

O/671/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003380063

BY BAM BAM BOOGIES CIC

TO REGISTER THE TRADE MARK:

Bam Bam Boogies

IN CLASSES 25 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001158 BY

KUTEYI CONSULTING LTD

BACKGROUND AND PLEADINGS

1. On 4 March 2019, Bam Bam Boogies CIC (“the applicant”) applied to register the trade mark **Bam Bam Boogies** in the UK. The application was published for opposition purposes on 29 March 2019. Registration is sought for the following goods and services:

Class 25 Dance clothing.

Class 41 Dance club services; Dance events; Dance instruction; Dance instruction for adults; Dance instruction for children; Dance schools; Dance studios; Aerobic and dance facilities; Entertainment in the nature of dance performances; Entertainment in the nature of live dance performances; Live dance exhibitions; Performance of dance, music and drama.

2. The application was opposed by Kuteyi Consulting Ltd (“the opponent”) by way of the Fast Track opposition procedure commenced on 28 June 2019. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK registration no. 3331760 for the trade mark **Bam Bam Boogie**. The earlier mark was filed on 15 August 2018 and registered on 9 November 2018. The opponent relies upon all services for which the mark is registered, namely:

Class 41 Fitness and exercise instruction; Fitness and exercise training services; Fitness training services; Physical fitness centre services; Physical fitness centres; Physical fitness centres (Operation of -); Physical fitness consultation; Physical fitness education services; Physical fitness instruction; Physical fitness instruction for adults and children; Physical fitness training services; Physical fitness tuition; Providing fitness and exercise facilities; Provision of educational health and fitness information; Provision of educational services relating to fitness; Provision of information on fitness training via an online portal; Sports and fitness; Sports and fitness services; Training services relating to fitness; Tuition in physical fitness; Dance club services; Dance events;

Dance instruction; Dance instruction for adults; Dance instruction for children; Dance schools; Dance studios; Aerobic and dance facilities; Entertainment in the nature of dance performances; Entertainment in the nature of live dance performances; Live dance exhibitions; Providing dance studio facilities; Providing instruction in the field of dance; Provision of dance classes.

3. The opponent submits that there is a likelihood of confusion because the goods and services are identical or similar, and the marks are similar.

4. The applicant filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. Both parties are unrepresented.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate costs; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUE

9. In its written submissions in lieu, the applicant references its use of the applied for mark prior to the date of the application (dating back to 2004). The applicant states that it has unregistered rights to the applied for mark and that the opponent's mark should be declared invalid pursuant to section 47(2)(b) of the Act.

10. For the avoidance of doubt, the fact that the applicant claims to have used its mark prior to the opponent's mark being applied for/registered, is not a defence in law to the opposition under section 5(2)(b). Tribunal Practice Notice 4/2009 explains this as follows:

"The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark.

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

11. The applicant has not made an application to invalidate the opponent's mark based on its claim to an earlier unregistered right. Section 72 of the Act states that registration shall be taken as prima facie evidence of the validity of a registered trade mark. The opponent's trade mark must be regarded as validly registered and, in these

circumstances, the law requires priority to be determined according to the filing dates of the applications for registration. This means that the opponent's mark has priority.

DECISION

12. Section 5(2)(b) of the Act states as follows:

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

(a)...

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

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

13. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant's mark pursuant to section 6 of the Act. As the opponent's trade mark had not completed its registration process more than 5 years before the date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the services it has identified.

Section 5(2)(b) – case law

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 and services

15. The competing goods and services are as follows:

Opponent's services	Applicant's goods and services
<u>Class 41</u> Fitness and exercise instruction; Fitness and exercise training services; Fitness training services; Physical fitness centre services; Physical fitness centres; Physical fitness centres (Operation of -); Physical fitness consultation; Physical fitness education services; Physical fitness instruction; Physical fitness instruction for adults and children; Physical fitness training services; Physical fitness tuition; Providing fitness and exercise facilities; Provision of	<u>Class 25</u> Dance clothing. <u>Class 41</u> Dance club services; Dance events; Dance instruction; Dance instruction for adults; Dance instruction for children; Dance schools; Dance studios; Aerobic and dance facilities; Entertainment in the nature of dance performances; Entertainment in the nature of live dance performances; Live dance exhibitions;

<p>educational health and fitness information; Provision of educational services relating to fitness; Provision of information on fitness training via an online portal; Sports and fitness; Sports and fitness services; Training services relating to fitness; Tuition in physical fitness; Dance club services; Dance events; Dance instruction; Dance instruction for adults; Dance instruction for children; Dance schools; Dance studios; Aerobic and dance facilities; Entertainment in the nature of dance performances; Entertainment in the nature of live dance performances; Live dance exhibitions; Providing dance studio facilities; Providing instruction in the field of dance; Provision of dance classes.</p>	<p>Performance of dance, music and drama.</p>
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16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

17. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“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 for 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.”

Class 25

19. “Dance clothing” in the applicant’s specification clearly differs in nature, method of use and purpose to the opponent’s services. The fact that users of the opponent’s services may also be users of dance clothing is not sufficient, by itself, for a finding of

similarity. The goods and services are not in competition and are not complementary as defined by the case law; neither is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the goods and services lies with the same undertaking.¹ However, I accept that there may be overlap in trade channels. For example, “dance studios” in the opponent’s specification may sell their own range of dance clothing. I consider there to be a low degree of similarity between the goods and services.

Class 41

20. “Performance of dance [...]” in the applicant’s specification is self-evidently identical to “entertainment in the nature of dance performances” in the opponent’s specification. “Performance of [...] music and drama” in the applicant’s specification will overlap in trade channels, user, uses, method of use and nature with “entertainment in the nature of dance performances” in the opponent’s specification. These services are highly similar.

21. The remaining services in class 41 of the applicant’s specification are replicated identically in the opponent’s specification.

The average consumer and the nature of the purchasing act

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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

¹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

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.”

23. The average consumer for the goods and services will be a member of the general public. The goods and services are unlikely to be highly expensive. However, various factors will still be taken into consideration during the purchasing process such as aesthetic appearance, target age group or type of class or dance instruction provided. I, therefore, consider that a medium degree of attention will be paid during the purchasing process.

24. The goods are most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. I acknowledge that verbal advice may be sought from a sales assistant or representative. The services are likely to be purchased following inspection of the physical premises, the website of the service provider or an advert (either online or in the form of a physical flyer or poster). I recognise that word-of-mouth recommendations may also play a part. Consequently, visual considerations will dominate the selection process, although I do not discount that there will also be an aural component to the purchase of the goods and services.

Comparison of trade marks

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

26. 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.

27. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
Bam Bam Boogie	Bam Bam Boogies

28. The opponent's mark consists of the words BAM BAM BOOGIE in title case. The overall impression lies in the combination of these words. The applicant's mark consists of the words BAM BAM BOOGIES in title case. Again, the overall impression lies in the combination of these words.

29. Visually, the only difference between the marks is the addition of the “S” at the end of the applicant's mark. I consider the marks to be visually highly similar.

30. Aurally, the only difference in the pronunciation of the marks will be the pluralisation of the word “BOOGIE” in the applicant's mark. I consider the marks to be aurally highly similar.

31. Conceptually, the words “BOOGIE” and “BOOGIES” are both likely to be seen as a reference to dancing.² The words “BAM BAM” are unlikely to be attributed any particular meaning. I do not consider that the addition of the “S” significantly affects

² <https://dictionary.cambridge.org/dictionary/english/boogie>

the meaning of the applicant's mark. I consider the marks to be conceptually highly similar.

Distinctive character of the earlier trade mark

32. 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-2779, 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).”

33. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

34. There is no evidence to support a finding of enhanced distinctiveness and, consequently, I have only the inherent position to consider. As noted above, the word BOOGIE will be seen as a reference to dancing, which will be descriptive of some of the services provided. The words BAM BAM will be viewed as invented words. Taken as a whole, I consider that the earlier mark has a medium degree of inherent distinctive character.

Likelihood of confusion

35. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

36. I have found the marks to be visually, aurally and conceptually highly similar. I have found the opponent's mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public, who will select the goods and services primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will be medium. I have found the parties' goods and services vary from identical to similar to only a low degree.

37. Taking all of these factors into account, as well as the principle of imperfect recollection, I am satisfied that the marks will be misremembered or mistakenly recalled as each other. Taking into account the interdependency principle, I consider this will be the case even for those goods and services that share only a low degree of similarity, as this will be offset by the high degree of similarity between the marks. I consider there to be a likelihood of direct confusion.

CONCLUSION

38. The opposition is successful, and the application is refused.

COSTS

39. The opponent has been successful and would normally be entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2015. However, as the opponent is unrepresented, the tribunal wrote to the opponent on 3 September 2019 and invited it to indicate whether it intended to make a request for an award of costs. The opponent was informed that, if so, it should complete a proforma, providing details of its actual costs and accurate estimates of the amount of time spent on various activities in the prosecution of the opposition. The opponent was informed that, "if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded". No proforma was filed by the opponent. That being the case, I award the opponent the sum of £100 only in respect of the official opposition fee.

40. I therefore order Bam Bam Boogies CIC to pay Kuteyi Consulting Ltd the sum of £100. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 5th day of November 2019

S WILSON

For the Registrar