

BL O/1107/22

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3698846

BY

TRIPPIN RECORDS LTD

TO REGISTER THE TRADE MARK:

**TRIPPIN**

IN CLASS 9

-AND-

THE OPPOSITION THERETO UNDER No. 600002169

BY

TRIPPIN LIMITED

## **Background and pleadings**

1. TRIPPIN Records Ltd (“**the Applicant**”) applied to register the trade mark ‘TRIPPIN’ (“**the Contested Mark**”) in the UK on 22 September 2021 in respect of goods in Class 9. It was accepted and published in the Trade Marks Journal on 22 October 2021. The goods for which registration is sought are laid out in their entirety at **Annex 1** to this decision.
2. Trippin Limited (“**the Opponent**”) has opposed the Contested Mark on the basis of sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”).

### **Section 5(2)(a)**

3. Under its section 5(2)(a) claim the Opponent relies on the trade mark registration shown below (“**the Earlier Word Mark**”) which is registered in respect of Classes 16, 25, 38, 39 and 41. For the purposes of its section 5(2)(a) claim, the Opponent relies solely on the services set out in the table below:

Representation of the Earlier Word Mark:	TRIPPIN
Registration No.:	3521986
Filing Date:	12 August 2020 <sup>1</sup>
Registration Date:	25 December 2020
Services relied on: <sup>2</sup>	<u>Class 38</u>  Transmission of data and multimedia content via internet-enabled devices; <sup>3</sup> providing access to video sharing portals; webcasting services; Providing access to multimedia content online.

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<sup>1</sup> Given the respective filing dates, the Opponent’s mark is an earlier trade mark in accordance with section 6 of the Act.

<sup>2</sup> As the Earlier Word Mark had not been registered for five years or more at the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent does not need to show any use at all of the services upon which it relies.

<sup>3</sup> With regards to this term, see the Preliminary Issues section to this decision, my paragraph 23.

	<p><u>Class 41</u></p> <p>Video production; Entertainment information services; Information and advisory services relating to entertainment; Publication of the editorial content of sites accessible via a global computer network.</p>
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4. The opposition under section 5(2)(a) is directed solely against the following goods in the Opponent’s Class 9 specification:

*Audiovisual recordings; Video recordings; Downloadable media; Media content; Recorded media; Downloadable podcasts; Downloadable video recordings featuring music; sound, music, audio, visual and audio visual content and recordings; sound, music, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web.*<sup>4</sup>

5. The Opponent claims that the Contested Mark is identical to the Earlier Word Mark and that the applied-for goods are similar to the services on which it relies, giving rise to a likelihood of confusion.



Section 5(2)(b)

6. Under its section 5(2)(b) claim the Opponent relies on the trade mark registration shown below (“**the Earlier Figurative Mark**”) which is a series of two marks, and is registered in respect of Classes 9, 16, 25, 39, 41 and 45. For the purposes of its Section 5(2)(b) claim, the Opponent relies solely on its goods in Class 9 as

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<sup>4</sup> I note the Opponent’s TM7F included a duplicate reference to the term “*downloadable media*” which I have removed from this list.

set out in the table below:

Representations of the Earlier Figurative Mark:	<u>1 of 2:</u> 	<u>2 of 2:</u> 
Registration No.:	3284192	
Filing Date:	22 January 2018 <sup>5</sup>	
Registration Date:	4 May 2018	
Goods relied on: <sup>6</sup>	<u>Class 9</u>  Audio tapes; compact discs; videos; television films; cinematographic films; computer software; publications in electronic form supplied on-line from databases or from the Internet (including web sites); computer software and hardware to enable searching of data and connection to databases and the internet; downloadable digital music; digital music downloadable from the internet; music recordings; downloadable smart phone applications (software); downloadable smart phone application software.	

7. The opposition under section 5(2)(b) is directed against all the goods applied for in Class 9.
8. The Opponent claims that the Contested Mark is similar to the Earlier Figurative

<sup>5</sup> Given the respective filing dates, the Opponent's mark is an earlier trade mark in accordance with Section 6 of the Act.

<sup>6</sup> As the Earlier Figurative Mark had not been registered for five years or more at the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent does not need to show any use at all of the goods upon which it relies.

Mark and that the respective goods in Class 9 are identical or similar, giving rise to a likelihood of confusion.

9. The applicant filed a counterstatement denying the claims made under sections 5(2)(a) and 5(2)(b) of the Act.
10. This is an opposition to which the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 applies, deemed a 'Fast Track' opposition. As there was no use requirement, the Opponent did not file any evidence with its notice of Opposition. Only the Opponent filed written submissions,<sup>7</sup> and neither party sought leave to file evidence nor made any request to be heard. This decision has therefore been taken following a careful perusal of the papers.
11. In these proceedings the Opponent is represented by Gunnercooke LLP and the Applicant acts on its own behalf.
12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Preliminary Issues**

### **The Opponent's 'Witness Statement'**

13. In the Registry's letter to the Opponent dated 31 August 2022, the Registry informed the Opponent that it could file written submissions in these proceedings in accordance with Tribunal Practice Notice 2/2013, and the Opponent was given a deadline in which to file its submissions. In its letter, the Registry also informed the Opponent that a request for leave to file evidence should be submitted by a given deadline.
14. The Registry's letter clarified that "*submissions are opinions or legal arguments made by a party to support its case*" and that "*evidence should not include legal*

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<sup>7</sup> See the 'Preliminary Issues' section to this decision with regards to the written submissions filed by the opponent, my paragraphs 13 to 19.

*argument and/or opinions, but should be confined to facts relating to the case. It should be submitted in the form of either, a Witness Statement, Statutory Declaration or Affidavit. This is in accordance with Rule 64.”<sup>8</sup>*

15. As stated in my paragraph 10, this is a Fast Track opposition and the Opponent did not seek leave to file evidence. Despite this, the Opponent filed, what it refers to as ‘written submissions’ in the form of a ‘witness statement’.<sup>9</sup> More specifically, in its covering letter to the Registry, dated 28 September 2022, the Opponent states that *“In accordance with Tribunal Practice Notice 2/2013 we now attach written submissions on behalf of the Opponent. Pursuant to Rule 64 these submissions are made by way of a witness statement.”*

16. The ‘Witness Statement’ contains the following statements (my emphasis):

*“2. To the extent that **information in this statement is** within my knowledge it is true to the best of my knowledge and belief **based on:***

*(a) my own knowledge of the case;*

*(b) **discussions I have had** with Mr Sam Blenkinsopp, who is the Chief Executive Officer and Co-Founder of the Opponent.*

*3. These **written submissions** are made pursuant to Rule 64 [...].*

*4. **The Opponent has not sought leave to file evidence** in relation to this Opposition or the Applicant’s revised TM8, as the Opponent’s position is straightforward.*

17. Rule 64 of the Trade Mark Rules 2008 relates to the formal requirements that ‘evidence in proceedings before the registrar’ should comply with. It does not relate to written submissions. The issue is that legal arguments should be set out separately to evidence, as legal arguments are not statements of fact.

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<sup>8</sup> Rule 64 of the Trade Mark Rules 2008

<sup>9</sup> The Witness Statement of Nicholas William John Berry (who is a solicitor and partner at Gunnercooke LLP), dated 28 September 2022.

18. I have reviewed the Witness Statement and although it contains some statements of fact, for the most part it contains legal argument. I am satisfied that the legal arguments contained in the Witness Statement are for all intents and purposes written submissions (even though they are conveyed in a Witness Statement) and I will treat them as such.
19. I shall disregard the Witness Statement to the extent that it contains any factual references and/or statements of fact since the Opponent did not seek leave to file evidence in these proceedings (as the Opponent acknowledges in its Witness Statement).

### The Opponent's pleadings

20. In its submissions,<sup>10</sup> the Opponent refers to the grounds for opposition as including section 5(1) of the Act.
21. In its TM7F, the Opponent states that it has “*established a significant reputation*”; that its “*TRIPPIN trade marks benefit from substantial goodwill throughout the United Kingdom*”; that there is a “*high level of public recognition of the TRIPPIN Trade Marks in the United Kingdom*”; that “*any confusion arising from the applicant’s use of the opposed mark [...] will significantly dilute the reputation and goodwill associated with the TRIPPIN trade marks*”; and that (in reference to its section 5(2)(b) claim) “*the stylised roundel which the applicant uses in conjunction with the opposed mark is very similar to the Opponent’s [Earlier Figurative Mark].*”
22. Firstly I note that the Opponent has not made a claim under section 5(1) of the Act and I shall not be considering such claim in my decision. Secondly, the terms used within the Opponent’s submissions in its TM7F are more apt to other grounds under the Act that have not been pleaded and they do not influence my decision under the sections 5(2)(a) and 5(2)(b) grounds that have been pleaded.<sup>11</sup> Thirdly, the Contested Mark is the mark as represented in the trade

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<sup>10</sup> See paragraphs 8 and 23 of the Opponent’s ‘Witness Statement’

<sup>11</sup> It is noted that the Opponent has not made any claim to enhanced distinctiveness of its mark and in any event it did not subsequently file evidence to support any of its statements that are of a factual nature.

mark application (which is a word-only mark that does not contain a 'roundel' device). The task before me is to compare the Opponent's marks with the applied-for mark as it appears on the register.

#### The services relied upon under the section 5(2)(a) claim

23. In its Form TM7F and in its submissions, the Opponent indicated it relies on (amongst others) the following services in Class 38:

*“data and multimedia content via internet-enabled devices”.*

I note that the full term registered is (my emphasis):

*“**transmission of** messages, data and multimedia content via internet-enabled devices”.*

Whilst reference to 'messages' can be omitted for the purposes of limiting the specification on which the Opponent wishes to rely, in the interests of legal certainty, the words 'transmission of' cannot be omitted. This is because 'transmission of' identifies the nature of the service registered, within the scope of Class 38 (i.e. the general heading of Class 38 of the Nice Classification system being 'telecommunications'). I shall therefore consider the term being relied on as:

*“transmission of data and multimedia content via internet-enabled devices”.*

#### The Applicant's Counterstatement

24. The registry informed the Applicant, by letter dated 26 July 2022, that in its preliminary view, the Applicant's counterstatement (despite several prior amendments) *“still included evidence of fact”*. The Registry reminded the Applicant that the fast track opposition process does not include the routine filing of evidence and as they had not sought leave to file evidence, the Registry requested the Applicant remove the evidence of fact and invited them to file an amended counterstatement.



25. The Applicant chose not to amend its counterstatement and did not seek leave to file evidence. As a consequence, I shall disregard any statements and evidence of fact contained in the Applicant's counterstatement.

## **DECISION**

### **Legislation and Case Law**

26. Sections 5(2)(a), 5(2)(b) and 5(A) of the Act are as follows:

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

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

(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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

27. I am guided by the following principles which 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 great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Approach**

28. Since the opposition under section 5(2)(a) is a partial claim against the goods applied for, I shall first consider the claim under section 5(2)(b) given that it is directed against the entirety of the Applicant's Class 9 specification. If the opposition under section 5(2)(b) is successful in its entirety then there will be no need to consider the claim under section 5(2)(a) as it would not materially improve the Opponent's position. If on the other hand the opposition under section 5(2)(b) is unsuccessful or only partially successful, I shall go on to consider the claim under section 5(2)(a).<sup>12</sup>

### **Section 5(2)(b)**

#### **Comparison of goods**

29. In *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>13</sup> ("**Meri**c"), the General Court held to the effect that goods can be considered as identical when

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<sup>12</sup> For the avoidance of doubt, in the event of a partially successful section 5(2)(b) claim, my consideration of the claim under section 5(2)(a) shall only be to the extent that it relates to any of the Applicant's goods where no similarity is found, where those goods are also the goods being opposed under section 5(2)(a).

<sup>13</sup> Case T- 133/05

the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

30. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:<sup>14</sup>

- (i) the physical nature of the goods;
- (ii) their intended purpose;
- (iii) their method of use / uses;
- (iv) who the users of the goods are;
- (v) the trade channels through which the goods reach the market;
- (vi) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (vii) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors)

or

- (viii) whether they are complementary to each other. Complementary means *“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”*.<sup>15</sup> I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.<sup>16</sup>

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<sup>14</sup> See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v. James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

<sup>15</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

<sup>16</sup> *Kurt Hesse v OHIM*, Case C-50/15 P

31. For the purposes of making my comparison, I have grouped the goods where the same reasoning applies.<sup>17</sup>
32. The goods to be compared are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b> <sup>18</sup>
<p><u>Class 9</u></p> <p>Audio tapes; compact discs; videos; television films; cinematographic films; computer software; publications in electronic form supplied on-line from databases or from the Internet (including web sites); computer software and hardware to enable searching of data and connection to databases and the internet; downloadable digital music; digital music downloadable from the internet; music recordings; downloadable smart phone applications (software); downloadable smart phone application software.</p>	<p><u>Class 9</u></p> <p>Digital music; Digital music downloadable from the Internet; Digital music downloadable provided from the internet; Downloadable music files; Digital music downloadable provided from MP3 internet websites; Downloadable digital music provided from MP3 Internet web sites; Downloadable musical sound recordings; Digital music [downloadable] provided from mp3 web sites on the internet; Records [sound recordings]; Downloadable music sound recordings; Recorded discs bearing sound; Phonograph records featuring music; Musical recordings; Music recordings; Audiovisual recordings; Video recordings; Downloadable media; Media content; Recorded media; Downloadable podcasts; Downloadable digital music; Downloadable video recordings featuring music; Musical video</p>

<sup>17</sup> *Separode Trade Mark* BL O/399/10, paragraph 5

<sup>18</sup> For comparison purposes I have removed all the duplicate terms contained in the applied-for specification. See Annex 1 to this decision for details of the duplicate terms.

	recordings; Musical sound recordings; Pre-recorded phonograph records; sound, music, audio, visual and audio visual content and recordings; sound, music, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web.
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Digital music and downloadable digital music

33. The term “*digital music downloadable from the internet*” in the Opponent’s specification:

- (i) also appears in the Applicant’s specification. These terms are **identical**;
- (ii) is self-evidently **identical** to “*digital music downloadable provided from the internet*” in the Applicant’s specification; also it
- (iii) is self-evidently **identical** to the following goods in the Applicant’s specification (or at least they are identical on the principle outlined in *Meric*):

*“digital music downloadable provided from MP3 internet websites; downloadable digital music provided from MP3 Internet web sites; digital music [downloadable] provided from MP3 web sites on the internet”.*

34. The term “*downloadable digital music*” in the Opponent’s specification:

- (i) also appears in the Applicant’s specification. These terms are **identical**;
- (ii) is self-evidently **identical** to the following goods in the Applicant’s

specification (or at least they are identical on the principle outlined in *Meric*):

*“downloadable music files; downloadable musical sound recordings; downloadable music sound recordings”*; also it

(iii) is **identical** to the Applicant’s term “*digital music*”, on the principle outlined in *Meric*.

35. The following goods in the Applicant’s specification, namely:

*“music recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web”*<sup>19</sup>

fall within the following categories in the Opponent’s specification:

*“downloadable digital music; digital music downloadable from the internet”*.

These goods are **identical** on the principle outlined in *Meric*.

36. The following terms in the Applicant’s specification, namely:

*“sound [and] audio recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web”*<sup>20</sup>

and the following terms in the Opponent’s specification, namely:

*“music recordings; downloadable digital music; digital music downloadable from the internet”*

(i) are **identical** on the principle outlined in *Meric*. This is because digital music and music recordings by their very nature are ‘sound and audio

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<sup>19</sup> The full term in the Applicant’s specification being: “*sound, music, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web*”

<sup>20</sup> The full term in the Applicant’s specification being: “*sound, music, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web*”

recordings' that can be downloaded and/or streamed therefore they fall into this broad category; or

- (ii) in the **alternative** they are **highly similar**. This is because they will overlap in purpose and nature as downloadable digital music is both a sound and an audio recording/ file. There will be overlap in method of use and user. There will also be overlap in trade channels as the same undertakings will likely sell both. There may be a degree of competition between them and they are likely to fall within the same market sector.

### Music recordings

37. The term "*music recordings*" in the Opponent's specification:

- (i) also appears in the Applicant's specification. These terms are **identical**;
- (ii) is self-evidently **identical** to the following terms in the Applicant's specification, namely:

*"music content and recordings;<sup>21</sup> musical recordings; musical sound recordings"* in the Applicant's specification.

38. "*Music recordings*" in the Opponent's specification is a broad category that covers the following goods in the Applicant's specification:

*"records [sound recordings]; recorded discs bearing sound; phonograph records featuring music; pre-recorded phonograph records; sound [and] audio content and recordings<sup>22</sup>"*

These goods are **identical** on the principle outlined in *Meric*;

39. The following terms in the Applicant's specification, namely:

*"downloadable video recordings featuring music; musical video recordings"*

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<sup>21</sup> The full term in the Applicant's specification being: "*sound, music, audio, visual and audio visual content and recordings*"

<sup>22</sup> The full term in the Applicant's specification being: "*sound, music, audio, visual and audio visual content and recordings*"



and the following terms in the Opponent's specification, namely:

*“music recordings; downloadable digital music; digital music downloadable from the internet”*

- (i) are **identical** on the principle outlined in *Meric*; or
- (ii) in the **alternative**, they are at least **highly similar**, since a 'musical video' is a video containing a music recording (often used to promote a music recording)<sup>23</sup>, therefore they overlap in purpose and nature and there will be overlap in method of use and user. There will also be overlap in trade channels as the same undertakings will likely provide both. There would also be a degree of competition between them since a consumer may, for example, favour a music video so they can see a music artist perform as opposed to just listening to a music recording. They are also complementary to each other.

#### Visual and audio visual recordings

40. The term “*videos*” in the Opponent's specification is self-evidently **identical** to “*video recordings*” in the Applicant's specification.

41. The following terms in the Applicant's specification, namely:

*“audiovisual recordings; visual and audio visual content and recordings;<sup>24</sup> visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web.<sup>25</sup>”*

and the following terms in the Opponent's specification, namely:

*“videos; television films; cinematographic films”*

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<sup>23</sup> See the definition for ‘*music video*’ contained in the Oxford English Dictionary – [www.oed.com](http://www.oed.com), and the Collins English Dictionary – [www.collinsdictionary.com](http://www.collinsdictionary.com).

<sup>24</sup> The full term in the Applicant's specification being: “*sound, music, audio, visual and audio visual content and recordings*”

<sup>25</sup> The full term in the Applicant's specification being: “*sound, music, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web*”

are **identical** on the principle outlined in *Meric* since the Opponent's goods are included in the broad category of visual and audio visual content and recordings, that can also be obtained by downloading and/or streaming.

#### 'Media'

42. "Recorded media" in the Applicant's specification is a broad category that covers the following categories of goods in the Opponent's specification:

*"music recordings; downloadable digital music; digital music downloadable from the internet; videos; television films; cinematographic films."*

These goods are **identical** on the principle outlined in *Meric*.

43. "Downloadable media; media content;" in the Applicant's specification are broad categories that cover the following categories of goods in the Opponent's specification:

*"music recordings; downloadable digital music; digital music downloadable from the internet; videos; television films; cinematographic films; publications in electronic form supplied on-line from databases or from the Internet (including web sites)."*

These goods are **identical** on the principle outlined in *Meric*.

#### Downloadable podcasts

44. "Downloadable podcasts" in the Applicant's specification are similar to the following goods in the Opponent's specification, namely:

*"videos; downloadable digital music; digital music downloadable from the internet; publications in electronic form supplied on-line from databases or from the Internet (including web sites)."*

45. This is because they overlap in nature, since a podcast can be in video format and podcasts can be digital audio files of music, podcasts can also be considered

as a form of audio publication.<sup>26</sup> The goods also overlap in their intended purpose since podcasts are a form of entertainment, and there is also an overlap in method of use and user. There would also be overlap in trade channels as the same undertakings that provide podcasts to download are likely to be the same undertakings that will offer videos, music and publications available to download. There would be a degree of competition between them as a consumer may select a podcast as their chosen form of entertainment above the others. There is also a degree of complementarity between them. These goods are **similar** to a **medium degree**.

#### Conclusion on the comparison of goods

46. For the most part I have found identity between the respective goods (and in some instances I have made an alternative finding of a high degree of similarity). I have found one term in the Applicant's specification that is similar to a medium degree. I have not found any instance of dissimilarity between the parties' specifications.

#### The average consumer and the nature of the purchasing act

47. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word "average" merely denotes that the person is typical.<sup>27</sup>

48. It is therefore necessary to determine who the average consumer of the respective goods is, and how the consumer is likely to select those goods. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.<sup>28</sup>

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<sup>26</sup> See the entry for 'podcast' in the Oxford English Dictionary ([www.oed.com](http://www.oed.com)) and the Collins English Dictionary ([www.collinsdictionary.com](http://www.collinsdictionary.com)).

<sup>27</sup> *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), paragraph 60; also see *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98, as to what "average" means

<sup>28</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

49. I consider the average consumer of the goods at issue will be a member of the general public at large.
50. The goods are likely to be sold through a range of retail outlets (and their online equivalents), such as entertainment stores, supermarkets and online marketplaces as well as through online entertainment platforms and online streaming services. Where the goods are in their physical form, they are likely to be displayed on shelves in stores. Where the physical goods can be bought online, an image of them will likely be displayed on a webpage – a similar process will apply where the goods can be downloaded or streamed. In each instance, the consumer will select the goods having viewed them or an image or description of them first.
51. The selection of the goods is therefore primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants. However, it is my view that even where the physical goods are selected by making requests to staff, the selection process would primarily be visual in nature and the mark will be shown on the packaging of the goods. Accordingly, visual considerations dominate.
52. The goods will, for the most part, be inexpensive and will generally be purchased on a regular basis. When purchasing the goods, the average consumer will consider things such as the genre of the entertainment and the format in which they purchase the goods (for example, physical goods or their downloadable equivalents). The purchasing process is likely to be casual and will not require an overly considered thought process. The average consumer is likely to demonstrate a low to medium level of attention when selecting the goods.

### **Comparison of marks**

53. It is clear from established case law that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.<sup>29</sup> The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks in the



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<sup>29</sup> *Sabel BV v. Puma AG*, Case C-251/95, paragraph 23

mind of the average consumer, bearing in mind the distinctive and dominant components of the marks.<sup>30</sup> Then, in light of the overall impression, and all factors relevant to the circumstances of the case, it is necessary to assess the likelihood of confusion.<sup>31</sup>

54. It would be wrong, therefore, to dissect the trade marks artificially, 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.

55. The respective trade marks are shown below:

Earlier Figurative Mark	Contested Mark
<p><u>1 of 2:</u></p>  <p><u>2 of 2:</u></p> 	<p>TRIPPIN</p>

<sup>30</sup> Ibid.

<sup>31</sup> *Bimbo SA v OHIM*, Case C-591/12P, paragraph 34

## Overall impression

56. The Earlier Figurative Mark consists of the word 'TRIPPIN' which overlays and intersects a circular device that has gridlines that give the impression that it is a three dimensional sphere (the Opponent refers to this device as a 'roundel').
57. The word 'TRIPPIN' is in a large plain font that is slightly distorted so that the letters vary in size reading left to right, with the letters in the middle of the word being the largest. The stylisation places the word in the foreground by partially obscuring the device. These elements combined give the word 'TRIPPIN' particular visual prominence in the mark.
58. The mark is represented in both colour, being, green, black and white, and solely in black and white (the colour difference does not alter the material particulars of the marks).
59. The overall impression is dominated by the word 'TRIPPIN', because not only is it given particular visual prominence in the mark, but also because in the case of a mark consisting of both a word and figurative element, generally speaking, the mind of the average consumer 'latches on' to the word elements of such marks, and it is the word elements that the average consumer will use to identify the mark.
60. In that regard, it should be noted that, *"according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements"*.<sup>32</sup>
61. I now turn to the overall impression of the Contested Mark, which is a word-only mark consisting of the word 'TRIPPIN'. Therefore the overall impression rests purely in the word 'TRIPPIN'.

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<sup>32</sup> *Migros-Genossenschafts-Bund v EUIPO – Luigi Lavazza (CReMESPRESSO)*, Case T-189/16, paragraph 52

### Visual comparison

62. The word 'TRIPPIN' in the Earlier Figurative Mark dominates the overall visual impression of the mark and is identical to the Contested Mark. The stylisation of the word 'TRIPPIN' in the Opponent's mark is not sufficient to counter my finding that it is identical to the Applicant's word mark, 'TRIPPIN'.<sup>33</sup>
63. The device element in the Earlier Figurative Mark has no counterpart in the Contested Mark and represents a point of visual difference between the marks. Therefore, overall the marks are visually similar to a **high degree**.

### Aural comparison

64. The marks are aurally **identical** as 'TRIPPIN' would be pronounced the same way in both marks.

### Conceptual comparison

65. The parties have made no submissions as to the concept of their marks. The conceptual message of both marks is tied to the word 'TRIPPIN', the device playing a lesser role (if not neutral role) in the concept of the Earlier Figurative Mark, particularly when having regard to the overall impression of the mark. With regards to the device, I note that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>34</sup> It is not immediately apparent what the concept of the device is, in which case its concept is more likely to be neutral.
66. 'TRIPPIN' is likely to be viewed as an abbreviated or alternative spelling for the word 'tripping', the latter appearing in a standard English dictionary. The average consumer is likely to attribute the word 'TRIPPIN' with the same meaning as the

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<sup>33</sup> Bearing in mind also that it is well established that a 'word mark' protects the word itself, not simply the word presented in a particular font or capitalization which appears in the Register of Trade Marks. See the comments of the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14, paragraph 21

<sup>34</sup> This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

dictionary word. Either way, as the word is identical in both marks it follows that the marks share an **identical** concept.

### **Distinctive character of the Earlier Mark**

67. The degree of distinctiveness of the Earlier Mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the Earlier Mark, the greater the likelihood of confusion may be, although it is always important to bear in mind what it is about the earlier mark which gives it distinctive character.<sup>35</sup>
68. Simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.
69. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.
70. The Opponent makes no claim to enhanced distinctiveness through the use made of the Earlier Figurative Mark, therefore I only have the inherent distinctiveness of the mark to consider.
71. The word 'TRIPPIN' retains an independent distinctive role in the mark. Although the device element, the get-up and stylisation of the mark are not negligible and contribute to the overall impression of the mark, they are secondary relative to its word element and it is the word element that dominates, and in which the distinctiveness of the mark primarily lies.
72. The word 'TRIPPIN' resembles the ordinary word 'tripping' and is likely to be perceived as a common misspelling for that word. Either way, 'TRIPPIN' makes no descriptive or allusive reference to the Opponent's goods.

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<sup>35</sup> *Kurt Geiger v A-List Corporate Limited*, Case O-075-13, paragraph 39



73. The Earlier Figurative Mark possesses at least a medium degree of inherent distinctive character.

### **Conclusions on Likelihood of Confusion**

74. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.<sup>36</sup> I must also keep in mind the average consumer of the goods, the nature of the purchasing process and have regard to 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 vice versa.<sup>37</sup>

75. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark 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.<sup>38</sup> The relative weight of the factors is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case.<sup>39</sup>

76. There are three sets of circumstances where a consumer may associate a later mark with an earlier mark:<sup>40</sup> (i) direct confusion, which is a simple matter of the consumer mistaking one mark for another; (ii) indirect confusion, which is where the consumer recognises that the marks are different, but also that they share common elements, and because of those similarities, they conclude, for

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<sup>36</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

<sup>37</sup> *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

<sup>38</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

<sup>39</sup> See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

<sup>40</sup> See to that effect *Sabel BV v Puma AG*, Case C-251/95, paragraph 16

example, that the later mark is another brand of the owner of the earlier mark;<sup>41</sup> and (iii) mere association, where the later mark merely brings the earlier mark to mind but it does not lead to confusion between them.

77. Taking into account (i) the high degree of visual similarity between the respective marks (ii) the aural and conceptual identity between them; (iii) the at least medium degree of inherent distinctiveness of the Earlier Figurative Mark; and (iv) the identity and similarity between the respective goods, I find that a significant proportion of the average consumer would be directly confused as to the trade origin of the goods.
78. The opposition succeeds under section 5(2)(b) of the Act.

### **Final remarks**

79. In reference to the section 5(2)(a) claim, whilst I acknowledge that the Earlier Word Mark and the Contested mark are self-evidently identical and that there is some overlap between the Applicant's goods and the Opponent's services, leading to some degree of similarity between them, as the opposition is successful in its entirety based upon section 5(2)(b), there is no need to consider the section 5(2)(a) ground as it does not materially improve the Opponent's position.

### **OUTCOME**

80. The opposition succeeds in its entirety under section 5(2)(b) of the Act. Subject to any appeal, the Contested Mark, trade mark application number 3698846, shall be refused registration for all the goods applied for.

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<sup>41</sup> See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC (as he then was), sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion; see also the comments of Arnold LJ in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 12, in relation to 'L.A. Sugar' i.e. "This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."

## **COSTS**

81. The Opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for filing Form TM7F	£100
Preparing the Statement of Grounds and considering the Counterstatement	£200
Preparing written submissions	£300
<b>TOTAL</b>	<b>£600</b>

82. I therefore order TRIPPIN Records Ltd to pay Trippin Limited the sum of **£600**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 14<sup>th</sup> day of December 2022**

**Daniela Ferrari**

**For the Registrar**

## Annex 1

### The Goods of the Contested Mark

I note that the applied-for specification contains duplicate terms which I have highlighted in emboldened font for ease of reference. The terms that have been duplicated are underlined.

#### Class 9

Digital music; Digital music downloadable from the Internet; Digital music downloadable provided from the internet; Downloadable music files; Digital music downloadable provided from MP3 internet websites; Downloadable digital music provided from MP3 Internet web sites; **Digital music downloadable provided from MP3 internet web sites**; Downloadable musical sound recordings; Digital music [downloadable] provided from mp3 web sites on the internet; Records [sound recordings]; **Records [sound recordings]**; Downloadable music sound recordings; Recorded discs bearing sound; Phonograph records featuring music; **Records [sound recordings]**; Musical recordings; Music recordings; Audiovisual recordings; Video recordings; Downloadable media; Media content; Recorded media; Downloadable podcasts; **Downloadable music files**; Downloadable digital music; **Downloadable musical sound recordings**; **Downloadable music sound recordings**; Downloadable video recordings featuring music; **Digital music downloadable from the Internet**; **Digital music downloadable provided from the internet**; **Digital music downloadable provided from MP3 internet websites**; **Musical recordings**; **Music recordings**; Musical video recordings; Musical sound recordings; **Phonograph records featuring music**; **Downloadable musical sound recordings**; **Downloadable music sound recordings**; **Records [sound recordings]**; Pre-recorded phonograph records; **Downloadable media**; sound, music, audio, visual and audio visual content and recordings; sound, music, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web.