

O-162-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2606110
BY DAVID CAIN TO REGISTER THE FOLLOWING TRADE MARK IN
CLASSES 9 & 16:**



AND

**OPPOSITION THERETO (NO 103258) BY BAUER CONSUMER MEDIA
LIMITED**

The background and the pleadings

1) Mr Cain applied for the above trade mark on 2 December 2011 and it was published in the Trade Marks Journal on 27 January 2012. He seeks registration for the following goods:

Class 09: Electronic publications relating to sport.

Class 16: Printed material, magazines, publications - relating to sport.

2) Bauer Consumer Media Limited (“Bauer”) oppose the registration of Mr Cain’s mark on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The various earlier marks/signs are:

i) UK registration 2153420, which was filed on 12 December 1997, with its registration procedure being completed on 2 January 2000. The series of three marks registered, together with their goods, are as follows:

MATCH

MATCH

MATCH

Class 16: Magazines; diaries and posters; all relating to football.

The marks are relied upon under both sections 5(2)(b) and 5(3) of the Act. They are claimed to have been used and to have a reputation for all the above goods.

ii) UK registration 2227424 for the word **MATCH**, which was filed on 28 March 2000, with its registration procedure being completed on 19 April 2002. The mark is registered for the following goods and services:

Class 09: Magazines in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); electronic magazines, multi-media recordings and publications, computer software, computer programs, data recorded in electronic, optical and magnetic form; data carriers; audio and visual recordings; CD-ROMs, CDIs, discs, cassettes and other data carriers; all the aforesaid goods in magazine format and all relating to football.

Class 41: Interactive information relating to football supplied on-line from computer databases or from the Internet.

The mark is relied upon under both sections 5(2)(b) and 5(3) of the Act. It is claimed to have been used and to have a reputation for all the above goods and services.

iii) Under section 5(4)(a), Bauer claims to have rights in the word **MATCH** since its first use in 1979 for “[a]ll of the goods and services”; I take this to mean all of the goods and services covered by Bauer’s earlier trade marks. Although not clearly stated, the claim under section 5(4)(a) is based on the law of passing-off.

3) Both of Bauer's registrations were filed before Mr Cain made his application and, therefore, the marks qualify as earlier marks as defined by section 6 of the Act. Both of Bauer's registrations are subject to the proof of use requirements (as set out in section 6A of the Act) because they completed their respective registration procedures more than five years before the date on which Mr Cain's mark was published. Bauer stated that the marks have been used for all of the goods and services for which they are registered. In his counterstatement, Mr Cain did not ask for this to be proved, consequently, Bauer's statement must be accepted; Bauer may rely upon its marks in respect of the goods and services as registered.

4) Mr Cain made a number of other statements in his counterstatement including that the marks are totally different, as are the goods/services. Bauer's claims are therefore denied. Both sides filed evidence; I will draw from the evidence during my decision when it is necessary and relevant to do so. Neither side requested a hearing. Both sides have provided arguments about the merits of the case at various stages during the proceedings; these will be borne in mind.

Section 5(2)(b)

5) Section 5(2)(b) of the Act reads:

"5.-(2) A trade mark shall not be registered if because –

(a)

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

6) The Court of Justice of the European Union ("CJEU") has issued a number of judgments¹ which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

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

¹ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The goods/services comparison

7) Mr Cain refers in his counterstatement and in his evidence to the fact that his mark is to be used in the field of snooker. However, the goods he seeks to register are not so limited, they read:

Class 09: Electronic publications relating to sport.

Class 16: Printed material, magazines, publications - relating to sport

8) As Mr Cain's goods relate to sport, which could potentially be football, his goods must be considered as identical to the goods of the earlier marks which cover, *inter alia*, magazines (both printed and electronic) as well as other forms of printed matter, all of which relate to football. Even if Mr Cain had limited his goods to relate to snooker then there would still be some similarity as both types of products would, effectively, be sporting magazines, albeit relating to different sports. The evidence that Mr Cain filed about his snooker magazine has, therefore, no real significance to the matter.

The average consumer

9) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can vary, depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In terms of sporting magazines, the average consumer will be a member of the general public. The goods are not specialist products, they are purchased by someone with an interest in the sporting field concerned. They are not high cost items and they may be purchased fairly casually and fairly frequently (on a weekly or monthly basis). In terms of how the goods will be selected, this will normally be by way of self-selection from a newsagent or a supermarket magazine area, or, in the case of the online magazines, via perusal of websites.


The distinctiveness of the earlier mark

10) The more distinctive the earlier mark(s), the greater the likelihood of confusion. Distinctiveness can come from the mark(s)'s inherent characteristics or from the use that has been made of them. In terms of inherent characteristics, the word MATCH, in relation to football magazines etc, is a weak word. It has clear allusive qualities. However, Bauer's evidence must be factored in. The evidence comes from Christine Lund-Beck, a trade mark attorney with Urquhart-Dykes & Lord. Her evidence demonstrates that MATCH is a football magazine that has been in circulation since 1979. It appears to be a weekly magazine. Its circulation per edition is an average of 46k. Such a figure relates to the UK and the republic of Ireland, but from the totality of the evidence (such as the pricing on the front page, and information in the *Wikipedia* extract provided) the

magazine appears to be British-centric. An accompanying MATCH website has been in operation since 2003. Although market share information is not provided, I am more than satisfied that through the long-standing use that has been made of the mark(s), together with the circulation figures, MATCH is a mark of a high distinctive character in relation to football magazines.

Comparison of the marks

11) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. I will make the comparison with the plain word earlier mark. The marks to be compared are:

Mr Cain's mark	The earlier mark
	<p>MATCH</p>

12) The dominant and distinctive element of the MATCH mark is the word MATCH; it does not break down any further than that. In terms of Mr Cain's mark, the most striking element is the letters MSR. Each of those letters is, though, joined to the further letters below them forming a whole word(s) – the M joining "ATCH'O" to create MATCH'O, the S joining "CORE" to create SCORE and the R joining "ESULT'S" to create RESULT'S. This re-enforces that it is a whole mark comparison that is to be made even if the letters MSR stand out most.

13) From a visual perspective, although the word MATCH appears in Mr Cain's mark, it does not leap out. This is not only because MSR stands out the most, but also because the M is larger with ATCH standing below it which means, without close scrutiny, the eye may struggle to see the word MATCH. Furthermore, in Mr Cain's mark the word MATCH has an additional "O" and an apostrophe symbol. Any visual similarity is very low. Much of this follows through to the aural comparison. Given the way in which the letters MSR stand out, it is probable that this will form the only part of the mark which is going to be articulated. For those that articulate the whole of the applied for mark, it will be articulated as MSR MATCH-O, SCORE, RESULTS. The aural similarity is, therefore, extremely low when compared to the word MATCH alone. The conceptual hook of MATCH is the word itself (as in a football match). The most probable conceptual hook for Mr Cain's mark is the letters MSR themselves – those three letters are what is most likely to be packed away as the conceptual hook. However, even if this were not

the case and the whole mark is packed away, any conceptual similarity is low given the marks as a whole.

Likelihood of confusion

14) The factors assessed so far have a degree of interdependency. A global assessment of them must be made when determining whether there exists a likelihood of confusion. There is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

15) The earlier mark is highly distinctive. The goods are identical. I must bear in mind the principle of imperfect recollection and the nature of the purchasing process together with the predominantly visual selection process. The interdependency principle must also be borne in mind because a low degree of similarity between the marks may be off-set by a high degree of similarity between the goods; the goods in this case are identical. Confusion can be direct or indirect. Direct confusion occurs when the marks are close enough for them to be, effectively, mistaken for one another. In my view, this form of confusion is not likely. The differences between the marks are so obvious and so acute that the average consumer will clearly be able to differentiate between them.

16) Indirect confusion is, effectively, where the average consumer notices the differences between the marks, but nevertheless puts the similarity between the marks down (when all other factors are considered) to the undertakings responsible for the respective goods being the same or being related. Bauer highlights that the word MATCH is well-known as a publication and given that the word SCORE and RESULTS in the applied for mark are non-distinctive, this will lead the average consumer to associate the marks, so believing that they come from the same trade source. In Baeur's evidence there is also an exhibit to show that in the MATCH magazine information is given about the scores and results of football games. Mr Cain's evidence provides examples of other traders using the word MATCH, e.g. MATCH OF THE DAY and MATCH ATTAX. Whilst this is not sufficient to show that such a term is in common use, it nevertheless exemplifies the obvious. It is obvious that the word MATCH has a clear meaning in the world of sport. As I have already said, it is an inherently weak word. Whilst the word MATCH alone may be highly distinctive as the title of Bauer's magazine, the capacity of the word MATCH to indicate a Bauer product may become lost when the word is used in a different context. In such scenarios the word MATCH may no longer indicate a Bauer product, but will return to its normal dictionary meaning. Of course, everything depends on the context of the marks before me. The context here is that there is very little similarity between the marks. The applied for mark is dominated by the letters MSR. In the context of the applied for mark, even though the words SCORE and RESULTS are non-distinctive words, the word MATCH is not performing a distinctive trade mark role in the overall impression of the mark. I come to the clear view that what little similarity there is

between the marks will **not** be put down to economic connection. **There is no likelihood of confusion. The opposition under section 5(2)(b) of the Act is hereby dismissed.**

Section 5(4)(a) of the Act

17) Although not always the case, an opponent is often no better off under section 5(4)(a) than it is under section 5(2) of the Act. This is the case here. Even accepting that Bauer will have established the requisite goodwill associated with the word MATCH, I would not have been persuaded that there would have been the requisite misrepresentation. Bauer has not advanced a materially different case in its submissions. **The opposition under section 5(4)(a) of the Act is hereby dismissed.**

Section 5(3) of the Act

18) Section 5(3) of the Act requires the earlier mark(s) to have a reputation (which I accept it has) but also a link must be made between the respective marks. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

19) In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“*Intel*”), the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...”

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

20) I have borne all these factors in mind, but I come to the view that the marks are simply not similar enough for a link to be made. **Without a link, the ground of opposition under section 5(3) cannot succeed and is dismissed.**

Outcome

21) All of Bauer’s grounds of opposition have failed. The opposition is hereby dismissed.

Costs

22) Mr Cain has been successful and is entitled to a contribution towards his costs. In calculating costs, I have borne in mind that Mr Cain was not legally represented and would not, therefore, have expended any legal costs. I hereby order Bauer Consumer Media Limited to pay Mr David Cain the sum of £400. This sum is calculated as follows:

Preparing a statement and considering the other side’s statement
£150

Considering and filing evidence
£250

23) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 22nd day of April 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**