evidence presented before me. Having analysed the submitted evidence, I find that the examples provided do constitute 'actual use'[5] that is 'consistent with the essential function of a trade mark',[6] i.e., the evidence demonstrates real use of the earlier mark with the intention of identifying the origin of the goods and services. Although the majority of the evidence shows use of the earlier mark used in conjunction with another mark or as a combination mark, I nevertheless do not consider the additional elements to alter the distinctive character of the earlier mark, or detract from its obvious presence, and therefore the substantial volume of use is more than merely token.[7] Further, the use consistently appears in relation to certain goods and services for which the earlier mark is registered, and therefore accords with the commercial raison d'être of a trade mark, i.e., to create or preserve an outlet for the goods or services that bear the mark.[8]

32. I am aware that use need not always be quantitively significant for it to be deemed genuine, and that even minimal use of a mark may qualify as genuine use if it is

[3] *Plymouth* BL O/236/13

[4] BL O/424/14 *Guccio Gucci SPA v Gerry Weber International AG* – Although these proceedings related to revocation proceedings, the principle is nevertheless the same for proof of use in opposition actions, whereby it is essentially incumbent on the Opponent to provide the Registrar with its best case at the earliest opportunity.

[5] *Ansul* paragraph 35.
[6] *Ibid* paragraph 36.
[7] *Ibid* paragraph 36.
[8] *Reber* paragraph 29.

deemed justified in the economic sector of the relevant goods or services. [9] Further, there is no *de minimis* rule on what is or is not considered quantifiable use.[10] Whilst the probative value of the invoices submitted in evidence have been questioned by the Applicant, I nevertheless consider them to indicate economic activity, and they are therefore sufficient for the purposes of proving genuine use. In light of the above, I consider the evidence provided demonstrates genuine use of the earlier mark. However, the use does not relate to the entire specification upon which the Opponent relies.

Framing a fair specification

33. In the original notice of Opposition, the Opponent claimed in question 3a that the earlier mark has been used on all of the goods and services for which it is registered in classes 14, 16, 25, 28, 35, 41 and 42. The Applicant in its submissions in lieu of a Hearing argued that the earlier mark had in fact only been used on *set top boxes* (class 9), *subscription services to a television channel* (class 35), and *television entertainment on any media namely television set and the internet* (class 41). In my opinion, based on an examination of the evidence before me, the Applicant's submissions are a closer reflection of the actual use of the mark than the Opponent's claim in the notice of opposition.

34. In order to identify a 'fair specification', Mr Geoffrey Hobbs Q.C (as he then was) as the Appointed Person provided a summary of the law to be taken into account in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

[9] *Ansul* paragraph 39.
[10] *Leno Merken* paragraph 55; and *Ansul* paragraph 39

35. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

> “iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].
>
> v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in Pa*n World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].
>
> vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. Maier v Asos Plc [2015] EWCA Civ 220 ("Asos") at [56] and [60].
>
> vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider

to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46."

36. Based on an assessment of the evidence submitted before me, I consider it a fair reflection to say that the earlier mark has only been used in relation to a narrower scope of goods and services than that for which it is registered. Instead of listing the goods and services upon which the earlier mark has not been used, it is a more economic use of time to positively identity the goods and services upon which the earlier mark clearly *has* been used in the evidence. It appears to me that the Opponent's trade is primarily that of providing a television service. The Opponent claimed as much in its submissions in lieu of a Hearing, whereby it stated that it is a leading global brand in "… *premium content production, the creation of thematic and free-to-air channels, as well as the bundling and distribution of pay-TV services in France and other major markets around the globe."*

37. It is arguable and logical to assume that certain devices and instruments in class 9 would be required in order to provide such a service, and that if such services are proven to be genuinely used then this could be extrapolated to establish that the functionary goods in class 9 have also been genuinely used. The same would apply to certain design services in class 42. However, in both instances this would be an assumption, and a generous assumption at that. I refer to the principle that actual use must be proven through evidence (see *Ansul*). In my opinion it would be unfair and detrimental to the Applicant to allow the Opponent to proceed on the basis of goods or services which are assumed to be used, rather than expressly and explicitly evidenced. With this in mind, certain functionary goods and services, such as *satellite dishes*, *software* and *design of control systems for television programmes* for example, would need to have been proven to have been genuinely used in the evidence submitted, rather than generously assumed to have been used through my own supposition.

38. Based on a careful examination of the evidence submitted, I intend to propose a list of goods and services that is a more realistic and fair reflection of what has been unequivocally proven through use. The list will be neither restricted to the narrowest possible terms, nor extended to unfairly monopolise a general category. The list will

also be summarised into the identifiable categories that I consider to accord with the perception of the average consumer (see *Euro Gida Sanayi Ve Ticaret*). The first class on the list is class 9:

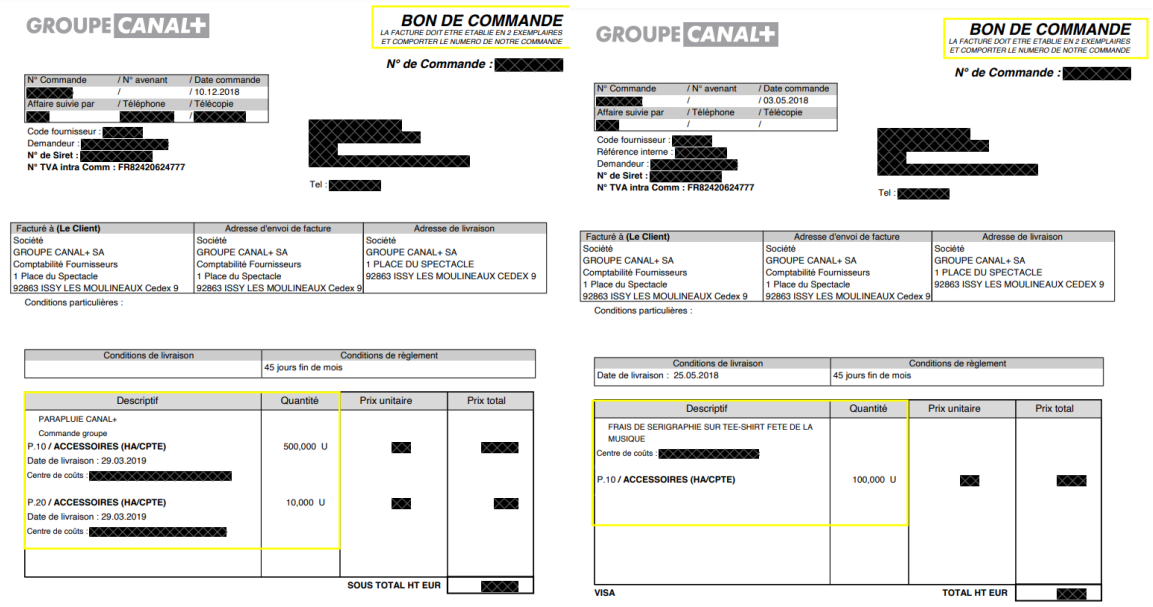
Class 9 *Set top boxes, encoders; simultaneous programming and television channel selection devices; apparatus and instruments for television programme selection and programming*; *interactive television apparatus and instruments.*

39. It is noted that the Opponent claimed that it provides broadcasting services on smartphones, tablet's and PC's etc, on the basis that its content is accessible via the internet. The fact that the services can be viewed on such a device does not signify that the mark has been used on or in relation to the actual devices themselves, and therefore the argument for genuine use on similar devices in class 9 (as I have interpreted the arguments to be) is unsupported by the evidence submitted. In addition, despite the Opponent's claim that the mark has been used on *apps*, the evidence provided to indicate this is restricted to a period primarily before the relevant period (see CHP3). The Opponent has therefore failed to show genuine use on *apps*, which has the knock-on effect of failing to show genuine use in relation to a synonym for *apps*, i.e., "software (recorded programs)".

40. The Opponent has claimed genuine use on a number of goods that could be classified as *merchandise*. This includes *key rings* (class 14); *note books* (class 16); *umbrellas, bags* (class 18) (although the Opponent did not rely upon class 18 in its notice of opposition); *tee-shirts* (class 25); and *footballs* and *rugby balls* (class 28). It is noted that goods from class 34 have not been mentioned/evidenced. In order to support its position of genuine use in relation to merchandise, the Opponent included images of such goods at CHP20, and purchase orders at CHP21. Although *footballs* and *rugby balls* have been referred to in the invoices, there is no imagery to support the use of the mark on these items. It is therefore not possible to assess how the mark is being used, or whether it is being used in a way that is 'consistent with the essential function of a trade mark'.[11] The same applies to the *travel bags* and *sports bags* for

[11] *Ansul* paragraph 36.

which genuine use has been claimed. I include herein a sample order form for *umbrellas* (500,000 units 10 December 2018) and *t-shirts* (100,000 units 3 May 2018):



GROUPE CANAL+

BON DE COMMANDE

LA FACTURE DOIT ETRE ETABLIE EN 2 EXEMPLAIRES ET COMPORTER LE NUMERO DE NOTRE COMMANDE

N° de Commande : [redacted]

N° Commande	/ N° avenant	/ Date commande
[redacted]	/	/ 10.12.2018
Affaire suivie par	/ Téléphone	/ Télécopie
[redacted]	[redacted]	/ [redacted]

Code fournisseur : [redacted]
Demandeur : [redacted]
N° de Siret : [redacted]
N° TVA intra Comm : FR82420624777

Tel : [redacted]

Facturé à (Le Client)	Adresse d'envoi de facture	Adresse de livraison
Société	Société	Société
GROUPE CANAL+ SA	GROUPE CANAL+ SA	GROUPE CANAL+ SA
Comptabilité Fournisseurs	Comptabilité Fournisseurs	1 PLACE DU SPECTACLE
1 Place du Spectacle	1 Place du Spectacle	92863 ISSY LES MOULINEAUX CEDEX 9
92863 ISSY LES MOULINEAUX Cedex 9	92863 ISSY LES MOULINEAUX Cedex 9	

Conditions particulières :

Conditions de livraison	Conditions de règlement
	45 jours fin de mois

Descriptif	Quantité	Prix unitaire	Prix total
PARAPLUIE CANAL+			
Commande groupe			
P.10 / **ACCESSOIRES (HA/CPTE)**	500,000 U	[redacted]	[redacted]
Date de livraison : 29.03.2019			
Centre de coûts : [redacted]			
P.20 / **ACCESSOIRES (HA/CPTE)**	10,000 U	[redacted]	[redacted]
Date de livraison : 29.03.2019			
Centre de coûts : [redacted]			
		SOUS TOTAL HT EUR	[redacted]

GROUPE CANAL+

BON DE COMMANDE

LA FACTURE DOIT ETRE ETABLIE EN 2 EXEMPLAIRES ET COMPORTER LE NUMERO DE NOTRE COMMANDE

N° de Commande : [redacted]

N° Commande	/ N° avenant	/ Date commande
[redacted]	/	/ 03.05.2018
Affaire suivie par	/ Téléphone	/ Télécopie
[redacted]	/	/

Code fournisseur : [redacted]
Référence interne : [redacted]
Demandeur : [redacted]
N° de Siret : [redacted]
N° TVA intra Comm : FR82420624777

Tel : [redacted]

Facturé à (Le Client)	Adresse d'envoi de facture	Adresse de livraison
Société	Société	Société
GROUPE CANAL+ SA	GROUPE CANAL+ SA	GROUPE CANAL+ SA
Comptabilité Fournisseurs	Comptabilité Fournisseurs	1 PLACE DU SPECTACLE
1 Place du Spectacle	1 Place du Spectacle	92863 ISSY LES MOULINEAUX CEDEX 9
92863 ISSY LES MOULINEAUX Cedex 9	92863 ISSY LES MOULINEAUX Cedex 9	

Conditions particulières :

Conditions de livraison	Conditions de règlement
Date de livraison : 25.05.2018	45 jours fin de mois

Descriptif	Quantité	Prix unitaire	Prix total
FRAIS DE SERIGRAPHIE SUR TEE-SHIRT FETE DE LA MUSIQUE			
Centre de coûts : [redacted]			
P.10 / **ACCESSOIRES (HA/CPTE)**	100,000 U	[redacted]	[redacted]
VISA		**TOTAL HT EUR**	[redacted]

41. I consider it pertinent to identify the difference between a purchase order and a sales invoice. The extracts above were described by the Opponent as purchase orders, which based on my understanding (and lack of explanation to the contrary) were made by GROUPE CANAL + SA to be purchased from GROUPE CANAL + SA. In other words, these appear to be internal orders of items rather than sales to third party customers. It seems to me that these merchandise goods are the type that are worn by members of staff, rather than an average consumer (the following image is taken from page 50 of exhibit CHP21):

Further, I consider the other merchandise goods to more likely be those gifted to consumers of the Opponent's services, rather than directly purchased by customers. Indeed, there are no invoices of actual sales in pounds sterling or euros to external

customers to suggest that they are directly bought. It is noted that the sales amounts on the order forms are blanked out. Without actual figures of sales, the suggestion that a sale has occurred is hampered. I therefore do not consider genuine use to have been proven on goods in classes 14, 25 or 28.

42. In relation to class 16 more specifically, it is noted that although evidence was provided which showed the earlier mark being referred to in publications, those publications were either mostly dated from a time before the relevant period (CHP5 and CHP7), or, if they were from within the period, were mentioned in a third-party publication (see e.g., page 42 – 57 of CHP9). Being referred to in an article by a third party does not constitute use of the mark by the Opponent on publications or printed matter. I note that exhibit CHP6 does include examples of the Opponent itself producing publications containing the earlier mark from within the relevant period. However, these publications consist exclusively of promotional leaflets and product guides. I therefore consider a fair specification of an identifiable category to be:

Class 16 *Printed matter, all being promotional material and user guides; television programme guides.*

43. As previously stated, and as clearly indicated by the Opponent in its submissions, the trade of the Opponent is the provision of a television service. I consider this to have been sufficiently evidenced to the point that I accept the mark to have been genuinely used in relation to the following identifiable categories in class 35:

Class 35 *Arranging of audiovisual programme, audio programme subscriptions for others; subscription services to a television channel.*

44. It is noted that the earlier mark is registered for the *retail of set-top boxes*. I am aware that I have accepted *set-top boxes* as goods in class 9 that have been proven to be genuinely used via the evidence. However, the evidence does not prove sale of such items. Moreover, whilst *set-top boxes* are clearly used in order to provide the *audio programme subscriptions* etc., the evidence does not indicate that the goods are purchased independently through a retail outlet. Rather, these goods tend to be provided (for free) in order that the services may be enjoyed, and are often even

collected once the service is no longer used. This implies a loan relationship, rather than a purchase.

45. I note that the evidence provided has supported the Opponent's position that it is a provider of television channels/services. However, the Opponent did not identify in its original notice of opposition that it would be relying upon class 38 (see 'continuation sheet', page 9 of the notice), and therefore the proof of use is not considered to have been filed to support use in this class.

46. I consider the evidence to have proven genuine use for the following services in class 41:

Class 41 *Television entertainment on any media namely television set, computer, PDA, mobile telephone, computer networks, the Internet; production of shows, films, television films, televised broadcasts, reports, debates, video recordings, sound recordings; production of shows, films, audiovisual, radio and multimedia programmes.*

47. The goods and services not indicated in the above list have either not been expressly evidenced, or are completely arbitrary and do not fall within the scope of proven trade of the earlier mark, which is the provision of a television service, e.g., *spectacles (class 9); sundials* (class 14); *paper face towels* (class 16); *ski footwear (class 25); casino services* (class 41).

Section 5(2)(b)

48. Section 5(2)(b) of the Act is as follows:

> "(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".

Section 5A

49. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

50. 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

51. Both parties provided submissions in relation to the respective goods and services at issue. Whilst the parties' comments are noted, the degree of similarity or identity of the goods and services, as the case may be, is something which fundamentally contributes to whether there is a likelihood of confusion. I must therefore conduct my own full analysis of the goods and services at issue. I shall refer to the submissions of each party if and when I consider them to provide assistance and clarity.

52. The goods and services of the earlier mark that shall be considered for the purposes of this comparison are only those for which genuine use has been proven.

Earlier mark	Applications 3627830 & 3627829
	Class 6: *Art objects of metal, metals in foil or powder form for 3D printing*.
Class 9: *Set top boxes, encoders; simultaneous programming and television channel selection devices; apparatus and instruments for television programme selection and programming*; *interactive television apparatus and instruments.*	Class 9: *Software, digital publications, downloadable electronic books*.
	Class 14: *Key chains, Watch straps of synthetic materials, non-metal key rings, non-metal key chains, articles of jewelry made of precious metals or precious metal alloys, pins.*
Class 16: *Printed matter, all being promotional material and user guides; television programme guides.*	Class 16: *Printed matter, art prints, printed publications, stickers, posters*.
	Class 17: *Rubber, artificial resins (semi-finished products), decoration articles made of rubber, plastic filaments for 3D printing.*
	Class 19: *Works of art of stone, artificial stone, clay*.
	Class 20: *Works of art of wood, wax, plaster or plastic, model figures of synthetic resin, models of synthetic resin*.

	Class 21: *Cups, glasses, works of art of glass, porcelain or ceramic.*
	Class 25: *Clothing, t-shirts, footwear, headgear.*
	Class 28: *Toys, playthings*.
	Class 30: *Coffee, tea, artificial coffee, cocoa-based beverages, coffee-based beverages, tea-based beverages.*
Class 35: *Arranging of audiovisual programme, audio programme subscriptions for others; subscription services to a television channel.*	Class 35: *Retail Services related to art objects of metal, metals in foil or powder form for 3D printing, software, digital publications, downloadable electronic books, key chains, Watch straps of synthetic materials, nonmetal key rings, non-metal key chains, articles of jewelry made of precious metals or precious metal alloys, printed matter, art prints, printed publications, rubber, artificial resins (semi-finished products), decoration articles made of rubber, plastic filaments for 3D printing, works of art of stone, artificial stone, works of art of wood, wax, plaster or plastic, model figures of synthetic resin, models of synthetic resin, cups, glasses, works of art of glass, porcelain or ceramic, clothing, t-shirts, footwear, headgear, toys, playthings, coffee, tea, artificial coffee, cocoa-based beverages, coffee-*

	based beverages, tea-based beverages; marketing.
	Class 40: *Printing, 3D printing, metal treating*
Class 41: *Television entertainment on any media namely television set, computer, PDA, mobile telephone, computer networks, the Internet; production of shows, films, television films, televised broadcasts, reports, debates, video recordings, sound recordings; production of shows, films, audiovisual, radio and multimedia programmes.*	Class 41: *Education, entertainment, art gallery services, arranging and conducting of seminars and conferences, arranging and conducting of exhibitions for cultural and educational purposes, providing online electronic publications (not downloadable).*
	Class 42: *Science and technological services, computer software design, maintenance of computer software*.
	Class 43: *Restaurant services, cafes, bar services, snack-bars.*

53. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

54. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

55. It has also been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, 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 fur 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".

56. 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 that the responsibility for those goods lies with the same undertaking".

57. 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 Amelia 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.

Classes 6, 19, 20, 21, 28, 30, 40, 43

58. The contested goods and services applied for in these classes can be fairly summarised as being *art pieces* (classes 6, 19, 20 and 21); *items of rubber* (class 17); *crockery* (class 21); *toys* (Class 28); *beverages* (class 30); *printing services* (class 40) and *provision of food and drink* (class 43). The earlier mark has not been proven to have been genuinely used on goods or services that are in any way similar to the contested goods and services in classes 6, 19, 20, 21, 28, 30, 40, 43. In fact, the earlier mark is not registered for any goods or services in several of these contested classes, nor is it registered for goods and services in classes that would otherwise be comparable. Further, other than for making the following statement in the submissions

in lieu of a Hearing, the Opponent has not provided any actual specifics as to where any identity or similarity between the goods and services may be found:

> "*The Opponent's earlier registration covers a broad range of goods and services which encompass the Applicant's goods and services. The Applicant's goods/services are therefore identical and closely similar to the goods and services covered by the Opponent's prior trade mark. The services would be marketed or advertised in the same way, through the same retail outlets or online shops and have the same end users. As such, the goods and services would be viewed by consumers as being in direct competition with each other*."

59. Considering the principles of the case law cited above, and lacking specifics as to why there may be any similarity or identity, I can see no justification for finding the contested goods in classes 6, 19, 20, 21, 28, 30, 40, 43 to be similar or identical to those of the earlier mark. As such, the goods and services in these contested classes are considered dissimilar.

Class 9

60. The contested *digital publications* and *downloadable electronic books* have a different nature, intended purpose, end user and trade channel from the goods in class 9 of the earlier mark, all of which are essentially devices, apparatus and instruments that are used in relation to providing, viewing, storing and selecting television channels. In addition, these particular contested goods are not in competition with those of the earlier mark. However, it is possible that the information contained on the *digital publications* and *downloadable electronic books* is that of a user manual for the items in class 9 of the earlier mark. Therefore, the contested *digital publications* and *downloadable electronic books* are considered to be complementary to the goods in class 9, as there is a likely close connection and importance/indispensability between them.

61. An additional comparison of the contested *digital publications* and *downloadable electronic books* can be made with the goods in class 16 of the earlier mark. The contested *digital publications* and *downloadable electronic books* are essentially the digital and downloadable versions of printed matter. The evidence has proven genuine

use of the earlier in relation to *Printed matter, all being promotional material and user guides; television programme guides* in class 16. The contested *digital publications* and *downloadable electronic books* could encompass as a more general category the specific content of the promotional matter, user guides and television programmes in class 16 of the earlier mark, and therefore have the same intended purpose and end user. Further, they are likely to be in competition. As a result, as well as being complementary to goods in class 9, the contested *digital publications* and *downloadable electronic books* are similar to a medium degree with the goods in class 16 of the earlier mark.

62. The contested *software* is a general category that could include a broad scope of specific sub-categories of software. It is undoubted that the goods in the earlier mark require software in order to function, and therefore there is likely a complementary relationship as one is essential or important to the provision of the other.

63. I note the Applicant's request to include a provisional "fall back" limitation to the goods in class 9, being *relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education.* The decision in relation to the proposed limitation will be reserved until the outcome of the decision, dependent on whether there is a likelihood of confusion between the marks, or not.

Class 16

64. The contested *Printed matter* and *printed publications* would encompass, as a more general category, the *printed matter, all being promotional material and user guides* and *television programme guides* of the earlier mark, and are therefore considered to be identical under the *Meric* principle. The contested *art prints, stickers* and *posters* have a different nature, intended purpose, end user and trade channel to the goods in class 16 (or any other class for that matter) of the earlier mark. Further, they are neither complementary nor are they in competition, and are therefore dissimilar.

Class 35

65. The contested services in class 35 are limited to the provision of a retail service for a selection of goods that can be categorised, in my opinion, as being art and art

items, software, digital publications, glassware, clothing and beverages. The services in class 35 of the earlier mark for which genuine use has been proven consists of the arranging and provision of subscriptions in relation to audio-visual programmes and television channels. The services at issue therefore differ as to their nature, intended purpose, end user and trade channel. Further, the services are neither in competition nor are they complementary. The earlier mark is not registered for any goods or services in other classes which could be considered similar to those of the contested mark in class 35. As a result, all of the contested services in class 35 are dissimilar.

Class 41

66. The contested *entertainment* is a general category that includes the *Television entertainment on any media namely television set, computer, PDA, mobile telephone, computer networks, the Internet* of the earlier mark, and is therefore identical under the *Meric* principle. The contested *providing online electronic publications (not downloadable)* is similar to the *Printed matter, all being promotional material and user guides* and *television programme guides* in class 16 of the earlier mark, insofar as it has the same intended purpose and end user and is likely to be in competition. As a result, the contested *providing online electronic publications (not downloadable)* is similar to a medium degree.

67. The remaining contested services relate to education, art galleries, seminars and exhibitions for cultural and educational purposes. They are all dissimilar to the services in class 41 of the earlier mark, which are specific to the provision and production of television, and therefore have a different intended purpose, nature, end user and trade channel. They are also not in competition nor are they complementary. The remaining contested services in class 41 are not similar to any of the services in class 35 of the earlier mark either, which focus on the provision of audio-visual programmes (i.e., television), predominantly via subscription.

68. Following a comparison of the respective goods and services at issue, I have found the following:

Class 9 *Software* – complementary

Digital publications; downloadable electronic books – complementary and similar to a medium degree

Class 16 *Printed matter, printed publications* – identical

Class 41 *Entertainment* – identical

Providing online electronic publications (not downloadable) – similar to a medium degree

Comparison of the marks

69. In *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, Lady Justice Arden stated that:

> "49... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover, I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

70. In relation to those contested goods and services that have been found to be dissimilar there can be no likelihood of confusion. It is therefore not necessary to conduct a comparison of the marks in relation to those particular goods and services.

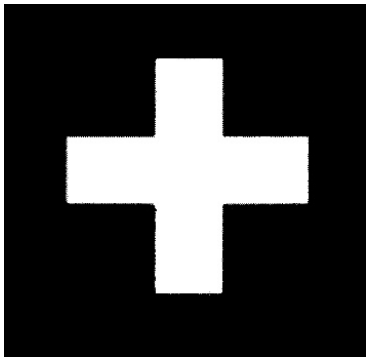
71. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference 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."

72. It would be wrong, therefore, to dissect the trade marks artificially, 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.

73. The respective trade marks are shown below:

Earlier mark	Applications 3627830 & 3627829
	 

74. The earlier mark is a figurative trade mark, consisting of a white cross/white plus sign on a black square background. The arms of the cross/plus are the same width and length. The overall impression of the mark is caused by the combination of the

cross/plus sign and the background upon which it is placed, which is also where any distinctiveness lies.

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75. The contested mark is a figurative trade mark, consisting of a white cross/white plus sign on a black square background. The edges of the square are rounded. The arms of the cross/plus are the same width and length. At the centre of the cross/plus sign where the arms meet, they curve into one another. The Applicant argued that the contested mark may be perceived as a reticle. A reticle, or reticule, is the pattern of lines built into an eyepiece or scope. As such, the surrounding border is invariably circular as opposed to square. Nevertheless, I do not entirely dismiss the possibility that a certain number of consumers may perceive this concept. The overall impression of the mark is caused by the combination of the cross/plus sign and background upon which it is placed, which is also where any distinctiveness lies.

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76. The contested mark consists of a combination of figurative and word elements. Viewing the mark from left to right, the first element is the figurative element as described above, which forms the entirety of application 3627830. The figurative element is the same height (but not the same width) as the element TECHLAB, which is written in a stylised font. The element TECHLAB is a combination of the two English-language words TECH, as in ‘Technical’, and LAB, as in ‘Laboratory’. Whilst the Opponent has argued TECHLAB is descriptive, I do not consider this to be an accurate submission, as several of the goods and services are neither technical nor created in/provided by a laboratory. For those more technical goods and/or services, I argue that the mark is still not entirely or directly descriptive, as it is a conjoined term that uses a distinctive font that potentially scrambles any obvious meaning. Above the letters T and E of the word TECHLAB is the smaller word JetBrains. It is the smallest element of the mark, and is written in a more standard font. The element JetBrains is a combination of the two English-language words ‘Jet’, as in fast aircraft, and ‘Brains’, as in the plural form of the organ that controls the human body (brains). As a combination it has no obvious meaning in relation to the goods and services at issue. Although the figurative element is the first to be seen if reading from left to right, I

consider the more dominant element of the mark to be the word TECHLAB, due to its larger size and eye-catching font. I also consider it to be the more distinctive.

Visual similarity

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77. Visually, the marks are similar insofar as they each consist of a white cross/white plus sign on a black background. I note that the arms of the cross/plus in the earlier mark are thicker than those in the contested mark, and that the centre of the cross/plus sign in the contested mark is invertedly curved. I also note that the edges of the square in the contested mark are rounded, whilst the edges of the square in the earlier mark are not. However, these visual differences are subtle, and are outweighed by the more evident similarities between the marks.

78. The marks are considered to be visually similar to a high degree.

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79. Visually, the marks are similar insofar as they each contain a white cross/white plus sign on a black background. The centre of the cross/plus sign in the contested mark is invertedly curved. In addition, the edges of the square in the contested mark are rounded, whilst the edges of the square in the earlier mark are not. This is the extent of the visual similarity. The marks differ from the visual aspect insofar as the contested mark contains the two word elements JetBrains and TECHLAB, which is stylised, neither of which have a counterpart in the earlier mark.

80. Due to the significant visual differences between the marks, caused by the inclusion of two word elements, one of which uses a stylised font, the marks are considered to be visually similar to no more than a low degree.

Aural similarity

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81. A figurative mark without word elements cannot be pronounced. Further, it is not necessary to examine the aural perception of a figurative mark that does not have

word elements. In this regard I refer to *DosenbachOchsner AG Schuhe und Sport v OHIM*, Case T- 424/10, whereby the GC stated:

> "45 The fact none the less remains that, contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to T-7/08 Nestlé v OHMI — Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe) [2010] ECR II-1177, paragraph 67). Page 28 of 34
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> 46 A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.
>
> 47 In those circumstances, and given that the contested mark is a figurative mark lacking word elements, it cannot be concluded there is either a phonetic similarity or a phonetic dissimilarity between that mark and the earlier marks."

82. Consequently, there is no aural comparison to be made.

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83. The contested mark contains two verbal elements: the larger and more dominant stylised two-syllable word TECH-LAB; and the smaller, less dominant two-syllable word JetBrains. Although JetBrains is the smaller of the two verbal elements it is not de minimis. Further, it is not descriptive. The element JetBrains is therefore neither negligible nor aurally invisible, and it would be articulated.

84. The earlier mark has no verbal element counterparts, and as such cannot be compared from an aural perspective.

85. Consequently, there is no aural comparison to be made.

Conceptual similarity

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86. The Applicant argued that the concept of the contested mark is a reticule. I do not entirely discount the possibility that a certain number of average consumers may perceive this concept, however, I am of the opinion that any consumer who perceives the contested mark as a reticule is as equally likely to perceive the earlier mark as a reticule also. In such instances, the marks would be conceptually identical.

87. In my opinion, and in light of the fact that none of the goods and services at issue relate to anything that would use a reticule, I find it more likely that the majority of consumers would not perceive the concept of a reticule in either mark. I believe the more obvious concept of each mark is simply that of a white cross/white plus sign on a black background. For the majority of consumers who do not perceive a reticule, the marks are considered to be conceptually similar to at least a high degree, if not conceptually identical.

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88. Conceptually the marks are similar insofar as they each contain a white cross/white plus sign on a black background (that may or may not be perceived as a reticule). This is the extent of any conceptually similarity.

89. The contested mark contains two additional verbal elements that have no counterpart in the earlier mark, each of which possesses a concept. The element TECHLAB has the concept of a technical (TECH) laboratory (LAB). Although the combination TECHLAB has an understandable concept, it does not appear to relate directly to the goods and services at issue. As a result, it is inherently distinctive to a medium degree. This level of distinctiveness is further enhanced by the use of a highly stylised font. The element JetBrains has the concept of a fast aircraft (Jet), and plural form of the organ that controls the human body (brains). As a combination, JetBrains is fanciful, and has no evidential meaning in relation to the goods and services at issue. As a result, it is inherently distinctive to a medium degree, also.

90. The marks are conceptually similar to a low degree.

Average consumer and the purchasing act

91. 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.[12] 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."

92. The goods and services at issue are everyday consumer items, insofar as they are purchased and used on a daily basis by the majority of average consumers in their personal or professional lives. I note that the goods at issue include *software*. I am aware that such an item can often have specific and specialist uses and needs, which could heighten the subsequent degree of attention. However, *software* can and will also be used to allow more menial tasks to function, therefore levelling out the general degree of attention. Whilst the price paid for the goods and services at issue can vary, dependent on a number of factors, I believe that overall they will fall within a generally affordable price range. As a result, I consider the level of attention of the average consumer to be between low and medium.

93. Based on the nature of the goods and services at issue I consider it most likely that the purchase process will be visually dominated. Whether the consumer is buying *software, digital publications* or *entertainment services*, for example, the consumer would be encountering such items in a store or magazine or online, and would therefore predominantly rely on the image of the trade mark on the products and

[12] *Lloyd Schuhfabrik Meyer*, Case C-342/97

services themselves. In the case of the earlier mark and the contested mark 3627830, the visual aspect is the only one which can be considered in the purchasing process, as neither include any verbal elements. That having been said, I find it apposite to keep in mind that a consumer may be forced to/attempt to describe the figurative elements of the earlier mark and contested mark 3627830 in certain purchasing situations, for example, when speaking to a sales assistant over the telephone in relation to a subscription service. As such, I accept that there may be an aural element to the purchasing process involving the two purely figurative trade marks, although this is secondary and less frequent than the visual process. I certainly consider there to be an aural element in the purchasing process of the contested mark 3627829, as it contains two verbal elements, one of which is the more dominant and distinctive aspect of that mark. However, as with the earlier mark and contested mark 3627830, the aural aspect will be secondary to the visual aspect of the purchasing process, bearing in mind the nature of the goods and services at issue.

Distinctive character of the earlier trade marks

94. The Opponent has provided proof of use, which has been examined and assessed to the point that genuine use has been proven only in relation to a reduced number of the goods and services for which the earlier mark is registered. Whilst the evidence provided has shown genuine use of the mark in relation to those goods and services, the evidence has not been filed in a way to indicate or suggest that the mark possesses any enhanced degree of distinctive character. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

95. 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 *WindsurfingChiemsee* 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)."

96. In *Kurt Geiger v A-List Corporate Limited* BL O-075-13, Mr Iain Purvis Q.C (as he then was), acting as the Appointed Person, pointed out that the level of 'distinctive character' is only 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."

97. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive

character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

98. The earlier mark is a figurative trade mark, consisting of a white cross or white plus sign on a black background. The Opponent has argued that the cross will be perceived as a Swiss or Greek cross (i.e., as the cross that appears on each respective flag). This may be the case, but it may also be the case that it will be perceived as a rudimentary cross, especially as neither of the colours red (Swiss flag) or blue (Greek flag) are the background upon which the cross is placed. There is no obvious or apparent relationship between the concept of a cross or plus and the goods and services at issue, nor has any meaning been argued by either party. As such, the mark is considered to be inherently distinctive to a medium degree.

Likelihood of confusion

99. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

100. 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 (see *Sabel*, C-251/95, para 22). 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 services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade 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.

101. In *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

> “49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

> And

> “50... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

102. In *Quelle AG v OHIM,* Case T-88/05, the GC found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

> “68... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight

will usually be attributed to any phonetic similarity between the signs (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland* v *OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55)… The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers."

103. Having conducted a full analysis and thorough comparison of the marks and their respective goods and services at issue, I have determined that it is the visual consideration which is of greater importance in the assessment of a likelihood of confusion between the earlier mark and the contested mark 3627830, due to the lack on any verbal elements in either mark. With this in mind, it is important to reaffirm that I have found the earlier mark and contested mark 3627830 to be visually similar to a high degree. As for the contested mark 3627829, I have determined that the visual consideration is also of primary importance, whilst not discounting the potential for an aural impact in the purchasing process. As such, it is important to reaffirm that I have found the earlier mark and contested mark 3627829 to be visually similar to no more than a low degree, whilst the marks are aurally dissimilar due to the lack of a verbal element in the earlier mark.

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104. The earlier mark is a white cross/white plus on a black background. The contested mark is a white cross/white plus on a black background. The marks are therefore visually similar to a high degree, with the only difference being minor design aspects, such as thinner arms of the cross/plus, rounded edges or inverted curves. Whilst the Applicant has argued that these differences are more significant, I consider them to be subtle and unlikely to be perceived by the reasonably observant and circumspect consumer.[13] Such a consumer is neither highly attentive nor casually dismissive, and in my opinion is unlikely to retain in its mind such minor details when imperfectly recalling the earlier mark. Although neither mark has an aural aspect, I have previously considered the possibility that a consumer may be forced to try to describe the marks in certain purchasing situations. In such scenarios, where the marks are articulated by way of a description in a conversation over the telephone, for example, it is my opinion that they would be pronounced identically as either "white cross on black background" or "white plus on black background".

105. Whilst the Applicant has argued that the contested mark is a reticule (and by implication has argued the earlier mark is not), I do not believe that the majority of the average consumers of the goods and services at issue would perceive the contested mark in such a way. I do not believe there is one universal style of reticule, and it is my understanding that a reticule can vary in terms of width and length of the arms, or whether the cross/plus is solid lines, or surrounded by circles, for example. I therefore find no reason to agree that the contested mark is conceptually different from the earlier mark by way of only one being an obvious reticule. In any case, if I were to accept the existence of a conceptual difference, this would not overcome the clear visual (and potential aural) similarities between the marks.[14]

106. In my opinion, it is a distinct possibility that when an average consumer (who is not paying a particularly high degree of attention) is faced with the contested mark consisting of a white cross/white plus on a black background on goods and services which are predominantly purchased based on their visual considerations, then they

[13] See paragraph 60 of *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*.
[14] *Nokia Oyj v OHIM,* Case T-460/07

may mistake it for a previously seen trade mark consisting of a white cross/white plus on a black background used in relation to goods and services that have been found to be identical, similar to a medium degree or complementary. It is important to appreciate that a consumer retains in its mind only an imperfect picture of an earlier mark, in which case I would argue that the minor differences of length and curvature of the cross/plus could be misremembered. Further, the only perceptible difference between the marks (being minor elements) would have zero impact on those occasions where the marks at issue are described over the telephone, for example, in which case the marks at issue would be considered to be identical when verbalised.

107. As I have previously made reference to, a global assessment includes keeping in mind a number of factors, one of which is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa.[15] The goods and services at issue have been found to be either identical, similar to a medium degree or complementary. Such degrees of similarity between the goods and services could offset a hypothetical lower degree of similarity between marks. Considering that the marks at issue have in fact been found to be visually highly similar (and potentially aurally identical), the identity, medium degree of similarity and complementarity between the goods and services only serves to reinforce a finding of a likelihood of direct confusion.

108. I therefore find there to be a likelihood of direct confusion.

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109. The contested mark contains the two verbal elements JetBrains and TECHLAB, neither of which has a counterpart in the earlier mark. In my opinion, the additional element TECHLAB is not purely descriptive, if for no other reason than the fact that it is almost disguised by its fanciful font. The additional element JetBrains is certainly not descriptive, and neither party has attempted to argue to the contrary. Whilst I acknowledge that it is smaller than the other elements, it occupies a position that a consumer may interpret as suggesting/representing the house brand of the goods or

[15] *Canon*, C-39/97, para 17

services. The element JetBrains is neither aurally invisible nor visibly negligible. Due to the inclusion of the additional distinctive word elements, I find it unlikely that the consumer would mistake the contested mark for the earlier mark.

110. I therefore find that there is no likelihood of direct confusion.

111. Having found there to be no likelihood of direct confusion, any confusion would now be dependent on a finding of indirect confusion. It should be borne in mind 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.[16] In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., (as he then was) as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no 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."
>
> 17. Instances where one may expect the average consumer to reach such a conclusion 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

[16] In *Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017,* paragraph 13, Arnold LJ approved this "consolation prize statement" as made by James Mellor KC's (sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria* (O/219/16) paragraph 16.

where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

112. As previously mentioned, I consider both of the additional word elements TECHLAB and JetBrains to be inherently distinctive. As such, I do not believe that the addition of either one of these elements would realistically be considered to represent the type of material one would expect to find in a sub-brand or brand extension of the earlier mark. In my opinion, the addition of either one of these elements by itself would appear illogical or inconsistent with a brand extension, and this would apply even more so when both elements are added at the same time.

113. In *L&D SA v OHIM* [2008] E.T.M.R. 62, the CJEU stated that:

"55 Furthermore, inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant asserts, that case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant."

114. Further, in *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253 the GC compared two figurative marks, both of which contained the words "Museum of Illusions". In holding that the words were weakly distinctive and that they were no more dominant than the figurative elements, it pointed out that:

> "57 According to the case-law, the public will not generally consider a descriptive or weakly distinctive element forming part of a composite mark to be the distinctive and dominant element in the overall impression conveyed by that mark (see judgment of 5 April 2006, *Madaus* v *OHIM – Optima Healthcare (ECHINAID)*, T-202/04, EU:T:2006:106, paragraph 54 and the case-law cited; judgment of 28 October 2009, *CureVac* v *OHIM – Qiagen (RNAiFect)*, T-80/08, EU:T:2009:416, paragraph 49).
>
> 58 It does not therefore automatically follow that, where a sign consists of both figurative and word elements, it is the word element which must always be considered to be dominant. In certain cases, in a composite sign, the figurative element may therefore rank at least equally with the word element (see, to that effect, judgment of 24 October 2018, *Grupo Orenes* v *EUIPO – Akamon Entertainment Millenium (Bingo VIVA ! Slots)*, T-63/17, not published, EU:T:2018:716, paragraph 43 and the case-law cited)".

115. Each of the above judgments rightly sets out that there will be occasions when the figurative element in a composite sign may be more dominant than the word elements. With this in mind, I am aware that I have previously found the figurative element of the contested mark 3627829 to be visually highly similar (and potentially aurally identical on the rare occasion that the marks have to be described) to the figurative element that is the earlier mark. However, unlike in the *Metamorfoza* judgment, the additional verbal elements in the contested mark are not descriptive nor are they weakly distinctive. Therefore, I do not consider the same conclusion from that judgment to be applicable in this instance.

116. In *Migros-Genossenschafts-Bund v EUIPO* (T-68/17) (CReMESPRESSO), the GC stated:

> 52 "In that regard, it should first of all be noted that, according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements (see, to that

effect, judgment of 6 December 2013, *Premiere Polish* v *OHIM — Donau Kanol (ECOFORCE)*, T-361/12, not published, EU:T:2013:630, paragraph 32 and the case-law cited)."

117. In light of the above, it is appropriate in this instance to consider the word elements JetBrains and stylised TECHLAB of the contested mark to be more distinctive than the contested mark's figurative element which, although is inherently distinctive in itself, is nevertheless less dominant than at least one of the additional distinctive word elements.

118. In conducting the comparison of the marks I have also kept in mind *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, in which Mr James Mellor Q.C. (as he then was) acting as the Appointed Person stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark, as this would be mere association rather than indirect confusion. In my opinion, whilst the contested mark contains a figurative element that is highly similar to the figurative element that is the earlier mark, this is not enough in and of itself to overcome the reality that the overall and global impression of the contested mark is, to my mind, dominated by the distinctive word TECHLAB, which has no counterpart in the earlier mark. In addition, the contested mark contains the additional verbal element JetBrains which, whilst being the smallest element of the mark, is nevertheless inherently distinctive to a degree that is higher than that of the figurative element.

119. Having found there to be no direct confusion, there would have needed to be a "proper basis" for finding a likelihood of indirect confusion.[17] In my opinion, I consider it unlikely that a consumer would carry out the mental process whereby they either consciously or subconsciously assume the contested mark is a logical extension of the earlier mark, based purely on the coincidence of a figurative element that is less dominant and less distinctive than either of the word elements. This is especially so when considering that word elements tend to be generally attributed more attention by a consumer when identifying trade origin.

[17] *Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017,* paragraph 13,

120. I therefore find there to be no likelihood of indirect confusion.

Conclusion for application 3627829

121. The opposition fails against the contested mark.

122. Subject to an appeal, the contested application will proceed to registration.

Interim conclusion for application 3627830

123. The opposition is partially successful against the contested mark 3627830, namely in relation to the following goods and services:

Class 9 *Software; digital publications; downloadable electronic books.*

Class 16 *Printed matter, printed publications,*

Class 41 Entertainment; providing online electronic publications (not downloadable

124. I have noted the Applicant's submissions regarding a fall-back specification, i.e., the addition of the following limitation to the specifications in classes 9, 35 and 42:

> *relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education*

125. It seems to me that the limitation could overcome the opposition in relation to class 9 (the opposition has been unsuccessful in relation to the other two classes for which the limitation was proposed) as the earlier mark has only been shown to have been genuinely used for software-using goods and publications/books that relate specifically to the provision of television programmes.

126. The limitation would have no effect on the goods or services in classes 16 and 41 respectively, which, subject to an appeal, would be refused.

127. The Applicant is hereby allowed 14 days from the date of this decision to consider providing the Tribunal with a revised specification for class 9 on the basis indicated above. If it wishes to do so, it should copy any revised specification to the Opponent.

The Opponent will then be allowed a period of 14 days from the date that it receives a copy of any revised specification from the Applicant to provide comments. At the conclusion of that period, I will review the proceedings and issue a supplementary decision, in which I will also deal with costs and set a period for appeal.

128. If the Applicant no longer wishes to file an amended specification it should, within the period allowed, write to the Tribunal (copied to the Opponent) providing an indication to that effect. On receipt of such an indication, I will issue a supplementary decision in which I will refuse the application in relation to the goods and services mentioned in paragraph 123, and also deal with costs and set a period for appeal.

129. Because the applications are consolidated, the contested application 3627829 shall not proceed to publication until the outstanding issues are addressed in relation to 3627830.

Dated this 28th day of December 2022

Dafydd Collins

For the Registrar