

O/017/18

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3173472  
BY BATTLEZONE PAINTBALL LIMITED  
TO REGISTER THE TRADE MARK**

**TOPGEAR KARTING**

**IN CLASS 41**

**AND**

**THE OPPOSITION THERETO UNDER NO. 407920  
BY THE BRITISH BROADCASTING CORPORATION**

## **BACKGROUND AND PLEADINGS**

1. Battlezone Paintball Limited ("the Applicant") applied on 7 July 2016 to register the words "TOPGEAR KARTING" as a UK Trade Mark for the following services in class 41:

*Organizing of sports events in the field of karting; Organizing of sports competitions, namely karting races; Providing training and education in the field of karting; Entertainment services provided at a motor racing circuit; Organisation of automobile racing events; Organisation of vehicle racing events; Party planning [entertainment].*

2. The application was published for opposition purposes in the Trade Marks Journal on 19 August 2016. It is opposed by The British Broadcasting Corporation ("the Opponent"), relying on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"), each ground opposing the entirety of the application.

### The section 5(2)(b) claim

3. For its section 5(2)(b) claim, the Opponent relies on its ownership of the following registrations protecting its trade mark "TOP GEAR":

#### **Registration 1**

**EU Trade Mark No.** 001231661 for TOP GEAR in classes 9, 16, 28, 38 and 41

**Filing date:** 6 July 1999

**Registration Date:** 20 March 2002

#### **Registration 2**

**UK Trade Mark No.** 1525433 for TOP GEAR in classes 16 and 41

**Filing date:** 29 January 1993

**Registration Date:** 9 February 1996

#### **Registration 3**

**UK Trade Mark No.** 2408687 for TOP GEAR in classes 9, 16 and 41

**Filing date:** 9 December 2005

**Date of entry in register:** 02 June 2006

7. The Opponent relies for its section 5(2)(b) claim on all its goods and services under Registrations 1 – 3 above. Annex A at the end of this decision sets out a full list of the goods and services under Registrations 1 – 3, and a selection from those specifications is set out in this decision where I compare the parties' respective goods and services.

8. The Opponent's statement of grounds claims as follows:

**The Application Mark is highly similar to the Opponent's Mark. The distinctive and dominant element of the Application Mark lies solely in the element TOPGEAR, which is phonetically and visually identical to the Opponent's Mark. The Opponent's Mark is highly distinctive for the words TOP GEAR for which it is registered. In addition, the inclusion of the word KARTING as part of the Application Mark does not assist in distinguishing the marks and serves only to describe the services to be provided under the mark. The marks are therefore very closely similar conceptually. On this basis, the Application Mark will serve to designate the same source of commercial origin as the Opponent's Mark.**

9. The Opponent contends that the Applicant's services are identical or similar to the goods and services covered by the Opponent's Registrations in classes 9, 16, 28, 38 and 41. It claims that:

**The similarity between the Application Mark and the Opponent's Mark, the similarity of the services for which the Application has been filed with the goods and services covered by the Opponent's Registrations, and the high degree of inherent distinctive character enjoyed by the Opponent's Mark is such that there exists a significant risk of confusion with the Application Mark, including a likelihood of association, contrary to Section 5(2)(b) of the Act.**

The section 5(3) claim

10. For its section 5(3) claim, the Opponent again relies on its ownership of Registrations 1, 2 and 3 (as above) protecting its trade mark "TOP GEAR" and the goods and services set out in Annex A at the end of this decision.

11. The Opponent claims that its mark *“enjoys a high degree of distinctiveness in addition to an extensive reputation amongst the public. The high degree of visual and phonetic similarity between the Opponent’s mark and the Applicant’s mark will create a “link” visually, aurally and conceptually in combination with the reputation of the Opponent’s mark, thereby causing direct confusion amongst users as to origin.”*
12. As to unfair advantage, the Opponent states that it *“enjoys an extensive reputation in the TOP GEAR mark. As a result of this reputation, the Applicant would be able to gain an advantage by generating goodwill in its services by virtue of the impression created in the minds of consumers that the Applicant’s services emanate from the same or a related source of origin as the goods or services provided by reference to the Opponent’s mark. The advantage gained is unfair because it is as a result of the “free riding” off the reputation of the Opponent’s prior mark.”*
13. As to detriment to the reputation of the Opponent’s mark, the Opponent states that since it *“has no control over the Applicant’s use of the later mark, particularly as regards to the quality of services, detriment is likely to take the form of dilution and tarnishing of the Opponent’s mark and the Opponent’s reputation.”*
14. As to dilution, the Opponent’s states that *“use of the Applicant’s mark is likely to lead to a dilution of the capacity of the Opponent’s mark to identify and distinguish its goods and services from those of others in the eyes of consumers. The average consumer is highly likely to perceive a TOPGEAR KARTING branded service as emanating from the same or a related licensed source of origin as services provided under the Opponent’s mark, and may alter his or her economic behaviour because of this perception by either mistakenly choosing services provided under the Applicant’s mark instead of those provided under the Opponent’s mark, or choosing such services under the misapprehension that they are connected.”*

The section 5(4)(a) claim

15. The Opponent claims to have unregistered rights in the sign “TOP GEAR” in relation to the goods and services set out in Annex B to this decision. The Opponent claims to have used the sign throughout the UK since 22 April 1977 and that use of the

Applicant's mark in respect of any its applied-for services would be restrained under the law of passing off, and therefore contravenes section 5(4)(a) of the Act. Passing off is claimed to arise on the basis that: the Opponent has "*extensive goodwill*" in the TOP GEAR sign and the similarities with the Applicant's mark and the similarity of the services provided are "*such as to misrepresent to consumers that there is a connection, or a mutual source of origin with the Opponent's Mark; and the Opponent is likely to suffer damage as a result*".

#### The Applicant's counterstatement

16. The Applicant filed a notice of defence on Form TM8, including a counterstatement contesting all grounds of the Opponent's opposition.
17. It contests the section 5(2)(b) claim as follows:

Our client's purpose of their trade mark application was to protect the intellectual property rights, good will and reputation of their own business activities. When filing their application, great care and consideration was taken into account to ensure their application included services in which our client has extensive prior trading history and public recognition within. In addition, all services claimed within our clients application including 'Organizing of sports events in the field of karting' and 'Providing training and education in the field of karting' are not specified within the opponent's earlier marks specified. In fact, the opponent has no registered trade mark specifying karting or amateur racing services.

In addition, our client has no intention previously or in the future to provide the specific services covered within the opponent's earlier marks including publications, broadcasting and television services among others. Therefore, our client does not agree to the opponent's claim that the services specified within their own application are identical or similar to the goods and services covered by the Opponent's Registrations.

The use of 'TopGear Karting' from the current premises was originally incorporated in 1993. The origin of the name by the owner at the time, was made on the assumption of speed, kart racing and being the impression of the company being of the highest order. During this time, the previous owner selected the name 'TopGear Karting' in relation to the assumption that TopGear / Top Gear defines:

1. a vehicle's highest gear '*She got to the highway and shifted into top gear*'.
2. a state of great or intense activity '*The project is now in top gear*'. '*The party hit top gear when the guest of honour arrived*'.

Definition provided via Merriam Webster Dictionary ([merriam-webster.com/dictionary](http://merriam-webster.com/dictionary))

18. The Applicant contests the section 5(3) claim as follows:

Due to the above regarding the origin of TopGear Karting, our client's prior trading history and difference in services provided, our client cannot agree that their use of TopGear Karting would take unfair advantage of the Opponent's earlier mark as highlighted under Section 5(3). Our client's use of TopGear Karting has also co-existed peacefully without issue of confusion by the relevant public and/or contest from the Opponent for over 23 years.

Our client has built up significant good will and reputation themselves through the results of their own activities and efforts.

19. The Applicant contests the section 5(4)(a) claim and its counterstatement includes the following words:

At this time, our client states that the BBC's use of Top Gear was at that time, a non-successful TV Programme with low viewing figures which had no relevance to our client's business activities (karting). Due to this, there would have been no advantage gained from passing-off on the Opponent's earlier mark or any general confusion by the relevant public.

#### Papers filed

20. The Opponent filed submissions and evidence to support its opposition and statement of grounds. The Applicant filed no evidence, and no submissions beyond the points made in its counterstatement. I refer to submissions where appropriate. Given the findings of my decision below, I consider it sufficient to provide only a brief summary of the evidence submitted by the Opponent.
21. Axis IP Services Limited represents the Applicant in these proceedings, and the Opponent is represented by Burges Salmon LLP. Neither party requested a hearing and I take this decision based on the papers received and taking into account relevant jurisprudence.

#### **THE OPPONENT'S EVIDENCE**

22. The Opponent's evidence takes the form of a witness statement dated 13 April 2017 from the Commercial Director of the BBC television programme TOP GEAR, along with 11 supporting exhibits. To give a flavour of the evidence filed, it is sufficient to note the following references from the witness statement:

- TOP GEAR is the BBC's very popular motoring show that ran initially from 1977 – 2001 and whose format was updated in 2002 with hour-long episodes fronted by Jeremy Clarkson;
- Data are given for over twenty series to demonstrate the popularity of the programme, showing that it attracted between approximately 12 and 29 percent of audience share, equating to viewing figures of around 3.4 million – 7.2 million;
- Press articles show coverage of the programme with dates from 2009 – 2017, including articles on the websites of *The Daily Mail*, *CNN*, *The Guardian*, *New York Daily News*, indicating its “reach beyond the UK and its global success”;
- The TOP GEAR programme has received 13 awards and 16 nominations over its 21 series run. In 2012 it won a Guinness World Record for “The Most Widely Viewed Factual Television Programme”;
- The TOP GEAR website attracts traffic of between 3 to 8 million global unique users , making it one of the biggest motoring media websites in the world; its Facebook has 14 million likes worldwide; it has 1.95 million followers on Twitter; 5.2 million subscribers on YouTube;
- The TOP GEAR magazine is a market leader in the automobile magazine industry, widely available in retailers such as WH Smith, Tesco, Asda; and readership is likely to be more extensive than circulation as copies are left in waiting areas such as in doctors' surgeries or read by households and guests;
- Its TOP GEAR online shop offers extensive merchandising including track days, birthday cards, games and clothing. Products are also sold elsewhere, such as through Amazon.co.uk, total sales of TOP GEAR merchandise 2011 – 2016 being £2.3 million;
- TOP GEAR hosts live stage events at cities around the UK, attracting tens of thousands of visitors;

- The TOP GEAR programme has had a dedicated TOP GEAR test track for 15 years, used for track drives on the programme, but also for track day experiences for members of the public. The evidence provides reviews of the track day experiences from, for example, the websites of the *Radio Times* and *The Telegraph*.

## DECISION

23. I deal first with the Opponent's claim based on section 5(2)(b). Section 5(2)(b) of the Act states:

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

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

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

24. All of the marks relied on by the Opponent have filing dates which predate the filing of the Applicant's mark and as such, constitute earlier marks within the meaning of Section 6(1)(a) of the Act.
25. Since Registrations 1-3 had been registered for five years or more when the Applicant's mark was published for opposition, those earlier trade marks are all subject to the proof of use provisions under section 6A of the Act. The Opponent has duly provided a statement of use, but the Applicant indicated in its Form TM8 that it does not require the Opponent to provide proof of use. The Opponent is therefore able to rely on those registrations in this opposition without having to prove use. The Opponent has nonetheless submitted evidence (as summarised above) which, while not required to establish proof of use in this case, does have a bearing on an assessment of whether the earlier mark enjoys any enhanced distinctiveness through use, and would also be relevant in relation to the claimed grounds under sections 5(3) and 5(4)(a).



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

*Sabel BV v Puma AG*, Case C-251/95;

*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97;

*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97;

*Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98;

*Matratzen Concord GmbH v OHIM*, Case C-3/03;

*Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04;

*Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and

*Bimbo SA v OHIM*, Case C-591/12P.

The principles are that:

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

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the respective goods and services**

27. Since the Applicant has not put the Opponent to proof of use of its earlier marks, my task of comparing the goods and services is to be made on the basis of notional and fair use of the goods and services in the parties' respective specifications. This idea of a notional comparison is in line with the words of Kitchin L.J. in *Roger Maier and Another v ASOS*<sup>1</sup>, where he stated that:

*"78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered.*

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<sup>1</sup> [2015] EWCA Civ 220

*.... it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification .... In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion."*

28. I approach this task by considering the services in the Applicant's specification and looking across the classes of the Opponent's specification. I give the words their natural meaning with neither undue extension nor constraint and I bear in mind the following principles from case law.

29. In *Gérard Meric v Office for Harmonisation in the Internal Market*<sup>2</sup>, the General Court stated that:

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

30. In *YouView TV Ltd v Total Ltd*,<sup>3</sup> Floyd J. (as he then was) stated that:

*"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise .... Nevertheless the principle should not be taken too far .... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."*

31. I also take account of the factors identified by the Court of Justice of the European Union ("the CJEU") in *Canon*<sup>4</sup> where it states that:

*"In assessing the similarity of the goods .... all the relevant factors relating to those goods .. themselves should be taken into account. Those factors include, inter alia,*

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<sup>2</sup> Case T- 133/05

<sup>3</sup> [2012] EWHC 3158 (Ch)

<sup>4</sup> Case C-39/97, at paragraph 23.

*their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.*

32. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>5</sup> 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.
33. The principles apply in respect of services as they do for goods.
34. The Opponent submits that its services particularly in class 41, are identical or at least highly similar to those claimed by the Applicant, albeit the Opponent's services are set out in broader terms.

<b>Applicant's services</b>
<b>Class 41:</b> <i>Organizing of sports events in the field of karting; Organizing of sports competitions, namely karting races; Providing training and education in the field of</i>

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<sup>5</sup> [1996] R.P.C. 281

*karting; Entertainment services provided at a motor racing circuit; Organisation of automobile racing events; Organisation of vehicle racing events; Party planning [entertainment].*

**Relevant services of the Opponent in class 41**

**Registration 1:** Entertainment; education, instruction, tuition and training; organisation, production and presentation of shows, competitions, contests, games and events; all relating to motoring and motor vehicles

**Registration 2:** Entertainment and education in the form of live events, shows; organisation of competitions; all relating to motoring and motor vehicles

**Registration 3:** Provision of entertainment, education, recreation, instruction, tuition and training; organisation, production and presentation of shows, competitions, games and events.

35. The Opponent's protection for "*organisation, production and presentation of shows, competitions, games and events*" is a broad phrase that covers the Applicant's various organisation services – namely *Organizing of sports events in the field of karting; Organizing of sports competitions, namely karting races; Organisation of automobile racing events; Organisation of vehicle racing events*. On the basis of the principle in *Gérard Meric* those respective services are identical.
36. The Opponent's protection for "*education, instruction, tuition and training*" is a broad phrase that covers the Applicant's "*Providing training and education in the field of karting*". On the basis of the principle in *Gérard Meric* those respective services are identical.
37. The Opponent's protection for "*entertainment*" and "*Entertainment ... in the form of live events, shows; organisation of competitions; all relating to motoring and motor vehicles*" covers the Applicant's "*Entertainment services provided at a motor racing circuit; Party planning [entertainment].*" On the basis of the principle in *Gérard Meric* those respective services are identical.

38. The Opponent submits in the alternative that the Applicant's services are highly similar to services covered by the Opponent's registrations, particularly in the context of live action motoring theatre shows and track-based entertainment. The Opponent submits that the above respective services in class 41 "*would be offered for sale through the same trade channels and would be purchased by the same types of consumers and have the same or similar end uses, i.e. track event days. Being identical, the services would be in direct competition with each other.*" I agree that such factors would establish similarity in this case, but I have in any case already found identity between the respective services.

### **The average consumer and the purchasing process**

39. It is necessary to determine who is the average consumer for the respective services and how the goods and services are likely to be selected.

40. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

*"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect*

*... the relevant person is a legal construct and ... the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical...."*

41. 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*).
42. The Opponent submits that the average consumer of the services in question will be the general public at large. I agree.

43. I would expect the average consumer to pay a normal level of attention when selecting the services at issue. The purchasing act will be visual as the services are likely to be offered and branded through a range of visual communications, including images on websites and in hard copy publicity literature. However, I do not discount aural considerations which may also play a part, including as part of advertisements or word-of-mouth recommendations, so the way the marks sound will also be relevant.

### **Comparison of the marks**

44. It is clear from *Sabel* 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 the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* 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.”
45. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks.

46. The respective trade marks are:

TOPGEAR KARTING	TOP GEAR
The Applicant's contested trade mark	The Opponent's earlier trade mark

47. In considering the overall impression of the Applicant's mark, one readily perceives that the single word "TOPGEAR" conjoins the two separate, familiar words "TOP" and "GEAR". One also notes the second half of the mark is the word "KARTING", which the average consumer would understand to refer to the sporting activity that involves driving go-karts, which are small, open, four-wheeled motor vehicles. Since the second word would be perceived as descriptive of the services under the mark, it is clearly the first, artificial word TOPGEAR that is dominant and distinctive in the mark.
48. As to the Opponent's mark, its overall impression rests solely in the ordinary words "TOP" and "GEAR".

### **Visual similarity**

49. Both marks comprise words only. The words in both instances are presented in upper case, but anyway both use standard characters and their reasonable normal use would include use in upper and lower case. The Applicant's mark involves two words, the first of which will readily be perceived as made up of two words, TOP and GEAR, which are the same words that make up the whole of the Opponent's mark. The marks differ in the additional presence in the Applicant's mark of the descriptive word KARTING, but since it is the TOPGEAR/TOP GEAR element that is dominant and distinctive, I find the marks to be visually similar to at least a reasonably high degree.

### **Aural similarity**

50. The Opponent's mark comprises, dependent on pronunciation, two or three syllables, which are the same syllables that start the Applicant's mark. The Applicant's mark differs by its inclusion of the word KARTING. It is considered a rule of thumb that in assessing similarity of trade marks the attention of the public fixes more readily on the first part of a mark than on its end. Since KARTING is descriptive in the Applicant's



mark and it is the TOPGEAR/TOP GEAR element that is dominant and distinctive, I find the marks to be aurally similar to at least a reasonably high degree.

### **Conceptual similarity**

51. I note the explanation given by the Applicant as to its reasons for selecting the wording of its trade mark. However, the comparison between the marks is to be made from the perspective of the notional average consumer, who will not know the particular considerations at play in the mind of the Applicant.
52. The single word TOPGEAR is not found in a dictionary, but it will be easily perceived as made up from the two standard English words TOP and GEAR. The phrase TOP GEAR will most likely suggest the concept of a vehicle's highest gear, or possibly, but much less likely, 'best quality equipment', or it may call to mind the concept of the well-known television programme. Conceptually, those two words in that order will be understood to carry the same meaning in each mark. The word KARTING will convey to the average consumer the concept of the nature of the services provided under the Applicant's mark and is therefore descriptive or allusive. Overall I find the marks to be conceptually similar to at least a reasonably high degree.

### **Distinctive character of earlier trade mark**

53. The distinctive character of the earlier mark (TOP GEAR) must be considered. The more distinctive it is, either by its inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

*"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (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).”*

54. The phrase TOP GEAR does not directly describe the Opponent’s services relating to entertainment; education, instruction, tuition and training; organisation, production and presentation of shows, competitions, contests, games and events. There may be a degree of allusiveness where the services relate to motoring and motor vehicles, but that allusiveness is not such as to affect materially the distinctiveness of the marks, which I find to have a reasonable degree of distinctiveness for the services in question.
55. The Opponent’s evidence, which I summarised earlier in this decision, is certainly sufficient to show an enhanced level of distinctiveness in relation to certain services in class 41 relating to the BBC television programme (including the live shows), which may fairly be said to include, entertainment, education and events. The exceptional popularity and reach of the television programme and related communications and publications serve to enhance the distinctiveness of the trade mark in relation to those types of services. Combined with degree of inherent distinctiveness of the mark, I find the mark has at least a reasonable degree of distinctiveness.

### **Conclusion as to likelihood of confusion**

56. I now turn to make a global assessment as to the likelihood of confusion between the marks if they were used in relation to the goods and services specified.

57. Case law<sup>6</sup> has made clear that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

*“...Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks ... cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors ...”<sup>7</sup>*

58. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of weighing up the combined effect of all relevant factors in accordance with the authorities I have set out in this decision. Earlier in this decision I concluded that:

- the services are identical;
- the average consumer of the services at issue is a member of the public, who will pay a normal degree of attention in the purchasing process;
- those services may be selected by predominantly visual means, but aural considerations will also play a part in the selection process;
- the overall impression conveyed by the Opponent’s trade mark rests in the phrase TOP GEAR and the mark has at least a reasonable degree of distinctiveness character;
- while both words in the Applicant’s trade mark may contribute its overall impression, its distinctiveness lies in the word TOPGEAR, in which the phrase TOP GEAR is clear;

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<sup>6</sup> See paragraph 66 of the judgment the Court of Justice of the European Union (“CJEU”) in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

<sup>7</sup> *Oakley v OHIM* (Case T-116/06)

- the competing trade marks are visually, aurally and conceptually similar to at least a reasonably high degree.

59. The average consumer does not have the ability to compare the marks side by side, but must instead trust in the imperfect recollection of them it has kept in its mind. The Opponent submits that the likely consumer recollection will be TOP GEAR and that *“there is an exceptionally high risk that the relevant public will believe that the services in question come from the same undertaking, or economically linked undertaking as a result of the Opponent's Marks being entirely subsumed within the Applicant's Mark. This is particularly the case with live action motoring theatre shows and track based entertainment. Consumers will identify The British Broadcasting Corporation as the broadcaster of the famous motoring TV show and naturally assume, from the mark TOPGEAR KARTING that this is an event put on by a BBC production company, such as BBC Studios or an independent event company licensed by the BBC in which the event in question will have similar or connected content to the famous TV show.”*
60. Weighing in the balance all of the above factors I find in this case that there would be a likelihood of confusion on the part of the relevant UK public as to the origin of those services, including a likelihood of association.<sup>8</sup> **Consequently, the opposition succeeds in full on the basis of s5(2)(b).** It is not therefore necessary to decide the claims based on the other grounds.

### Costs

61. The Opponent has been successful and is entitled to a contribution towards its costs. In awarding costs I take account of the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the Opponent the sum of £950 (nine hundred and fifty pounds) as a contribution towards the cost of the proceedings, calculated as follows:

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<sup>8</sup> In so far as the Applicant may have claimed peaceful co-existence, such a claim cannot succeed in the absence of evidence, and therefore need not be considered further.

Reimbursement of the official fee for Notice of Opposition and Statement of Grounds:	£200
Preparing a statement of grounds and considering the other side's statement:	£250
Preparation of evidence	£500
<b>Total:</b>	<b>£950</b>

62. I therefore order TOPGEAR KARTING to pay The British Broadcasting Corporation the sum of £950 (nine hundred and fifty pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 8<sup>th</sup> day of January 2018**

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

**ANNEX A**

**List of goods and services specified in respect of the  
Opponent's Registrations 1, 2 and 3.**

**Registration 1 (EUTM 1231661)**

*Class 9*

Sound, video and data recordings; films and sound films prepared for exhibition; carriers including records, discs, tapes, cassettes, cartridges and cards bearing or for use in bearing sound recordings, video recordings, data, images, games, graphics, text, programs or information; computer software; computer games; video games; electronic games; memory carriers; interactive compact discs; CD-ROMs; electrically, magnetically and optically recorded data for computers; instructional and teaching apparatus and instruments; sound, video and data recording and reproducing apparatus; games, apparatus for games and amusement apparatus all for use with or incorporating a television screen or video monitor; coin or token operated electrical or electronic amusement apparatus; all relating to motoring or motor vehicles

*Class 16*

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; printed publications; periodical publications; magazines; brochures; books; booklets; pamphlets; printed guides; catalogues; programs; photographs; stationery; instructional and teaching material (except apparatus); playing cards; posters; cards; postcards; greetings cards; trading cards; certificates; invitations; diaries; calendars; all relating to motoring or motor vehicles

*Class 28*

Toys, games and playthings; novelties in the form of souvenirs; all relating to motoring or motor vehicles

*Class 38*

Broadcasting; communications and telecommunications; broadcasting and transmission of radio and television programmes; data transmission and data broadcasting; broadcasting and transmission of text, messages, information, sound and images; transmission of radio and television programmes, text, messages, information, sound and images via communication and computer networks; computer aided transmission of information, messages, text, sound, images, data and radio and television programmes; broadcasting and transmission of digital information by means of cable, wire or fibre; receiving and exchanging of information, text, messages, sound, images and data; electronic mail services; inter-active video text services; news information and news agency services; message sending; communications by and/or between computers and computer terminals; communications for access to databases and computer networks; communication services for access to information, text, sound, images and data via

communication and computer networks; gateway services for access to a communications or computer network; retrieval, provision and display of information from a computerstored databank; electronic display of information, messages, text, images and data; on-line services; on-line information services; information and advisory services relating to any of the aforesaid services; all relating to motoring or motor vehicles.

*Class 41*

Entertainment; education, instruction, tuition and training; entertainment, education and instruction by means of or relating to radio and television; production, presentation, distribution, syndication, networking and rental of television and radio programmes, interactive entertainment, films and sound and video recordings, interactive compact discs and CD-ROMs; production and rental of educational and instructional materials; publication; exhibition services; organisation, production and presentation of shows, competitions, contests, games, concerts and events; educational examination, language teaching; provision of language schools and language courses; rental of radio and television broadcasting facilities; provision of entertainment and education for accessing via communication and computer networks; provision of information relating to radio and television programmes for accessing via communication and computer networks; provision of information for or relating to education, entertainment, cultural or recreational purposes, provision of information relating to radio and television programmes for accessing via communication and computer networks; provision of information relating to any of the aforesaid services; all relating to motoring or motor vehicles

**Registration 2 (UK Trade Mark 1525433)**

*Class 16*

Printed matter in the form of fact sheets, programmes, stickers; all relating to motoring and motor vehicles; all included in Class 16

*Class 41*

Entertainment, education and instruction provided by television; production and presentation of television programmes and video recordings; entertainment and education in the form of live events, shows and telephone advisory services; organisation of competitions; all relating to motoring and motor vehicles; all included in Class 41.

**Registration 3 (UK Trade Mark 2408687)**

*Class 9*

Data recordings including audio, video, still and moving images and text; downloadable electronic publications; computer, electronic and video games programmes

*Class 16*

Printed publications; magazines; books; photographs; stationery; posters; cards; postcards; greetings cards; trading cards; diaries; calendars; photograph albums; prints; gift bags, gift boxes, gift tags and gift wrap; notepads; writing instruments and crayons; stickers; transfers; stamps; personal organisers; address books; note books; pen and pencil holders; desk mats.

*Class 41*

Provision of entertainment, education, recreation, instruction, tuition and training; production, presentation and distribution of audio, video, still and moving images and data; the provision of discussion forums; non-downloadable electronic publications; organisation, production and presentation of shows, competitions, games, concerts exhibitions and events; provision of information and advisory services relating to any of the aforesaid services.



**ANNEX B**

**List of goods and services claimed for the Opponent's unregistered rights in relation to the section 5(4) ground**

**Sound, video and data recordings; films and sound films prepared for exhibition; carriers including records, discs, tapes, cassettes, cartridges and cards bearing or for use in bearing sound recordings, video recordings, data, images, games, graphics, text, programs or information; computer software; computer games; video games; electronic games; memory carriers; interactive compact discs; CD-ROMs; electrically, magnetically and optically recorded data for computers; sound, video and data recording and reproducing apparatus; games, apparatus for games and amusement apparatus all for use with or incorporating a television screen or video monitor; all relating to motoring or motor vehicles; paper, cardboard and goods made from these materials, not included in other classes; printed matter; printed publications; periodical publications; magazines; brochures; books; booklets; pamphlets; printed guides; catalogues; programs; photographs; stationery; playing cards; posters; cards; postcards; greetings cards; trading cards; certificates; invitations; diaries; calendars; all relating to motoring or motor vehicles; toys, games and playthings; novelties in the form of souvenirs; all relating to motoring or motor vehicles; broadcasting; communications and telecommunications; broadcasting and transmission of radio and television programmes; data transmission and data broadcasting; broadcasting and transmission of text, messages, information, sound and images; transmission of radio and television programmes, text, messages, information, sound and images via communication and computer networks; computer aided transmission of information, messages, text, sound, images, data and radio and television programmes; broadcasting and transmission of digital information by means of cable, wire or fibre; receiving and exchanging of information, text, messages, sound, images and data; news information and news agency services; message sending; communications by and/or between computers and computer terminals; communications for access to databases and computer networks; communication services for access to information, text, sound, images and data via communication and computer networks; electronic display of information, messages, text, images and data; on-line services; on-line information services; information and advisory services relating to any of the aforesaid services; all relating to motoring or motor vehicles; entertainment; education, instruction, tuition and training; entertainment, education and instruction by means of or relating to radio and television; production, presentation, distribution, syndication, networking and rental of television and radio programmes, interactive entertainment, films and sound and video recordings, interactive compact discs and CD-ROMs; publication; exhibition services; organisation, production and presentation of shows, competitions, contests, games, concerts and events; provision of entertainment and education for accessing via communication and computer networks; provision of information relating to radio and television programmes for accessing via communication and computer networks; provision of information for or relating to education, entertainment, cultural or recreational purposes, provision of information relating to radio and television programmes for accessing via communication and computer networks; provision of information relating to any of the aforesaid services; all relating to motoring or motor vehicles.**