

O-238-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3005773  
BY  
TRENT SOUND LIMITED**

**TO REGISTER THE TRADE MARK**



**IN CLASS 38**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 400807  
BY  
ORION MEDIA LIMITED**

## BACKGROUND

1. On 13 May 2013, Trent Sound Limited (the applicant) applied to register the above trade mark in class 38 of the Nice Classification system,<sup>1</sup> as follows:

Telecommunications services; electronic communication services; radio broadcasting, digital radio broadcasting and television broadcasting services; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means of a global computer network; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; telecommunication of information including web pages, computer programs, text and any other data; providing access to digital music websites on the Internet or other computer network; delivery of digital music by telecommunications; webstreaming being the transmission of data, information and audio-visual data via the Internet or other computer network; news agency services; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus and equipment.

2. Following publication of the application on 7 June 2013, Orion Media Limited (the opponent) filed notice of opposition against the application.

3. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon United Kingdom trade mark registration no 2574598:

Mark details and relevant dates	Services relied upon
Mark: MERCIA  Filed: 10 March 2011  Registered: 19 August 2011	<b>Class 38</b> Radio broadcasting services; television broadcasting services; online and digital broadcasting services; providing access to digital web sites on the internet; providing access to MP3 websites on the internet; delivery of radio programmes, digital music and television programmes by telecommunications; webstreaming, namely, the transmission of data information and audio-visual data via the internet, computer networks or computer databases; operation of chat rooms.  <b>Class 41</b> Entertainment services; radio entertainment services; interactive entertainment services provided via the internet or other computer networks; production, presentation, distribution, syndication, networking and rental of television and radio programmes, films, music, sound and video recordings; electronic publication services and provision of on-line electronic publications; providing digital music from the internet; providing digital music

<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<p>from MP3 internet web sites; providing television programmes, radio programmes, films, videos, sound, images or data for download from the internet or other computer networks; organisation of festivals, concerts, shows, sport events, competitions.</p>
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4. In its statement of grounds the opponent states:

*“5. The marks are similar because the earlier mark comprises the word Mercia. The mark applied for comprises the words Mercia Sound, the suffix ‘Sound’ being a common descriptive term used in radio broadcasting, etc. The prefix is the dominant part of the trade mark Mercia Sound. For this reason the mark applied for is visually, aurally and conceptually similar to the earlier mark and is to be registered for goods and services which are identical with or similar to those for which the earlier mark is protected, to the extent that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”*

5. The applicant filed a counterstatement on 17 September 2013. It denies the grounds on which the opposition is based and requests the opponent provide proof of use of its mark. It states:

*“We disagree with the opponent in that our application is for ‘Mercia Sound’ rather than just a single word ‘Mercia’, that their mark is significantly different from ours visually - our application uses a specific typeface and the colours red and black, their[s] is the single word followed by a ‘star’ device<sup>2</sup> which does not form part of our application.*

*In addition to these significant differences, their radio station ‘Mercia’ ceased to broadcast several years ago and has been re-branded under a completely different name...”*

6. Neither party filed evidence or submissions. A hearing took place on 16 April 2014, at the Trade Mark Registry in Newport. The applicant did not attend and was not represented. The opponent was represented by Mr Huw Evans of Chapman Molony.

## **DECISION**

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

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

(a)...

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<sup>2</sup> There is no ‘star device’ present in the mark relied upon by the opponent.

(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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. The opponent's mark is an earlier mark. Despite the applicant requesting the opponent prove use of it, the earlier mark is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.<sup>3</sup> Consequently, the opponent can rely on the full specification of its registration in classes 38 and 41.

### **Section 5(2)(b) case law**

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

#### The CJEU cases

*Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 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; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

#### The principles

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<sup>3</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

“(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, 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 average consumer and the nature of the purchasing act

11. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of services. The attention paid is likely to vary depending on price and, to some extent, the nature of the services and the frequency of the purchase.

12. The average consumer for the majority of services at issue will be a member of the general public but may also include a business/professional user, for example, commissioning news agency services.

13. With regard to this point, I am mindful of the decision in *Adelphoi Limited v DC Comics (a general partnership)*<sup>4</sup> in which Professor Annand, sitting as the Appointed Person, stated:

“21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v. OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41).”

14. The services at issue in classes 38 and 41 may be purchased visually or aurally. The radio based services are more likely to involve an aural element to the purchase than, inter alia, website, email and chatroom services, which are likely to be accessed online and will be visual purchases made on a mobile device, computer or tablet. The level of attention paid is likely to be at least average to the extent that the purchaser will ensure they are accessing the content they require, in the correct format.

## Comparison of services

The services to be compared are as follows:

The opponent's services	The applicant's services
<b>Class 38</b> Radio broadcasting services; television broadcasting services; online and digital broadcasting services; providing access to digital web sites on the internet; providing access to MP3 websites on the internet; delivery of radio programmes, digital music and television programmes by	<b>Class 38</b> Telecommunications services; electronic communication services; radio broadcasting, digital radio broadcasting and television broadcasting services; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio and video files via electronic and

<sup>4</sup> BL O/440/13

<p>telecommunications; webstreaming, namely, the transmission of data information and audio-visual data via the internet, computer networks or computer databases; operation of chat rooms.</p> <p><b>Class 41</b>  Entertainment services; radio entertainment services; interactive entertainment services provided via the internet or other computer networks; production, presentation, distribution, syndication, networking and rental of television and radio programmes, films, music, sound and video recordings; electronic publication services and provision of on-line electronic publications; providing digital music from the internet; providing digital music from MP3 internet web sites; providing television programmes, radio programmes, films, videos, sound, images or data for download from the internet or other computer networks; organisation of festivals, concerts, shows, sport events, competitions.</p>	<p>communications networks as well as by means of a global computer network; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; telecommunication of information including web pages, computer programs, text and any other data; providing access to digital music websites on the Internet or other computer network; delivery of digital music by telecommunications; webstreaming being the transmission of data, information and audio-visual data via the Internet or other computer network; news agency services; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus and equipment.</p>
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The applicant has made no comment in respect of the similarity of services at issue in these proceedings. The opponent has provided a list of the applicant's services which it believes to be identical or similar to those in its own specification and provided further detail at the hearing, at my request. I will refer to them as necessary below.

24. In comparing the services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

25. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*<sup>5</sup> (hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;
- (c) the physical nature of the goods or acts of service;

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<sup>5</sup>[1996] R.P.C. 281

(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 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, taking into account how goods/services are classified in trade.

26. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

27. The comments of Daniel Alexander, sitting as the Appointed Person, in *LOVE*<sup>6</sup>, which dealt with similarity of goods but by analogy is relevant to similarity of services, are also to be borne in mind:

“18... the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. 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.”

28. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark*<sup>7</sup>:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

29. When considering the parties services I am mindful of the decision in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, in which Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

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<sup>6</sup> *BL O/255/13*

<sup>7</sup> *BL O-399-10*



activities. They should be confined to the substance, as it were, the core of the possible meaning attributable to the rather general phrase.”

30. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

31. I will also bear in mind Floyd, J’s statement in *YouView TV Ltd v Total Ltd*.<sup>8</sup>

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

### **Class 38**

32. The applicant’s specification includes the broad term, ‘telecommunications services’. The opponent’s specification includes many telecommunications services, including providing digital music and television programmes by telecommunications. Since the services in class 38 of the earlier mark’s specification are included in a more general category contained in the application, in accordance with the principles in *Meric*, these are identical services.

33. The applicant’s specification includes ‘electronic communication services’, a broad term which includes a number of the opponent’s class 38 services, such as, ‘webstreaming’, ‘online and digital broadcasting services’ and ‘operation of chat rooms’. In accordance with *Meric*, these are identical services.

34. The application includes ‘radio broadcasting’, ‘digital radio broadcasting’ and ‘television broadcasting services’ and ‘broadcasting over the Internet or other computer network’. These are identical services to ‘television broadcasting services’, ‘online and digital broadcasting services’ and ‘providing access to digital web sites on the internet’, in the opponent’s specification.

35. ‘Electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means of a global computer

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<sup>8</sup> [2012] EWHC 3158 (Ch) at [12]

network', in the application, are identical to 'webstreaming services' and 'providing access to digital websites on the internet' and 'online and digital broadcasting services' in the opponent's class 38 specification.

36. Both parties' specifications include the term, 'operation of chat rooms'. These are identical terms. The application includes 'providing access to on-line chat rooms and bulletin boards', which is included within the operation of a chat room. Consequently this is also an identical service in accordance with the principles laid down *Meric*.

37. 'Webcasting services' (which are broadcasting services provided over the internet) are identical to 'online and digital broadcasting services' in the opponent's specification.

38. 'Telecommunication of information including web pages, computer programs, text and any other data', is identical to a number of the opponent's services in class 38, which are all telecommunications services. In particular, it is identical to 'online and digital broadcasting services', which include the types of information listed by the applicant.

39. The phrases, 'providing access to digital music websites on the Internet or other computer network' and 'delivery of digital music by telecommunications', in the application is included within 'providing access to digital web sites on the internet' in the specification of the opponent's earlier mark. Consequently, these are identical services.

40. Both parties' specifications include 'webstreaming being the transmission of data, information and audio-visual data via the internet or other computer network'. These are identical services.

41. 'Transmission of written and digital communications' in the application is identical to 'online and digital broadcasting services' in class 38 of the opponent's specification.

42. The remaining terms in the applicant's class 38 specification are not included in the opponent's specification in identical terms and do not fall within the other broader terms. At the hearing I requested that Mr Evans address me on these points as they were not fully particularised in his skeleton argument.

43. In respect of the applicant's 'electronic mail services', Mr Evans drew my attention to 'webstreaming' in the opponent's specification, which is described as the transmission of data, information and audio-visual data via the internet, computer networks or computer databases. In his view the services are of a similar nature, they share the same intended purpose and method of use and are complementary.

44. The users of both types of service may be any member of the general public and both are used to communicate information. In terms of their methods of use, webstreaming services are generally provided to an audience at large, whereas an email service allows the user to contact, or receive information from, specific individuals or organisations whom they wish to contact. Both allow for the transfer of information and both may be available from a website. The services are not in

competition with each other. There is a medium degree of similarity between these services.

45. In addition the opponent's specification also includes the operation of chat rooms. A chat room may be used by any member of the general public, as can an email service. In both cases the services are usually accessed following a simple registration process. Both services allow their users to communicate with others via a type of messaging service. Both types of service may be accessed via the internet and may be used on a computer, tablet or smart phone. These services are not in competition nor are they complementary, in the sense that one is indispensable for the use of the other, though a user of email services may, of course, also use chat room services. Consequently, these services are similar to a fairly high level.

46. The applicant's specification also includes, 'news agency services'. At the hearing Mr Evans submitted, on behalf of the opponent, that most programmes include an element of news reporting, which is similar to news agency services.

47. A news agency collects and provides news reports which may be made directly available to members of the public or may be sold to third parties who will then make the news content available to the intended audience. Radio, television and online broadcasting services are also accessed by any member of the general public and may include news reports collected by the broadcaster's own news teams or from third party news agencies. Broadcasting services are intended to entertain and/or inform the audience, news services are primarily for information but may include a degree of entertainment, such as that provided by some 'human interest' stories. All of these services may be accessed online and via television and radio. News agency services may also be accessed on paper.

48. Apart from the operation of chat rooms, all of the opponent's services in class 38 are complementary, to the extent that in order to broadcast news the broadcast service is essential. There may be a degree of competition between news agency services and the broadcaster's own news teams but it is unlikely that the end user will be aware of this when deciding which news service to access. Taking all of these factors into account, there is a fairly high degree of similarity between these services.

49. The applicant's specification also includes 'leasing and rental services in connection with telecommunications apparatus and equipment'. The opponent's specification includes the broadcasting/telecommunication services which will be accessed using such equipment. The user will be any member of the general public wishing to access telecommunication services. In order to do so the end user will need to have access to the services and be able to receive the service via the relevant apparatus.


50. Whilst there may be some overlap in the trade channels for these services, in my experience when entering a contract with an internet/broadband provider or television and radio broadcasting company, it is not uncommon to have the equipment provided as part of the contract; for example, a modem to receive the internet or a television box in order to receive a number of cable/satellite channels. These services are complementary to the extent that it is not possible to access the opponent's telecommunication services without the equipment/ apparatus necessary

to receive the signal. These types of apparatus are often provided on a lease/hire basis for the life of the contract.

51. At the hearing Mr Evans stated that the opponent has radio broadcasting services and other telecommunications in its specification. The average consumer seeing someone leasing telecommunications equipment, knowing that the opponent provided the services, would think that there was a connection in the course of trade between the two. Taking all of these factors into account, I find there to be a high level of similarity between these services.

### Comparison of marks

52. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
<b>MERCIA</b>	

53. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components<sup>9</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

54. The opponent's mark consists of the single word MERCIA in block capitals. No part of the word is stylised or emphasised in any way. Consequently, the distinctiveness lies in the mark as a whole.

55. The applicant's mark consists of the two words 'mercia sound' presented in lower case. The word 'mercia' is presented above the word 'sound' and both words are presented in white and are outlined with a substantial red border. The title of the letter 'i' is shown in black. Within the letter 'o' of 'sound' is a black equilateral triangle. In my experience, a circle is a commonly used symbol for 'record'; a triangle is the standard symbol for 'play'. I have no submissions on this point but in the context of the services at issue in this case such representations are non-distinctive. In my view the average consumer will consider them, if they notice them at all, as purely decorative elements.

56. In its statement of grounds the opponent submits:

*“The mark applied for comprises the words Mercia Sound, the suffix ‘Sound’ being a common descriptive term used in radio broadcasting etc. The prefix is the dominant part of the trade mark Mercia Sound.”*

<sup>9</sup> *Sabel v Puma AG, para.23*

57. The word 'sound' is descriptive of the applicant's services which are telecommunication/broadcasting services and consequently is a non-distinctive element for the services at issue. The distinctiveness of the mark rests in the word 'mercia'.

58. In its counterstatement the applicant submits:

*"...the word 'Mercia' historically was one of the kingdoms of the Anglo-Saxon Heptarchy, it was centred on the valley of the River Trent and its tributaries commonly known as the East Midlands. The name 'Mercia' is still in use today by a wide variety of organisations, including military units, public, commercial and voluntary bodies."*

59. Mercia is defined as:

*"A former kingdom of central England. It was established by invading Angles in the 6th century AD in the border areas between the new Anglo-Saxon settlements in the east and the Celtic regions in the west."*<sup>10</sup>

60. Neither side has provided evidence to indicate the extent to which the word 'Mercia' will be understood. People from or living in the relevant area may have an awareness of the geographic nature of the word and may be aware of the specific region to which the word refers. However, in the absence of any evidence to indicate that the average consumer in the UK would know this, in my view the average consumer will see it as a word without any particular meaning. Consequently, the word Mercia possesses a high level of distinctiveness.

61. In respect of the similarity between the marks the opponent submits that they are visually, aurally and conceptually similar.

### **Visual similarities**

62. In respect of the visual similarities the applicant states:

*"...their mark is significantly different from ours visually - our application uses a specific typeface and the colours red and black..."*

63. In considering the presentation of the marks at issue I am mindful of the comments in *Sadas*<sup>11</sup>, where the Court of First Instance (now the General Court) assessed the similarity of 'Arthur' (in script) against the application 'ARTHUR ET FÉLICIE', in plain block capital letters. It held,

*"47. At the visual level, given that the figurative elements of the earlier mark are secondary relative to its word element, the comparison of the signs may be carried out on the basis of the word element alone, whilst still adhering to the principle that an assessment of the likelihood of*

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<sup>10</sup> *Oxford Dictionary of English, 3<sup>rd</sup> Edition, 2010, Oxford University Press*

<sup>11</sup> *Sadas SA v OHIM, T-346/04*

confusion, with regard to the similarity of the signs, must be based on the overall impression given by them. Accordingly, since the earlier mark Arthur is entirely included in the trade mark sought ARTHUR ET FÉLICIE, the difference linked to the addition of the words 'et' and 'Félicie' at the end of the trade mark sought is not sufficiently large to counter the similarity created by the coincidence of the dominant element of the trade mark applied for, namely the word 'Arthur'. Moreover, since registration of the trade mark ARTHUR ET FÉLICIE was sought as a word mark, nothing prevents its use in different scripts, such as, for example, a form comparable to that used by the earlier mark. As a result, the signs at issue must be considered visually similar."

64. The CFI also applied *Sadas* in similar circumstances in *Peek & Cloppenburg v OHIM*<sup>12</sup>, where the earlier mark was the plain word mark. It stated,

"27...the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. ...[S]ince the early mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for."

65. Accordingly, in this case, normal and fair use of the opponent's mark would include use of the mark in a variety of fonts, including bold fonts of the type used for the applicant's mark. This would reduce the apparent visual difference between the marks when the opponent's mark is only considered in plain block capitals.

66. The colouring in the words does not have a bearing on the issue of similarity as neither party's mark is limited to any particular colour. The matter must be assessed on the similarity between the respective marks without regard to colour.<sup>13</sup>

67. Both marks contain the word 'MERCIA': it is the first word of the applicant's mark and the totality of the opponent's mark. The application also includes the additional word 'sound', which is non-distinctive for the services at issue. Taking all of these factors into account, I find the degree of visual similarity to be medium.

### **Aural similarities**

68. The opponent's mark, MERCIA, will be pronounced, MER-SEE-A (MER as in MERMAID, SEE as in SEEK and A, pronounced as in the first letter of ABOUT). The first word of the applicant's mark is also the word MERCIA which will be pronounced the same way. It is followed by the common English word SOUND, which is non-distinctive for the services at issue.

69. I find the parties' marks to be aurally highly similar.

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<sup>12</sup> T-386/07

<sup>13</sup> *Specsavers International Healthcare Ltd v Asda Stores Ltd (No.2)* [2011] FSR 1, Mann, J.

## Conceptual similarities

70. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>14</sup> The assessment must be made from the point of view of the average consumer.

71. However, the average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

“36...By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a Native American tribe. This is a matter that can easily be established from an encyclopedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

72. Similarly in this case, I am aware that ‘MERCIA’ may refer to an Anglo Saxon kingdom. However, in the absence of any evidence from the parties to the contrary, I am not able to take judicial notice of the fact that the average consumer for the services at issue would know this.

73. Some may be familiar with the word Mercia having an historic geographic meaning, particularly those from or living in that area (in which case the conceptual similarity between the marks is high). However, absent any evidence to the contrary, it is more likely that it will simply be seen as a word with no particular meaning, such that the conceptual position is neutral.

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<sup>14</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

## **Distinctive character of the earlier mark**

74. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been used as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

75. I have no evidence to consider in this case so need only consider the inherent distinctive character of the earlier mark. As I have concluded above, the word MERCIA is likely to be considered to be a word with no particular meaning. As a consequence the mark enjoys a high degree of inherent distinctive character.

## **Likelihood of confusion**

76. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>15</sup> I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.

77. I have found the marks to possess a medium degree of visual similarity, to be aurally similar to a high degree and to be conceptually neutral.

78. I have found the majority of the applicant's services to be identical, and the remainder to be similar to the opponent's services. I have identified the average consumer, namely a member of the general public, and have concluded that the level of attention paid to the purchase will be at least average as the end user will need to ensure that they are accessing the required services and media content.

79. In *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-505/11* the GC stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal's taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM – nfon (nfon)*, not published in the ECR, paragraph 69).”

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<sup>15</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27



80. The word MERCIA is the totality of the opponent's mark and the first word of the applicant's mark. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027<sup>16</sup>, that the first parts of words (and consequently, first words of marks) catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes.

81. In this case, even where the services share a medium degree of similarity (which is the lowest level I have identified) rather than a higher degree of similarity or identity, the nature of the common element MERCIA (which is the distinctive element of the applicant's mark and the totality of the opponent's mark) gives rise to direct confusion, where one undertaking will be confused with the other.

## **CONCLUSION**

### **82. The opposition succeeds under section 5(2)(b) of the Act.**

#### **Costs**

83. The opponent has succeeded and is entitled to an award of costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Preparation for and attending a hearing:	£500
Total	£900

84. I order Trent Sound Limited to pay Orion Media Limited the sum of £900. This sum is to 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 30th day of May 2014**

**Ms AI Skilton  
For the Registrar,  
the Comptroller General**

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<sup>16</sup> *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR) [2004] ECR II – 965, paragraph 81*