

O-217-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3164426

BY NSU MEDIA LTD

TO REGISTER THE TRADE MARK

NSU Media

IN CLASSES 35 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 407142

BY AEN MEDIA GROUP LIMITED

BACKGROUND

1. On 15 May 2016 NSU Media Ltd (“the applicant”) applied to register the mark shown on the cover page of this decision in respect of the following services:

Class 35: Business management, business administration, office functions.

Class 41: Providing of training.

2. The application was published for opposition purposes on 10 June 2016. On 10 August 2016 Aen Media Group Limited (“the opponent”) filed a notice of opposition. The opposition is brought on grounds under section 5(2)(b) of the Trade Marks Act (“the Act”) and it is directed against all of services in the application. The opponent relies upon its European Union Trade Mark (EUTM) application number 15742001 for the mark MEDIA.COM which was filed on 10 August 2016 and claims a priority date of 11 April 2016 on the basis of five trade mark applications filed in Pakistan under numbers 416344, 416345, 416347, 416349, 416342. Certified copies of the priority documents were filed together with the notice of opposition which substantiate this claim. The opponent relies upon all of the services in its application, namely:

Class 9: Computer hardware; computer software; computer peripherals; electronic data processing installations; computer network apparatus; parts and fittings for all the aforesaid goods.

Class 16: Printed publications, books, music sheets, music scores, magazines; printed matter; photographs; stationery.

Class 25: Clothing; fashion garments; footwear and headgear; swimwear; sportswear and leisurewear.

Class 38: Television, cable television and radio broadcasting services.

Class 41: Education; production and distribution of television shows and movies; services related to exhibitions, shows and fairs, organization and preparation in the field of fashion, culture and entertainment, music publishing services.

3. The opponent argues that the respective marks are similar and that the respective goods and services are identical or similar.

4. The applicant filed a counterstatement in which it admits that the respective services in class 41 are similar but denies that the marks are similar and that there exists a likelihood of confusion.

5. Only the opponent filed written submissions during the evidence rounds. Neither party asked to be heard but they both filed written submissions in lieu of attendance at the hearing.

DECISION

6. Section 5(2)(b) of the Act reads:

“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.”

7. At the time of writing the right relied upon by the opponent is still a pending application. Section 6(1) of the Act is therefore relevant. It reads:

“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.”

(b)

(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.”

8. It follows that application number EUTM 15742001 is an earlier mark by virtue of the priority claimed and can be relied upon in these proceedings.

Section 5(2)(b) - case-law

9. The following principles 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 greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

10. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

11. 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.

12. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

13. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

14. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated 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 activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

15. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), [2013] E.T.M.R. 33, Floyd J (as he then was) held:

“12 ... 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 *The Chartered Institute of Patent Attorneys (Trade Marks) (IPTRANSLATOR)* (C-307/10) [2012] E.T.M.R 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.”

16. It should also be noted that, as per the judgment of the GC in *Gérard Meric v OHIM*, case T-133/05, goods and services can be considered identical when the goods and services of the earlier mark are included in a more general category, included in the specification of the application and vice versa.

Class 41

17. The opponent’s “education” is encompassed by the applied for “providing of training”. Applying the guidance in *Meric* the services are identical. Even if providing of training is not identical to education, they are, at least, highly similar and the applicant itself admits that there is a degree of similarity.

Class 35

18. In its notice of opposition, the opponent directs its objection to all of the services in the application, however, it does not provide any reason as to why it considers the applied for services in class 35 to be similar to any of its goods and services. In response to the applicant’s criticisms on the point, the opponent simply argues that the applicant has provided no argument or evidence to substantiate its claim that there is no similarity in respect of these services. Further, it says that the distribution channel must be considered.

19. Where the similarity between the respective goods or services is not self-evident, the evidential burden is on the opponent to show how and in which respects, they are similar¹. That said, in the absence of any specific submissions from the opponent

¹ See *Raleigh International trade mark* [2001] R.P.C. 11 at paragraph 20 and *Commercy AG, v OHIM*, Case T-316/07, paragraph 43.

as to how and why the applied for services in class 35 are similar to any of its goods and services, I must reach a conclusion on the basis of the criteria set out by the relevant case-law. The applied for services in class 35 are services provided by specialist companies to other businesses. In particular, business management services are provided in order to improve the performance of a business and business administration services (and office functions) are performed in order to organise and run a business. The applicant's services in class 35 and the opponent's goods and services in classes 16, 25, 38 and 41 are different in nature and purpose, are not complementary or in competition and it seems to me, do not reach consumers through the same trade channels. The fact that some of the opponent's goods and services in classes 16 and 41, e.g. stationery, education, may also be purchased by the same businesses that use the applied for services in class 35 is not sufficient in itself, for a finding of similarity. Insofar as the opponent's specification in class 9 is concerned, whilst it encompasses (in particular) software of all kind, business software solutions are likely to be customised and developed to meet the needs of a specific business and are, therefore, different from off-the-shelf software which is covered by the opponent's specification; consequently the respective goods and services are not in competition since the opponent's software could not be an alternative to the business management and administration services provided by the applicant. Further, the fact that the applied for services may use business applications, does not create a complementary relationship in the sense required by the case-law². Finally, there is no evidence that companies providing business management and administration services also manufacture computer software. In the absence of any evidence or submission to the contrary, I cannot see any self-evident similarity between the applied for services in class 35 and any of the opponent's goods and services. Hence, I conclude that there is no similarity between the opponent's goods and services and the following:

Class 35: Business management, business administration, office functions.

² Case T-450/11, *Galileo International Technology LLC v OHIM* where the GC stated "67 ... to acknowledge similarity in all cases in which the earlier right covers computers and where the services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark ...68 ... The goods and services covered by the two marks may be complementary only if they are indispensable or important for the use of each other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services. "

20. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

Consequently, as there is no similarity between the respective goods and services, there can be no likelihood of confusion. The opposition to the applied for services in class 35 fails accordingly.

The average consumer and the nature of the purchasing act

21. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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.”

22. The average consumer of the parties' educational and training services in class 41 is the general public, although the services could also be sought by business users with training or educational requirements. The level of care and attention will be slightly above average, as the services will be selected to fit the requirements of the recipient. The purchasing process will often be primarily visual with the services being selected from, inter alia, brochures and the like and also websites, however, I do not ignore that the selection may involve word-of-mouth recommendations and bookings by telephone where aural considerations will play a part.

Comparison of marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

24. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, (which are not negligible) and therefore contribute to the overall impressions created by them.

25. The marks to be compared are:

| Opponent's mark | Applicant's mark |
|-----------------|------------------|
| MEDIA.COM | NSU Media |

26. The opponent's mark consists of the word MEDIA joined to the top level domain .COM. The mark is likely to be taken as an Internet address. Although the component .COM contributes to the overall impression conveyed by the mark, given its nature, it is endowed with only a low degree of distinctive character. Consequently, the word MEDIA is the most distinctive and dominant component of the mark.

27. The applicant's mark consists of the words NSU Media. The opponent argues that the component NSU is non-distinctive because it has no meaning and it does not alter the meaning of the word Media. Contrary to what the opponent asserts, the fact that NSU appears to be a meaningless combination of three letters, results in that component being inherently highly distinctive. Insofar as the word Media is concerned, it is a dictionary word and there is nothing unusual about it; further, since it is placed after the component NSU, it will be perceived as being qualified by that component. Accordingly, although the component Media is not negligible, I consider that, due to its inherent distinctiveness and positioning at the beginning of the mark³, it is the sequence NSU that plays the greatest role in the overall impression.

Visual and aural similarity

28. The marks are of different length and coincide in the element MEDIA/Media, which is placed in different sides of the words. In my view, the marks are visually and aurally similar to a low degree.

³ Joint cases T-183/02 and T-184/027, *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, paragraph 81

Conceptual similarity

29. I have no submissions from the parties on how the component NSU is likely to be perceived in the applied for mark. Insofar as the word MEDIA/Media is concerned, both parties refer to the dictionary definition of it as “means of communication such as television, radio and newspapers”. In particular, the opponent states that this is the meaning that will be attributed to the component MEDIA/Media in both marks.

30. The applicant states that MEDIA.COM is likely to be perceived as indicating that the goods and services offered under the mark “are provided via different media available on the internet”, a statement that is not challenged by the opponent.

31. The significance of the respective marks must be considered in relation to the services which I have found to be identical and to which I will limit my consideration. I agree with the applicant that MEDIA.COM is likely to be perceived, in the earlier mark, as a website where the services are offered. Moving on to the applied for mark, the sequence NSU has no meaning and, in my view, it is likely to be perceived as an abbreviation which identifies the company who provides the services. Insofar as the component MEDIA/Media is concerned, I agree with the opponent that it will be seen, in both marks, as a reference to a mean of communication and/or to “the media”.

32. The fact that the shared component, i.e. MEDIA/Media, is likely to be perceived, in both marks, in the same manner, does not necessarily create a significant conceptual similarity. This is because, in the context of educational and training services, the word MEDIA/Media is likely to be seen as a reference to the subject matter of the education and training services, i.e. media studies, media training, and is, therefore, of weak distinctive character. Further, taking into account the more precise meaning of the earlier mark as an Internet address and the fact that NSU is the most distinctive component of the applied for mark, I conclude that if there is any conceptual similarity between the marks it must be of a low degree.

Distinctive character of the earlier trade mark

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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).”

34. The earlier mark is, at the time of writing, an application. However, the present case is not concerned with the registrability or otherwise of the earlier mark and I will proceed on the basis that the mark must be assumed to have a degree of distinctiveness⁴. I have already found that MEDIA.COM is likely to be perceived as a website where the services are offered and that in the context of the services which I found to be identical, the word MEDIA is of weak distinctive character. Consequently, the mark has a below average degree of distinctive character.

⁴ *Formula One Licensing BV v OHIM*, Case C-196/11P

Likelihood of confusion

35. 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 marks may be offset by a greater degree of similarity between the respective services and vice versa. 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 marks and must instead rely upon the imperfect picture of them he has retained in his mind.

36. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and/or services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

37. I make my assessment on the basis that the contested services in class 41 are identical to the opponent’s services in the same class. This is an important factor weighing in the opponent’s favour. I have also found that the degree of attention paid by the consumer during the purchase is likely to be slightly above average, a factor which is likely to militate against imperfect recollection. Considering that the services will be selected primarily by the eye, the differences between the two marks stand out sufficiently enough that, even where identical services are involved, the average consumer will not directly confuse them.

38. In terms of indirect confusion, the shared component, i.e. Media, is qualified, in the applied for mark, by the distinctive and dominant element NSU. In those circumstances, I consider that the component Media will not be seen as identifying the commercial source or origin of the services and I conclude that there is no likelihood of indirect confusion. **The opposition fails.**

CONCLUSION

39. The opposition has failed.

Costs

40. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (TPN 2/2016). The applicant requests that it be awarded costs above the scale because, it submits, the opposition is unreasonable. In particular, it states, that since “the opponent’s mark is entirely descriptive/non-distinctive and does not function as a badge of origin” it is unlikely that the opposition was brought with a belief that it had a solid base. The Office’s practice is to award costs based on a published scale, but as the published Manual of Trade Mark Practice makes clear, awards may be made above or below scale costs where the circumstances justify it; further, the fact that a party has lost is not indicative, in itself, of unreasonable behaviour⁵. The applicant’s request rests on an assumption that the opponent’s mark is objectionable on absolute grounds. However, I note, the application relied upon in these proceedings is still at the examination stage and I cannot see anything in the opponent’s conduct which would warrant an award of costs above the scale. In approaching the award, I note that the applicant has been professionally represented and that it was a relatively uncomplicated opposition based only on one ground. Accordingly, I award costs to the applicant on the following basis:

| | |
|---|-------------|
| Preparing a statement and considering the other side’s statement: | £200 |
| Considering the other side submissions: | £200 |
| Preparing and considering written submissions: | £200 |
| Total: | £600 |

⁵ See paragraph 5.6 of the Tribunal section of the Manual of Trade Mark Practice

41. I order Aen Media Group Limited to pay NSU Media Ltd the sum of £600 as a contribution towards its costs. This sum is 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 8TH day of May 2017

Teresa Perks

For the Registrar

The Comptroller – General