

O-201-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2491149  
BY QUEENSBERRY BOXING LTD TO REGISTER A  
TRADE MARK IN CLASSES 16, 25, 35, 41 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 98391 BY QUEENSBERRY RULES LIMITED**

## BACKGROUND

1. On 26 June 2008, Queensberry Boxing Ltd (QB) applied to register the following trade mark:



Following examination, the application was accepted and published for opposition purposes on 17 October 2008 in Trade Marks Journal No.6757 for the following goods and services:

**Class 16:** Advertising promotional and marketing materials; souvenirs and mementos; books, magazines, programmes, leaflets and newsletters; stationery of all types; photographs; posters; tickets.


**Class 25:** Sports promotional and casual clothing of all types; headgear and footwear of all types.

**Class 35:** Advertisement promotion and marketing of sporting events, programmes and activities by printed matter, banners, television, radio, the Internet and similar media; production and management of television and radio advertisements; agency and business management services for sporting and entertainment clients; retail services connected with the sale of sports promotional and casual clothing, headgear, footwear, stationery, books, magazines, programmes, tickets, photographs, posters, leaflets and newsletters, souvenirs, mementos and memorabilia.

**Class 41:** Provision of training for sports and general entertainment purposes; provision of sporting and cultural activities and entertainment; provision and operation of fan clubs; provision of electronic games and publications including through the Internet.

**Class 42:** Design and development of computer software and web sites; creation and maintenance of websites and web pages on the Internet.

2. On 8 December 2008, Queensberry Rules Limited (QR) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act) directed against all of the goods and services contained in the application. QR indicate that their opposition is based upon the following trade marks:

Trade Mark	No.	App Date	Reg Date	Goods & Services
<p>QUEENSBERRY Queensberry queensberry</p> <p>(Series of 3)</p>	2486784	8.05.08	10.10.08.	<p><b>Class 25</b> –Articles of clothing; footwear; headgear.</p> <p><b>Class 35</b> - Advertising services; marketing, developing and managing Internet advertising campaigns; gathering information for the development of new websites; business information services provided on-line from a computer database, the Internet, intranets or extranets; search engine marketing services, search engine optimisation services, search engine submission services.</p> <p><b>Class 41</b> – Publishing on the Internet, intranets or extranets; providing on-line electronic publication.</p> <p><b>Class 42</b> – Computer services; design services; illustration services; computer software design and web design; creating and maintaining websites; compilation of web pages on the Internet; artwork, typography, prints, publication and pre-press design services.</p>
 <p>The word in the mark is "Queensbury".</p>	2410709	5.12.05	15.09.06	<p><b>Class 25</b> - Articles of clothing; footwear; headgear.</p>

3. In their Notice of Opposition QR say:

“[The application in suit] is essentially in its dominant and distinctive features the word QUEENSBERRY...The use of the mark as applied for...would result in confusion with the opponent’s earlier marks....in that all marks will be seen as

QUEENSBERRY marks and would be identified by the relevant consumer accordingly...”

4. On 5 March 2009 QB filed a counterstatement (which was resubmitted on 20 July 2009). I also note from official records that on 1 March 2009 the application in suit was assigned from QB to Mr Luigi La Mura and Mr Andrew Goodwin (hereafter LMG); as nothing appears to turn on this assignment I need make no further mention of it in this decision.

5. In their counterstatement LMG comment on, inter alia, the origin of the name Queensberry (stemming from the Marquess of Queensberry rules and its association with boxing), their aim for their trade mark (to launch a new sports clothing and boxing attire brand), the history of the business (from 1 August 2007 until 14 June 2008), the development of the trade mark the subject of the application in suit and what they describe as “our defence”. Insofar as the latter is concerned, LMG explain, inter alia, that they applied for their trade mark in good faith, “were at the time of application the only company using this mark with the specific wording in our field or any other clothing or sports related field” and that they took professional advice. They add that “having actively used our brand since 2007 we feel that we can state a claim to some active history behind our brand”. Finally, they raise a number of questions regarding the identity of the opponent QR.

6. I note from official records that in an official letter dated 24 March 2009 the Trade Marks Registry (TMR) raised this latter issue with QR’s professional representatives at that time, Barlin Associates. The relevant part of the official letter said:

“The counterstatement has now been considered and it is the registry’s preliminary view that your comments are required in respect of the identity of the opponent before any further action can be taken.”

7. In a letter dated 8 April 2009 Barlin responded to the official letter. They said:

“The opponent is a company incorporated in Gibraltar having a place of business in the United Kingdom. A copy of the witness statement made by Edward Simons setting out the status of the opponent is filed herewith....”

8. The witness statement referred to (which was filed in relation to another matter) is dated 8 February 2009 and is from Edward Simons who is a shareholder and manager of QR . Mr Simons explains that the nature of the company’s business is to sell goods bearing the company’s trade marks and to licence such trade marks. He states that the business is primarily concerned with the marketing of merchandise associated with boxing, adding that all such merchandise bears the trade marks QUEENSBERRY and/or QUEENSBERRY RULES. He goes on to say that the company is trading in the United Kingdom from offices at Centurion House, Bircherley Green, Hertford and he provides information regarding the company’s association with Frank Warren’s Sports

Network Limited as well as various sponsorship agreements and details of television coverage the company have enjoyed.

9. In response to this information the TMR said in an official letter dated 15 July 2009:

“...In view of the comments made by Barlin in their letter of 8 April 2009 and Mr Edward Simons in his witness statement it is the Registry’s preliminary view that the opponent is a Gibraltar incorporated company which has a place of business in the United Kingdom. Therefore, the proceedings can continue as [sic] the opponent as Queensberry Rules Limited.”

10. In a letter dated 17 July 2009 LMG responded to this letter (confirming their agreement to a different point raised in the official letter), but, I note they did not challenge the TMR’s approach to the status and identity of the opponent. While for the sake of completeness I think it is important for the outcome of this issue to be recorded here, it appears to me that LMG have accepted that QR are entitled to bring these opposition proceedings and I intend to proceed on that basis.

11. Neither party filed evidence in these proceedings nor asked to be heard nor filed written submissions in lieu of attendance at a hearing. I have therefore only the comments in QR’s Notice of Opposition and those in LMG’s counterstatement to assist me.

## **DECISION**

12. The opposition is based solely upon section 5(2)(b) of the Act which reads as follows:

“5 (2) 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.”

13. 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.”

14. In these proceedings QR are relying on the registered trade marks shown in paragraph 2 above both of which have application dates prior to that of the application for registration; as such, they qualify as earlier trade marks under the above provisions. The application for registration was published for opposition purposes on 17 October 2008 and QR's earlier trade marks were registered on 15 September 2006 and 10 October 2008 respectively. As QR's earlier trade marks had not been registered for five years at the point at which LMG's application was published, they are not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

### **Section 5(2)(b) – case law**

15. The European Court of Justice (ECJ) has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

### **The average consumer and the nature of the purchasing act**

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. Both LMG's application and QR's registrations relate to a range of goods and services; I will consider each class of goods and services in turn.

### **Class 16**

17. LMG's goods in this class consists of advertising promotional and marketing materials, souvenirs and mementos, books, magazines, programmes, leaflets and newsletters, stationery, photographs, posters and tickets. These are all goods which are capable of being purchased by both the general public and by those in business. My own experience suggests that the selection of these types of goods is most likely to

consist primarily of a visual act having inspected them in perhaps a retail setting, in a catalogue or on-line. Having done so, it is possible that some if not all of the goods may then be ordered by telephone; in those circumstances aural considerations will also play a part in the selection process. The level of attention paid by the average consumer to the selection of the goods is, in my experience, likely to vary depending on the nature of the goods at issue and their cost. For example, one is unlikely to spend as much time considering the selection of an inexpensive pencil (included in the term stationery) as one would perhaps a (reasonably expensive) photograph. Similarly, one would expect an average consumer to take more care when selecting advertising promotional and marketing materials for personal or business use than they would if they were, for example, selecting a magazine. In summary, I consider that the average consumer's level of attention when selecting the goods is likely to vary from low (the pencil example) to reasonable (the photograph or advertising materials examples).

### **Class 25**

18. The goods at issue are all items of clothing, footwear and headgear. These again are goods which will be bought by both the general public and by those in business; they then are the average consumer for such goods.

19. In my experience the selection of the goods at issue is (once again) most likely to consist primarily of a visual act in the same manner indicated in paragraph 17 (see also the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285). Whilst this is likely, in my view, to be the principal means by which the goods are selected, once again I do not rule out that orders may also be placed by telephone.

20. The cost of the goods at issue may vary from very small sums (for a pair of socks for example) to many thousands of pounds (for, for example, a bespoke gown or suit). The factors the average consumer would be conscious of when selecting such goods are likely to be, *inter alia*, cost, design, material, size, colour, compatibility with other items of clothing and ultimately if the goods were suitable for their purposes. All of these factors point to the average consumer paying a reasonably high level of attention to their purchase.

### **Class 35**

21. The services in this class can, I think, be broadly described as: (i) advertising and marketing services, (ii) agency and business management services for those in the fields of sport and entertainment, (iii) business information services, and (iv) retail services in relation to the sale of sports promotional and casual clothing, headgear, footwear, stationery, books, magazines, programmes, tickets, photographs, posters, leaflets, newsletters, souvenirs, mementos and memorabilia. It appears to me that as the services in categories (i) to (iii) are predominantly those that would be provided by one business to another, the average consumer is more likely to be a business user than a member of the general public. As to how these services are likely to be selected by the average consumer, I have little experience of my own from which to draw. In the



absence of any evidence to assist me, I am inclined to think that a business user wishing to avail themselves of such services may, for example, consult appropriate trade journals, directories and websites and attend relevant trade shows. If I am right, that suggests that the selection process is once again likely to consist predominantly of a visual act. In reaching that conclusion it would not, I think, be appropriate to ignore aural considerations altogether as these may also feature to some extent at least in the selection process. Given the nature of the services in these categories, their likely cost and the role they play in, for example, improving a business's efficiency or making them more visible to their existing and potential customers etc., suggests to me that the average consumer is likely to pay quite a high level of attention when selecting them.

22. That leaves the services in category (iv) above which relate to the retailing of a range of clothing, stationery, books, memorabilia etc., the average consumer of which may be either a member of the general public or a business user. Given the manner in which the average consumer meets providers of retail services, for example, in a shopping centre in the real world or a series of potential web sites in the virtual world, they are, I think, once again likely to rely predominantly on visual considerations when making their selection. While the average consumer is likely to display greater care (and a degree of brand loyalty) when selecting the retail outlet from which they purchase, for example, clothing, this level of care is, I think, likely to reduce significantly when they are selecting a retail outlet for, for example, a magazine.

#### **Class 41**

23. The services in this class can, I think, be broadly described as (i) publishing services, (ii) training services in the fields of sports and general entertainment, (iii) provision of sporting, cultural and entertainment activities, (iv) providing and operating fan clubs, and (v) providing electronic games. While the publishing services in category (i) above are, in my view, most likely to be provided primarily to those in business, the same is not, I think, true of the services in categories (ii) to (v) all of which are likely to be targeted (primarily) at the general public. As to how the services in category (i) are likely to be selected by the average consumer, I think that given their nature my comments in relation to the services in categories (i) to (iii) in class 35 apply equally here.

24. Insofar as the remaining services are concerned, their selection is most likely again, in my view, to consist predominantly of a visual act having encountered the services being offered in, for example, magazines, on posters and on-line. However, as entertainment services (for example the visit of a travelling circus) may also be promoted by means of radio, aural considerations may also play a part in the selection process. The terms "training for sports and general entertainment" and "provision of sporting and cultural activities and entertainment" are extremely broad and would encompass services ranging from, for example, providing training in relation to boxing to staging a concert or sporting event and providing an entertainer for a child's birthday party. It appears to me that in those circumstances the average consumer's level of

attention is likely to vary from quite low to reasonably high depending on the cost and nature of the service being selected.

25. As to the services which remain i.e. “provision and operation of fan clubs” and “provision of electronic games”, these are all likely to be selected on the basis of their subject matter. Insofar as the former is concerned, the name of the person/group whose fan club is being offered will, I think, be the most important factor along with the cost of membership and whether or not the fan club is endorsed by the person/group concerned i.e. is it an official fan club? This suggests to me that a reasonable level of attention will be paid to the selection of fan club services.

26. As to the provision of electronic games, the factors that are likely to be important to the average consumer are, in my view, the cost and type of game i.e. is it an arcade style game, a game based on a sporting theme or a fantasy type game . Also important but to a lesser extent are, I think, likely to be the degree of sophistication of the game concerned (its graphics, sound etc), its ease of play and compatibility with other platforms and users. When taken together all these factors suggest to me that the average consumer is likely to pay a reasonable level of attention to the selection of these services.

**Class 42**

27. The services in this class can, I think, be broadly described as (i) computer services (at large), (ii) design services (at large), (iii) illustration services, (iv) computer software design and web design, (v) creating and maintaining websites and (vi) artwork, typography, prints, publication and pre-press design services. While many of these services are capable of being provided to the general public, it appears to me that they would predominantly be targeted at those in business, with the traits of the average consumer much as I have described them in relation to the services in categories (i) to (iii) in relation to class 35.

**Comparison of goods and services**

28. The goods and services to be compared are as follows:

<b>LMG’s goods and services</b>	<b>QR’s goods and services</b>
<p><b>Class 16:</b> Advertising promotional and marketing materials; souvenirs and mementos; books, magazines, programmes, leaflets and newsletters; stationery of all types; photographs; posters; tickets.</p> <p><b>Class 25:</b> Sports promotional and casual clothing of all types; headgear and footwear of all types.</p> <p><b>Class 35:</b> Advertisement promotion and marketing of sporting events, programmes and activities by printed matter, banners, television, radio, the Internet and similar media; production and</p>	<p><b>Class 25</b> –Articles of clothing; footwear; headgear.</p> <p><b>Class 35</b> - Advertising services; marketing, developing and managing Internet advertising campaigns; gathering information for the development of new websites; business information services provided on-line from a computer database, the Internet, intranets or extranets; search engine marketing services, search engine optimisation services, search engine submission services.</p>

<p>management of television and radio advertisements; agency and business management services for sporting and entertainment clients; retail services connected with the sale of sports promotional and casual clothing, headgear, footwear, stationery, books, magazines, programmes, tickets, photographs, posters, leaflets and newsletters, souvenirs, mementos and memorabilia.</p> <p><b>Class 41:</b> Provision of training for sports and general entertainment purposes; provision of sporting and cultural activities and entertainment; provision and operation of fan clubs; provision of electronic games and publications including through the Internet.</p> <p><b>Class 42:</b> Design and development of computer software and web sites; creation and maintenance of websites and web pages on the Internet.</p>	<p><b>Class 41</b> – Publishing on the Internet, intranets or extranets; providing on-line electronic publication.</p> <p><b>Class 42</b> – Computer services; design services; illustration services; computer software design and web design; creating and maintaining websites; compilation of web pages on the Internet; artwork, typography, prints, publication and pre-press design services.</p>
--	--

29. As QR's trade mark No. 2410709 is only registered for goods in class 25 (goods which are also contained in trade mark No. 2486784), it is only necessary for me to refer to this latter trade mark when conducting the comparison.

30. The leading authorities on how to determine similarity between goods and services are considered to be the *Canon* case (supra) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
  - (b) The respective users of the respective goods or services;
  - (c) The physical nature of the goods or acts of service;
  - (d) The respective trade channels through which the goods or services reach the market.
  - (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
  - (f) The extent to which the respective goods or services are competitive.
- This inquiry may take into account how those in trade classify goods,

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

31. Insofar as complementary goods and services are concerned, I must keep in mind the comments of the Court of First Instance (now the General Court) in Case T-420/03 *El Corte Inglés, SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) - José Matías Abril Sánchez and Pedro Ricote Saugar*. The Court said:

“98....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 (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 35).”

32. In reaching a conclusion on the degree of similarity, I will also bear in mind the comments of Jacob J (as he then was) in *Avnet Incorporated v Isoact Ltd*, [1998] FSR 16 when he said:

"... definitions of services ..... are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes".

In my view, 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."

## **Class 16**

33. Having applied the appropriate guidance there is, in my view, no similarity between the goods in LMG's application in class 16 and any of the goods and services in QR's registration. In reaching this conclusion I have not overlooked the fact that LMG's application in this class includes a reference to "Advertising promotional and marketing materials" and QR's registration in class 35 is in respect of, inter alia, advertising and marketing services. However, while one may argue that the uses and users of the respective goods and services are the same, they are, in my view, likely to be supplied by different suppliers, through different trade channels and are neither competitive with one another nor complementary in the sense described in paragraph 31.

## **Class 25**

34. QR's registration consists of articles of clothing, footwear and headgear at large which would include all of the goods in this class contained in LMG's application for registration. The goods in class 25 are therefore identical.

## **Class 35**

35. QR's registration contains, inter alia, a range of advertising and marketing services. These services are, in my view, the same or highly similar to the following services in LMG's application for registration:

“Advertisement promotion and marketing of sporting events, programmes and activities by printed matter, banners, television, radio, the Internet and similar media; production and management of television and radio advertisements.”

36. Insofar as the retail services contained in LMG's application are concerned, I note the comments of the Court of First Instance (now the General Court) in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06. In that case the conflict was between an earlier mark which was registered for goods in classes 18 and 25 and a later mark which had been registered for “Retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets’. The General Court upheld OHIM's decision that the goods in classes 18 and 25 were similar to “retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets” as there was a complementary relationship between the retail of the goods and the goods themselves. The Court said:

“54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau-und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade 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. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

37. Based on the decision in *Oakley*, I conclude that the retail services connected with the sale of sports promotional and casual clothing, headgear and footwear in LMG's

application are similar to the goods in class 25 of QR's registration. However, I can see no such similarity between any of the goods and services contained in QR's registration and the following services in LMG's application:

“Retail services connected with the sale of stationery, books, magazines, programmes, tickets, photographs, posters, leaflets and newsletters, souvenirs, mementos and memorabilia.”

38. Finally, and keeping in mind the guidance provided by Jacob J in *Avnet*, I can find no meaningful relationship between the remaining services in LMG's application i.e. “agency and business management services for sporting and entertainment clients” and any of the goods and services in QR's registration.

#### **Class 41**

39. QR's registration includes a reference to “providing on-line electronic publication” which I consider to be either the same or highly similar to “provision of publications including through the Internet” included in LMG's application. Having again applied the guidance in *Avnet* to the remaining services in LMG's application i.e. “provision of training for sports and general entertainment purposes; provision of sporting and cultural activities and entertainment; provision and operation of fan clubs; provision of electronic games including through the Internet”, I once again cannot find any meaningful relationship between the respective services.

#### **Class 42**

40. QR's registration in this class contains references to “computer software design and web design; creating and maintaining websites; compilation of web pages on the internet, which would include all the services contained in LMG's application in this class. The services are therefore identical.

41. In summary, having compared the goods and services in LMG's application with the goods and services in QR's registration I have concluded that:

**Class 16:** No similarity exists.

**Class 25:** The goods are identical to those in Class 25 of QR's registration.

#### **Class 35:**

The following services are the same or highly similar to the advertising and marketing services included in class 35 of QR's registration:

“Advertisement promotion and marketing of sporting events, programmes and activities by printed matter, banners, television, radio, the Internet and similar media; production and management of television and radio advertisements.”

The following services are similar to the goods in class 25 of QR's registration:

"Retail services connected with the sale of sports promotional and casual clothing, headgear and footwear."

No similarity exists with the following services:

"Retail services connected with the sale of stationery, books, magazines, programmes, tickets, photographs, posters, leaflets and newsletters, souvenirs, mementos and memorabilia."

"Agency and business management services for sporting and entertainment clients."

**Class 41:**

The following services are the same or highly similar to the providing on-line electronic publication services included in class 41 of QR's registration:

"Provision of publications including through the Internet."


No similarity exists with the following services:

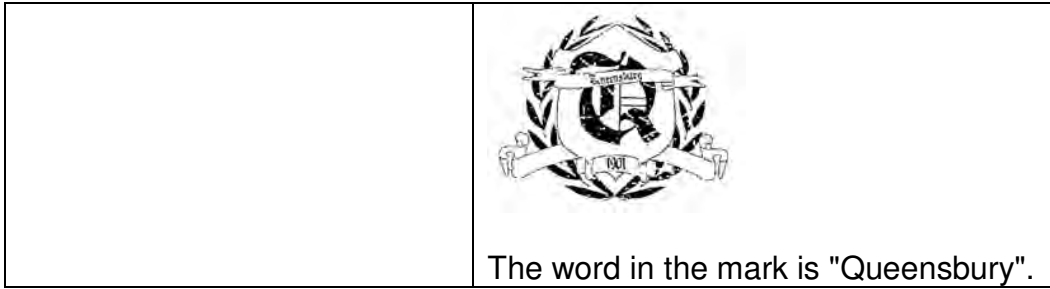
"Provision of training for sports and general entertainment purposes; provision of sporting and cultural activities and entertainment; provision and operation of fan clubs; provision of electronic games including through the Internet."

**Class 42:** The services are identical to those contained in class 42 of QR's registration.

**Comparison of trade marks**

42. For the sake of convenience, the trade marks to be compared are as follows:

LMG's trade mark	QR's trade marks
	QUEENSBERRY Queensberry queensberry (Series of 3)



43. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and with that conclusion in mind, I must, as the case law dictates, then go on to compare the respective trade marks from the visual, aural and conceptual perspectives.

44. In these proceedings QR are relying on the two trade marks shown above. Earlier in this decision when conducting the comparison of goods and services, I noted that trade mark No. 2410709 i.e. the composite trade mark consisted only of goods in class 25, and as a result I conducted the comparison solely on the basis of the goods and services contained in trade mark No. 2486784 i.e. the word only versions of the trade mark. In my view the word only trade marks provides QR with their best prospect of success. If they do not succeed in relation to these trade marks they will, in my view, be in no better position in relation to their other registration which consists of a stylised letter Q, the word Queensbury, the numerals 1901 and additional graphical elements.

45. QR's word only registration consists of a series of three trade marks i.e. the word QUEENSBERRY presented as a single word in upper, lower and title case. For the sake of convenience when conducting the comparison I will refer to the version of the trade mark presented in upper case. However, as the trade marks have been accepted as a series under section 41 of the Act i.e. they are considered to resemble each other as to their material particulars, any conclusion I reach in relation to this version of the trade mark will apply equally to the other versions of the trade mark in the series.

46. LMG's application also consists of the word QUEENSBERRY presented as a single word in upper case but is accompanied by the numerals 1867 and the word BOXING presented in upper case in which the letters B and G are enlarged to what appears to me to be twice the size of the other letters in the word. The three elements are contained within a rectangular border. I note that in their counterstatement LMG say:

"You could say that BOXING is actually more prominent than QUEENSBERRY within the image."



47. Consisting as it does of a word only trade mark presented as a single word, QR's QUEENSBERRY trade mark cannot, in my view, be said to have a distinctive or dominant component. Rather, the distinctive character of the trade mark resides in its totality. I noted above that in their Notice of opposition QR said:

“[The application in suit] is essentially in its dominant and distinctive features the word QUEENSBERRY..”

48. I share QR's views in this regard. The first element of LMG's trade mark is the word QUEENSBERRY which whilst it may (when used together with other words) have a historic connection to the sport of boxing (see paragraph 5 above), has as far as I am aware when used alone no specific meaning for the goods and services for which registration is being sought (I shall return to this point later when I consider the distinctive character of QR's trade mark.) The numerals 1867 (apparently the year in which the code was published) and the word BOXING are not, in my view, either distinctive or dominant elements of LMG's trade mark. They are, I think, more likely to be taken by the average consumer as a reference to, for example, the year in which the undertaking concerned was formed and the area of trade in which they operate. As a consequence of those conclusions, it is the word QUEENSBERRY which is, in my view, the distinctive and dominant component of LMG's trade mark.

49. The word QUEENSBERRY is the only element in QR's trade mark and is, in my view, the distinctive and dominant element in LMG's application. In that respect at least the respective trade marks are visually, aurally and (insofar as they may send a message) conceptually identical. However, when compared as totalities (and bearing in mind the descriptive/non-distinctive nature of the numerals 1867 and the word Boxing), the competing trade marks are, in my view, similar to a high degree.

### **Distinctive character of QR's earlier trade mark**

50. As QR have not provided any evidence of the use they may have made of their trade mark, I have only its inherent characteristics to consider. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

51. While none of QR's specifications are limited in any way, from the information available to me (see paragraph 8) it appears that QR's use of their trade mark will be in connection with the sport of boxing. While I noted above that in their counterstatement LMG comment on the use of the word in a historical context, I concluded that when

used alone it had no specific meaning for the goods and services for which LMG had applied.

52. I take a similar view in relation to the goods and services for which QR's trade mark is registered. In the absence of evidence to the contrary, QR's QUEENSBERRY trade mark is, in my view, possessed of a high level of inherent distinctive character.

### **Likelihood of confusion**

53. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also be mindful of the distinctive and dominant elements of the respective trade marks and assess the distinctive character of QR's trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also bear in mind the average consumer for the goods and services, the nature of the purchasing process and remember that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have retained in their mind.

54. Having done so, I have concluded that that if LMG's trade mark was to be used on goods and services which are the same or similar to those for which QR's trade mark is registered, direct confusion (where one trade mark is mistaken for the other) is likely to result. However, the same is not true where I have found no similarity of goods and services, as notwithstanding the high degree of similarity between the respective trade marks there must also be at least a minimum degree of similarity in the goods and services to engage the test for likelihood of confusion.

55. In summary, the application will be refused in respect of:

**Class 25:** Sports promotional and casual clothing of all types; headgear and footwear of all types.

**Class 35:** Advertisement promotion and marketing of sporting events, programmes and activities by printed matter, banners, television, radio, the Internet and similar media; production and management of television and radio advertisements; retail services connected with the sale of sports promotional and casual clothing, headgear, footwear.

**Class 41:** Provision of publications including through the Internet.

**Class 42:** Design and development of computer software and web sites; creation and maintenance of websites and web pages on the Internet

56. But may proceed to registration in respect of:

**Class 16:** Advertising promotional and marketing materials; souvenirs and mementos; books, magazines, programmes, leaflets and newsletters; stationery of all types; photographs; posters; tickets.

**Class 35:** Agency and business management services for sporting and entertainment clients; retail services connected with the sale of stationery, books, magazines, programmes, tickets, photographs, posters, leaflets and newsletters, souvenirs, mementos and memorabilia

**Class 41:** Provision of training for sports and general entertainment purposes; provision of sporting and cultural activities and entertainment; provision and operation of fan clubs; provision of electronic games including through the Internet.

### **Costs**

57. As both parties have achieved a measure of success each should bear their own costs.

**Dated this 22 day of June 2010**

**C J BOWEN  
For the Registrar  
The Comptroller-General**