

O-117-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2636275  
BY  
LIONS MMA  
TO REGISTER THE TRADE MARK**



**IN CLASS 41**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 40052  
BY  
LIONS GYM LTD**

## Background and pleadings

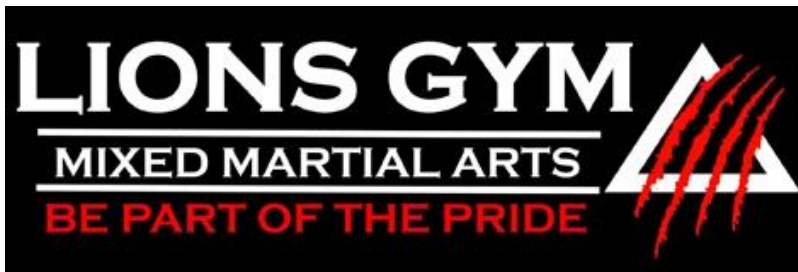
1. Lions MMA (“the applicant”) has applied to register the following trade mark in Class 41 for *Community, religious, sports and martial arts services*.



The application was filed on 25 September 2012 and was published for opposition purposes on 28 December 2012.

2. Lions Gym Ltd (“the opponent”) objects under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup> to the application achieving registration for community, sports and martial arts services (there is no objection to religious services) because it claims there would be a likelihood of confusion with the following services of its own trade mark registration:

2624554



Class 41: *Education; coaching and training in fitness and mixed martial arts; sporting and cultural activities.*

Filed 14 June 2012; registration procedure completed 14 December 2012.

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

“(2) A trade mark shall not be registered if because –

(a) ...

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<sup>1</sup> A pleading made under section 5(3) was later struck out because the opponent did not file evidence of its claimed reputation.

(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.”

4. Earlier trade marks are defined in section 6 of the Act:

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

(a) a registered trade mark, international trade mark (UK), 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,

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK),

(ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(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.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry.”

5. The trade mark upon which the opponent relies qualifies as an earlier mark because it was applied for before the applicant’s trade mark application was made.

6. The opponent claims that MMA is simply an abbreviated version of Mixed Martial Arts, words which form part of the opponent’s trade mark. The opponent refers to its

fight team being called Lions MMA and its domain names contain “Lions MMA”. The opponent states:

“Lions gym has been contacted on numerous occasions by customers mistaking Lions Gym – Mixed Martial Arts with their organisation. The situation is not ideal for either parties and is creating confusion with our customer and marketing campaigns.”

The opponent claims that the services are identical or similar, and that there would be a likelihood of confusion as a consequence.

7. The applicant filed a counterstatement in which it denies the opponent’s claims. It put the opponent to proof of its claims regarding the abbreviation, the name of the fight team, the domain names and the alleged actual confusion. The applicant states that it has no base in Coventry, where the opponent is based, and that, therefore, there is no confusion. The applicant states<sup>2</sup>:

“17. It is contented that the Applicant is a not-for-profit organisation bringing mixed martial arts, education, religious beliefs to the Sikh Community at Sikh Temples and has done so for a number of years and therefore the applicant already has an established reputation of its own..

18. It is contented [sic] that the “Lions MMA” logo does not represent the same specifications as the ‘Lions Gym Ltd’ logo: There is no comparable of colour or theme; the symbolism differentiates in all capacities and does not cause confusion in differentiating between the two logo’s. This is disputed on the grounds of the number of gym type businesses currently using the ‘Lions’ and ‘MMA’ and ‘Gym’ wording in todays commercial market. The opponent is to put to strict proof thereof.”

8. Both parties are self-represented. Both parties were given the choice of having a decision made from the papers, in which case time would be given for written submissions to be filed, or to have a decision made following a hearing. Neither party replied and no written submissions were filed in lieu of a hearing. I make this decision on the basis of the papers filed, which are the notice of opposition, the defence and counterstatement, and evidence filed by the applicant (the opponent did not file any evidence).

## **Evidence**

9. The applicant’s evidence comes from Rajdeep Singh, who states that he is a trustee of Lions MMA (UK), a registered charity (he exhibits the Charity Commission certificate at exhibit RS1). Mr Singh states that, in March 2010, he started to develop his idea of setting up a local organisation as a volunteer and that the name he chose was Lions MMA. The aim was to promote health and wellbeing through Martial Arts, Meditation and Yoga. Mr Singh states that he wished to focus on children from age 4 to 14 in the Sikh community, who sometimes suffer from social

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<sup>2</sup> Reproduced verbatim.

isolation; and to concentrate on 14 year olds up to adults, to promote health and wellbeing.

10. Mr Singh states that, by December 2010, he had created the logo and had 'established' the name Lions MMA. Exhibit RS2 is a print from Mr Singh's Facebook page which shows Lions MMA was present on the page on 9 December 2010. Exhibit RS3 is a copy of the constitution for Lions MMA which includes an aim to hold shows, to participate in local functions and activities, to encourage exhibitions of performances, an aim to encourage participants to learn about their heritage through education, music, dance and sports, and to showcase talent to the community. Mr Singh says that these aims are completely different to the opponent's aims because the opponent is working for profit, is not a charity and is not a community venture.

11. Mr Singh states that at the date of his witness statement (December 2013), the applicant has over 50 children and 30 adults participating each week. Mr Singh states that the children all recognise Lions MMA and wear the t-shirts, as members of a group. Mr Singh states that the applicant works with the community police force on a 'stranger danger' project. Education has been provided to older children about internet dangers. He states:

"Our project aim remains to bring children and adults together through sports and meditation. This is giving something back to the community in which we grew up in allowing our young children and adults to develop a happier, healthier profile..."

12. Exhibit RS6 is a copy of the certificate awarding to the applicant the Duke of York's Community Initiative award. Exhibit RS8 shows recent articles about the applicant. Exhibit RS9 is a "to whom it may concern" letter dated 7 August 2013 from a police officer, in relation to community collaboration with the local police.

13. Mr Singh states:

"There are thousands of organisations in the UK around the world who are called MMA as this a standard name for Mixed Marital Arts. The same could be used with regards to the word Karate as there are many Karate Gyms around the Country..."

## **Decision**

14. The earlier mark is not subject to the proof of use provisions because it had been registered for less than five years at the date on which the application was published<sup>3</sup>. This means that the opponent's mark must be considered upon the basis of notional and fair use for all the services upon which the opponent relies: *education; coaching and training in fitness and mixed martial arts; sporting and cultural activities.*

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

15. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(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*,

(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*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive

character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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*.

#### Average consumer and purchasing process

16. The assessment of the nature and purchasing behaviour of the average consumer is to be carried out according to the notional scope of the parties' specifications. The average consumer is a 'legal construct': it means the typical consumer<sup>4</sup>. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. In relation to both parties' specifications, the average consumer is the general public. Purchasing/choosing to use the parties' services will be primarily a visual encounter, although there is likely to be an aural aspect, particularly in relation to the applicant's 'community' services. On a notional basis, the services will be the subject of an average degree of attention; that is to say, not low and not high.

#### Comparison of services

17. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*. where the CJEU stated at paragraph 23 of its judgment:

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

18. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

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

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<sup>4</sup> As per the decision in the High Court: *Hearst Holdings Inc and another v A.V.E.L.A. Inc and others* [2014] EWHC 439(Ch), Birss J.

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

19. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

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

20. The table below sets out the parties’ competing specifications:

<b>Opponent</b>	<b>Applicant</b>
<i>Education; coaching and training in fitness and mixed martial arts; sporting and cultural activities.</i>	<i>Community, sports and martial arts services</i>

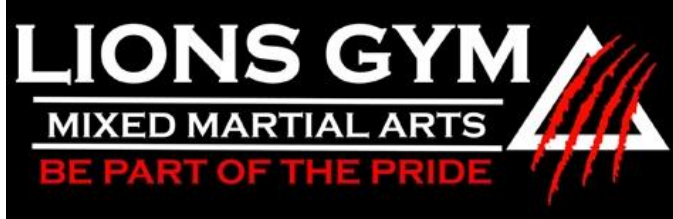

21. As per the judgment of the General Court of the European Union in *Gérard Meric v OHIM* Case T-133/05, goods and services can be considered as identical when the goods and services of the earlier mark are included in a more general category, included in the specification of the trade mark application. Vice versa, if the goods or services of the application are included in a more general category included in the specification of the earlier mark, they must be identical. Applying this to the parties’ specifications, the applicant’s term ‘martial arts services’ covers the opponent’s coaching and training in fitness and mixed martial arts: these services are therefore identical. The applicant’s ‘sports services’ are identical to the opponent’s sporting activities.

22. That leaves the applicant’s ‘community services’. This is a wide term which, as illustrated by the applicant’s own evidence, encompasses activities such as charity, sport, dance, education and entertainment. The opponent has cover for education, sporting and cultural activities which fall within the wider term community services. These services are identical.

### Comparison of trade marks

23. The marks to be compared are:



Opponent	Applicant
 <p>The logo for Lions Gym Mixed Martial Arts features the words "LIONS GYM" in large white letters, "MIXED MARTIAL ARTS" in smaller white letters below it, and "BE PART OF THE PRIDE" in red letters at the bottom. To the right is a white triangle with three red claw-like slashes.</p>	 <p>The logo for Lions MMA features a large orange lion's head in profile. Below it, the words "LIONS MMA" are written in orange. At the bottom, the text "MIXED MARTIAL ARTS - CONDITIONING &amp; TECHNIQUE" is written in orange, flanked by two small orange circular symbols.</p>

24. The authorities cited earlier in this decision direct that, in making a comparison between the marks, I must compare each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details, as per *Sabel BV v Puma AG*, paragraph 23:

“That 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 dominant and distinctive components.”

25. Both marks are complex, comprising a number of different elements. They both share the word LIONS and the words ‘Mixed Martial Arts’. The devices are clearly different and, apart from the common LIONS and Mixed Martial Arts wording, the other words are different. The Sikh emblem<sup>5</sup> appears only in the applicant’s mark, but it is very small proportionately, to the point of being almost negligible within the overall impact of the applicant’s mark. The marks will be read from the top so, in each case, the first word is LIONS. By virtue of its position and size in the opponent’s mark, the word LIONS is the most dominant of the elements making up the mark. In the applicant’s mark, despite the lion device being very prominent, the eye is naturally drawn to the word LIONS because (i) it is in the centre of the mark and is proportionately large in the mark; and (ii) there is a natural inclination to articulate words in trade marks. Different colour combinations are used in the marks. The applicant considers the different colour combinations to be an important differentiating factor. I would observe that most trade marks inhabit a coloured world and the average consumer is used to coloured words and devices. Whilst the colours play a part in creating points of difference between the marks, such as highlighting the claw-like slashes in the earlier mark, and creating the contrast necessary to see the elements of the applicant’s mark, the differences in colour are not overwhelming in the overall impression of the marks, when all the other elements are factored into the visual comparison. Putting together the points of similarity and difference, the degree of visual similarity is at a moderate level.

26. The devices will not figure in articulation of the marks. There is some similarity in rhythm between the marks: both marks start with LIONS; then another word

<sup>5</sup> The applicant has referred to the emblem in its evidence as a Sikh emblem.

(GYM/MMA); next both marks contain Mixed Martial Arts; and then each mark ends with a further combination of words (Be Part of the Pride/Conditioning and technique). Weighing up the similar words with those which are absent from each mark and, bearing in mind that both marks start with the word LIONS, there is a reasonable degree of aural similarity between the marks.

27. The marks share the concept of LIONS, most obviously because of the prominent word LIONS in each mark. This is a particularly strong concept in the applicant's mark because the lion device reinforces the word LIONS. The opponent's device is more abstract, with the red slashes across the triangle reminiscent of claw marks. The words Be Part of the Pride in the opponent's mark also reinforce the 'lion' message. The two marks clearly share the Mixed Martial Arts message because these words are present in each mark. There are therefore two identical concepts shared by the marks: LIONS and Mixed Martial Arts. The letters MMA are absent from the opponent's mark. In the applicant's mark, it is possible that the letters MMA may be seen as an abbreviation for Mixed Martial Arts, by virtue of the words Mixed Martial Arts immediately following the letters. This point is illustrated in the following section of the Trade Mark Registry's Examination Guide:

**“2.4 Two, Three (or more) letters presented as a descriptive abbreviation**

The distinctive character of a mark must be assessed by reference to the mark as a whole. Accordingly, marks which include the name of a class of the goods/services in combination with letters which are made up of the initial letter of each such word, may be devoid of any distinctive character even if the combination of letters is not a known abbreviation for the words.

For example, "M.G.S. MISSILE GUIDANCE SYSTEM" has no distinctive character for electronic guidance systems. If it is not a known abbreviation, it may be the public would not penetrate the meaning of M.G.S. alone, but once combined with words describing the goods in question, *the letters become no more than an abbreviation for the type of technical goods at issue.*"

28. The opponent's mark contains the word GYM which is absent from the applicant's mark. However, there is a clear message of gym-like activities in the applicant's mark because of the words 'Conditioning & Technique', and 'Mixed Martial Arts'. Whilst not as obvious as the lion and martial arts concepts, the gym/exercise message is also present in both marks. Overall, there is a strong degree of conceptual similarity between the marks.

29. Bringing together the visual, aural and conceptual comparisons, the marks are similar to a good degree.

Distinctiveness of the earlier mark

30. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>6</sup> the CJEU stated that:

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<sup>6</sup> Case C-342/97

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

31. The opponent has not filed any evidence to show that it has used its mark, so I have only the inherent position to consider. Whilst the words Mixed Martial Arts and Gym are descriptive in relation to the opponent’s services, the mark as a whole must be considered. Apart from the words Mixed Martial Arts and Gym, there is nothing descriptive or allusive in the earlier mark when considered in relation to the services relied upon. The earlier mark, as a whole, has a good level of inherent distinctive character.

#### Likelihood of confusion

32. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. This is particularly relevant in relation to the applicant’s submission that the marks can be distinguished by virtue of matters such as the different fonts used, the different shaped rectangular backgrounds and the two horizontal lines in the opponent’s mark. I also keep in mind the principle of interdependency, whereby a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). In these proceedings, I have found that the parties’ services are identical and that there is a good degree of similarity between the marks; in particular, a strong degree of conceptual similarity.

33. A factor which I should consider is the ‘beginnings of marks’ rule of thumb, which allows for the propensity of the average consumer to notice, particularly, the beginnings of marks because that is what is seen or heard first. It is a rule of thumb, and it does not always follow, but, in the current case, the position of LIONS, which is distinctive, as the first component of each mark is important.

34. I bear in mind that the assessment means that I should not simply take just this component of the applicant's mark and compare it with the opponent's mark. It is an assessment of the whole mark. In the present case, the memory hooks for recollection of the marks by the average consumer will be, in both cases, the LION and Mixed Martial Arts concepts. The letters MMA are likely to be seen as the abbreviation for the words. This is the context in which the mark will be encountered: in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24; [2012] FSR 19, Kitchin LJ said (§ 87):

"In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer's mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context."

So, the letters MMA, while absent from the opponent's mark, are not a strong point of difference between the marks because they will have descriptive significance and, therefore, less weight as a distinguisher of trade origin. The applicant itself submits:

"There are thousands of organisations in the UK around the world who are called MMA as this a standard name for Mixed Martial Arts."

Likewise, the word Gym, not present in the applicant's mark, has clear descriptiveness for the services relied upon and is not a strong point of difference between the marks.

35. I do not think that the marks will be directly mistaken for each other. The average consumer will notice that there is a difference between the marks and so will not imperfectly recall them. However, in my view, the average consumer is likely to put the similarities between the marks, particularly the strong conceptual similarity, for identical services, down to the marks being another brand of the same undertaking or a linked undertaking. This means that there is a likelihood of confusion ('indirect confusion', as per point (l) in the case law summary cited at paragraph 14 of this decision).

36. In its counterstatement, the applicant denies confusion because of the number of gym businesses currently using 'Lions', 'MMA and 'Gym' wording in the commercial market. There is no evidence to show me that this is the case, especially in relation to 'Lions'. Even if the applicant had provided evidence, it would be unlikely to assist its case. There must be evidence to suggest that the relevant public has shown that it distinguishes between the various providers' goods and services. Lack of evidence of confusion does not mean that there has been no confusion<sup>7</sup>. Additionally, as shown in this case, sports services are often provided in a confined locality. The businesses are not confused because they do not bump up

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<sup>7</sup> The notice of opposition states that there has been confusion, but the opponent has not substantiated this claim.

against each other in the marketplace. The applicant itself states that it has no base in Coventry. Applying for a trade mark upsets the status quo: a trade mark registration is a national right, granting rights throughout the UK. It cannot help the applicant to claim that it has no business base in Coventry because, by making a trade mark application, it seeks a national right.

37. It also does not help the applicant that it has been using its mark for two years prior to making the application. A similar argument was made in *Ion Associates Ltd v Philip Stainton and Another*<sup>8</sup>, where the applicant, facing an opposition under section 5(2)(b) (as here), considered that its unregistered rights ought to mean that it had the right to register its mark. The Appointed Person, Ms Anna Carboni said:

“Even if the evidence were sufficient to establish the existence of an earlier right within a locality, of the sort recognised under article 6(2), that provision is about the owner of such a right being able to continue using it notwithstanding the registration of a national trade mark by a third party. As implemented in the Act, section 11(3) could be relied on to defend an action for infringement of a UK trade mark if, say, the defendant owned a local passing off right. I agree with the hearing officer that there is nothing in either article 6(2) (or, I would add, section 11(3)) to assist the Applicant in the second step of the argument to the effect that the owner of such a locally based right should itself be entitled to register the mark underlying its earlier right.”

38. There is no automatic entitlement to a registration simply because a mark has been used. An opposition raised under Section 5(2) operates on the basis of the ‘first to file’ UK trade mark registration system. Ms Carboni’s decision was referred to in the Registrar’s Tribunal Practice Notice 4/2009:

**“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark**

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. 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.”

39. The test in this case is whether there is a likelihood of confusion ‘notionally’, i.e. whether all the factors I have discussed throughout this decision combine to lead to

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<sup>8</sup> BL O/211/09.

a conclusion that there is, or is not, a likelihood of confusion, on the part of the average consumer, between the marks. The average consumer is likely to believe that the services derive from providers which are linked economically. **There is a likelihood of confusion.**

### **Outcome**

**40. The opposition succeeds in full. The application is refused except for religious services, against which there is no opposition. The application may proceed to registration for 'religious services'.**

### **Costs**

41. The opponent has been successful and is entitled to a contribution towards its costs. The Registrar normally awards costs according to the published scale in Tribunal Practice Notice 4/2007. The only documentation filed by the opponent was its notice of opposition. It is entitled to the fee for this (£200). In relation to the costs of compiling the content of the notice of opposition and considering the counterstatement, it is appropriate to award half of what would have been awarded had the opponent had legal representation. Therefore, the amount I will award for this work is £100. This makes a total award of £300.

42. I order Lions MMA to pay Lions Gym Ltd the sum of £300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12<sup>th</sup> day of March 2014**

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