

O-054-18

TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED PROCEEDINGS INVOLVING:

TWO TRADE MARK APPLICATIONS (Nos 3174696 & 3174702)

IN THE NAME OF DARSHINI JOSHI

FOR THE TRADE MARKS:

SANSKRITI GURU

&



AND

OPPOSITION THERETO (UNDER Nos 407825 & 407871)

BY O2 WORLDWIDE LIMITED

BACKGROUND AND PLEADINGS

1. These consolidated proceedings concern two trade mark applications filed by Ms Darshini Joshi. The first, for the word mark **SANSKRITI GURU**, was filed on 14 July 2016 and was published for opposition purposes on 5 August 2016. Registration is sought for the following goods and services:


Class 9: Pre-recorded cd's, video tapes, laser disks and dvd's; Video and audio recordings; Computer programs.

Class 16: Printed matter; paper; stationery; tickets, printed cards, labels, tags, tokens, booklets, catalogues, pens, pencils; posters; books, teaching materials.

Class 25: Clothing; footwear; headgear; Dance clothing, warm-up suits, bodysuits, leotards, tights, cover-ups, leggings, leg warmers; headwear, hats, caps, berets, toques, visors, headbands, yoga clothing; bandanas; footwear, casual shoes, dance shoes, slippers; Indian clothing and costumes.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; Education academy services for teaching acting; Education services related to the arts; Education services relating to music; Education services relating to vocational training; Educational services for the dramatic arts; Entertainment in the nature of theatre productions; Entertainment agency services; Entertainment by means of concerts; Entertainment by means of theatre productions; Entertainment in the form of live musical performances; Entertainment in the form of recorded music; Entertainment services in the form of concert performances. training in performing arts and public speaking; artistic direction of performing artists; production of shows; tutoring; training services relating to speech; performing of music and singing; provision of cultural activities; presentation of live performances; providing electronic online publications (non-downloadable); provision of seminars, workshops and classes relating to performing arts and public speaking; Educational and training services; conducting classes, seminars, lectures and workshops for professional development of instructors in the field of dance; educational and


training services; conducting dance, fitness, aerobics and exercise classes, courses and workshops; choreography of music and dance programs for others, for instruction, fitness and entertainment purposes; organization, production, management, sponsorship, distribution and presentation of music and dance competitions and performances; provision of theatre summer school; performing arts tuition for children and young adults; part-time training in performing arts for young people; provision of acting lessons; provision of dance classes; provision of singing lessons; provision teacher training in the field of performing arts; theatre production services; direction of theatre performances, including musicals and dance shows; provision of theatre facilities; establishment of a purpose built theatre for children and young people; ticket booking and reservation services; organisation of talent competitions and shows; providing on-line (non-downloadable) information in relation to all of the aforesaid; languages teaching and classes; tabla teaching and classes; yoga teaching and classes; organisation of musical shows, dramas and cultural events; production and presentation of shows and live performances; information and advisory services related to all the aforesaid services; information relating to entertainment provided on-line from a computer database or the Internet; publication services; information, consultancy and advisory services relating to all the aforesaid services.

2. The second application is for the mark: . It was also filed on 14 July 2016, but published on 12 August 2016. Registration is sought for the same goods and services as above.

3. Registration of the two marks is opposed by O2 Worldwide Limited (“O2”). In both cases, the grounds of opposition are the same, namely, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis that there is a likelihood of confusion with five earlier marks that O2 owns, as follows:

UK registration no. 3024436 for the mark **GURU**, with O2 relying on its services in classes 35, 38, 41 & 42.



EUTM¹ registration no. 012195772 for the mark  with O2 relying on its services in classes 35, 38, 41 & 42.

EUTM registration no. 010245942 for the mark **GURU TV** with O2 relying on its goods/services in classes 9, 35, 38, 41 & 42.

EUTM registration no. 010177152 for the mark **O2 GURU** with O2 relying on its services in classes 35, 38, 41 & 42.

EUTM registration no. 011914587 for the mark **O2 GURU TV** with O2 relying on its services in classes 35, 38, 41 & 42.

4. O2 initially pleaded further grounds under section 5(3) of the Act, relying on the same five earlier marks, however, it subsequently dropped those grounds.

5. Ms Joshi filed a counterstatement denying the grounds of opposition. She put O2 to proof on the similarity between the goods/services. She also denied that the similarity between the marks would lead to a likelihood of confusion, highlighting that her mark contains the additional word SANSKRITI, with that word being of equal or more prominence than the word GURU, and that it is the combination of elements that has enabled her mark to be accepted for registration.

6. The proceedings were consolidated. O2 filed evidence, however, it subsequently wrote to the tribunal on 5 October 2017 (after the section 5(3) grounds had been dropped) to say that at the forthcoming hearing no submissions would be made in relation to the evidence given that it was only relevant to the section 5(3) ground. As such, I will say no more about O2's evidence in terms of the substantive decisions required of the tribunal. No evidence was received from Ms Joshi, although, she did file a set of written submissions.

¹ European Union Trade Mark

7. The matter was then heard before me on 19 October 2017 at which O2 were represented by Mr Julius Stobbs of Stobbs IP, and at which Ms Joshi was represented by Charlotte Scott, of counsel, instructed by Joshi Worldwide IP Limited. It should be recorded that the hearing took place via video conference, with myself at the IPO's Newport office, Ms Scott at the IPO's London office, and Mr Stobbs at his own firm's office in Cambridge. Regrettably, the video link with Mr Stobbs failed a number of times, following which he was joined to the hearing by telephone. Neither side took issue with that course of action. From my perspective, I was able to hear Mr Stobbs' submissions without further difficulty.

SECTION 5(2)(B)

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

“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.”

9. The following principles are gleaned from the judgments 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods/services

10. Goods and services may be considered identical if one term in a specification falls within the ambit of something in the competing specification, as per the guidance provided by the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

11. In terms of similarity, when making a comparison of goods/services, all relevant factors relating to them should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”) stated at paragraph 23 of its judgment:

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

12. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

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

13. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-

757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri* (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

14. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

15. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”² and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³. I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

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. Without withdrawing reliance on the other earlier marks, Mr Stobbs submitted that O2's best earlier marks were those which comprised the word GURU, GURU in logo form, and GURU TV. Indeed, he further submitted that the GURU word mark was probably the best mark overall, but he did identify one area (which I come on to) where the GURU TV mark may put O2 in a better position (at least in terms of the goods) than GURU alone. Therefore, from this point onwards, I will focus on the GURU word mark when making the relevant comparisons, but will touch on the GURU TV mark when it is necessary to do so. I begin the comparison with the opposed class 9 goods, which read:

Class 9: Pre-recorded cd's, video tapes, laser disks and dvd's; Video and audio recordings; Computer programs.

17. This is the one area where the GURU TV mark may put O2 into a stronger position. This is because, as highlighted by Mr Stobbs, the class 9 specification of that earlier mark covers a number of terms which overlap with the applied for specification. I do not need to detail them further here because Ms Scott accepted that the goods were identical (see para 37 of her skeleton argument).

18. Even though there may be identity with goods in the GURU TV mark, it is still necessary to make findings in relation to the GURU mark, the mark relied on to the greater extent overall. The GURU mark is not registered in class 9, but similarity is argued on the basis of a number of goods and services. One of the areas relied on by Mr Stobbs was the specification in class 35 which relates to the retail of various goods, as follows:

“Retail services and online retail services connected with...magnetic data carriers, recording discs...computer applications software, computer software recorded onto CD Rom...audio tapes, audio cassettes, audio discs, audio-video tapes, audio-video cassettes, audio-video discs, video tapes, video cassettes, video discs, CDs, DVDs, electronic publications (downloadable)

19. Mr Stobbs relied on the various cases that have demonstrated that a complementary relationship may exist between retailing on the one hand, and the goods the subject of that retail service on the other. In *Oakley, Inc v OHIM*, Case T-116/06 (to which Mr Stobbs referred), at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and methods of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

20. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning retail services v goods. He said that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

21. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*⁴, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁵, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁶, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

22. I should say to begin with, that I construe the applied for specification as various forms of pre-recorded media, recordings per se, and computer programs. In terms of recordings and pre-recorded media, the retail services normally associated with them would, in my view, be retail establishments such as supermarkets, and what one would traditionally regard as record stores, online retail stores, and specialist online retailers that provide downloadable recordings. The one thing that strikes me from this perspective is that such establishments are not particularly likely to offer their own

⁴ Case C-411/13P

⁵ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁶ Case C-398/07P

versions of such goods. As Ms Scott submitted, the retailer is not normally the producer. This is because the recorded content will normally be the fruit of the artist/publisher of the recording as opposed to the retailer. There may be some exceptions to this. For example, Mr Stobbs submitted that the BBC would have its own retail store to sell its own recordings to the public. Of course, there is no evidence on that, and whilst I accept that this may be possible, there is nothing to suggest that this is the normal route for recordings to reach the market. I consider any similarity between the recorded media and recordings, with the retail of such goods, to be low. I also extend this finding to computer programs for much the same reasoning.

23. In relation to computer programs, Mr Stobbs also relied on computer programming etc in class 42. Ms Scott submitted that there was no similarity on the basis of the normal assessment of the *Canon* factors. However, whilst I would not pitch it particularly highly, I am of the opinion that there is some similarity given that the end purpose of both computer programs and computer programming is to avail oneself of computer code to facilitate a particular software solution and, further, a user (particularly a business user) may make a competitive choice between an off-the-shelf solution, or a bespoke solution via a computer programming service. I consider there to be a moderate (between low and high) level of similarity.

24. In relation to recordings and recorded media, Mr Stobbs also relied on “transmission of digital music” in class 38 and, in class 41, various production, rental (of sound recordings and videotapes) and distribution services. I am not persuaded that reliance upon “transmission of digital music” improves O2’s position given that one is a form of recording, whereas the other is simply the facilitation of the transmission of something. In my view, neither does reliance upon the various production and distribution services assist further as these strike me more as specialist business to business services. However, the rental services may assist. This is because the end purpose of both a recording and a rental of a recording is to enable the user to experience the particular recording, albeit one is in the form of purchasing it, the other in the form of renting it. The average consumer may also make a competitive choice between one or the other, and, also, the same outlets may offer both sale and/or rental. I consider there to be a medium degree of similarity.

25. I now turn to class 16, which reads:

Class 16: Printed matter; paper; stationery; tickets, printed cards, labels, tags, tokens, booklets, catalogues, pens, pencils; posters; books, teaching materials.

26. Mr Stobbs relied, again, on the retail specification of the GURU mark, with such services being connected with “printed matter, books, magazines, paper, stationery”. I should stress that I consider all of the applied for terms to be forms of printed matter or stationary. This applies even to teaching materials which could either be printed matter for assisting in teaching, or stationary type items for the same purpose. I have set out the case-law earlier in relation to the conflict between retail services and the goods retailed. Here, I think the link is stronger than the one I have assessed thus far, with the goods, again, being sold through supermarkets, but, also, stationers and book shops. I consider it more probable that such establishments would sell their own versions of particular types of stationary, paper and even printed matter. I consider there to be a medium degree of similarity.

27. Mr Stobbs also relied on educational services in class 41 in comparison to the teaching materials in class 16. However, in my view, this does not improve O2’s position, there being no greater degree of similarity.

28. I now turn to class 25, which reads:

Class 25: Clothing; footwear; headgear; Dance clothing, warm-up suits, bodysuits, leotards, tights, cover-ups, leggings, leg warmers; headwear, hats, caps, berets, toques, visors, headbands, yoga clothing; bandanas; footwear, casual shoes, dance shoes, slippers; Indian clothing and costumes.

29. Mr Stobbs relied, again, on the retail specification of the GURU mark, with such services being connected with clothing, footwear and headgear. Ms Scott, on the basis of the *Oakley* case, accepted that there was some similarity. I consider the nature of the link between clothing and the retail of clothing to result in a medium degree of similarity for similar reasons as set out in paragraph 26, above.

30. I finally turn to class 41 which reads:

Class 41: Education; providing of training; entertainment; sporting and cultural activities; Education academy services for teaching acting; Education services related to the arts; Education services relating to music; Education services relating to vocational training; Educational services for the dramatic arts; Entertainment in the nature of theatre productions; Entertainment agency services; Entertainment by means of concerts; Entertainment by means of theatre productions; Entertainment in the form of live musical performances; Entertainment in the form of recorded music; Entertainment services in the form of concert performances. training in performing arts and public speaking; artistic direction of performing artists; production of shows; tutoring; training services relating to speech; performing of music and singing; provision of cultural activities; presentation of live performances; providing electronic online publications (non-downloadable); provision of seminars, workshops and classes relating to performing arts and public speaking; Educational and training services; conducting classes, seminars, lectures and workshops for professional development of instructors in the field of dance; educational and training services; conducting dance, fitness, aerobics and exercise classes, courses and workshops; choreography of music and dance programs for others, for instruction, fitness and entertainment purposes; organization, production, management, sponsorship, distribution and presentation of music and dance competitions and performances; provision of theatre summer school; performing arts tuition for children and young adults; part-time training in performing arts for young people; provision of acting lessons; provision of dance classes; provision of singing lessons; provision teacher training in the field of performing arts; theatre production services; direction of theatre performances, including musicals and dance shows; provision of theatre facilities; establishment of a purpose built theatre for children and young people; ticket booking and reservation services; organisation of talent competitions and shows; providing on-line (non-downloadable) information in relation to all of the aforesaid; languages teaching and classes; tabla teaching and classes; yoga teaching and classes; organisation of musical shows, dramas and cultural events; production and presentation of shows and live

performances; information and advisory services related to all the aforesaid services; information relating to entertainment provided on-line from a computer database or the Internet; publication services; information, consultancy and advisory services relating to all the aforesaid services.

31. Ms Scott accepted that the goods were similar and/or identical. However, to ensure that due regard is given to the interdependency principle, it is necessary to make more specific findings than that. The vast majority of the long list of applied for services are either educational or entertainment services of one form or another, with the consequence that the services are identical to services of the earlier GURU mark, which itself covers entertainment and education. Having gone through the above specification, the only terms which would not be an educational or entertainment services per se are set out below, together with why I still consider there to be an overlap:

- Sporting and cultural activities – the earlier mark also covers these services so they are identical.
- Entertainment agency services – although not an entertainment service per se, an entertainment agency will provide talent to individuals and businesses. There is a clear link with entertainment services in what would be perceived a complementary manner, and, also, a link with services such as entertainment production. Similarity is accepted by the applicant, I consider that it is of a medium degree.
- Production of shows – the earlier mark covers various production services which are, therefore, identical.
- Provision of cultural activities – the earlier mark also covers these services so they are identical.
- Theatre production services; direction of theatre performances, including musicals and dance shows – the earlier mark covers various production

services (including production of shows) which encompass the applied for services, including the direction of theatre performances.

- Ticket booking and reservation services - the earlier mark covers various booking and reservation services and are, thus, identical.
- Publication services – the earlier mark covers various publication services and are, thus, identical.
- Information services relating thereto – the earlier mark covers various information services and are, thus, identical.

Average consumer and the purchasing act

32. 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.”

33. For the conflicting services in class 41, I consider the average consumer to be a member of the public or a business. Although the cost of the services may vary depending on what is being offered, the services are generally speaking ones which

have a reasonable as opposed to heightened degree of consideration. Whilst both education and entertainment can sometimes be very costly, one must also consider services are either end of the price spectrum. The marks will be encountered visually on websites, brochures, leaflets etc, and signage at the point of service delivery. However, for services such as these, telephone contact may also be applicable which means that the aural impact also has a role to play.

34. In relation to the goods, whilst I am alive to any differences in terms of the average consumer and the purchasing process, whether they are in class 9, 16 or 25, they still strike me as goods purchased by the general public employing a no higher or lower degree of care and attention than the norm. The purchasing process will be through predominantly visual means, although the aural impact of the marks is not to be ignored completely.

Distinctiveness of the earlier mark(s)

35. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *WindsurfingChiemsee 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).”

36. No use having been filed, I have only the inherent characteristics of the marks to consider. Distinctiveness is not a fixed concept. A mark may be more distinctive for some goods/services than it is for others. However, given that the earlier marks are registered, they must all be treated as having some level of distinctiveness for everything covered by the registration (see, for example, Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*).

37. In class 41, the earlier mark is registered for what can collectively be described as educational and entertainment services. Ms Scott argued that the distinctiveness of the word GURU must be very low, indeed, at times her submissions appeared to suggest that the word GURU had 0% distinctiveness, a submission which is not open to her (at least in relation to O2's GURU mark). She relied on the dictionary definition of the word, in particular the meaning of “influential teacher or popular expert”. She made reference to terms such as “management guru”. Mr Stobbs argued that the word was not apt to make the suggestive connotation that had been put forward. Even if it had some suggestiveness in, say, the field of yoga (which could be said to relate to the more spiritual meaning of the word), such suggestiveness did not transfer to other types of educational services and certainly not entertainment services.

38. The dictionary meaning underpins my own understanding of the word GURU. It is a word that will be associated not just with spiritual significance, but also with a more general application given that an expert in something will, in my experience, often be referred to as a guru. The suggestiveness the mark gives in relation to all education services is, in my view, strong. I consider that, in respect of these services, the earlier mark has a very low level of inherent distinctive character.

39. In terms of entertainment services, it is worth bearing in mind that entertainment is a broad term which includes services which can be provided/performed by leaders in a particular field. As such, whilst accepting that there is more inherent distinctiveness in relation to such services, I still consider it to have only a moderate (between low and medium) level of inherent distinctiveness.

40. The distinctiveness of the word GURU also needs to be considered for various other services. In so far as the retail services (connected with clothing, with printed matter and stationery, and with the media type goods), the inherent distinctiveness is, again, higher than that assessed already. Ms Scott suggested that for virtually anything the mark was low in distinctiveness because it is suggestive that the services are offered by an expert in the field concerned. However, for retail services, any suggestiveness is, in my view, mild. I consider there to be a medium level of inherent distinctiveness.

41. For computer programming services, I consider the suggestiveness to be much stronger given the likely desire to engage a service provider with great expertise. I consider the mark to be low in inherent distinctiveness for these services. The final service covered by the earlier mark which is worth commenting upon is the service of rental of video tapes and sound recordings. Here I believe there to be a moderate (between low and medium) level of inherent distinctive character.

42. In terms of the GURU TV mark, it is only worth commenting upon the distinctiveness in relation to its media goods in class 9. The media could contain information provided by an expert in the field. There are, therefore, reasonably strong suggestive connotations. As a whole, GURU TV has a moderate level of inherent distinctiveness, but the common element, which is key to the assessment⁷, has a low degree.

⁷ As per the decision of Mr Iain Purvis QC, sitting as the Appointed Person, in *Kurt Geiger* (BL O-075-13).

Comparison of marks

43. 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 the marks, 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.”

44. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

SANSKRITI GURU and 

v

GURU and **GURU TV**

45. In terms of overall impression, O2's GURU mark has just one component (the word GURU) and, as such, is the only thing which contributes to its overall impression.

In relation to GURU TV, given that the relevant goods (media) could feature TV content, or be provided via the TV, the TV element plays a subordinate role in the mark. Whilst TV is not negligible in the overall impression, the word GURU has greater relative weight.

46. In terms of the overall impression of Ms Joshi's SANSKRITI GURU word mark, both representatives appeared to agree that some average consumers would be aware of the word SANSKRIT and that SANSKRITI would evoke this word, whereas some average consumers would not and would, therefore, see the word SANSKRITI as purely invented with no evocative significance. For those that fall in the first camp, SANSKRITI GURU forms a unit which, whilst not 100% clear in meaning, is suggestive of an expert/teacher (GURU) who specialises in something to do with the Sanskrit language or culture. Neither word materially dominates the other.

47. For those that fall in the second camp, Mr Stobbs submitted that the two elements would be seen as separate, independently distinctive components. Whilst I understand the point, I take the view that the nature of the word GURU lends itself so easily to combination with other words that the phrase will still hang together as a unit albeit this time indicating an expert/teacher in connection with something (SANSKRITI) with which the average consumer is not familiar. The stylisation of the applied for stylised mark makes a contribution to its overall impression, but of less relative weight than the words themselves.

48. Visually, in all of the comparisons there is some degree of visual similarity given that the word GURU is common to all of the marks, albeit as the second (and shorter) word in the applied for marks. However, there are visual differences on account of: i) the presence of the word SANSKRITI at the start of the applied for marks, ii) the additional stylisation in the stylised mark of the applicant, iii) the additional difference created by the element TV in the GURU TV earlier mark. The most visually similar marks are: SANSKRITTI GURU and GURU, which I assess as a moderate (between low and medium). The additional differences in the other comparisons mean that I consider the level of visual similarity to be low.

49. Aurally, the stylisation in the applied for stylised mark will not be articulated. This means that the comparison with both applied for marks with the word GURU is the same. The endings sound the same – GURU. But the additional three syllable word at the beginning of the applied for marks creates a difference. I consider there to be a moderate (between low and medium) level of aural similarity. There is a further difference in comparison to the GURU TV mark on account of the additional two syllable word at the end of the earlier mark. In comparison to the two applied for marks, I consider the aural similarity to be low.

50. Conceptually, all of the marks are suggestive of a specialist in something. This creates a degree of conceptual similarity. However, the applied for marks make specific reference to a guru in a particular (evocative) field, or a unknown field (but still something particular) if the average consumer is unaware of the word Sanskrit. I consider that this equates to only a low level of conceptual similarity when compared to GURU alone, and an even lower level when compared to GURU TV given that this has a further concept of television dedicated to gurus.

Likelihood of confusion

51. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“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).”

52. I focus, in the first instance, on the alleged conflict between SANSKRITI GURU and GURU. In relation to direct confusion, and notwithstanding the concept of imperfect recollection, I come to the view that the average consumer will not misrecall/misremember the presence of the additional word SANSKRITI. This is so even for those that see the allusive qualities in that word. In that respect, the word still makes

up an integral part of the mark and will not be overlooked. Thus, if there is any confusion, the better prospect is indirect confusion.

53. In relation to the educational type services, I bear in mind that this is where I found the degree of inherent distinctiveness in the earlier mark GURU to be of the lowest (I found it to be of a very low degree). It was upon this factor that Ms Scott primarily relied, together with the differences that exist between the marks. Mr Stobbs argued that confusion was likely on either of the following basis. First, for those that see an allusive meaning in the word SANSKRITI, they would assume that SANSKRITI GURU was merely a subset of the services offered under the GURU mark, with SANSKRITI alluding to the field of activity of the educational service. Alternatively, for those that see no allusive meaning in SANSKRITI, they would see two independently distinctive elements and confusion likely as per the *Thompson Life case (Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04)*.

54. In relation to Mr Stobbs' first argument, the difficulty is that for those that see an allusive meaning in SANSKRITI, they would not, in my view, attach any trade origin significance to the word GURU alone in the context of the mark as whole. They would see the whole as an indication that the services on offer are provided by a guru in the field of something to do with the Sanskrit language/culture. The average consumer would put the commonality of this word in the applied for mark down to a co-incidental use as opposed to indicating an economic connection.

55. In relation to the second argument, I have already taken the view that the mark stills forms a unit even if the word SANSKRITI is not seen as allusive. Thus, I do not regard that the opponent is in any better position. Even if this were not right, and the mark still seen as two independently distinctive elements, I take the view that the first element of the word so strongly dominates the mark that there will be no confusion on the basis of the least dominant element which is very low in distinctive character. Again, any commonality will be put down to co-incidence. There is no likelihood of confusion, be it direct or indirect, in respect of the identical educational services in play. It follows that this also applies to the claimed conflict with the stylised SANSKRITI GURU mark, as this mark is less similar.

56. In terms of the applied for entertainment type services, which, again, I largely found to be identical, I come to the same view. Although I have assessed the inherent distinctiveness to be higher (compared to educational services), the degree is still only of a moderate level. For much the same reasons as I have already given, there is no likelihood of direct or indirect confusion.

57. In terms of the applied for goods in class 9, I bear in mind that there are various goods/services clashes. The most notable are the conflicts with the retailing of the goods (which I found creates a medium level of similarity), the clash between computer programs and computer programming (which I found to create a medium degree of similarity) and the clash between the recordings and their rental (again, with a medium degree being found). I have considered each of these classes separately, together with the level of inherent distinctiveness of the earlier mark in respect of the conflicting goods it covers (which again varies). Having done so, I still come to the view that there is no likelihood of confusion. The combination of the various factors does not combine to suggest that confusion is likely particularly given that my primary view of the applied for mark is that the GURU element will merely signify that the goods are offered by, or are about, a guru in the field.

58. In terms of the goods in classes 16 and 25, the clash with the opponent's specification is with regard to the retailing of those goods. This, in my view, is the area where the required decision is most evenly balanced. There is clearly still no direct confusion. In terms of indirect confusion, despite the earlier mark having a medium degree of distinctiveness, with a medium degree of similarity between the goods/services, I am still not persuaded that the average consumer will put the common presence of the word GURU down to economic connection. In terms of the categories explained by Mr Purvis in *LA Sugar* (which I accept are just illustrative), the common word is not so strikingly distinctive that no one other than the (same or related) brand owner would use it (again bearing in mind that one is considering the goods against a retail service), and neither in this scenario (of goods against retailing) would the average consumer see it is a brand extension or some form of sub-brand. There is no likelihood of confusion.

59. In view of the above findings, there is no likelihood of confusion between SANSKRITI GURU and GURU (and by extension, with the stylised version of SANSKRITI GURU).

60. The final consideration lies with the earlier GURU TV mark. The only area where the opponent may have been in a better position is with regard to the class 9 goods given that identity is in play. However, even taking this into account, I still consider that the various factors combine to inform me that there is no likelihood of confusion given not only the differences between the marks (including the additional difference that the TV element of O2's mark introduces) but also the distinctiveness and role the word GURU plays in the respective marks. There is no likelihood of confusion.

Conclusion

61. The opposition fails. Subject to appeal, the two applications may proceed to registration in respect of all of the applied for goods and services.

Costs

62. The applicant has been successful and is, therefore, entitled to a contribution towards her costs. Ms Scott argued that costs should either be above ordinary scale costs, or at least at the upper end, due to: i) the need to consider the opponent's evidence which ultimately was not relied upon, ii) the need to consider the 5(3) ground, including consideration by counsel, a ground not pursued and, iii) the lack of particularisation of the opponent's case, particularly with regard to the goods and services. Mr Stobbs submitted that all the opponent had done was to provide greater focus for the purpose of the hearing in order for a more efficient discussion to take place. In my view, the opponent ought to have presented its more focused case earlier, however, its conduct in not doing so is not of the type where I consider off scale costs to be appropriate. I agree, though, that costs more towards the higher end of the scale are appropriate. My assessment is set out below:

Preparing a statement of case and considering the counterstatement - £600

Considering evidence and filing written submissions - £1000

Preparing for and attending the hearing: - £800

63. I order O2 Worldwide Limited to pay Ms Darshini Joshi the sum of £2400 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 24th day of January 2018

Oliver Morris

For the Registrar

the Comptroller-General