

O-098-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2556387
BY STEVEN GRYGELKO
TO REGISTER THE TRADE MARK
TRANNYSHACK
IN CLASS 41
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER Nos. 101488 BY
Mr WALT UTZ**

BACKGROUND

1) On 20 August 2011, Steven Grygelko (hereinafter the applicant) applied to register the trade mark TRANNYSHACK in respect of the following services:

Class 41: Entertainment services; staging of shows and revues; theatrical services; arrangement, organisation and performance of stage acts and shows; live performances.

2) The application was examined and accepted, and subsequently published for opposition purposes on 3 December 2010 in Trade Marks Journal No.6864.

3) On 28 January 2011 Mr Walt Utz (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates	Class	Specification
TRANNYSHACK	2510775	11.03.09 12.06.09	41	Services providing entertainment in the form of live musical performances; services providing entertainment in the form of recorded music; organisation of musical entertainment; organisation of pop music concerts; club [discotheque] services; club entertainment services.

- a) The opponent contends that its mark and the mark applied for are similar. It also contends that the services for which its mark is registered are identical and/or similar to the services applied for. The application therefore offends against Section 5(2)(b) of the Act.
- b) The opposition also included grounds of opposition under sections 3(6), 5(3) and 5(4)(a). However, in the absence of any evidence these grounds must fail.

4) On 12 April 2011 the applicant filed a counterstatement, basically stating that as the originator of the mark the applicant had the right to use it and that the earlier right was obtained in bad faith.

5) Neither side filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard nor did they provide written submissions.

DECISION

6) The only ground of opposition is under section 5(2)(b) which reads:

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

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

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

7) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

8) The opponent is relying upon its trade mark listed in paragraph 3 above, which is clearly an earlier mark.

9) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *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.

(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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

10) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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 parties were agreed that 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

11) The services of the two parties are, broadly speaking, offering entertainment services, staging of shows and concerts and theatrical services. These services would be offered to the general public who wish to see a live performance as well as businesses including performers who require theatrical services such as booking entertainers. Therefore, the average consumer for both sides' services would be the general public in the UK including businesses. The types of services on offer are likely, to my mind, to be initially chosen by reference to advertising either in print or on the internet. In either event the initial selection would be by eye although aural similarity must be considered as word of mouth recommendations may come into play. Whilst those in business may be more discerning over choosing whose hands they put their businesses or careers into, the general public seeking to attend a performance will pay little attention as to who offers the entertainment, concentrating more on the entertainment on offer. **I therefore conclude that the degree of attention paid by the average consumer would vary according to the type of purchase. Fairly low in the case of a member of the general public, higher in respect of a business purchase, where the services are being commissioned.**

Comparison of services

12) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

13) 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.

14) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

15) The services of the two parties are:

Applicant's services	Opponent's services
Class 41: Entertainment services; staging of shows and revues; theatrical services; arrangement, organisation and performance of stage acts and shows; live performances.	Class 41: Services providing entertainment in the form of live musical performances; services providing entertainment in the form of recorded music; organisation of musical entertainment; organisation of pop music concerts; club [discotheque] services; club entertainment services.

16) Whilst the applicant's services are theatrical in nature, and the opponent's services are geared to music and disco there are a number of crossovers. They are all entertainment based, the users are likely to be similar if not identical, as are the trade channels, and they are likely to be in competition. All the terms included in the applicant's services could encompass the services offered by the opponent. To my mind it is obvious that the services of both sides are identical or at least similar to a medium degree.

Comparison of trade marks

17) The marks of the two parties are identical.

Distinctive character of the earlier trade mark

18) 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 (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).”

19) The opponent's mark is a made up word which does not appear to have any meaning linked to the services it offers and must be regarded as a **having a high degree of inherent distinctiveness but it cannot benefit from enhanced distinctiveness as the opponent has not shown that it has a significant reputation in the UK.**

Likelihood of confusion

20) 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' trade marks as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the services by predominantly visual means and who will pay a low to high degree of care when doing so.
- The services are identical or similar to at least a medium degree.
- The marks are identical.
- the opponent's earlier trade mark has a high level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness.

21) In view of the above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the services provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in full.**

CONCLUSION & COSTS

22) As the opponent has succeeded in full it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Expenses	£200
TOTAL	£400

23) I order Steven Grygelko to pay Mr Walt Utz the sum of £400. This sum 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 25TH day of February 2016

**George W Salthouse
For the Registrar,
the Comptroller-General**