

O/746/19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3336377 BY
WHITE CUFFS LLC
TO REGISTER:**

FIRE TV CUBE

AS A TRADE MARK IN CLASSES 9, 35, 38, 41 AND 42

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 414348 BY
GROUPE CANAL+ SA**

Background and Pleadings

1. White Cuffs LLC (“the applicant”) applied to register **FIRE TV CUBE** as a trade mark in the United Kingdom on 5 September 2018. It was accepted and published in the Trade Marks Journal on 14 September 2018 in respect of goods and services in Classes 9, 35, 38, 41 and 42. The full specification can be found in the Annex to this decision.

2. The application was opposed by Groupe Canal+ SA (“the opponent”) on 14 November 2018. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods and services in the application. The opponent is relying on European Union Trade Mark (EUTM) No. 8699291, which was registered on 27 May 2010:



The colours claimed are black, white and grey. The mark is registered in respect of the following goods and services:

Class 9

Decoders; Remote controls; antennas satellite dishes.

Class 35

Retailing and wholesaling of set-top boxes; Retail sale of aerials; Arranging subscriptions to audiovisual programmes; Arranging subscriptions to a television channel.

Class 38

Television communication; Transmission of videos and images; Television broadcasting; Broadcasting of programmes via satellite, via cable, via computer networks (in particular via the internet), and via radio waves; Audiovisual and

cinematographic broadcasting, whether or not for interactive purposes; Rental of aerials and satellite dishes; Transmission of programmes and selection of television channels.

Class 41

Rental of decoders.

Class 42

Online downloading of films and other audiovisual programmes.

3. The opponent claims that the goods and services of the application are identical or similar to the goods and services of the registration, and that the marks are similar, owing to the presence in both of the “prominent and distinctive element” **CUBE**. The opponent therefore claims that there is a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier mark.

4. The applicant filed a defence and counterstatement, denying all the grounds and requesting that the opponent provide evidence of proof of use of the earlier mark for all the goods and services in respect of which it stands registered.

5. Both parties filed evidence in these proceedings. This will be summarised to the extent that is considered necessary.

6. The applicant filed written submissions on 18 June 2019. These will not be summarised but will be referred to as and where appropriate during this decision.

7. A Hearing took place before me on 29 October 2019, with the opponent represented by Tim Rose of Wilson Gunn and the applicant by Nick Bolter of Cooley (UK) LLP.

Preliminary issue

8. At the hearing, Mr Bolter sought the admission as evidence of two examination reports, one from the Registry dated 10 October 2019 and the other from the European Intellectual Property Office (EUIPO) dated 11 October 2019, which both refused

registration of a mark consisting solely of the word “CUBE”, as lacking in distinctiveness. As these reports had only recently become available, it had not been possible to provide them earlier. Mr Rose submitted that these letters should not be admitted to the proceedings, as they did not necessarily represent the final outcome on either of those applications, as the periods for responding to these objections had not finished. Having listened to both parties’ submissions, I was not satisfied that the additional evidence would have an important influence on the proceedings and refused the request to admit this further evidence.

Evidence

9. The opponent’s evidence comes from M. Clement Hellich Praquin, the Corporate General Counsel of Group Canal+ SA, a position he has held since 2016.

10. Mr Praquin states that the opponent was founded in 1998 and is active in free-to-air and pay-TV broadcasting. It also has an advertising sales division. He notes that the opponent has three national channels in France, is the top pay-TV broadcaster in French-speaking countries around the world, and is also “a leader” in pay-TV in France, Poland and Vietnam. Mr Praquin states that the earlier mark has been used in relation to set-top boxes (decoders) and associated goods and services. The boxes have been on the market since 4 November 2008.

11. Attached to the witness statement are 29 exhibits. These contain corporate information, extracts from websites showing goods and services on sale, information about programming, figures for the numbers of subscribers owning decoders bearing the mark, and press articles. Most of the exhibits are in French although partial English translations have been provided. I shall refer to individual exhibits in more detail where necessary in my decision.

12. The applicant is an affiliate of Amazon.com. Its evidence comes from Martin George Henshall, an associate solicitor with Cooley (UK) LLP, the representatives for the applicant. His witness statement is directed towards showing that “CUBE” is a descriptive and non-distinctive term and that a number of other “CUBE” marks coexist

with the opponent's mark, both on UK and EU trade mark registers and in the marketplace.

DECISION

Proof of Use

13. The opponent's earlier mark had been registered for more than five years on the date on which the contested application was published. It is, therefore, subject to the proof of use provisions under section 6A of the Act, and the applicant has requested such proof for all the goods and services in respect of which it stands registered. The opponent has stated that it has made genuine use of the marks in the EU in the relevant period for all the goods upon which it is relying. The relevant period for these purposes is the five years prior to and ending on the date of publication of the contested application: 15 September 2013 to 14 September 2018.

14. Section 6A of the Act states that:

“(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

15. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2349, *La Mer* (cited above); Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundesvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create

or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [132].”

16. The onus is on the opponent, as the proprietor of the earlier mark, to show use. Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17. The relevant territory in which use should be shown is the EU. Exhibit MCHP-19 contains some subscriber figures. These are only for one month, but provide a snapshot: in April 2015, 3,367,978 million subscribers had a decoder supplied under the earlier mark or a variant thereof. The location of those subscribers is not stated in that exhibit. However, as of 31 December 2014, nearly two-thirds of the opponent’s 15.3 million subscribers were located in France.¹ The geographical extent of the use shown is, however, just one of the factors to be taken into account in assessing whether there has been genuine use.

18. The opponent submits that the decision by the Cancellation Division of the EUIPO (No. 11012 C) is evidence that it has made genuine use of the mark for all the goods and services that remain in the specification.² Such decisions are not binding on this tribunal, and in any case the relevant periods are different. The application for revocation had been filed at the EUIPO on 11 June 2015 and it is not clear from the parts of the decision that have been translated into English whether the evidence showed use within any part of the five-year period that is relevant for the purposes of these proceedings. The applicant, on the other hand, submits that the opponent has not shown genuine use of the earlier mark.

19. The earlier mark as registered is as follows:

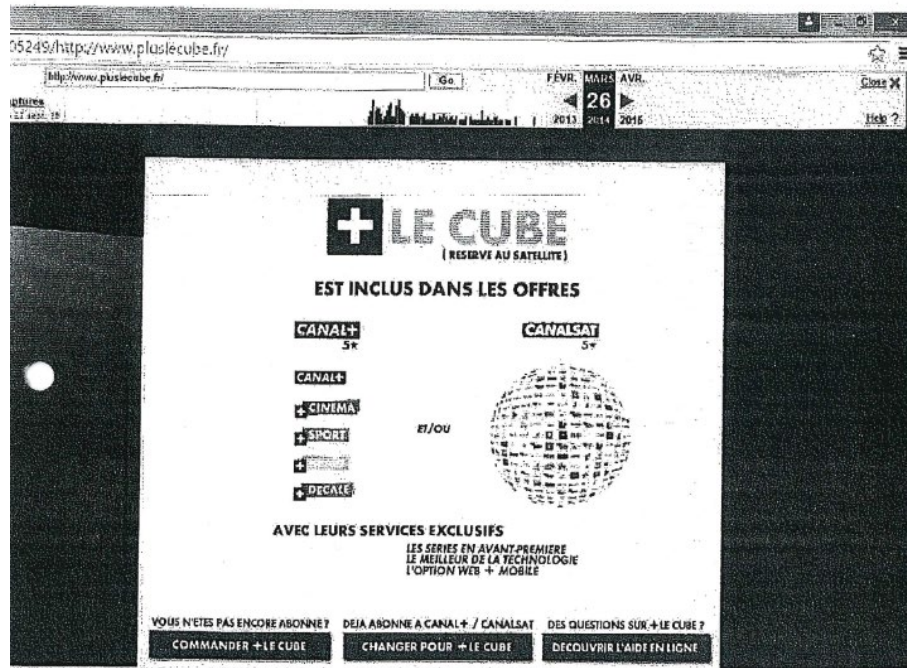


20. The mark as registered appears on a printout from the website www.pluslecube.fr dated 26 April 2014 and retrieved by an internet archive service.³

¹ Exhibit MCHP-01, page 4.

² Exhibit MCHP-02.

³ Exhibit MCHP-22, page 222.



It is not clear what goods or services are supplied under this mark. The partial translation reads “+LE CUBE (only for satellites) is included within the packages CANAL+ and CANALSAT”.⁴

21. The other exhibit that contains images of the mark as registered is Exhibit MCHP-12. This consists of screenshots from a Caribbean-facing website. The partial translation offers the non-French reader little assistance. It says that page 1 contains the following statements:

“You must have this equipment to receive our TV packages by satellite”.

“+LE CUBE

- Watch for a first or second time CANAL+ and CINE+ programmes”⁵

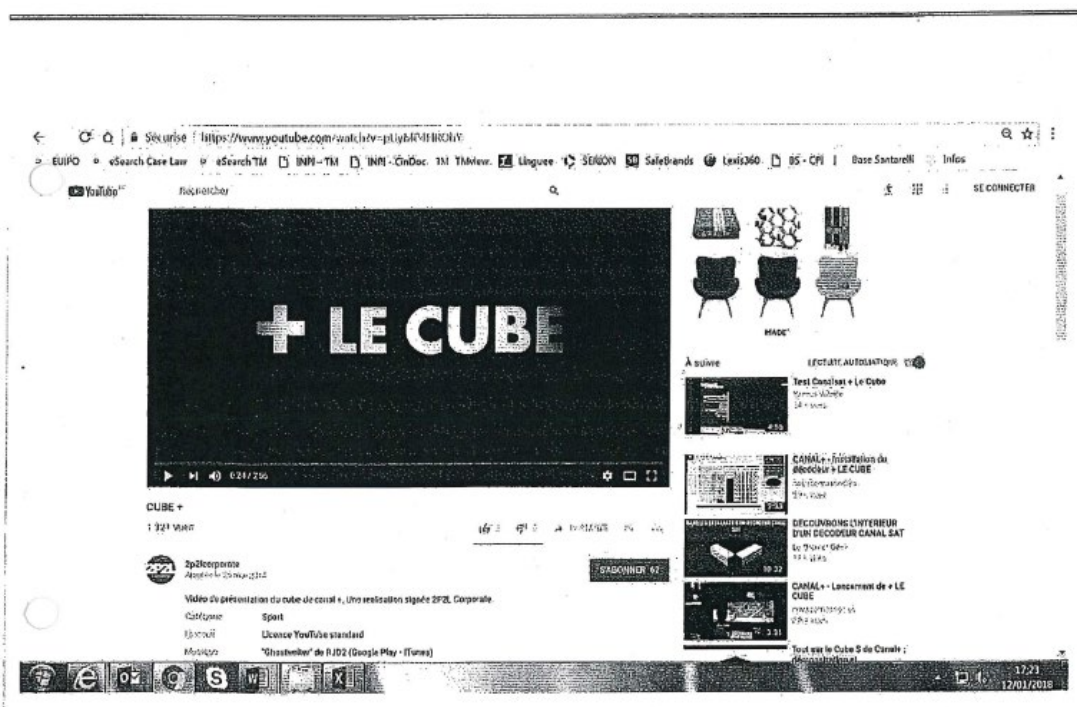
22. Page 1, however, contains a great deal of text. It is possible, by a logical process, for the non-French reader to identify the second phrase and associate it with the mark. With regard to the first one, the reader simply has to guess. What one can say is that the mark relates to some equipment that enables the consumer to watch CANAL+ and

⁴ Page 223.

⁵ Page 163.

CINE+ programmes. The average consumer will assume these are television services. Prices for these services are shown in euros. However, I do not think that whether any of the French-speaking Caribbean territories are part of the EU is a fact so well known that I may take judicial notice of it.

23. On the opponent's website and Twitter account, the mark appears as **+LE CUBE** or **+LE CUBE**.⁶ It is also seen in the latter form on a fee schedule dating from 2016 and showing the amount of deposit required and the monthly rental fee.⁷ Another variant is shown in the screenshot below, taken from a video on Youtube.⁸ The date when the video was uploaded is not entirely clear. However, the print was made on 12 January 2018 so it was accessible by consumers during the relevant period. All the characters appear to be in the same colour and there is no obvious contrasting background around the plus symbol. All these uses are in relation to decoders and reception equipment. I must consider whether these forms are acceptable variants under section 6A(4)(a) of the Act.



⁶ See, for example, Exhibits MCHP-08 and MCHP-05 respectively.

⁷ Exhibit MCHP-09, page 125.

⁸ Exhibit MCHP-24, page 234.

24. In *NIRVANA Trade Mark*, BL O/262/06, Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, summarised the test as follows:

“33. ... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

25. In *Menelaus BV v EUIPO*, Case T-361/13, the General Court (GC) found that use of the marks shown below on the left and in the middle constituted use of the registered mark on the right:



The court held that the word “VIGAR” was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

“73. [The first sign] differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different

orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term 'vigar', are minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

74. That finding is not called into question if the second form of use ... is taken into account inasmuch as, even though, in that case, the basic background disappears and the word 'spain' is present, the latter will be understood as a merely descriptive addition."

26. I shall consider the degree of distinctiveness of the mark later in my decision, but at this stage I note that there are two distinctive elements: the plus symbol and the words. These are present in both marks. The black square seems to me to be relatively banal and simply serves to highlight the plus symbol. Consequently, I find that the differences of presentation are minor and do not alter the distinctive character of the earlier mark.

27. I must now consider what would be a fair specification. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Carr J summed up the law as follows.

"iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly

describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

28. Based on the evidence before me, the mark has been used in connection with the television reception equipment, rather than broadcasting and other content delivery services. This remains the case even if I am wrong about **+LECUBE** being an acceptable variant. The average consumer would expect this to cover the decoders, but also remote controls, as these are generally used to operate such devices, and the

equipment used to enable content to be received. Consequently, I find that the opponent has shown use for the following goods and services, on which it may rely:

Class 9

Decoders; Remote controls; antennas satellite dishes.

Class 35

Retail and wholesaling of set-top boxes.

Class 38

Rental of aerials and satellite dishes.

Class 41

Rental of decoders.

Section 5(2)(b)

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

“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.”

30. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG (C-251/95)*, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*

(C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v OHIM* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone 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 and services

31. Some of the contested goods and services (for example, *television decoders, remote controls and retail store services and online retail store services connected with the sale of ... set top boxes*) are identical to the goods or services on which the opponent may rely. I will begin my examination of the opposition on the basis that the contested goods or services are identical to those covered by the earlier trade mark. If the opposition fails, even where the goods or services are identical, it follows that the opposition will also fail where the goods or services are only similar. I shall return to the goods and services comparison later in my decision, if required.

Average consumer and the purchasing process

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, I must bear in mind that the average consumer's level of attention is likely to vary

according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.

33. In *Hearst Holdings Inc, Fleisher Studios Inc v A.V.E.L.A. Inc and others* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”⁹

34. The average consumer for the goods and services at issue is a member of the general public. These will be relatively infrequent purchases and the cost is likely to vary. Some of the goods, such as remote controls, are fairly cheap, while a decoder would be more expensive, although the cost of the latter may be included in a subscription television package that also provides access to broadcasting services for one payment. Such services are unlikely to be frequently changed. The purchase will be made visually, as the consumer will have the opportunity to see printed brochures and advertisements and websites. However, word-of-mouth recommendations will also play a part. In my view, the average consumer will be paying an average level of attention.

Comparison of marks

35. It is clear from *SABEL* (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


⁹ Paragraph 60.

marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”¹⁰

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

37. The respective marks are shown below:

Opponent's mark	Applicant's mark
	FIRE TV CUBE

38. The opponent's mark consists of a black square containing a white plus sign. To the right of this device are the words "LE CUBE" in grey capitals in a standard sans serif typeface. The opponent submits that the word "CUBE" has an independent distinctive role. I agree that the average UK consumer will notice that the mark has elements that could stand on their own, although both the device and the words make a contribution to the overall impression of the mark. I find neither to be dominant, as the device benefits from a darker colouring that makes it stand out and is the first element, but the eye is also drawn to words. In my view, the average UK consumer will know that "le" is French for "the", and so the words form a unit. "CUBE" may allude

¹⁰ Paragraph 34.

to the shape of some of the goods, but, in my view, for a UK consumer the presence of the French definite article gives it some distinctiveness.

39. The applicant's mark consists of three words. The second word, "TV", describes some of the goods and services, and alludes to others. The distinctive elements of the mark are therefore the first and third words. As with the opponent's mark, the word "CUBE" may refer to the shape of some of the goods (such as a television decoder). For these, "FIRE" will be the dominant and distinctive element; for other goods and services, "CUBE" plays an independent distinctive role.

Visual comparison

40. The applicant's mark is a word mark. Normal and fair use of this mark would cover use in upper- or lower-case, a standard typeface and any colour. It shares the word "CUBE" with the opponent's mark, and in both cases that word is placed at the end of the mark. The opponent's mark has an additional device element, which is not present in the applicant's mark. In addition, the positioning of the dominant and distinctive element "FIRE" draws the attention to a different part of the mark, I find the marks to be visually similar to a low degree.

Aural comparison

41. The applicant's mark will be pronounced in full, with four syllables. Some consumers will articulate the opponent's mark as "PLUS-LE-CUBE". I note that this is also how it appears in a web address used by the opponent. However, others will simply say "LE-CUBE". All the marks end with the same syllable. I find the marks to be aurally similar to a low degree.

Conceptual comparison

42. I find the marks to be conceptually different. The word "FIRE" at the beginning of the applicant's mark will bring to mind the ideas of heat or warmth, perhaps something exciting. The plus symbol in the opponent's mark could be seen to indicate extra or improved services. Some consumers may even see the symbol as a cross.

Distinctiveness of the earlier mark

43. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

“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).”

44. The opponent has adduced no evidence to show that it has used its mark in the UK and consequently the inherent distinctiveness is all I need to consider here. Earlier, I found that the device and “LE CUBE” played independent distinctive roles within the mark. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis QC, sitting as the Appointed Person, pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”¹¹

45. The device has no counterpart in the applicant’s mark, while both contain the word “CUBE”. For *decoders* and ancillary equipment (such as remote controls) I consider that the level of inherent distinctiveness is low. The word alludes to a shape that is seen in a range of electrical goods. For the services, the distinctiveness is slightly higher, but, as a dictionary word, this will be no more than medium.

Conclusions on likelihood of confusion

46. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 30. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa.¹² The distinctiveness of the earlier mark must also be taken into account.

47. Such a global assessment does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the goods and services and the nature of the purchasing process. I note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture he has kept in his mind.¹³

48. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, gave helpful guidance on making the global assessment:

¹¹ Paragraph 39.

¹² *Canon Kabushiki Kaisha*, paragraph 17.

¹³ *Lloyd Schuhfabrik Meyer*, paragraph 27.

“81.2 ... In my view it is important to keep in mind the purpose of the whole exercise of a global assessment of a likelihood of confusion, whether direct or indirect. The CJEU has provided a structured approach which can be applied by tribunals across the EU, in order to promote a consistent and uniform approach. Yet the reason why the CJEU has stressed the importance of the ultimate global assessment is, in my view, because it is supposed to emulate what happens in the mind of the average consumer on encountering, for example, the later mark applied for with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.

81.3 Third, when a tribunal is considering whether a likelihood of confusion exists, it should recognise that there are four options:

81.3.1 The average consumer mistakes one mark for the other (direct confusion);

81.3.2 The average consumer makes a connection between the marks and assumes that the goods or services in question are from the same or economically linked undertakings (indirect confusion);

81.3.3 The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);

81.3.4 For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services;

81.3.5 Accordingly, in most cases, it is not necessary to explicitly set out this fourth option, but I would regard it as a good discipline to set out the first three options, particularly in a case where a likelihood of indirect confusion is under consideration.”

49. Earlier in my decision, I made the following findings:

- The goods and services currently under consideration are identical.
- The average consumer will be paying an average degree of attention. The purchasing process is mainly visual, although word-of-mouth recommendations will play some part.
- The marks are visually and aurally similar to a low degree and conceptually different.
- The word “CUBE” plays an independent distinctive role in both marks.
- The shared element in the earlier mark has a low degree of inherent distinctiveness for some of the goods (namely television decoders), and a slightly higher degree of inherent distinctiveness for the services on which the opponent may rely.

50. The opponent draws my attention to the findings of the CJEU in *Medion* and submits that this case clearly states that there may be a likelihood of confusion if the common word between two marks has an independent distinctive role within the marks, even if it is not the dominant one.

51. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J (as he then was) considered the impact of the CJEU’s judgment in *Bimbo* on the court’s earlier judgment in *Medion*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the

composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can apply only in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meanings of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

52. Even taking into account the shared element of “CUBE”, I consider it unlikely that there will be direct confusion. The marks are too dissimilar, and the distinctiveness of “CUBE” is low to medium. The average consumer, who will be spending an average amount of attention when choosing what to buy, will not, in my view, assume they are the same, even where the goods and services are identical. I recall that I found that “FIRE” was the dominant and distinctive element of the applicant’s mark for some of

the goods. Where it is not the dominant and distinctive element, it is still the first part of the mark and, in general, the beginnings of marks have more visual and aural impact than the ends: see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

53. I shall now consider whether there is likely to be indirect confusion. In *Duebros*, Mr Mellor stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. The average consumer must assume that the goods and services are the responsibility of the same or connected undertakings. I cannot see a reason why this should be the case because the marks share the word “CUBE”, given that this is the only point of similarity. On encountering the applicant’s mark, the average consumer is, instead, likely to think that the brand is “FIRE” or “FIRE TV” and that “CUBE” is a sub-brand, given the order of the words and the distinctiveness of “FIRE” for the goods and services in the specification. Consequently, I find there is no likelihood of indirect confusion.

54. As I have found there to be no likelihood of confusion where the goods and services are identical, there will also be no likelihood of confusion where the goods and services are only similar.

Conclusion

55. The opposition has failed. The application by White Cuffs LLC may proceed to registration in respect of all the goods and services for which application is sought.

Costs

56. The applicant has been successful and is entitled to a contribution towards its costs, in line with the scale set out in Tribunal Practice Notice 2/2016. In the circumstances I award the applicant the sum of **£1700**. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement: £250

Preparing evidence and considering and commenting on the other side’s evidence: £800

Preparing for and attending a hearing: £650

Total: £1700

57. I therefore order Groupe Canal+ SA to pay White Cuffs LLC the sum of £1700. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of December 2019

Clare Boucher

For the Registrar,

Comptroller-General

ANNEX: GOODS AND SERVICES OF THE APPLICATION

Class 9

Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; data processing equipment; computers; information technology and audiovisual equipment; audio and video players; digital audio players; digital media streaming devices; digital video players; media players; radios; set top boxes; stereo systems, home theater systems, and home entertainment systems; televisions; television apparatus; television decoders; television receivers; television transmitters; video streaming devices; projection apparatus; remote controls; remote controllers; telecommunications apparatus and instruments; intercommunication apparatus; video telephones; stand-alone voice controlled information devices; voice and data transmitters and receivers; voice controlled speakers; voice recording and voice recognition apparatus; wireless communication devices for voice, data, or image transmission; 3D spectacles; wires, cables, adapters, plug-in connectors, electrical power connectors and docking stations; memory cards and memory card readers; speakers; microphones; headsets; cases, covers, and stands for portable electronic devices and computers; recorded content; media content; audiovisual recordings featuring entertainment programs; downloadable audiovisual and multimedia content featuring fiction and non-fiction stories on a variety of topics provided via a video-on-demand service; downloadable audio files, multimedia files, text files, written documents, audio material, video material featuring fiction and non-fiction content on a variety of topics; downloadable audio and video recordings featuring fiction and non-fiction stories on a variety of topics; downloadable motion pictures and television shows featuring fiction and non-fiction stories on a variety of topics; downloadable music files; software; computer software; application software; voice command and recognition software; speech to text conversion software; voice-enabled software applications; software for televisions; application software for televisions; application software for streaming audio-visual media content via the internet; computer software used for controlling stand-alone voice controlled information devices; computer software to enable users to view or listen to audio, video, text and multimedia content; computer software for creating and providing user access to searchable databases of information and data; computer software for wireless content delivery; computer

software for use in sharing information about products, services, and deals; computer software for electronic storage of data; computer software for image and speech recognition; computer software for purchasing, accessing and viewing movies, TV shows, videos, music, and multimedia content; software for access to communications networks including the Internet; software for analyzing and recovering data; downloadable mobile applications to enable users access to music, audio, video, games, audiovisual, multimedia content and other data; computer software for configuring, operating and controlling computers, and computer peripherals, and audio and video players; computer game software.

Class 35

Advertising; advertising services; advertising and marketing services, namely, promoting the goods and services of others; providing product information for the purpose of assisting with the selection of general consumer merchandise to meet the consumer's needs; retail store services and online retail store services connected with the sale of apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, data processing equipment, computers, information technology and audiovisual equipment, audio and video players, digital audio players, digital media streaming devices, digital video players, media players, radios, set top boxes, stereo systems, home theater systems, and home entertainment systems, televisions, television apparatus, television decoders, television receivers, television transmitters, video streaming devices, projection apparatus, remote controls, remote controllers, telecommunications apparatus and instruments, intercommunication apparatus, video telephones, stand-alone voice controlled information devices, voice and data transmitters and receivers, voice controlled speakers, voice recording and voice recognition apparatus, wireless communication devices for voice, data, or image transmission, 3D spectacles, wires, cables, adapters, plug-in connectors, electrical power connectors and docking stations, memory cards and memory card readers, speakers, microphones, headsets, cases, covers, and stands for portable electronic devices and computers; retail store services and online retail store services connected with the sale of recorded content, media content, audiovisual recordings featuring entertainment programs, downloadable audiovisual and multimedia content featuring fiction and non-fiction stories on a variety of topics provided via a video-on-demand

service, downloadable audio files, multimedia files, text files, written documents, audio material, video material featuring fiction and non-fiction content on a variety of topics, downloadable audio and video recordings featuring fiction and non-fiction stories on a variety of topics, downloadable motion pictures and television shows featuring fiction and non-fiction stories on a variety of topics, downloadable music files; retail store services and online retail store services connected with the sale of software, computer software, application software, voice command and recognition software, speech to text conversion software, voice-enabled software applications, software for televisions, application software for televisions, application software for streaming audio-visual media content via the internet, computer software used for controlling stand-alone voice controlled information devices, computer software to enable users to view or listen to audio, video, text and multimedia content, computer software for creating and providing user access to searchable databases of information and data, computer software for wireless content delivery, computer software for use in sharing information about products, services, and deals, computer software for electronic storage of data, computer software for image and speech recognition, computer software for purchasing, accessing and viewing movies, TV shows, videos, music, and multimedia content, software for access to communications networks including the Internet, software for analyzing and recovering data, downloadable mobile applications to enable users access to music, audio, video, games, audiovisual, multimedia content and other data, computer software for configuring, operating and controlling computers, and computer peripherals, and audio and video players, computer game software; subscription-based order fulfillment services in the fields of audiobooks, music, movies, TV shows, videos and games; computerized database and file management.

Class 38

Telecommunications; video-on-demand transmission; Internet protocol television (IPTV) transmission services; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; electronic transmission of information and data; electronic transmission and streaming of digital media content for others via global and local computer networks; telecommunication services, namely, transmission and streaming of voice, data, images, films, television programs, audio and audiovisual programs and other digital media content and

information by means of telecommunications networks, wireless communication networks, and the internet; streaming of audio, video and audiovisual material on the Internet, communications networks and wireless telecommunications networks; streaming of data; streaming of music, films, movies, TV shows and games on the Internet; broadcasting services; audio and video broadcasting services; broadcasting of cinematographic films and audiovisual programs; subscription-based audio and video broadcasting services over the Internet; broadcasting services and provision of telecommunication access to films, television programs, audio and audiovisual programs and other digital media content and information, provided via a video-on-demand service; Internet broadcasting services; Internet radio broadcasting services; telecommunication services, namely, transmission of webcasts; transmission of digital files; transmission of digital content by computer networks, the Internet, DSL, cable networks, digital download, digital streaming, video-on-demand, near-video-on-demand, TV, free-to-air TV, pay-per-view TV, satellite, cable, telephone or mobile telephone; electronic transmission of digital photo files among Internet users; providing access to online directories, databases, websites, blogs and reference materials; transmission of news; delivery of messages by electronic transmission; electronic transmission of mail and messages; podcasting services; providing an on-line forum for transmission of messages among computer users and the transmission of photos, videos, text, data, images and sound; transmission of television and movie guides; communication between computers; provision of access time to multimedia materials on the Internet; provision of telecommunications connections to computer databases; transmission of data by audio-visual apparatus controlled by data processing apparatus or computers.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; entertainment services, namely, providing information via a global computer network in the field of entertainment and entertainment-related topics; providing a website featuring non-downloadable audio, video and audiovisual content in the nature of recordings featuring movies, TV shows, videos and music; entertainment services, namely, providing temporary use of non-downloadable online video; provision of non-downloadable videos featuring programs on a wide variety of entertainment topics via a video-on-demand service; provision of non-downloadable films, movies and

television shows via a video-on-demand service; distribution and rental of entertainment content, namely computerized on-line searching and ordering service featuring movies, motion pictures, documentaries, films, television programs, graphics, animation and multimedia presentations, and other audiovisual works in the form of digital downloads and direct digital transmission viewable over computer networks and global communication networks; film and video rental services; rental of audio-visual works, specifically, motion pictures, television programming, videos, music videos, and music; film, movie, TV show and video production and distribution; audio and video recording services; providing a searchable database featuring audio, video and audiovisual content through the Internet, telecommunications networks and wireless telecommunications networks in the field of movies, TV shows, videos and music; providing online radio programming; digital audio, video and multimedia publishing services; entertainment services, namely, providing non-downloadable prerecorded music and audio programs featuring fiction and non-fiction stories on a variety of topics, and information in the field of music, and commentary and articles about music, all on-line via a global computer network; entertainment services, namely, live visual and audio performances, musical, variety, news, dramatic and comedy shows; entertainment services, namely, providing a website featuring the ratings and reviews of television, movies, videos, music, screenplays, scripts, books and video game content; entertainment information; providing online news, information and commentary in the field of entertainment; presenting live musical concerts and performances; entertainment services, namely, profiling of musicians, artists and bands by providing non- downloadable video clips of musical performances over a global computer network; providing non-downloadable interactive resource for searching, selecting, managing, and viewing audiovisual content in the nature of recordings featuring movies, TV shows, videos and music; providing online newsletters in the field of television, movies, and videos via e-mail; game services provided on-line from a computer network; providing karaoke services; radio entertainment; production of radio and television programmes; rental of sound recordings; subtitling; television entertainment.

Class 42

Scientific and technological services and research and design relating thereto; design and development of computer hardware and software; technical support services,

namely, troubleshooting in the nature of diagnosing computer hardware and software problems; application service provider (ASP), namely, hosting computer software applications for others; providing temporary use of non-downloadable computer software for controlling stand-alone voice controlled information devices; providing temporary use of non-downloadable computer software to enable users to view or listen to audio, video, text and multimedia content; providing temporary use of non-downloadable computer software for creating and providing user access to searchable databases of information and data; providing temporary use of non-downloadable computer software for wireless content delivery; providing temporary use of non-downloadable computer software for use in sharing information about products, services, and deals; providing temporary use of non-downloadable computer software for electronic storage of data; providing temporary use of non-downloadable computer software for image and speech recognition; providing temporary use of non-downloadable computer software for purchasing, accessing and viewing movies, TV shows, videos, music, and multimedia content; providing temporary use of non-downloadable software for access to communications networks including the Internet; providing temporary use of non-downloadable software for analyzing and recovering data; providing temporary use of non-downloadable computer software for configuring, operating and controlling computers, and computer peripherals, and audio and video players; providing temporary use of non-downloadable computer game software; electronic data storage; data backup and recovery services; hosting of digital content on the Internet; computer services, namely, creating computer network-based indexes of information, websites and resources; computer services, namely, uploading music and photos to the Internet for others; computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services in the fields of books, TV shows, films, music, entertainment, video games, fiction, and non-fiction; creating an on-line community for connecting video players, teams and leagues for the purpose of organizing game and sports activities; providing a website featuring technology that creates personalized movie, TV show, video and music channels for listening, viewing, and sharing; providing an online website featuring technology that enables users to share video game enhancements and game strategies; production of video and computer game software; provision of information, consultancy and advisory services relating to the aforesaid.