

O/0545/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004072306

BY PERRY DANIEL

TO REGISTER:

Don't Say A Word

IN CLASSES 35 & 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000449623 BY

DSAW LIMITED

Background and pleadings

1. On 5 July 2024, Perry Daniel (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision (“the applicant’s mark”). The application was accepted and published for opposition purposes on 19 July 2024 and registration is sought for the following services:

Class 35: Advertising; Business management; Business administration; Office functions; Retail store services and wholesale store services provided on any on-line (the Internet), mobile, wireless or remote (mail order, teleshopping) communication media, all connected with the sale of clothing, clothing accessories, footwear, footwear accessories, headgear, optical goods and accessories, books, leaflets, guides, printed matter, informational publications, programmes, calendars, charts, and dietary supplements; Administrative processing of purchase orders; Services of sales promotion for others by means of customer loyalty schemes, loyalty scheme services involving or not involving the use of a card; Organization of exhibitions and tests of sports goods for commercial or advertising purposes; Small advertisement services; Personnel recruitment; Information, consultancy and advisory services relating to the aforesaid services.

Class 41: Production of podcasts; Creation [writing] of podcasts; Creation [writing] of educational content for podcasts; Editing and production of podcasts, sound recordings, audio books and videos; Publication of audio books; Creation, provision and delivery of educational content and documents for podcasts, sound recordings, audio books and videos; Training relating to podcasts, sound recordings, audio books and videos; Selection and compilation of pre-recorded music for broadcasting by others; Providing online electronic publications, not downloadable, in the field of music; Providing online electronic publications in the field of music, not downloadable; Providing online music, not downloadable; Providing digital music from the internet.¹

¹ Registration was originally sought for a longer list of class 41 services (see paragraphs 7 – 10 below).

2. On 13 September 2024, DSAW Limited (“the opponent”) sought to partially oppose the applicant’s mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is aimed at the applicant’s class 41 services specified in paragraph 10 below. The opponent relies upon the following mark:

DSAW Don’t Say A Word

UK registration no.UK00003555058

Filing date 12 November 2020; registration date 26 March 2021

Relying on all goods, being:

Class 9: Audio tapes featuring music; Compact discs featuring music; Digital music [downloadable] provided from mp3 web sites on the internet; Digital music downloadable from the Internet; Music recordings; Musical cassettes; Musical juke boxes; Musical recordings; Musical recordings in the form of discs; Musical sound recordings; Musical video recordings; Digital music downloadable provided from MP3 internet web sites; Digital music downloadable provided from MP3 internet websites; Digital music downloadable provided from a computer database or the internet; Digital music downloadable provided from the internet; Downloadable digital music; Downloadable digital music provided from MP3 Internet web sites; Downloadable music files; Downloadable music sound recordings; Downloadable musical sound recordings; Downloadable video recordings featuring music.

Class 25: Clothing; Footwear; Headgear.

Class 41: Entertainment; Entertainment by means of concerts; Entertainment by means of television.

3. By virtue of relying on section 5(2)(b) of the Act, the opponent’s case is that the marks at issue are similar and that the goods and services of the parties are either identical or similar, resulting in a likelihood of confusion.
4. The applicant filed a counterstatement submitting that the services in class 41 of the application are dissimilar to the opponent’s goods and services. The applicant

further submitted that, considering the difference between the two trade marks, there is no likelihood of confusion or association and the opposition should be dismissed.

5. The opponent is represented by Daniel Francis. The applicant is represented by GCS Europe Ltd. Neither party filed evidence. No hearing was requested and neither party filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.
6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

PRELIMINARY ISSUES

Form TM21B

7. On 16 January 2025, the Tribunal informed the parties that further to a Form TM21B filed against the application on 7 January 2025 the specification in Class 41 had been amended to read as follows:

“Digital Entertainment; Production of podcasts; Creation [writing] of podcasts; Provision of entertainment via podcast; Creation [writing] of educational content for podcasts; Arranging, organizing, presenting and providing entertainment via podcasts, sound recordings, audio books and videos; Editing and production of podcasts, sound recordings, audio books and videos; Publication of audio books; Creation, provision and delivery of educational content and documents for podcasts, sound recordings, audio books and videos; Training relating to podcasts, sound recordings, audio books and videos; Selection and compilation of pre-recorded music for broadcasting by others; Providing online electronic publications, not downloadable, in the field of music; Providing online electronic publications in the field of music, not downloadable; Providing online music, not

downloadable; Providing digital music from the internet.”

8. The Tribunal asked the opponent to confirm in writing whether this amendment to the applicant’s class 41 specification would allow the opposition to be withdrawn. The opponent responded stating they did not wish to withdraw their opposition and they believed the services in class 41 of the applicant’s mark are identical or very similar to all goods/services in the opponent’s mark.

Preliminary Indication

9. On 16 January 2025, the Tribunal issued a preliminary indication in respect of the following services only:

“Digital Entertainment; Provision of entertainment via podcast; arranging, organizing, presenting and providing entertainment via podcasts, sound recordings, audio books and videos.”

wherein it found that there was similarity between the respective marks and the services at issue which is sufficient to result in a likelihood of confusion in relation to the above terms in class 41. The Tribunal stated that for the remaining services in class 41 of the application, a more in-depth comparison was needed and a preliminary indication for the remaining services was not appropriate. In giving its preliminary indication in respect of the above services, the Tribunal provided the applicant with the opportunity to file a Form TM53 on or before 13 February 2025 if it wished to proceed with its application for the above services where the Tribunal indicated that the application should be refused. The Tribunal set out that if the applicant did not file a Form TM53, it would be deemed to have withdrawn its application for those services.

10. The applicant did not file a Form TM53. As a result, the Tribunal deemed the application to be withdrawn in relation to the services listed in the preceding paragraph and this was confirmed to the parties by way of written correspondence dated 21 February 2025. Consequently, the proceedings have continued in respect of the following applicant’s services only:

“Production of podcasts; Creation [writing] of podcasts; Creation [writing] of educational content for podcasts; Editing and production of podcasts, sound recordings, audio books and videos; Publication of audio books; Creation, provision and delivery of educational content and documents for podcasts, sounds recordings, audio books and videos; Training relating to podcasts, sound recordings, audio books and videos; Selection and compilation of pre-recorded music for broadcasting by others; Providing online electronic publications, not downloadable, in the field of music; Providing online electronic publications in the field of music, not downloadable; Providing online music, not downloadable; Providing digital music from the internet.”

DECISION

Section 5(2)(b): legislation and case law

11. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

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

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

12. Section 5A of the Act states as follows:

“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.”

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

- (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

14. The opponent’s mark qualifies as an earlier trade mark under the above provisions. As the opponent’s mark had not completed its registration process more than five years before the filing date of the applicant’s mark, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on the goods and services highlighted in his notice of opposition without having to demonstrate genuine use.

15. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

- (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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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; and

- (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.

Comparison of goods and services

16. The parties' goods and services are as follows:

The opponent's goods and services	The applicant's services
Class 9: Audio tapes featuring music; Compact discs featuring music; Digital music [downloadable] provided from mp3 web sites on the internet; Digital music downloadable from the Internet; Music recordings; Musical cassettes; Musical juke boxes; Musical recordings; Musical recordings in the form of discs; Musical sound recordings; Musical video recordings; Digital music downloadable provided from MP3 internet web sites; Digital music downloadable provided from MP3 internet websites; Digital music downloadable provided from a computer database or the internet; Digital music downloadable provided from the internet; Downloadable digital music; Downloadable digital music provided from MP3 Internet web sites; Downloadable music files; Downloadable music sound recordings; Downloadable musical	Class 41: Production of podcasts; Creation [writing] of podcasts; Creation [writing] of educational content for podcasts; Editing and production of podcasts, sound recordings, audio books and videos; Publication of audio books; Creation, provision and delivery of educational content and documents for podcasts, sounds recordings, audio books and videos; Training relating to podcasts, sound recordings, audio books and videos; Selection and compilation of pre-recorded music for broadcasting by others; Providing online electronic publications, not downloadable, in the field of music; Providing online electronic publications in the field of music, not downloadable; Providing online music, not downloadable; Providing digital music from the internet.

sound recordings; Downloadable video recordings featuring music. Class 25: Clothing; Footwear; Headgear. Class 41: Entertainment; Entertainment by means of concerts; Entertainment by means of television.	
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17. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*² where the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgement:

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

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

² Case C-39/97

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

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

20. In *Kurt v Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “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”.

21. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken against transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public is liable to believe that the responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

22. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

23. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining

the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

24. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*.³

25. In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms: *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev 1) [2024] UKSC 36*.

26. Taking guidance from Iain Purvis KC, sitting as Appointed Person in the *SmartX* trade mark decision,⁴ in the absence of the opponent’s statement of grounds or any submissions regarding the similarity of the goods and services at issue, I will proceed to make my own comparison. Accordingly, as per *Separode*, I will approach the comparison of the goods and services at issue by grouping them collectively in as few groups as I consider logical. Further, where the terms listed are particularly wide or vague, I will endeavour to follow the principles outlined in *YouView* and *Skykick* by comparing what I consider to be the core meaning of the goods or services, without affording them neither a too liberal, nor an artificially narrow, interpretation.

27. In making the following comparison, I remind myself of Section 60A(1)(b) of the Act which sets out that goods or services are not to be regarded as dissimilar from each other solely on the ground that they appear in different classes under the Nice Classification. I also note that in *Unicorn Studio Inc v Veronese* [2024] EWHC 1098 (Ch), Iain Purvis KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense.⁵

28. I have not received any submissions from the opponent regarding their position on the similarity of the goods and services. The applicant’s position is that the services in class 41 of the application are dissimilar to the goods and services of the

³ BL O/399/10

⁴ BL O/0911/24, at [32].

⁵ At [24].

opponent's mark. As I have not received any submissions from the opponent and very limited submissions from the applicant, I will carry out the comparison of the goods and services to the best of my knowledge.

29. When considering the likelihood of confusion under section 5(2)(b) the assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods and services based on the specifications before me, not the goods and services actually provided by the parties.⁶

Production of podcasts; Creation [writing] of podcasts; Creation [writing] of educational content for podcasts; Editing and production of podcasts, sound recordings, audio books and videos; Creation, provision and delivery of educational content and documents for podcasts, sounds recordings, audio books and videos.

30. The opponent's specification includes the broad term "Entertainment" which encompasses a broad range of activities/interests across a number of service industries and genres to provide enjoyment to the consumer, to include podcasts, music, radio, television, reading, arts, sports and gaming. Consequently, the above applied for services are all encompassed within the opponent's term "Entertainment" and are thus identical in accordance with the principles in *Meric*.

31. If I am incorrect in this finding I find the above applied for services to be similar to the opponent's broad term "Entertainment". As stated in the preceding paragraph, "Entertainment" is a broad term which encompasses a broad range of activities/interests across a number of service industries and genres to provide enjoyment to the consumer, to include podcasts, music, radio, television, reading, arts, sports and gaming. The above services are of a technical, creative and/or educational nature which result in the creating, production and delivery of podcasts, sounds recordings, audio books and videos. The purpose of the respective services overlaps in that the end purpose is to provide entertainment to the average consumer. However, the above services are more specifically directed

⁶ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

at producing or developing podcasts, sound recordings, audio books or videos which ultimately results in entertainment being provided to the average consumer. The method of use may differ in that the above applied for services are actively created by users whereas “entertainment” can be consumed by users in a variety of ways. The average consumer of the applied for services is likely to be a business or consumer who wishes to produce podcasts, sound recordings audio books or videos. The average consumer for “Entertainment” is likely to be the general public. There is no competition between the services. The services have a complementary relationship as the applicant’s services are important for the provision of the opponent’s “Entertainment” services, meaning that the consumer may well conclude that the same undertaking is responsible for both services. The above applied for services can often be integrated with the delivery of the podcast, and therefore could be characterised as being part of the entertainment offering. Overall, I find the services to be similar to between a low and medium degree.

Training relating to podcasts, sound recordings, audio books and videos.

32. The applicant’s services above relate to transferring knowledge and providing instructions regarding podcasts, sound recordings, audio books and videos to consumers. The closest comparable term in the opponent’s specification is “Entertainment”. The nature of “Entertainment” is different to that of the above applied for service. “Entertainment” services are enjoyed by the general public whereas the above applied for training services are likely to be enjoyed by consumers wishing to improve their skills or knowledge in relation to the production of podcasts, sound recordings, audio books and videos, sometimes for professional purposes. The services are not in competition, with the above applied for services being for training purposes and the opponent’s “Entertainment” service being for entertainment purposes. The services are not complementary. Taking all of these factors into account, I find the services to be dissimilar.

Publication of audio books.

33. As I have no submissions from the parties as to the similarity of individual goods and services, I consider that the closest comparable opponent’s term to the above

applicant's service is "Entertainment". "Entertainment" is a broad term which encompasses a broad range of activities/interests across a number of service industries and genres to provide enjoyment to the consumer, to include podcasts, music, radio, television, reading, arts, sports and gaming. The nature of the applicant's service is the publication of books in audio format, whereas the nature of the opponent's service is entertainment in general. The services have different core purposes, although ultimately the publishing of audio books allows consumers to access entertainment content. The users of the services will differ as the user of the above applicant's service is likely to be the creator of the audio book rather than a member of the general public looking for an audio book to read/listen to. The above applicant's service will be used by authors with the audio book only reaching the end consumer being the general public through another distribution channel. Consequently, the trade channels differ. The services are not in competition as the publication of an audio book cannot be substituted for an entertainment service. Additionally, the services are not complementary. Taking all of these factors into consideration, I find the services to be dissimilar.

Selection and compilation of pre-recorded music for broadcasting by others.

34. The above service relates to the selection and compilation of music to be broadcast by another source. "Entertainment" encompasses a broad range of activities/interests across a number of service industries and genres to provide enjoyment to the consumer, to include podcasts, music, radio, television, reading, arts, sports and gaming. As such the services differ in nature with the applicant's above service being preparatory in nature and a type of production activity, whereas the opponent's "Entertainment" service is not preparatory or a type of production activity. The core purpose of the respective services also differs. The opponent's service of "Entertainment" is to provide enjoyment to the average consumer being a member of the general public, whereas the purpose of the above applicant's service is to select and compile music that will then be broadcast by someone else, albeit with maybe a secondary outcome being that it provides enjoyment to the consumer. In terms of user, "Entertainment" is used by members of the general public whereas the above applicant's service is likely to be used by professional users such as broadcasters. The services are not in competition.

Whilst the compiled music of the applicant can be used in the entertainment services of the opponent, I do not believe that an average consumer would consider them to have a complementary relationship as the applicant's services themselves are not important for the provision of the opponent's "entertainment" services in such a way that the average consumer would conclude that the same undertaking is responsible for both services. Overall, I find the services to be dissimilar.

Providing online music, not downloadable; Providing digital music from the internet.

35. The above applied for services include the provision of online music and digital music from the internet. Given that the above services are the provision of music, I consider that they are a form of entertainment. Consequently, as the above applied for services are all encompassed within the opponent's term "Entertainment" they are identical in accordance with the principles in *Meric*.

36. If I am incorrect in this finding I find the above applied for services to be similar to some of the opponent's class 9 goods, being "Music recordings, Musical recordings; Musical sound recordings and Musical video recordings". Clearly, these goods and services are different in nature. However, they overlap in both purpose and method of use. The purpose of music recordings is to deliver music content to consumers for listening or viewing and the provision of online music, not downloadable, and digital music from the internet are to deliver music content to consumers also. Music recordings can be accessed via playback devices, the internet or downloaded. Online music, not downloadable, and digital music from the internet, can be accessed via the internet and digitally via the same types of devices. The users will often be the same as the goods and the services will be aimed at the same average consumer who is interested in music. There will also be an overlap in trade channels as both will be offered via online platforms, websites and streaming platforms. Moreover, undertakings offering music over the internet may also offer music recordings as goods, and vice versa. There may be a degree of competition between the opponent's class 9 goods listed above and the above applied for services, whereby a consumer could select a musical recording (as a good in class 9) or, instead, access the musical recording via a

online service. Additionally, the respective goods and services are complementary given that musical recordings are important to the provision of music as a service and consumers would assume that both are provided by the same undertaking. Overall, I find these goods and services similar to a medium degree.

Providing online electronic publications, not downloadable, in the field of music;

Providing online electronic publications in the field of music, not downloadable.

37. The above applied for services include the provision of online electronic publications in the field of music, not downloadable. Given that the above services involve the provision of electronic publications in the field of music for people's enjoyment, I consider them to be a form of entertainment. Consequently, as the above applied for services are all encompassed within the opponent's term "Entertainment" they are identical in accordance with the principles in *Meric*.

38. If I am incorrect in this finding, I find the above applied for services to be similar to the opponent's broad term "Entertainment". Both the above applicant's services and the opponent's service of "Entertainment" have similar natures, with them providing entertainment albeit the opponent's being broader. The purpose of providing online electronic publications is to inform the consumer on the topic of the online electronic publication, which is a form of entertainment in itself. As stated previously, "Entertainment" is a broad term which encompasses a broad range of activities/interests across a number of service industries and genres to provide enjoyment to the consumer, to include podcasts, music, radio, television, reading, arts, sports and gaming. The purposes of both services overlap in that they both entertain the consumer even if the above applicant's services are also informative. The respective services can overlap in their method of use with the above applicant's services being available via websites or digital platforms, and "Entertainment" also being available in many forms including websites and digital platforms. There is an overlap in user with the general public being the average consumer for both services. The services are in competition as a consumer could choose between accessing an online electronic publication in the field of music or some other form of entertainment for their enjoyment. Taking all factors into consideration, I find these services to be similar to a medium degree.

Conclusion on the goods and services comparison

39. Where there is no similarity between goods and services, there can be no likelihood of confusion under section 5(2)(b) of the Act.⁷ As a result, my findings above mean that the opposition must fail in respect of the following services, being those that I have found dissimilar:

Class 41: Training relating to podcasts, sound recordings, audio books and videos; Publication of audio books; Selection and compilation of pre-recorded music for broadcasting by others.

The average consumer and the nature of the purchasing act

40. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

41. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

⁷ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and
- (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

42. I have no submissions from either party as to who the average consumer for the goods and services at issue will be.

43. The average consumer for the goods and services at issue is likely to include members of the general public as well as businesses and professional users. The goods and services will be available via both general retailers and more specialist retailers, and their online or catalogue equivalents. At the retailers' physical premises, the goods will be displayed on shelves and in cabinets and information about the services will be displayed on signs and placards, both being self-selected by the consumer. A similar process will apply when the goods and services are selected online or via catalogues, in that a consumer will select them after seeing an image, on, for example, a webpage or in a catalogue. The services will be

accessed via websites or streaming platforms, or purchased directly from the entertainment provider/publisher/distributor after viewing information online or in brochures. In my view, the visual component will dominate all methods of sale, although I do not discount an aural component playing a part given that orders may be placed by telephone or that word-of-mouth recommendations and advice may be received from sales assistants. Given the range of goods and services at issue, the price and frequency of purchase will vary depending on their nature and type. For example, some entertainment services or downloadable music files could be selected inexpensively with a fairly low level of attention, whereas other services (such as services of a production company for a podcast) could be much more expensive and require a greater level of attention. Even though the average consumer will pay a different level of attention for different goods and services, overall, when selecting the goods and services at issue, the average consumer is likely to pay a medium degree of attention.

Comparison of marks

44. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23)⁸ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

45. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

⁸ C-251/95

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

46. 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.

47. The respective trade marks are shown below:

The opponent’s mark	The applicant’s mark
DSAW Don’t Say A Word	Don’t Say A Word

48. The opponent provided no submissions regarding the comparison of both trade marks. In its counterstatement, the applicant simply highlights that there is a difference between the marks.

Overall impression

49. The applicant’s mark is a word only mark consisting of the words “Don’t Say A Word”. The overall impression lies in the combination of these words, as they will be seen as a single complete phrase by the average consumer, with no single word or words dominating the mark.

50. The opponent’s mark is a word only mark consisting of the words and letters “DSAW Don’t Say A Word”. I find that the overall impression lies in the two elements that make up the mark; the first element being the acronym “DSAW” and the second element being the phrase “Don’t Say A Word”. As the first element “DSAW” is likely to be perceived as an acronym of the phrase “Don’t Say A Word”, even though “DSAW” is the first element within the mark I consider it to be slightly less dominant than the phrase “Don’t Say A Word”.

Visual comparison

51. Visually, the opponent's mark and the applicant's mark overlap through the use of the four words "Don't Say A Word" being the entirety of the applicant's mark and the most dominant element of the opponent's mark. This identical phrase takes up most of the opponent's mark. The marks differ in that the start of the opponent's mark begins with the additional letters "DSAW", and I bear in mind that consumers tend to focus on the beginnings of marks.⁹ Overall, however, I am of the view that the marks at issue are visually similar to a medium to high degree.

Aural comparison

52. I acknowledge that some consumers will pronounce the whole of the opponent's mark, including the first element being the acronym "DSAW". For these consumers, the opponent's mark will consist of ten syllables and be pronounced as "DEE-ESS-AI-DUB-UL-EWE-DON'T-SAY-A-WORD". However, I consider that at least a significant proportion of consumers is likely to only pronounce the second element of the opponent's mark being the phrase "Don't Say A Word", and elect not to articulate its acronym. For these consumers, the opponent's mark will consist of four syllables and will be pronounced in the ordinary way as "DON'T-SAY-A-WORD".

53. As for the applicant's mark, this consists of four syllables and will be pronounced in the ordinary way as "DON'T-SAY-A-WORD". As I have stated in the preceding paragraph, I consider that at least a significant proportion of consumers will only pronounce the second element of the opponent's mark being the phrase "Don't Say A Word" and will not pronounce the acronym "DSAW". In this case, the four syllables of the applicant's mark are identical to the second element of the opponent's mark. Given this, I find the marks to be aurally identical.

⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Conceptual comparison

54. I have no submissions from either party regarding the conceptual comparison of the marks.

55. The opponent's mark consists of the acronym and words "DSAW Don't Say A Word". All four words are English dictionary words which will, in combination, be understood to mean keep silent or not to share information. The acronym "DSAW" is comprised of the initials of each word in the phrase "Don't Say A Word". The acronym "DSAW" has no conceptual meaning on its own. However, in the context of the opponent's mark, "DSAW" would be seen as an acronym for the phrase "Don't Say A Word" and consequently has a meaning. However, this meaning is only derived from the phrase. Overall, the only concept in the mark as a whole is from the phrase "Don't Say A Word". The acronym "DSAW" does not change this concept.

56. The applicant's mark consists of the words "Don't Say A Word". As was the case with the opponent's mark above, all four words are English dictionary words which will, in combination, be understood to mean keep silent or not to share information.

57. The concept of both marks is identical meaning to keep silent or not to share information. As a result, I find the marks to be conceptually identical.

Distinctive character of the opponent's mark

58. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

59. Registered trade marks possess varying degrees of inherent distinctive character.

The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. However, the opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness and no evidence has been filed to that effect. Therefore, I only have the inherent position to consider.

60. It is my view that the distinctive character of the opponent's mark "DSAW Don't Say A Word" will predominantly derive from the second element being the phrase "Don't Say A Word". I say this because (1) the first element being the acronym "DSAW" is slightly less dominant than the second element being the phrase "Don't Say A Word" given it is comprised of the initials of each word in the second element of the mark and (2) the letters on their own that make up the acronym are meaningless and not particularly distinctive given there is a propensity for many undertakings to adopt letters as indicators of trade origin. The letters that comprise the acronym only derive meaning from the second element being the phrase and simply represent each first letter of that phrase. Turning back to the second element of the opponent's mark being the phrase "Don't Say A Word", this is a phrase with an immediately graspable meaning. It is not allusive or descriptive of the goods and services at issue. However, given the ordinary dictionary words used in this phrase, and its well-known meaning as a whole, I do not consider it to

be particularly remarkable from a trade mark perspective. Taking all of these factors into account, overall, I find that the inherent distinctiveness of the opponent's mark is between low and medium.

Likelihood of confusion

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

62. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods and services at issue are marketed, and in which type of store/platform they are made available.

63. Throughout the course of this decision, I have found that the respective goods and services to range from being identical to similar to between a low and medium degree. The average consumers are members of the general public as well as businesses and professional users. The average consumers will select the goods and services via primarily visual means, although I do not discount an aural

component. I have concluded that, the average consumer when selecting the goods and services at issue, is likely to pay a medium degree of attention. I have found the marks to be visually similar to a medium to high degree, and aurally and conceptually identical. I have found the opponent's mark to possess between a low and medium degree of inherent distinctive character.

64. The more dominant part of the opponent's mark (being "Don't Say A Word") and the entirety of the applicant's mark (being "Don't Say A Word") are identical. The only difference between the marks is the additional acronym "DSAW" at the start of the opponent's mark. Although the beginnings of trade marks tend to have more impact, that is a general rule which is not necessarily determinative.¹⁰ I have found that, as it is an acronym comprised of the initial letters of the phrase "Don't Say A Word", it contributes to a lesser extent to the overall impression of the mark. The acronym does not introduce any conceptual difference between the marks and, for at least a significant proportion of consumers, will not be pronounced. In my view, the average consumer is likely to retain the full phrase "Don't Say A Word", but may misremember or fail to accurately recall whether this phrase was accompanied by the acronym for it. Given the identity between the more dominant part of the opponent's mark and the entirety of the applicant's mark, the overall levels of similarity between the marks, and the fact that the goods and services are similar to between a low and medium degree (at least), it is my view that, factoring in the principle of imperfect recollection, the acronym is unlikely to be sufficient to enable the average consumer, even paying a medium degree of attention or higher, to differentiate between the marks. Consequently, I consider there exists a likelihood of direct confusion between the marks at issue. In reaching this conclusion, I have borne in mind that the earlier mark is distinctive to only between a low and medium degree. However, the weak distinctive character of the earlier mark does not preclude a likelihood of confusion.¹¹ In this case, I find that the relatively weak distinctiveness of the mark is outweighed by the visual, aural and conceptual similarities.

¹⁰ See, for example, *CureVac GmbH v OHIM*, Case T-80/08.

¹¹ *L'Oréal SA v OHIM*, Case C-235/05 P

65. In the event that I am incorrect about direct confusion, I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C. (as he then was) sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”

66. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*.¹² This is mere association not indirect confusion.

67. The types of examples of indirect confusion as set out in *L.A. Sugar* (cited above) are not exhaustive. However, they are the most usual circumstances where indirect confusion may arise. In the present case, as the entirety of the applicant's mark and the more dominant part of the opponent's mark are identical (being "Don't Say A Word"), the present assessment of indirect confusion is focused on the consumer noticing the first element of the opponent's mark (being "DSAW") in the context of the marks as wholes. As "DSAW" is an acronym comprised of the initial letters of the phrase "Don't Say A Word", it plays a lesser role in the opponent's mark. In the circumstances, I consider it likely that consumers would, when confronted by both parties' marks, believe them to originate from the same or economically connected undertakings. It is my view that the addition/removal of an acronym for an identical common element is entirely consistent with a logical brand extension or the use of variant marks by the same or a related undertaking. If the consumer did accurately recall the acronym "DSAW", in my view, it would not take away the impact that the shared "Don't Say A Word" element has. The marks are likely to be perceived as the same brand, one with the acronym for the full phrase and the other without. Whilst I recognise that the common element (and the opponent's mark as a whole) is only distinctive to between a low and medium degree, in the context of the particular difference between the marks, I find that it is sufficiently distinctive for confusion to occur. As a result, I consider there to be a likelihood of indirect confusion. Again, given the level of similarity between the marks, I find that this applies regardless of the level of similarity of the goods and services and the level of attention paid by the consumer.

CONCLUSION

68. The opposition succeeds in respect of all the services that I have found to be identical or similar. Therefore, the applicant's mark is, subject to any successful appeal of my decision, refused registration for the following:

¹² BL O/547/17

Class 41: Production of podcasts; Creation [writing] of podcasts; Creation [writing] of educational content for podcasts; Editing and production of podcasts, sound recordings, audio books and videos; Creation, provision and delivery of educational content and documents for podcasts, sounds recordings, audio books and videos; Providing online music, not downloadable; Providing digital music from the internet; Providing online electronic publications, not downloadable, in the field of music; Providing online electronic publications in the field of music, not downloadable.

69. That being said, the applicant's mark may proceed to registration (again, subject to any successful appeal of my decision) for the following services which were not opposed or against which the opposition has failed:

Class 35: Advertising; Business management; Business administration; Office functions; Retail store services and wholesale store services provided on any on-line (the Internet), mobile, wireless or remote (mail order, teleshopping) communication media, all connected with the sale of clothing, clothing accessories, footwear, footwear accessories, headgear, optical goods and accessories, books, leaflets, guides, printed matter, informational publications, programmes, calendars, charts, and dietary supplements; Administrative processing of purchase orders; Services of sales promotion for others by means of customer loyalty schemes, loyalty scheme services involving or not involving the use of a card; Organization of exhibitions and tests of sports goods for commercial or advertising purposes; Small advertisement services; Personnel recruitment; Information, consultancy and advisory services relating to the aforesaid services.

Class 41: Training relating to podcasts, sound recordings, audio books and videos; Publication of audio books; Selection and compilation of pre-recorded music for broadcasting by others.

COSTS

70. Although both parties have achieved a measure of success in these proceedings. on balance, I consider the opponent has enjoyed the greater degree of success.

Therefore I consider that the opponent is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. Given the applicant has succeeded in registering some of their services, I consider it appropriate to reduce the costs award to a degree in order to reflect the applicant's success.

71. In the circumstances, I award the opponent the sum of £250 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing a statement and considering the other side's statement:	£250
Reduction	-£100
Total:	£250

72. I therefore order Perry Daniel to pay DSAW Limited the sum of £250. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of June 2026

N Barratt
For the Registrar