

O-174-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3124066
AND THE REQUEST BY FUREEL OTUBU AND JONATHAN KES OTUBU
TO REGISTER THE TRADE MARK**



IN CLASSES 25, 35, 38, 41

AND

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 406129
BY YES MUSIC AG**

BACKGROUND AND PLEADINGS

1. On 26 August 2015 Fureel Otubu and Jonathan Kes Otubu (“the Applicants”) applied to register as a trade mark, in relation to goods and services in classes 25, 35, 38 and 41, the figurative mark shown on the front page of this decision. Details of the Applicants’ specification are set out in the table below.

CLASS	APPLICANTS’ GOODS and SERVICES
25	T-shirts, Clothing, Headgear, Footwear, Wristbands, Belts, Hoods, Hooded tops, Jackets, Caps.
35	Production of video recordings for marketing purposes. Production of video recordings for advertising purposes. Production of video recordings for publicity purposes. Production of internet and television advertising content. Producing promotional videos, video disc, and audio visual recordings. Business consulting; advertising via electronic media and specifically the internet. Media research and consultancy. Providing marketing consulting in the field of social media. Retail services connected with the sale of branded T-Shirts, clothing and headgear.
38	Transmission of sound and images; providing radio and television broadcasting, also via internet networks; radio communication.
41	Education; providing of training; entertainment; sporting and cultural activities; publishing; organising and operating entertainment, cultural and educational events and shows; organising and operating games and competitions; examining for and granting of educational, cultural and entertainment awards; creating blogs and video blogs for others; information, advice and assistance relating to any of the aforesaid provided online or via the internet; and/or via communications, telephone, mobile telephone and/or wireless communication networks; Entertainment services in the form of television programmes; Production and presentation of television programmes, shows, films, videos and DVDs; Production and presentation of television, radio, cable, satellite

and Internet programmes; Production, presentation, distribution, syndication, networking and rental of television, radio, cable, satellite and Internet programmes and of films, sound recordings, video recordings and DVDs; Gaming services; Organisation, production and presentation of competitions, contests, games, game shows, quizzes, fun days, exhibitions, roadshows, staged events, theatrical performances, concerts and participation events; Organisation, production and presentation of events for educational, cultural or entertainment purposes; Entertainment provided via online games websites; Educational services relating to entertainment; Information relating to entertainment or education, provided on-line from a computer database or the Internet or by communications satellite, microwave or other electronic, digital or analogue media; Electronic gaming services, including provision of games online, on social networks or by means of a global computer network; Information and advisory services relating to any of the aforesaid services; Arranging and conducting of conferences; publishing, including online publishing; provision of entertainment via podcast; conducting courses, seminars and workshops; publication of electronic magazines; publication of magazines; publishing of web magazines; publication of books, magazines, almanacs and journals; production of magazines; providing on-line non downloadable general feature magazines.

2. The application was published for opposition purposes in the Trade Marks Journal on 27 November 2015 and is opposed by Yes Music AG (“the Opponent”).
3. The Opponent owns an EU trade mark registration (numbered 001652262), for its word mark “BOBO”. The Opponent applied for its trade mark on 12 May 2000 and it was registered by the EU Intellectual Property Office on 26 March 2002.
4. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent relies on all goods and services covered by its registration as follows:

Class 9: *image and sound carriers excluding overhead projectors.*

Class 35: *business management for performing artists, sales promotion via the Internet, merchandising.*

Class 41: *live music concerts and performances.*

5. The Opponent's EU trade mark has a date of application for registration earlier than that of the Applicants' trade mark and is therefore an earlier trade mark as defined in section 6(1)(a) of the Act.
6. Since the earlier trade mark had been registered for more than five years before the Applicants' mark was published for opposition, section 6A of the Act requires that the earlier trade mark must have been put to genuine use in the European Union by the proprietor or with his consent in relation to the goods or services for which it is registered. The Opponent has duly provided a statement of use of its mark in relation to all of its registered goods and services. The Applicants have opted not to require the Opponent to prove that use, which means that the Opponent is therefore able to rely on all the goods and services protected by its earlier mark without having to provide evidence as to how it has used the mark.
7. The Opponent claims that there is a high level of similarity between the respective trade marks and identity or a high level of similarity between the respective goods or services in question, such that there would be a likelihood of confusion on the part of the relevant UK public as to the origin of the goods or services in question, including a likelihood of association.
8. The Applicants filed a counterstatement pointing out how the respective marks and classes differ. I will take those points into account and refer to them where appropriate during this decision.
9. The Opponent is represented by Kempner & Partners LLP, based in the UK. The Applicants represent themselves. Neither party has requested a hearing. The Opponent has filed written submissions, which include two annexes in support of

two points it makes as to similarity of the respective goods and services. I consider those annexes to be evidence since they seek to establish facts about the opponent. Those annexes are not accompanied by a statement of truth and the absence of such requisite formality means that I cannot take them into account in this decision.

10. The Applicants have made very succinct written submissions in lieu of an oral hearing, which in substance are that the Opponent's evidence does not show the Opponent to be "*engaging in video production or youth education*" and the "*Opponent's merchandising does not show any other branding apart from the "DJ BOBO" branding.*" However, as noted above, the evidence contained in the annexes to the Opponent's written submissions is not taken into account in this decision. Moreover, the Applicants have anyway indicated in their notice of defence (Form TM8) that the Opponent is not in this case required to prove matters relating to use of its EU trade mark, despite its having been registered for more than five years. The Applicants have filed evidence, which I briefly summarise below. I take this decision based on the papers received and taking into account relevant jurisprudence.

Applicants' evidence

11. The Applicants' evidence comprises an amended Witness Statement in the name of Fureel Otubu and dated 27 September 2016, together with two exhibits labelled B1 and B2. Mr Otubu states that he is known professionally as Bobo Furell and that he operates as a UK media, cultural arts and education practitioner, under the brand that he founded in 2008 using the figurative mark BOBO, the subject of this application. The Witness Statement lists the goods and services on which the Applicants' mark has been used in classes 25, 35, 38 and 41. Exhibit B1 is a sample of screenshots of pictures and videos of events at the 2008 Notting Hill Carnival where the Applicants' mark is seen to be used. Exhibit B2 is a sample of screenshots of pictures and videos documenting education projects and various media productions under the Applicants' mark, said to be from 2008 – 2016.

12. The Witness Statement expresses Mr Otubu's belief that as a result made of the mark BOBO (figurative) within the media, cultural arts and education sectors that it is "well known to the general public and to buyers and users in the United Kingdom" and distinguishes his goods and services from those of others. It is not clear to me whether by this statement the witness means to invoke a right to use the trade mark that he now applies to register, which predates the Opponent's registration. Whilst I note this evidence of use from the Applicant, I cannot consider it relevant for the purposes of this opposition. Tribunal Practice Notice 4/2009 states that "*Section 5(2) of the Act turns on whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.*"¹

DECISION

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

"... A trade mark shall not be registered if because-

... (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

14. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

¹ See the decision of Ms Anna Carboni, sitting as the Appointed Person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09.

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.

The principles are that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

15. The Opponent submits that the Applicants have admitted in their Counterstatement that the services covered by the Application in classes 35 and 41 are similar to the services covered by the Opponent's registration. I see no clear admission to that effect, only a reference by the Applicants to the classes being similar. The specifications both of the Opponent and Applicants clearly include classes 35 and 41. It remains necessary, however, to compare the respective goods and services to assess the degrees of similarity between them.
16. In approaching the task of comparing goods and services of the Applicants as against those of the Opponent, I am mindful of the words of Floyd J. (as he then

was) in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch.), where he stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise Nevertheless the principle should not be taken too far 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."

17. I also take account of the factors identified by the Court of Justice in *Canon*, Case C-39/97, where at paragraph 23 of its judgment it states that:

"In assessing the similarity of the goods all the relevant factors relating to those goods .. themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

18. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. I also take note that in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

Goods in Class 25

T-shirts, Clothing, Headgear, Footwear, Wristbands, Belts, Hoods, Hooded tops, Jackets, Caps.

20. The Opponent submits that these “are all sold for promotional purposes as merchandising goods to help promote the Applicants’ entertainment events or productions. Accordingly, these goods share an intended purpose with, and are related to, the Opponent’s “merchandising” services in class 35. As part of its merchandising services the Opponent provides merchandise under the BOBO name on its website as shown in Annex 1.”

21. My task of comparing the goods must be made on the basis of notional and fair use of the goods in the parties’ respective specifications. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. And in *Oakley v OHIM* (Case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

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

22. It may be very likely that the Applicants would market the goods it lists in just the promotional manner the Opponent describes, but since the comparison is based on notional, prospective uses, it is also possible that clothing could be marketed under the Applicants' mark in an ordinary retail context. I bear this in mind as I make the following points.
23. The dictionary² defines “*merchandising*” as “*the activity of promoting the sale of goods, especially by their presentation in retail outlets*” and as “*branded products used to promote a film, pop group, etc., or linked to a fictional character.*” The Opponent's registration in class 35 gives it protection to provide a merchandising service. I find this to be a broad specification and I am not clear as to its scope, which could involve simply giving advice to relevant businesses on strategies for sales of promotional items. In view of its vagueness, I am therefore loth to enable the service to cover the goods at issue. In this regard I note the following case law.
24. In *Advance Magazine Publishers, Inc. v OHIM*, Case T-229/12, the General Court held that ‘*accessories*’ is a vague term. The OHIM (now EUIPO) Board of Appeal therefore erred in law in comparing it with ‘*umbrellas*’. It therefore appears that where a term is not sufficiently precise to identify the characteristics of the goods (or services) at issue, that term cannot be the subject of a finding that it covers goods/services which are similar to other goods/services.³

²Oxforddictionaries.com

³ See also *Chartered Institute of Patent Attorneys v Registrar of Trade Marks* – BL O/197/13 (AP)

25. In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the General Court held that a registration for ‘retail services’, which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.
26. The term “merchandising” does not make clear who is the target market of that merchandising service. In my view, the average consumer of merchandising services would be a business, whereas the average consumer for clothing would be a member of the general public.
27. Nor does the Opponent’s registration make clear the category of items to be branded for promotional purposes and I have not been able to consider evidence as to whether or how the Opponent has used its mark. I recognise that clothing items are commonly used as merchandising, but so too is a virtually endless diversity of items susceptible for such use. To find, in these circumstances, similarity between the Opponent’s merchandising service and the Applicants’ goods risks flexing the scope of the service to include any goods I have in mind here the view expressed by Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 that “... *specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.*”
28. I do not find similarity between the Opponent’s “*merchandising*” services in class 35 and the Applicants’ goods in class 25.

Services in Class 35

Production of video recordings for marketing purposes. Production of video recordings for advertising purposes. Production of video recordings for publicity purposes. Production of internet and television advertising content. Producing promotional videos, video disc, and audio visual recordings

29. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

30. The Applicants’ production services above are all framed as forms of promotional services and would fall within the broad term “*sales promotion*” in the Opponent’s registration in class 35. Under the principle expressed in *Meric*, these services may therefore be considered identical, and I find them at least similar to a high degree on the basis of their nature, intended purpose, complementarity, channels of trade and common users.

Business consulting

31. The Opponent submits that there is similarity between “*business consulting*” and the Opponent’s “*business management*” services in class 35. I note that protection of the latter is restricted to management services “*for performing artists.*” I agree that there is a degree of complementarity in that a business manager may find it important to use a business consultant as part of its service, and a business consultant may serve to manage at least an aspect of business. The services may often originate from the same source and their overall purpose is similar in that they are essentially concerned with sustaining and developing business. I therefore find the services similar to a reasonable degree, but that similarity is limited to the business consulting for performing artists.

Advertising via electronic media and specifically the internet.

I find these services to be identical to the Opponent’s registration for “*sales promotion via the Internet.*”

Providing marketing consulting in the field of social media

32. I find a reasonable degree of similarity between these services of the Applicants and the Opponent's registration for "*sales promotion via the Internet.*" They share the same ultimate purpose of promoting the goods or services of third parties, are often provided by the same source, share the same relevant public and the services could mutually compete.

Media research and consultancy

33. I find some similarity between the Applicants' specification of "*Media research and consultancy*" and the Opponent's registration for "*business management for performing artists, sales promotion via the Internet.*" Managing the business of performing artists and promoting sales online would commonly entail media research, indeed the latter service would be important for the former services and they are therefore complementary. The Opponent submits that providers of business management (albeit exclusively for performing artists) and online sales promotion often also provide media research and consultancy and the services are directed at the same business market. I agree that there may be common channels of trade and users, but the match is far from absolute. Media research and consultancy may have quite different providers and are services that extend beyond selling via the Internet and whose consumers are not limited to performing artists. Overall, I find the services similar to a low degree.

Retail services connected with the sale of branded T-Shirts, clothing and headgear

34. As the CJEU stated at paragraph 54 of its judgment in *Oakley* (above) "... *the objective of retail trade is the sale of goods to consumers ... retailing includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction.*" I compare this with Opponent's registration for "*merchandising*", for which I have earlier given the definition as "*the activity of promoting the sale of goods, especially by their presentation in retail outlets.*" I find these services to be similar. The Applicants' retail services are connected only with the sale of clothing and selling clothing is

important for merchandising and is therefore complementary. These services will share channels of trade and aspects of common purpose. I also find similarity in business consumers, as the consumer of retail services will be not only the general public, but also other businesses and manufacturers who seek to have their goods sold via the Applicants' retail services. I therefore find that there exists an at least average degree of similarity between the Opponent's "*merchandising*" services in class 35 and the Applicants' retail services in class 25.

Services in Class 38

Transmission of sound and images; providing radio and television broadcasting, also via internet networks; radio communication.

35. The Opponent submits that these services in the Applicants' specification are similar in nature to the Opponent's protection for goods and services in classes 9 and 41.
36. The Opponent has protection in class 9 for "*image and sound carriers excluding overhead projectors*". Goods of this description must be involved in the Opponent's service of "*transmission of sound and images.*" The Opponent submits that such goods are used in the provision of the radio and television broadcasting services of the Applicant. I accept that accordingly these goods and services share the same purpose, are used together in a complementary way (goods to carry images / sound being indispensable to transmission and broadcast of such images / sounds). They are therefore similar. However, it seems to me that an average consumer for broadcast / transmission services would not necessarily anticipate that that service provider would also be a purveyor of the electronic hardware to carry the sound (which may include amplifiers and speakers and the like). I therefore estimate the similarity to be low.
37. The Opponent submits that its "*live music concerts and performances*" in class 41 may be broadcast on television, radio or online either as live or after the event and that there is accordingly an interrelationship with the Applicants' "*radio and television broadcasting and radio communication services*" and that they are

directed at the same audience. I am less persuaded by this line of argument as the Opponent makes no claim to provide broadcasting services, but seems rather to have chosen to focus on live concerts and performances. At any rate, I do not find that this line of argument elevates the degree of similarity higher than my earlier estimation (i.e. low). However, Inasmuch as live concerts and performances will commonly involve amplification of sound and large screens showing the performer on stage, the Opponent's service does involve transmission of sound and images.

Services in Class 41

38. The Opponent submits that all of the Applicants' various services in class 41 are identical or similar to the Opponent's services in classes 35 and 41. It is convenient to examine the extent of any similarity in more or less the same order that the Opponent has set out its points in its submissions (albeit that that approach picks out terms from across the specification as presented and collects them out of order).

Education; examining for and granting of educational, cultural and entertainment awards; conducting courses, seminars and workshops; providing of training

39. The Opponent submits that since the Applicants have not limited the specific fields to which these services relate, there is overlap with the Opponent's protection for "live music concerts and performances." The Opponent submits that should the average consumer in the UK "see a BOBO award for music, it is highly likely they would expect the award to be connected in some way to the Opponent."

40. I do not find this a strong line of argument. The services involved in "live music concerts and performances" do not share the same nature, purpose or method as the education, examination and training services here specified. The specification is widely cast, but even at its closest intersection of "granting entertainment awards" I do not find similarity with the Opponent's registration for live music concerts and performances.

entertainment; sporting and cultural activities; organising and operating entertainment, cultural and educational events and shows; Entertainment services in the form of television programmes; Production and presentation of television programmes, shows, films, videos and DVDs; Production and presentation of television, radio, cable, satellite and Internet programmes; Production, presentation, distribution, syndication, networking and rental of television, radio, cable, satellite and Internet programmes and of films, sound recordings, video recordings and DVDs;

41. The Opponent points out that it has protection in class 41 for “*live music concerts and performances*” which are forms of entertainment and cultural activities. On that basis it submits that there is similarity with all of the Applicants’ above entertainment, cultural and related services, as they “*share the same purpose, essentially entertainment of the public, and are aimed at the same market.*” I find that line of argument to be high level and sweeping in nature. I must compare the terms more closely.

42. Certain terms in the Applicants’ specification are extremely wide, notably “*entertainment*” and “*cultural activities*” and “*organising and operating entertainment, cultural and educational events and shows.*” Despite their breadth, I see no reason to give the words an unnaturally narrow meaning⁴ - they include the Opponent’s “*live music concerts and performances.*” The latter are readily described as entertainment and cultural events and shows. Under the principle in *Meric*, I find the services to be identical or at least similar to a very high degree. As to the “*educational*” component, it is not uncommon for live music performances to be used to an educational end, for example to teach young people about an orchestra, and I therefore find similarity in the services, but only to the extent that the Applicants’ educational services may include live music concerts and performances.

43. I find no similarity between the Opponent’s protection for “*live music concerts and performances*” and the Applicants’ “*sporting activities.*”

⁴ In line with comments of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

44. The remainder of the specified items grouped above are broadly concerned with production and distribution services for television and other recordings. The explicit focus of the Opponent is on live provision, whereas the Applicants' services here focus on producing and distributing recorded materials, which by definition are not live. This is a core difference in the nature of the services, which weighs heavily in my estimation. However, it is possible to read the Applicants' specification of "*production and presentation of .. shows ..*" as including "*live music concerts and performances*" (as live, unmediated events). To that extent the services may be seen as similar to a high degree, if not identical.

45. I again bear in mind the words of Floyd J. in *YouView TV Ltd* cautioning against such liberal interpretation that the limits of the registration become "*fuzzy and imprecise.*" Nonetheless, in these days of easy access to digital sound and image capture and distribution it is commonplace for live music concerts and performances to be recorded and that recorded material disseminated in different media. The services of a provider who has protection for "*live music concerts and performances*" may reasonably include these production and dissemination services. Overall I find the Applicants' services - namely "*entertainment services in the form of television programmes; Production and presentation of television programmes, ... films, videos and DVDs; Production and presentation of television, radio, cable, satellite and Internet programmes; Production, presentation, distribution, syndication, networking and rental of television, radio, cable, satellite and Internet programmes and of films, sound recordings, video recordings and DVDs*" - to share a low degree of similarity with the Opponent's registered services for "*live music concerts and performances*" and limited to that subject matter.

Organisation, production and presentation of exhibitions, roadshows, staged events, theatrical performances, concerts and participation events;

46. I conceptualise "*exhibitions*" as the largely static presentation of information through text, image and objects. I do not associate live music performances with the term "*exhibitions*" and I find little or no similarity in the services. The other

terms above are broader. “*Organisation of concerts*” is clearly identical. “*Roadshows, staged events, theatrical performances, ... and participation events*” may readily include “*live music concerts and performances*” and since they share the same nature, method and relevant public I find them similar to a reasonably high degree.

Organisation, production and presentation of events for educational, cultural or entertainment purposes;

47. These services are essentially the same as *organising and operating entertainment, cultural and educational events and shows*, which I have already compared. I find these services similar to a reasonably high degree for the reasons I have given.

Educational services relating to entertainment; Information relating to entertainment or education, provided on-line from a computer database or the Internet or by communications satellite, microwave or other electronic, digital or analogue media;

48. I disagree with the Opponent’s submission that the above services are similar to the Opponent’s registration for “*live music concerts and performances*”. The services are different in nature and are not similar. They have different methods of use and different purposes (one focused on providing education and digital information, the other on live entertainment).

provision of entertainment via podcast

49. I find a reasonable level of similarity between the Applicants’ “*provision of entertainment via podcast*” Opponent’s registered services for “*live music concerts and performances*” (albeit limited to that subject matter). Live music concerts and performances may frequently be recorded and it is a relatively straightforward service to make any resultant digital audio files available on the Internet for downloading to a computer or portable media player (which in my understanding constitutes a podcast). The services share a common purpose and users

(entertainment of the fans of the live performers) and there may be an element of competition in that the relevant public may make a choice between attending a live concert or performance and downloading and listening to it after the event.

Publishing; publishing, including online publishing; publication of electronic magazines; publication of magazines; publishing of web magazines; publication of books, magazines, almanacs and journals; production of magazines; providing on-line non downloadable general feature magazines.

creating blogs and video blogs for others; information, advice and assistance relating to any of the aforesaid provided online or via the internet; and/or via communications, telephone, mobile telephone and/or wireless communication networks;

50. I do not find the Opponent's registration for "*live music concerts and performances*" similar to the above. The services are different in nature and are not similar. They have different methods of use and different purposes. The fact that the content of a publication or blog may relate to music is insufficient to generate similarity. The Opponent submits that there is overlap with "*business management for performing artists.*" I recognise that the latter management service may entail such activities as blogs and publications, but I find the services different in essential nature and purpose, overriding any element of complementarity. (I again bear in mind the caution of Jacob J in *Avnet* (above) against a wide construction of services in a specification.)

organising and operating games and competitions; Organisation, production and presentation of competitions, contests, games, game shows, quizzes, fun days

Gaming services; Entertainment provided via online games websites; Electronic gaming services, including provision of games online, on social networks or by means of a global computer network; Information and advisory services relating to any of the aforesaid services; Arranging and conducting of conferences;

51. I do not find the Opponent's registration for "live music concerts and performances" similar to the above. The services are different in nature and are not similar. They have different methods of use and different purposes.

The average consumer and the purchasing process

52. It is necessary to determine who the average consumer is for the respective goods and services and the manner in which they are likely to be selected. 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 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 word "average" denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median."*

53. I consider that the average consumer for the goods and services at issue will notionally be a mix of members of the general public, music artists and businesses.


54. *Goods at issue:* The Applicants' clothing goods in 25 are bought by the general public at large. The goods will vary in cost, but will not be especially expensive. They are not everyday purchases, but nor are they luxury items. I would expect average consumer to pay a reasonable level of attention when selecting such goods, sufficient to obtain the correct size, colour and fit. The purchasing act will be mainly visual as such goods are commonly purchased based on their aesthetic appeal; they are likely to be selected after perusal of racks/shelves in retail outlets, or from images on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

55. *Services at issue*: The Applicants' video production and consultancy services under class 35 may be accessed by the general public, but are more targeted to businesses. The average consumer for the Applicant's clothing retail services in class 35 will be the general public, but could include businesses insofar as the Applicant could retail on behalf of others.
56. The Opponent's business management services in class 35 are targeted at performing artists.
57. The average consumer of the Applicants' transmission and communication services in class 38 is likely to be a business or community interest.
58. The consumer of the Applicants' services under class 41 will be a mix: the education and training, games and entertainment services may be accessed by the general public (including community groups), but also by businesses; the media production services more targeted to business (which may include community groups).
59. None of the services at issue is an everyday service, and the process of selecting the provider would be one that took account of the consumer's needs, objectives and circumstances. Case law recognises⁵ that the average consumer's level of attention may vary according to the category of goods or services in question. In making its selection of the services at issue, I would expect the relevant consumer to pay at least a normal level of attention. I would expect both visual and aural considerations to feature within the purchasing act. This takes account of the fact that consumers may deploy the mark as a search term online or may read about it in marketing and other relevant literature, but also factors in word of mouth recommendations and referrals.

⁵ See for example comments of the General Court in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03

Comparison of the marks

60. The Applicants in their counterstatement argue that the respective marks are visually, aurally and conceptually different and, accordingly, deny that any confusion would be likely to arise between the two marks. The respective trade marks are shown below:

BOBO	
Opponent's earlier trade mark	Applicants' contested trade mark

61. In *Sabel*, the CJEU stated that the global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. It would therefore be wrong to artificially dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features that are not negligible⁶ and therefore contribute to the overall impressions created by the marks.

Visual similarity

62. The Opponent's trade mark is simply the word "BOBO". A word mark protects the word itself⁷ and allows for use with moderate presentational variations such as uppercase and lower case and font. The Applicant's mark is a figurative mark, based on the word "BOBO" but in a way that is very highly stylised and elaborated.

⁶ *Matratzen Concord v OHIM* [2003] E.T.M.R. 31 GC at para.33; *Calvin Klein Trademark Trust v OHIM* [2011] E.T.M.R. 5 CJEU at para.56

⁷ *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14, Mr Iain Purvis QC, sitting as the Appointed Person

The second letter in the Applicant's mark is depicted in the shape of a world globe, encircled by the words "B-LOVE CAN! CAN! Spirit Of The Dream." The additional text and globe device are distinctive, but do not prevent the average consumer from visually perceiving the combination as serving as the first of two letters "O" in the word "BOBO". Since the mark begins and ends with letters, the natural inclination is to attempt to read it and the device will, therefore, be interpreted as an "O". The word "BOBO" represents the whole of the distinctive character of the Opponent's mark and I find it to be the dominant component of the Applicants' mark. Overall I find between the marks a medium degree of visual similarity.

Aural similarity

63. I have found that the average consumer would visually perceive the Applicants' mark as essentially being the word "BOBO", and it is that word that the notional consumer would voice. The average consumer would generally be unlikely to voice the smaller textual aspects of Applicants' mark – "B-LOVE CAN! CAN! Spirit of the Dream." Much more likely the mark would be described orally, and perceived aurally, as "BOBO." I see no reason why that word would not be pronounced in a manner phonetically identical to the Opponent's mark. I therefore find the marks to be aurally identical. If I am wrong about the consumer not vocally expressing any of the supplementary text encircling the globe device, I find it unlikely that any such voicing would omit the dominant verbal aspect of the overall mark, which is BOBO. So to the extent that the mark may be spoken as "B-Love BOBO" or "CAN! CAN! BOBO" etc, I find, in that alternative, the Applicants' mark to be aurally similar to the Opponent's mark to a reasonably high degree.

Conceptual similarity

64. "BOBO" is a word that is defined in an English dictionary as a noun signifying "a person having both the values of the counterculture of the 1960s and the materialism of the 1980s; a bourgeois Bohemian as in "Bobo culture."⁸ However,

⁸ Oxforddictionaries.com

this is far from a well-known word and is not one that the average consumer would perceive as carrying a meaning in the English language.

65. The Applicants explain in their counterstatement that their mark is an acronym for “Best of British origin” as part of a London 2012 Olympics legacy campaign. The additional textual components of the trade mark derive from a multipartite campaign project brand tag, namely “Be The Spirit Of The Dream, Be The Spirit Of The Team, Be The Spirit Of The BOBO” / “Be The Dream, Be The Team, Be The BOBO” / “TEAM BOBO (Best Of British Origin).” Despite this explanation, I find that the average consumer would perceive the mark as being an invented word and one with no immediately clear meaning.
66. The Opponent states in its submissions that its mark is an invented term that has no meaning within the music industry other than to denote the Opponent’s goods and services.
67. I find that both parties’ marks will be treated as invented words and that neither mark will create any conceptual picture in the mind of the average consumer. I therefore find the word elements of the marks to be conceptually neutral. If the average consumer readily recognises the globe device, and reads and understands the words encircling it (and do not see it solely as an elaborated “O”) I find that they would take some general, positive message about the world. No such message is present in the Opponent’s mark, so this is a conceptual difference between the marks. The Applicant’s globe device and encircling text are distinctive, but since I find the dominant impression of both marks to be the invented word “BOBO” I do not find that the device and additional text operate to significantly alter the conceptual neutrality of the marks.

Distinctive character of earlier trade mark

68. The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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

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 ...”

69. To the extent that the mark will be perceived as an invented word that neither describes nor alludes to the relevant goods and services, it has a high level of inherent distinctiveness. Despite the Opponent’s submissions as to levels of record sales worldwide, I have no evidence on which to consider whether there has been any enhancement of the mark through use in the UK.

Conclusion as to likelihood of confusion

70. I now turn to reach a conclusion as to the likelihood of confusion between the two marks if they were used in relation to the goods and services specified. In making this global assessment of likelihood of confusion I take stock of my findings set out in the foregoing sections of this decision as to: the relevant average consumer and the nature of the purchasing process; the similarity between the specified goods and services; and the similarity between the conflicting marks, taking account of the distinctiveness of the earlier mark. I also take account of the principles from case law enumerated at paragraph 14 above.

71. I have found the relevant average consumer for the goods and services in question variously to be the public at large, music artists and businesses; they would pay a reasonable level of attention when purchasing the goods in question and at least a normal level of attention when purchasing the services in question;

visual considerations predominate in the purchasing process for the clothing goods in question and that both visual and aural considerations feature in the purchasing process for the services at issue.

72. As to the goods and services at issue, I have found some services to be identical and that there are various degrees of similarity between the parties' services ranging from low through reasonable and high to identical. I have found no similarity in the goods in question and no similarity between certain of the services in question. If there is no similarity at all, there is no likelihood of confusion to be considered.⁹ If there is some similarity, then the likelihood of confusion has to be considered. I will return to this in detail below, but as stated by Richard Arnold Q.C., sitting as the Appointed Person in *Sensornet Trade Mark* [Case O/136/06]:

"50....if an objection to registrability only applies to some goods or services in the specification applied for, then the application should only be refused in so far as it covers those goods or services and should be allowed to proceed in respect of the remainder."

73. In comparing the marks I have found that they are visually similar to a medium degree, aurally identical or similar to a reasonably high degree and share conceptual neutrality. In *Bimbo SA v OHIM* Case C-591/12P, the CJEU stated at paragraph 34 of its judgment 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."

⁹ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU) and Lady Justice Arden in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA,

74. I have found that the word “BOBO” has a high level of inherent distinctiveness. It represents the whole of the dominant and distinctive character of the Opponent’s mark. I find the same word is dominant within the Applicant’s mark. The additional text and globe device within the Applicant’s mark are distinctive and far from negligible, but their combined effect serves in part to represent one of the four letters of the word component. I find the overall impression of both marks to be the word “BOBO” and the marks are therefore similar to a high degree.

75. On a global comparison, taking all factors into account including the interdependency principle¹⁰ that a lesser degree of similarity between the respective goods and services may be offset by a greater degree of similarity between the respective marks (and vice versa), I find there is a likelihood of confusion in respect of each of the services of the application which I have found to be similar to (to whatever degree) or identical with the services of the earlier mark. The opposition under section 5(2)(b) succeeds in respect of these services as follows:

Class	Services
35	Production of video recordings for marketing purposes. Production of video recordings for advertising purposes. Production of video recordings for publicity purposes. Production of internet and television advertising content. Producing promotional videos, video disc, and audio visual recordings. Business consulting; advertising via electronic media and specifically the internet. Media research and consultancy. Providing marketing consulting in the field of social media. Retail services connected with the sale of branded T-Shirts, clothing and headgear.
38	Transmission of sound and images; providing radio and television broadcasting, also via internet networks; radio communication.
	entertainment; cultural activities; organising and operating entertainment, cultural and educational events and shows;

¹⁰ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*

41	Entertainment services in the form of television programmes; Production and presentation of television programmes, shows, films, videos and DVDs; Production and presentation of television, radio, cable, satellite and Internet programmes; Production, presentation, distribution, syndication, networking and rental of television, radio, cable, satellite and Internet programmes and of films, sound recordings, video recordings and DVDs; roadshows, staged events, theatrical performances, concerts and participation events; Organisation, production and presentation of events for educational, cultural or entertainment purposes; provision of entertainment via podcast;
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76. Subject to any appeal against this decision, the application will be allowed to proceed to registration for the following goods and services:

25	T-shirts, Clothing, Headgear, Footwear, Wristbands, Belts, Hoods, Hooded tops, Jackets, Caps.
41	Education; providing of training; sporting activities; publishing; organising and operating games and competitions; examining for and granting of educational, cultural and entertainment awards; creating blogs and video blogs for others; information, advice and assistance relating to any of the aforesaid provided online or via the internet; and/or via communications, telephone, mobile telephone and/or wireless communication networks; Gaming services; Organisation, production and presentation of competitions, contests, games, game shows, quizzes, fun days, exhibitions, Entertainment provided via online games websites; Educational services relating to entertainment; Information relating to entertainment or education, provided on-line from a computer database or the Internet or by communications satellite, microwave or other electronic, digital or analogue media; Electronic gaming services, including provision of games online, on social networks or by means of a global computer network; Information and advisory services relating to any of the aforesaid services; Arranging and conducting of conferences; publishing, including

	<p>online publishing; conducting courses, seminars and workshops; publication of electronic magazines; publication of magazines; publishing of web magazines; publication of books, magazines, almanacs and journals; production of magazines; providing on-line non downloadable general feature magazines.</p>
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77. It is noted that the success of the opposition in respect of the services identified above results partly from the Opponent’s registration for services where I have found some similarity with the Applicant’s specification, but where such similarity is limited to the context of “*performing artists*” or of “*live music concerts and performances*”. In formulating this decision – which allows registration to proceed “save for” a comprehensible list of services in respect of which the opposition has succeeded - I have borne in mind the guidance on partial refusals provided in Tribunal Practice Notice (1/2012). That guidance states that “... *where an opposition action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner’s business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal.*”

Costs

78. The Opponent has been partially successful and is entitled to a contribution towards its costs, which I assess based on the guidance in Tribunal Practice Notice 4/2007, less a reduction of 40% to reflect the extent to which the opposition did not succeed. In the circumstances I award the Opponent the sum of £360 (three hundred and sixty pounds) as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Reimbursement of the official fee for Notice of Opposition and Statement of Grounds:

£100 (one hundred pounds)

Preparing a statement and considering the other side's statement:

£200 (two hundred pounds)

Preparation of written submissions in lieu of oral hearing:

£300 (three hundred pounds)

Less 40%

79. I therefore order Fureel Otubu and Jonathan Kes Otutbu to pay Yes Music AG the sum of £360 (three hundred and sixty pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of April 2017

Matthew Williams

**For the Registrar,
the Comptroller-General**