

O-110-18

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATION No. 3201584

BY JUMP NINJA LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 41:

JUMP NINJA

AND

OPPOSITION THERETO (No. 408868) BY NINJA INVESTMENTS LIMITED

Background and pleadings

1. The trade mark the subject of these proceedings was filed by Jump Ninja Limited (“the applicant”) on 11 December 2016 and published for opposition purposes on 23 December 2016. Its registration is opposed by Ninja Investments Limited (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on a single earlier trade mark, namely UK registration 3154655, which was filed on 13 March 2016¹ and registered on 12 August 2016². Although the opponent’s mark is registered in three classes, it relies only on its services in class 41. Given all this, the proceedings boil down to a conflict between the following marks:

| Application | Earlier mark |
|--|---|
| JUMP NINJA Class 41: Educational services; entertainment services; training; sporting and cultural activities; provision and organisation of indoor leisure activities; provision of indoor play centres; provision of trampoline parks; provision of fitness classes; organising of sports competitions and events; rental of sports equipment and facilities; sports tuition, coaching and training; leisure services; information, advisory and consultancy services in relation to all of the aforesaid. | NINJA.COM Class 41: Teaching, education, training and entertainment services; Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line. |

¹ This date of filing means that the opponent’s mark qualifies as an earlier mark in accordance with section 6 of the Act.

² This date of registration means that the earlier mark is not subject to the use conditions set out in section 6A, it being registered less than 5 years prior to the date of publication of the application.

2. The opponent claims that due to the similarity between the marks, and the identity and/or similarity between the services, there exists a likelihood of confusion.

3. The applicant filed a counterstatement denying the grounds of opposition. It denies that the common presence of the word NINJA is sufficient to cause confusion, particularly bearing in mind, for example, the overall impressions of the marks, the fact that one of the marks is a domain name and, further, that the applied for mark is comprised of two words. The applicant states that the areas of interest of the parties do not overlap. The applicant identified from the website of Companies House that the opponent company's principal activities are listed as specialising in television and broadcasting. The applicant requests proof that the opponent intends to operate in a field beyond television and broadcasting and requests that the tribunal limit the scope of the opponent's services to services offered in connection with television and broadcasting. The applicant says that the result of this is that there is no similarity with the applicant's activities, which are in the field of children's and young person's trampolining and fitness. In my view, the applicant's arguments in relation to the opponent's services are misconceived. The opponent's mark is not subject to the proof of use provisions and it can, therefore, be relied upon in respect of its class 41 services as they stand on the register, without any limitation in their scope. A notional assessment of the specifications must be made.

4. Neither side filed evidence, although the opponent did provide a set of written submissions. Neither side requested a hearing or filed written submissions in lieu. The applicant is represented by Michael Young of Maya Solicitors, the opponent is self-represented.

Section 5(2)(b)

5. 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.”

6. 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 services

7. Services may be considered identical if they fall within the ambit of a term in the competing specification (or vice versa) (I refer to this as the “inclusion principle”), as per the guidance provided by the General Court (“GC”) 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 fur 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”.

8. When making a comparison, all relevant factors relating to the services in question should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“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.”

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

“(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.”

10. 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).”

11. I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL 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.”

12. The applicant seeks registration for various services in class 41, as follows:

Educational services; entertainment services; training; sporting and cultural activities; provision and organisation of indoor leisure activities; provision of indoor play centres; provision of trampoline parks; provision of fitness classes; organising of sports competitions and events; rental of sports equipment and facilities; sports tuition, coaching and training; leisure services; information, advisory and consultancy services in relation to all of the aforesaid.

13. In relation to the opponent's specification, the opponent submits, a submission with which I agree, that its specification should not be limited to the field of television and broadcasting. As I have already noted, the opponent is able to rely on its specification in class 41 as it stands on the register, with a notional comparison being made. The opponent's class 41 specification reads:

Teaching, education, training and entertainment services; Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line.

14. Given the scope of the opponent's specification, some of the applied for services are clearly identical because they have essentially identical counterparts, namely: educational services; entertainment services; training.

15. I also accept that the opponent's "training" includes within its ambit the following applied for terms: "provision of fitness classes; sports tuition, coaching and training". These services are identical on the inclusion principle. I will go through the rest of the applied for specification term by term:

Sporting.....activities

16. The earlier mark does not cover sporting activities. Whilst sporting activities could be undertaken to entertain oneself, this would be stretching the meaning of the term entertainment too far. Further, I consider the nature and purpose of entertainment and sporting activities to be quite different. It is unlikely that a competitive choice would be made between one and the other, and there is nothing to suggest that the services are complementary. I note that the earlier mark also covers training services, which could theoretically relate to sport. However, whilst this may create a degree of complementarity, there is no evidence to show how strong that link is. In summary, I consider that there is no similarity with entertainment services and only a low level of similarity with training.

....cultural activities

17. Entertainment services could include those of a cultural nature and, in principle, I consider the services to be identical on the inclusion principle. If they are not identical then they are highly similar. I further note that the earlier mark also includes “organization of exhibitions for cultural purposes” which must also be considered highly similar given the similarity in nature, purpose and trade channels etc.

Provision and organisation of indoor leisure activities; leisure services

18. The term “leisure activities” is a broad one and covers services which could be for entertainment purposes. Given this, these services are highly similar on account of their similarity in nature, purpose and trade channels etc.

Provision of indoor play centres; Provision of trampoline parks

19. I do not consider these terms to naturally fall within the scope of entertainment. There is neither identity nor similarity with such a term. Neither is there any evidence to show that any form of complementarity exists with training and the like. These services are not similar.

Organising of sports competitions and events

20. In the absence of any sporting services in the earlier mark, I can see no obvious aspects of similarity with the earlier mark's specification. The best one can argue is on the basis of the opponent's training services, because the training could relate to sport. However, there is no reason to find that sporting training services are similar (even on a complementary basis) to arranging sports competitions and events. I find no similarity here.

Rental of sports equipment and facilities

21. As already stated, the earlier mark does not cover sporting services. These rental services are even further away from the earlier mark's specification (including its training services) than the already assessed sporting activities. I come to the view that there is no similarity here.

Information, advisory and consultancy services in relation to all of the aforesaid

22. This term rests and falls with the aforesaid services already assessed, with the same degree of similarity (where applicable).

Summary of findings:

23. Based on all of the above, my findings on similarity can be summarised as:

Identical: Educational services; entertainment services; training; provision of fitness classes; sports tuition, coaching and training;cultural activities [if not identical, highly similar]; information, advisory and consultancy services in relation to all of the aforesaid.

Highly similar [with the opponent's entertainment]: Provision and organisation of indoor leisure activities; leisure services; information, advisory and consultancy services in relation to all of the aforesaid.

Low level of similarity [with the opponent's training]: Sporting....activities; information, advisory and consultancy services in relation to all of the aforesaid.

No similarity: Provision of indoor play centres; provision of trampoline parks; organising of sports competitions and events; rental of sports equipment and facilities; information, advisory and consultancy services in relation to all of the aforesaid.

24. In relation to the services for which I have found no similarity, there can be no likelihood of confusion under section 5(2)(b) because some similarity is required. Consequently, I say no more about such services, with the opposition failing to that extent.

Average consumer and the purchasing act

25. 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.”

26. The conflicting services are in the fields of leisure and entertainment, education, and sporting activities. The average consumer will be a member of the general public for most of these services, although some education/training may be aimed at the

business world. Generally speaking, most of the services will be selected with a normal level of care and attention, no higher or lower than the norm. Education/training services may be slightly more considered in their selection, but not to the highest degree. The services will be selected via mainly visual means by perusing information in brochures, leaflets, websites etc, although, I will not ignore the aural impacts of the marks completely.

Comparison of marks

27. 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.”

28. 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 I am comparing are:

JUMP NINJA v **NINJA.COM**

29. In terms of overall impression, JUMP NINJA consists of two words with neither, in my view, materially dominating the other. The words make a roughly equal contribution

to the overall impression. NINJA.COM is clearly a domain name. Given this, it is probable that more focus will be placed on the NINJA part, with this word having greater relative weight in the overall impression. The opponent submits that the .COM element will be largely ignored - whilst I understand the point, .COM still plays a role within the overall impression as it functions to create the overall domain name.

30. Visually, both marks contain the word NINJA. This creates an inevitable degree of similarity. However, there are visual differences including: the additional word JUMP in the applied for mark, the additional .COM in the opponent's mark, that the word NINJA is at the start of the opponent's mark whereas it is at the end of the applied for mark. I consider this equates to a moderate (between low and medium) degree of visual similarity.

31. Aurally, a similar assessment to that made above follows through to the aural comparison, with those similarities and differences feeding through to the way in which the marks will be articulated – JUMP-NIN-JA against NIN-JA-DOT.COM. I consider there to be a moderate (between low and medium) degree of aural similarity.

32. Conceptual, both marks conjure up the image of a ninja, a word which is well known in the UK. The applied for mark has an added concept based on the word JUMP, suggesting in some way that the ninja may be jumping. Whilst the .COM element turns the opponent's mark into a domain name, this does not negate the similarity in concept based on the meaning of the word ninja. I consider there to be a medium degree of conceptual similarity.

Distinctive character of the earlier mark

33. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

34. No use of the earlier mark has been provided so I have only its inherent characteristics to consider. The word NINJA has no real suggestive or allusive characteristics in respect of the services relied upon by the opponent. I consider it to have a medium degree of inherent distinctiveness which is not materially affected by the addition of .COM.

Likelihood of confusion

35. 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 (effectively occurring 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). The difference between these two forms of confusion was explained 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).”

36. Some of the services are identical. The opponent is in its strongest position here because a higher degree of similarity between the services may offset the lower degree of similarity between the marks. The earlier mark also has a medium degree of inherent distinctive character. In terms of direct confusion, even bearing in mind the concept of imperfect recollection, I consider there are sufficient differences overall that there is no likelihood of the consumer mistaking one mark for the other. They will not be directly misremembered/miscalled as each other.

37. That then leaves indirect confusion. In my view, the level of distinctiveness of the earlier mark, together with the degree of mark similarity, and particularly bearing in mind the shared NINJA concept, means, in my view, that where the services are identical or highly similar there is a likelihood that the average consumer will believe that the respective services come from the same or an economically linked undertaking. They will likely see it as a new brand variant. Thus, I disagree with the applicant’s submission that the shared NINJA element is insufficient to cause confusion. However, there will be no likelihood of confusion for those services which I found to have only a low degree of similarity - there is too great a leap for the average consumer to make the required economic connection.

Conclusion

38. The opposition succeeds in relation to:

Class 41: Educational services; entertainment services; training; cultural activities; provision and organisation of indoor leisure activities; provision of fitness classes; sports tuition, coaching and training; leisure services; information, advisory and consultancy services in relation to all of the aforesaid.

but fails, and the mark (subject to appeal) may be registered in relation to:

Class 41: Sporting activities; provision of indoor play centres; provision of trampoline parks; organising of sports competitions and events; rental of sports equipment and facilities; information, advisory and consultancy services in relation to all of the aforesaid.

Costs

39. Given the roughly equal measure of success, I do not intend to favour either party with an award of costs.

Dated this 19th day of February 2018

Oliver Morris

For the Registrar,

The Comptroller-General