

O/0695/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003622249

BY SOHO YACHT CLUB LTD

TO REGISTER:

Soho Yacht Club

AS A TRADE MARK IN CLASSES 25, 35 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000429521

BY CARR MEDIA LIMITED

Background and pleadings

1. On 7 April 2021, Soho Yacht Club Ltd (“the applicant”) applied to register the trade mark shown below – No. UK00003622249 – and the application was published for opposition purposes on 24 September 2021.

Soho Yacht Club

2. The registration is sought for the goods and services set out in paragraph 36 below.
3. Carr Media Limited (“the opponent”) opposes the trade mark on the basis of section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application and is reliant upon the trade mark and the goods and services detailed below.
4. UK00003622101, a series of two marks, which was filed on 6 April 2021 and registered on 27 August 2021.

SOHO YACHT CLUB

soho yacht club

5. The opponent relies upon all goods and services for which the mark is registered, as set out in paragraph 36 below.
6. In its Form TM7 and accompanying statement of grounds, the opponent argues that the applicant’s mark is identical to its own and that the competing goods and services are identical or highly similar.

7. The applicant filed a Form TM8 and counterstatement denying the claims made. It considers the respective users of the goods and services at issue to be “clearly highly distinct”. It also regards the goods that are produced by the respective parties as not in competition with each other, albeit I must assess the competing goods on a notional basis.
8. Both parties filed evidence which is detailed below.
9. Neither party requested a hearing. The opponent wrote to the Tribunal to confirm that it would be making no further submissions. The applicant did not file any written submissions.
10. Both parties are litigants in person.
11. This decision is taken after careful consideration of the papers.

Evidence

12. The opponent filed a witness statement from Jan Simmons, a director of the opponent, signed and dated 31 July 2022. This witness statement was accompanied by Exhibits JS1 to JS4.
13. The applicant filed evidence from Harry Clements, a director of the applicant, signed and dated 21 October 2022. This witness statement was accompanied by Exhibits HC1 to HC12.
14. The opponent filed evidence in reply in the form of a second witness statement from Jan Simmonds, signed and dated 31 December 2022, along with Exhibits JS5 to JS9.
15. The evidence consists of accounts and documentation relating to the training activity under the signs that went on to be the earlier and applied for marks, and the dates on which such trading activity commenced. The evidence also

contains the opponent's cease-and-desist letter, which was served on the applicant, together with associated email correspondence. However, this is not relevant for the purposes of assessing the opponent's claim under section 5(2)(a) of the Act. The pertinent question in this regard is which one of the marks was filed first. Having said that, the opponent has also put forward evidence of actual confusion between the marks which I am able to consider.

DECISION

16. Although the UK has left the EU, section 6(3)(a) of the European (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 on in these proceedings are derived from an EU Directive. That is why this decision continues to make reference to the trade mark case law of EU courts.

17. Section 5(2)(a) of the Act reads as follows:

“(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, ...

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

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

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

(a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

19. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark as defined above. As the earlier mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act.

Case law

20. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be

reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the marks

21. The marks are shown below.

Opponent's mark	Applicant's mark
SOHO YACHT CLUB soho yacht club	Soho Yacht Club

22. As it is a prerequisite of a section 5(2)(a) claim that the marks be identical, I will begin by assessing whether they are identical within the meaning of the Act and the case law.

23. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ('CJEU') held that:

"54 ... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or

where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

24. The marks are both word marks. The opponent’s mark is a series of two – “SOHO YACHT CLUB” and “soho yacht club” – one fully capitalised, the other in all lower case. The applicant’s mark is “Soho Yacht Club” and hence the initial letter of each word is capitalised. Considering this state of affairs, I refer to Mr Iain Purvis QC [as he was then], sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks ... A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand- writing as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

25. Bearing the above in mind, the respective marks are identical.

Distinctive character of the earlier mark

26. 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).”

27. Registered trade marks possess varying degrees of distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a trade mark can be enhanced by virtue of the use made of it.

28. The words “SOHO YACHT CLUB”/”soho yacht club” are recognisable, as opposed to being invented. The words are allusive of the opponent’s Class 41 sport-related club services and yachting terms, and for those services I find the mark to be of low inherent distinctiveness. The mark is not suggestive of the remaining goods and services for which I make a finding of a medium level of inherent distinctiveness.

29. The opponent has not pleaded that the distinctiveness of its mark has been enhanced through use, nor has it filed sufficient evidence to demonstrate enhanced distinctiveness. This is because the modest sales documented in the evidence and the information that could be construed as marketing activity is not on a scale that would warrant such a finding.

Comparison of the goods and services

30. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for

instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

32. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

33. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) 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.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

34. 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 for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

35. In *Kurt Hesse v 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 Office for Harmonization in the Internal Market* (Trade Marks and Designs) (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 the responsibility for those goods lies with the same undertaking.”

36. 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 are liable to believe that 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-0-255-13:

“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.”

While 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.”

37. The competing goods and services are set out below.

The opponent’s goods and services	The applicant’s goods and services
<p><u>Class 18</u> Rucksacks; Small rucksacks; Hiking rucksacks; Backpacks [rucksacks]; Rucksacks for mountaineers; Rucksacks on castors; Handbags; Evening handbags; Leather handbags; Frames (Handbag -); Slouch handbags; Gentlemen's</p>	

<p>handbags; Fashion handbags; Gent's handbags; Ladies' handbags; Ladies handbags; Pocketbooks [handbags]; Clutch handbags; Handbag frames; Handbags for ladies; Purse frames [handbags]; Clutch purses [handbags]; Straps for handbags; Handbags for men; Handbags, purses and wallets; Handbags made of leather; Handbags, not of precious metal; Purses, not of precious metal [handbags]; Purses, not made of precious metal [handbags]; Handbags, not made of precious metal; Suitcases; Leather suitcases; Motorized suitcases; Wheeled suitcases; Suitcase handles; Overnight suitcases; Small suitcases; Handles (Suitcase -); Roller suitcases; Suitcases, motorized, rideable; Suitcases with wheels; Straps for suitcases; Trunks and suitcases; Carry-on suitcases; Suitcases with built-in shelves.</p>	
<p><u>Class 25</u> Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing;</p>	<p><u>Class 25</u> Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports</p>

<p> Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layette [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Wraps [clothing]; Athletic clothing; Shirts; Golf shirts; Casual shirts; Sport shirts; Tennis shirts; Sleep shirts; Camouflage shirts; Under shirts; Pique shirts; Yokes (Shirt -); Sports shirts; Football shirts; Knit shirts; Fishing shirts; Turtleneck shirts; Rugby shirts; Polo shirts; Shirt yokes; Tee- shirts; Dress shirts; Shirt fronts; </p>	<p> clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing. </p>
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<p>Ramie shirts; Hunting shirts; Woven shirts; Sweat shirts; Collared shirts; T-shirts; Soccer shirts; Night shirts; Aloha shirts; Yoga shirts; Shirt-jacs; Maternity shirts; Corduroy shirts; Button down shirts; Shirts and slips; Printed t-shirts; Mock turtleneck shirts; Shirts for suits; Short-sleeve shirts; Short-sleeved shirts; Open-necked shirts; Hooded sweat shirts; Long-sleeved shirts; American football shirts; Short-sleeved T-shirts; Button-front aloha shirts; Moisture-wicking sports shirts; Sports shirts with short sleeves; Padded shirts for athletic use; Snap crotch shirts for infants and toddlers; Fashion hats; Face masks [fashion wear]; Veils [clothing]; Hats; Top hats; Mitters [hats]; Beanie hats; Rain hats; Bobble hats; Ski hats; Bucket hats; Fascinator hats; Chefs' hats; Cloche hats; Small hats; Woolly hats; Sun hats; Mitres [hats]; Baseball hats; Beach hats; Fur hats; Toques [hats]; Frames (Hat -) [skeletons]; Party hats [clothing]; Fake fur hats; Hats (Paper -) [clothing]; Hat frames [skeletons]; Sedge hats (suge-gasa); Baseball caps and hats; Sports caps and</p>	
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<p>hats; Paper hats for wear by chefs; Paper hats for wear by nurses; Paper hats for use as clothing items; Clothing for horse-riding [other than riding hats]; Shoes; Riding shoes; Work shoes; Wooden shoes; Golf shoes; Jogging shoes; Anglers' shoes; Canvas shoes; Women's shoes; Sports shoes; Athletic shoes; Training shoes; Flat shoes; Tap shoes; Platform shoes; Bowling shoes; Snowboard shoes; Dress shoes; Basketball shoes; Cycling shoes; Running shoes; Walking shoes; Hiking shoes; Hockey shoes; Soccer shoes; Baseball shoes; Rubber shoes; Aqua shoes; Leisure shoes; Shoe straps; Baby shoes; Gymnastic shoes; Dance shoes; Deck shoes; Mountaineering shoes; Football shoes; Infants' shoes; Shoe uppers; Shoe soles; Yoga shoes; Driving shoes; Roller shoes; Ballet shoes; Handball shoes; Boxing shoes; Volleyball shoes; Rugby shoes; Deck-shoes; Rain shoes; Leather shoes; Beach shoes; Tennis shoes; Athletics shoes; Sport shoes; Skiing shoes; Waterproof shoes; Nursing shoes; Wooden shoes [footwear]; Slip-on shoes; Spiked running</p>	
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shoes; Shoes for infants; Ballroom dancing shoes; Hidden heel shoes; High-heeled shoes; Apres-ski shoes; Shoes for leisurewear; Esparto shoes or sandals; Shoe soles for repair; Socks; Men's socks; Bed socks; Trouser socks; Ankle socks; Anklets [socks]; Sports socks; Sock suspenders; Tennis socks; Thermal socks; Slipper socks; Woollen socks; Pop socks; Footless socks; Water socks; Toe socks; Yoga socks; American football socks; Non-slip socks; Anti-perspirant socks; Socks and stockings; Japanese style socks (tabi); Socks for men; Men's dress socks; Sweat-absorbent socks; Inner socks for footwear; Japanese style socks (tabi covers); Socks for infants and toddlers; Lingerie; Maternity lingerie; Bodices [lingerie]; Boxer shorts; Shorts; Boxer briefs; Cycling shorts; Boxing shorts; Trousers shorts; Bermuda shorts; Sliding shorts; Swim shorts; Maternity shorts; Fleece shorts; Bib shorts; Gym shorts; Walking shorts; Short trousers; American football shorts; Short petticoats; Tennis shorts; Rugby shorts; Sweat shorts; Board shorts; Golf shorts; Short

<p>sets [clothing]; Boy shorts [underwear]; Short overcoat for kimono (haori); Padded shorts for athletic use; Polo sweaters; Polo boots; Polo neck jumpers; Polo knit tops; Trousers; Snowboard trousers; Corduroy trousers; Ski trousers; Rain trousers; Golf trousers; Waterproof trousers; Leggings [trousers]; Trouser straps; Trousers of leather; Over-trousers; Casual trousers; Riding trousers; Trousers for sweating; Trousers for children; Men's and women's jackets, coats, trousers, vests; Hoodies; Baseball caps; Caps; Coats; Sheepskin coats; Coats (Top -); Trench coats; Evening coats; Duffle coats; Morning coats; Denim coats; Wind coats; Suit coats; Sport coats; Tail coats; Rain coats; Winter coats; Coats for men; Light-reflecting coats; Coats for women; Jeans; Denim jeans; Blue jeans; Chino pants.</p>	
<p><u>Class 35</u> Retail services in relation to fashion accessories; Fashion show exhibitions for commercial purposes; Organization of fashion shows for promotional purposes; Fashion shows for promotional</p>	<p><u>Class 35</u> Retail services relating to jewelry; Retail services relating to furniture; Retail services relating to flowers; Retail services relating to furs; Retail services relating to accumulators; Retail services</p>

<p>purposes (Organization of -); Organisation of fashion shows for commercial purposes; Retail services relating to jewelry; Retail services relating to furniture; Retail services relating to clothing; Retail services relating to sporting goods; Mail order retail services for clothing; Online retail services relating to jewelry; Online retail services relating to handbags; Online retail services relating to cosmetics; Retail services relating to fragrancings preparations; Retail services in relation to clothing; Retail services in relation to cookware; Mail order retail services for cosmetics; Retail services in relation to fabrics; Online retail services for downloadable digital music; Online retail store services relating to clothing; Online retail store services in relation to clothing; Online advertisements; Online marketing; Online advertising; Online retail store services relating to cosmetic and beauty products; Online retail services for downloadable and pre-recorded music and movies; Online ordering services; Online advertising services; Online business</p>	<p>relating to candy; Retail services relating to food; Retail services relating to clothing; Retail services for computer software; Retail services relating to batteries; Retail services connected with stationery; Business management of retail outlets; Retail services in relation to jewellery; Retail services in relation to headgear; Retail services in relation to bags; Retail services in relation to furnishings; Retail services in relation to cocoa; Retail services relating to alcoholic beverages; Retail services relating to home textiles; Retail services in relation to toiletries; Retail services in relation to umbrellas; Retail services in relation to luggage; Retail services in relation to tableware; Retail services in relation to toys; Retail services in relation to desserts; Retail services in relation to coffee; Retail services in relation to beer; Retail services relating to automobile accessories; Retail services relating to sporting goods; Mail order retail services for clothing; Online retail services relating to jewelry; Online retail services relating to handbags; Retail services relating to</p>
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<p>networking services; Online data processing services; Online advertising on computer networks; Retail services in relation to headgear.</p>	<p>fragrancing preparations; Retail services in relation to bicycles; Retail services in relation to clothing; Retail services in relation to threads; Retail services in relation to games; Retail services in relation to sorbets; Online retail services relating to toys; Retail services in relation to footwear; Retail services in relation to confectionery; Retail services in relation to chocolate; Retail services in relation to teas; Online retail services relating to luggage; Online retail services relating to clothing; Retail services in relation to sanitation equipment; Retail services in relation to sporting equipment; Retail services in relation to art materials; Retail services in relation to sporting articles; Mail order retail services related to beer; Retail services in relation to pet products; Retail services in relation to stationery supplies; Business management of wholesale and retail outlets; Online retail store services relating to clothing; Retail services in relation to fashion accessories; Retail services in relation to bicycle accessories; Mail order retail</p>
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	<p>services for clothing accessories; Management of a retail enterprise for others; Event marketing; Promotion of special events; Marketing services relating to esports events; Arranging and conducting of marketing events; Arranging and conducting of promotional events; Advertising services relating to esports events; Promotion of sports competitions and events; Arranging and conducting of advertising events; Promotion services relating to esports events; Arranging promotion of charitable fundraising events; Arranging and conducting sales events for livestock; Arranging and conducting sales events for cattle; Organisation of events for commercial and advertising purposes; Arranging and conducting marketing promotional events for others.</p>
<p><u>Class 41</u> Night clubs; Fan clubs; Fan club organisation; Social club services for entertainment purposes; Country clubs providing sporting facilities; Music publishing; Publishing of music; Music publishing services; Publishing of musical works; Music</p>	<p><u>Class 41</u> Dance events; Organising gymnastics events; Sporting event organization; Organising sporting events; Organising dancing events; Special event planning; Organisation of musical events; Special event planning consultation;</p>

<p>publishing and music recording services; Publishing services; Song publishing; Magazine publishing; Music recording; Music production; Music performances; Music festival services; Live musical concerts; Live musical performances; Musical entertainment services; Performance of music; Live music concerts; Live music performances; Publishing of books and reviews; Recording of music; Production of music; Organization of fashion shows for entertainment purposes; Organization of fashion parades for entertainment purposes; Fashion shows for entertainment purposes (Organization of -); Entertainment in the nature of fashion shows; Organisation of fashion shows for entertainment purposes; Organizing and presenting displays of entertainment relating to style and fashion; Book publishing; Publishing; Newspaper publishing; Multimedia publishing; Electronic publishing; Micro-publishing; Publishing of journals; Desk top publishing; Electronic publishing services; Publishing services (including electronic publishing services); Publishing of newsletters;</p>	<p>Arranging of sporting events; Organising of sports events; Conducting of educational events; Organisation of cycling events; Timing of sports events; Organising of recreational events; Organisation of cultural events; Organization of sporting events; Organisation of educational events; Arranging of educational events; Conducting of cultural events; Organisation of esports events; Organising community sporting events; Provision of recreational events; Organising of football events; Musical events (Arranging of -); Conducting of sports events; Organisation of sporting events; Organising of sporting events; Provision of sporting events; Organisation of entertainment events; Sports events (Timing of -); Gymnastics events (Organising of -); Arranging of musical events; Organization of dancing events; Production of sporting events; Handicapping for sporting events; Arranging of cultural events; Conducting of entertainment events; Production of esports events; Organising community cultural events; Handicapping</p>
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<p>Electronic desktop publishing; Publishing of web magazines; Multimedia publishing of magazines; Multimedia publishing of journals; Multimedia publishing of books; Publishing of documents; Publishing of stories; Publishing of reviews; Publishing of books; Publishing of newspapers; Publishing of instructional books; Book and review publishing; Electronic text publishing services; Multimedia publishing of newspapers; Publishing by electronic means; Music concerts; Multimedia entertainment software publishing services; Electronic publishing services for others; Music instruction; Music-halls; Musical performances; Advisory services relating to publishing; Multimedia publishing of electronic publications; Musical entertainment; Publishing of educational matter; Publishing of books, magazines; On-line publishing services; Online digital publishing services; Music production services; Music group services; Live music shows; Publication of music; Music entertainment services; Music performance services; Online</p>	<p>services for sporting events; Providing facilities for sports events; Organising events for entertainment purposes; Organisation of automobile racing events; Organising of motor racing events; Ticket reservation for cultural events; Conducting of live esports events; Organizing cultural and arts events; Ice-skating events (Organising of -); Publication of calendars of events; Organising events for cultural purposes; Conducting of live entertainment events; Production of live entertainment events; Conducting of live sports events; Providing information on congress events; Organization of cosplay entertainment events; Video editing services for events; Horse jumping events (Organising of -); Organisation of vehicle racing events; Ticketing and event booking services; Presentation of live entertainment events; Sound engineering services for events; Lighting technician services for events; Organizing community sporting and cultural events; Organisation of entertainment and cultural events; Arranging and</p>
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<p>entertainment services; Publishing of printed matter; Publishing services for books; Publishing of scientific papers; Publishing services, except printing; Publishing of electronic publications; Publishing, reporting, and writing of texts; Musical education services; Musical instruction services; Musical performance services; Multimedia publishing of printed matter; Publishing of scripts for theatrical use; Music competition services; Beach and pool clubs; Provision of sporting club facilities; Providing health club and gymnasium services; Management of events for sporting clubs; Provision of health club [physical exercise] facilities; Provision of club entertainment services; Organisation of yacht races; Organisation of yachting competitions; Dance club services; Comedy club services; Entertainment club services; Club [cabaret] services; Club [discotheque] services; Club entertainment services; Club services [entertainment]; Sports club services; Night-club services; Fan clubs (Organisation of -); Club</p>	<p>conducting of educational events; Organising of sports and sports events; Wine tasting events for educational purposes; Production of esports events for television; Management of events for sporting clubs; Organisation of sporting events and competitions; Organising of sports competitions and events; Ticket procurement services for entertainment events; Production of sporting events for film; Ticket procurement services for sporting events; Booking of seats for entertainment events; Ticket information services for esports events; Organization of sporting events and competitions; Production of sporting events for television; Preparing subtitles for live theatrical events; Production of sporting events for radio; Organization of events for cultural purposes; Arranging and conducting of sports events; Time recording services for sporting events; Provision and management of sporting events; Ticket information services for entertainment events; Ticket information services for sporting events; Organisation of stock car</p>
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<p>services [entertainment or education]; Health and fitness club services; Entertainment in the nature of yacht races; Club sporting facilities (Provision of -).</p>	<p> racing events; Arranging and conducting of entertainment events; Organizing and conducting college athletic events; Entertainment services relating to sporting events; Services for the organisation of football events; Organisation of sporting competitions and sports events; Provision of information relating to sporting events; Entertainment services in the nature of skating events; Ticket reservation and booking services for esports events; Disc jockeys for parties and special events; Organising of sports competitions and sports events; Entertainment provided during intervals of sporting events; Arranging and conducting of live entertainment events; Services for the organisation of sports events; Rental of equipment for use at athletic events; Entertainment services provided during intervals at sports events; Ticket reservation and booking services for sporting events; Disc jockey services for parties and special events; Organising of sports events and of sports competitions; Booking of seats for shows and sports events; Ticket reservation and booking </p>
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	services for entertainment events; Organisation of automobile rallies, tours and racing events; Organization of sporting events and competitions, involving animals.
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Class 25

38. All the terms listed in the applicant's specification are present in the opponent's specification and hence the respective terms are identical.

Class 35

39. "Retail services relating to jewelry" and "Retail services in relation to jewellery" are identical to the opponent's "Retail services relating to jewelry".

40. "Retail services relating to furniture" and "Retail services in relation to furnishings" are identical to the opponent's "Retail services relating to furniture".

41. "Retail services relating to clothing" are identical to the opponent's "Retail services relating to clothing".

42. "Retail services in relation to clothing" are identical to the opponent's "Retail services in relation to clothing".

43. "Retail services in relation to headgear" are identical to the opponent's "Retail services in relation to headgear".

44. "Retail services relating to sporting goods" are identical to the opponent's "Retail services relating to sporting goods".

45. “Retail services in relation to sporting goods”, “Retail services in relation to sporting equipment” and “Retail services in relation to sporting articles” are identical to the opponent’s “Retail services relating to sporting goods”.
46. “Retail services in relation to fashion accessories” are identical to the opponent’s “Retail services in relation to fashion accessories”.
47. “Online retail store services relating to clothing” are identical to the opponent’s “Online retail store services relating to clothing”.
48. “Online retail services relating to jewelry” are identical to the opponent’s “Online retail services relating to jewelry”.
49. “Online retail services relating to handbags” are identical to the opponent’s “Online retail services relating to handbags”.
50. “Retail services relating to fragrancings preparations” are identical to the opponent’s “Retail services relating to fragrancings preparations”.
51. “Retail services relating to furs” are *Merici* identical to the opponent’s “Retail services relating to clothing” in that the services designated by the trade mark application are included in a more general category designated by the earlier mark. Collins online dictionary states that “A fur is a coat made from real or artificial fur”¹.
52. “Retail services relating to home textiles” are *Merici* identical to the opponent’s “Retail services in relation to fabrics” in in that the services designated by the trade mark application are included in a more general category designated by the earlier mark.
53. “Retail services in relation to toiletries” are *Merici* identical to the opponent’s “Retail services relating to fragrancings preparations” in that the services designated by the earlier mark are included in a more general category designated by the trade mark application.

¹ www.collinsdictionary.com/dictionary/english/fur

54. “Mail order retail services for clothing” and “Online retail services relating to clothing” are *Meric* identical to the opponent’s “Retail services relating to clothing” in that the services designated by the trade mark application are included in a more general category designated by the earlier mark.
55. “Event marketing”, “Promotion of special events”, “Arranging and conducting of marketing events”, “Arranging and conducting of promotional events”, “Arranging and conducting of advertising events”, “Organisation of events for ... advertising purposes” and “Arranging and conducting marketing promotional events for others” are *Meric* identical to the opponent’s “Organization of fashion shows for promotional purposes” in that the services designated by the earlier mark are included in the more general categories designated by the trade mark application.
56. “Organisation of events for commercial ... purposes” is *Meric* identical to the opponent’s “Organisation of fashion shows for commercial purposes” in that that the service designated by the earlier mark is included in the more general category designated by the trade mark application.
57. “Retail services in relation to bags”, “Retail services in relation to luggage” and “Online retail services relating to luggage” are *Meric* identical to the opponent’s “Online retail services relating to handbags” in that the services designated by the earlier mark are included in the more general categories designated by the trade mark application.
58. “Mail order retail services for clothing accessories” are *Meric* identical to the opponent’s “Retail services in relation to fashion accessories” in that the services designated by the trade mark application are included in a more general category designated by the earlier mark.
59. “Online retail services relating to toys” is *Meric* identical to the opponent’s “Online ordering services” (which I take to be a synonym for online retail

services) in that the services designated by the trade mark application are included in a more general category designated by the earlier mark.

60. To the extent that “Marketing services relating to esports events”, “Advertising services relating to esports events”, “Promotion of sports competitions and events”, “Promotion services relating to esports events” and “Arranging promotion of charitable fundraising events” include online marketing activities, they would be *Merix* identical to the opponent’s “Online marketing”. Where such services relate to physical marketing activities, they would be highly similar, and so the respective services are at least highly similar.

61. To the extent that “Retail services relating to flowers”, “Retail services relating to accumulators”, “Retail services relating to candy”, “Retail services relating to food”, “Retail services relating to batteries”, “Retail services connected with stationery”, “Retail services in relation to cocoa”, “Retail services relating to alcoholic beverages”, “Retail services in relation to toys”, “Retail services in relation to desserts”, “Retail services in relation to coffee”, “Retail services in relation to beer”, “Retail services relating to automobile accessories”, “Retail services in relation to bicycles”, “Retail services in relation to games”, “Retail services in relation to sorbets”, “Retail services in relation to confectionery”, “Retail services in relation to chocolate”, “Retail services in relation to teas”, “Retail services in relation to sanitation equipment”, “Retail services in relation to art materials”, “Retail services in relation to pet products”, “Retail services in relation to stationery supplies” and “Retail services in relation to bicycle accessories” include online retailing, they would be *Merix* identical to the opponent’s “Online ordering services” which I take to be a synonym for online retail services. Where the services relate to physical retailing, they would be highly similar, and so the respective services are at least highly similar.

62. I compare “Retail services in relation to threads” with the opponent’s “Retail services in relation to fabrics”. In that both are retail services, they share the same nature, purpose and method of use. Both services would be used by members of the general public engaged in activities such as dressmaking and

making curtains. The trade channels also coincide in that such retail services would be delivered through the same outlets, such as dressmakers and haberdashers. These services are highly similar.

63. I compare “Retail services in relation to footwear” to the opponent’s “Retail services relating to clothing”. Both services are retail services for goods that are worn on the body and so, as goods, their nature, purpose, and method of use will overlap. Both services would be discharged through the same area of a department store or supermarket and the same businesses may offer both. The users will be the same. The services are not complementary, nor are they in competition. Overall, I find these services to be highly similar.

64. I compare “Retail services in relation to tableware” with the opponent’s “Retail services in relation to cookware”. Both are retail services, and so the broad nature, purpose and method of use will overlap. Both services would be offered by specialist kitchen retailers, so the services would be discharged through the same outlets. The users would clearly overlap in that they would be members of the public looking to buy items used in meal preparation and consumption. They are not complementary, nor are they in competition. I find these services to be highly similar.

65. I compare “Retail services for computer software” with the opponent’s “Online retail services for downloadable digital music”. Given that the applicant’s service includes the online retailing of computer software and could extend to such software being downloaded by the customer, the respective services overlap in terms of nature, purpose, and method of use. Both services concern the retail of Class 9 goods but the goods in these instances would ordinarily be sold through distinct trade channels as between computing outlets and online platforms dedicated to music such as Spotify and YouTube. The respective services are not complementary, nor are they in competition. I find these services to be of low similarity.

66. I compare “Mail order retail services related to beer” with the opponent’s “Online ordering services” which I take to be synonym for online retail services. Both are retail services and therefore have some general characteristics in common. Furthermore, both services are designed for ordering from home, but the applicant’s service is specifically for beer and the transaction takes place by post, whereas the opponent’s service is for all goods and the transaction takes place on line. The respective services are not complementary and are only in competition in relation to consumers of beer. I find the respective services to be of low similarity.
67. I compare “Retail services in relation to umbrellas” to the opponent’s “Retail services relating to clothing”. As retail services, they both have common characteristics. There would also be some overlap of trade channels in that umbrellas might be sold in the same establishments that sell clothing, particularly outdoor clothing. However, such goods are essentially different in nature, purpose, and method of use. The services are not complementary, nor are they in competition. I find these services to be of low similarity.
68. By comparison with the applicant’s “Business management of retail outlets”, “Management of a retail enterprise for others” and “Business management of wholesale and retail outlets”, the opponent’s specification contains no reference to wholesale activities. The retail activities that the opponent holds, such as “Online ordering services” which I take to be synonym for online retail services, are all aimed at end users. As such, they are markedly different from the applicant’s services which are business to business services. Consequently, the respective services are different in terms of nature, purpose, and method of use, as are the trade channels. These services are dissimilar.
69. By the same token, the same analysis applies to “Arranging and conducting sales events for livestock” and “Arranging and conducting sales events for cattle” in that these retail activities are business to business services whereas the opponent’s retail services are all aimed at end users. Furthermore, the

only events for which the opponent holds a registration are its Class 41 “Management of events for sporting clubs”. Therefore, these services are also dissimilar.

Class 41

70. The applicant’s “Management of events for sporting clubs” is identical to the opponent’s “Management of events for sporting clubs”.

71. “Sporting event organization”, “Organising sporting events”, “Arranging of sporting events”, “Organising of sports events”, “Organising of recreational events”, “Organization of sporting events”, “Provision of recreational events”, “Conducting of sports events”, “Organisation of sporting events”, “Organising of sporting events”, “Provision of sporting events”, “Production of sporting events”, “Conducting of live sports events”, “Organising of sports and sports events”, “Organisation of sporting events and competitions”, “Organising of sports competitions and events”, “Organization of sporting events and competitions”, “Arranging and conducting of sports events”, “Provision and management of sporting events”, “Organisation of sporting competitions and sports events”, “Organising of sports competitions and sports events”, “Services for the organisation of sports events” and “Organising of sports events and of sports competitions” are *Merici* identical to the opponent’s “Organisation of yachting competitions” in that the services designated by the earlier mark are included in the more general categories designated by the trade mark application.

72. “Organisation of musical events”, “Musical events (Arranging of -)” and “Arranging of musical events” are *Merici* identical to the opponent’s “Music festival services” in that the services designated by the earlier mark are included in the more general categories designated by the trade mark application.

73. “Organisation of cultural events”, “Conducting of cultural events”, “Arranging of cultural events”, “Organizing cultural and arts events”, “Organising events for cultural purposes”, “Organisation of ... cultural events”, “Organization of events for cultural purposes”, “Organising community cultural events” and “Organizing community ... cultural events” are *Merix* identical to the opponent’s “Music festival services” in that the services designated by the earlier mark are included in the more general categories designated by the trade mark application.
74. “Organisation of entertainment events”, “Conducting of entertainment events”, “Organising events for entertainment purposes”, “Conducting of live entertainment events”, “Production of live entertainment events”, “Presentation of live entertainment events”, “Organisation of entertainment ... events”, “Arranging and conducting of entertainment events” and “Arranging and conducting of live entertainment events” are *Merix* identical to the opponent’s “Organization of fashion shows for entertainment purposes” in that the service designated by the earlier mark is included in the more general categories designated by the trade mark application.
75. “Publication of calendars of events” is *Merix* identical to the opponent’s “Publishing services” in that the service designated by the trade mark application is included in a more general category designated by the earlier mark.
76. “Providing facilities for sports events” is *Merix* identical to the opponent’s “Provision of sporting club facilities” in that the service designated by the earlier mark is included in the more general category designated by the trade mark application.
77. “Timing of sports events”, “Sports events (Timing of -)”, “Time recording services for sporting events”, “Handicapping for sporting events”, “Handicapping services for sporting events”, “Provision of information relating to sporting events”, “Ticket information services for sporting events”, “Ticket reservation and booking services for sporting events”, “Booking of seats for ...

sports events”, “Ticket reservation and booking services for esports events”, “Ticket information services for esports events” and “Ticket procurement services for sporting events” are *Meric* identical to the opponent’s “Management of events for sporting clubs” in that the services designated by the trade mark application are included in a more general category designated by the earlier mark.

78. “Organising gymnastics events”, “Organisation of cycling events”, “Organising of football events”, “Gymnastics events (Organising of -)”, “Organisation of automobile racing events”, “Organising of motor racing events”, “Ice-skating events (Organising of -)”, “Horse jumping events (Organising of -)”, “Organisation of vehicle racing events”, “Organisation of stock car racing events”, “Organizing and conducting college athletic events”, “Rental of equipment for use at athletic events”, “Services for the organisation of football events”, “Organisation of automobile rallies, tours and racing events”, “Organization of sporting events and competitions, involving animals”, “Organisation of esports events”, “Production of esports events”, “Conducting of live esports events”, “Organising community sporting events”, “Organizing community sporting ... events” and “Entertainment services in the nature of skating events” are *Meric* identical to the opponent’s “Management of events for sporting clubs” in that the services designated by the trade mark application are included in a more general category designated by the earlier mark. If the respective services are not *Meric* identical, they are at least highly similar.

79. I compare “Entertainment services relating to sporting events”, “Entertainment services provided during intervals at sports events” and “Entertainment provided during intervals of sporting events” with the opponent’s “Musical entertainment”. All these services are entertainment services. The applicant’s services consist of half time shows and so on, which are highly likely to include musical entertainment. To the extent that the applicant’s services include musical entertainment, the services would be *Meric* identical. However, given that they also include other forms of entertainment, the trade

channels will coincide to at least a great extent. The services are not strictly complementary due to there being other types of entertainment than musical entertainment. There would, however, be competition where a sporting event promoter chose between a general entertainment provider which specialises in sporting events and a musical entertainment service. Overall, I find the respective services to be at least highly similar.

80. I compare “Dance events”, “Organising dancing events” and “Organization of dancing events” with the opponent’s “Dance club services”. The respective terms share the same nature, purpose, and method of use, only differing to the extent that events are occasional whereas a club is a longer-term or even a permanent arrangement. They are not complementary but would be in competition, with the consumer choosing between a one-off dance event and a more established club. I find the respective terms to be highly similar.

81. I compare “Disc jockeys for parties and special events” and “Disc jockey services for parties and special events” with the opponent’s “Club [discotheque] services”. Both services utilise DJs for the purpose of getting people dancing. The opponent’s service is a slightly broader term which will generally be offered at a fixed venue, although it is not uncommon for club discotheque services to be provided at parties and special events on a “pop up” basis. The respective services will be sold through the same trade channels. While not complementary, the services would be in meaningful competition. I find them to be highly similar.

82. I compare “Special event planning” and “Special event planning consultation” with the opponent’s “Management of events for sporting clubs”. All are event-related services, albeit the applicant’s services are for the planning of special events at large, whereas the opponent’s services are for the management of events on behalf of sporting clubs (and therefore the user base is narrower) and, for the latter, the events could be special or routine. The respective services will share trade channels, albeit the opponent’s services are more specialised. The services are not complementary, but there would be a

degree of competition where a sporting club was putting on a special event and had a choice between buying an events management service that included planning the event and specific planning expertise. Overall, I find these services to be of medium similarity.

83. I compare “Ticketing and event booking services”, with the opponent’s “Management of events for sporting clubs”. While ticketing is a discrete activity which differs in nature, purpose, and method of use from the management of a sporting event as a whole, such events management can extend to ticketing. Where this is the case, the trade channels would converge and there would be complementarity in that the respective services are important to each other, and the average consumer may think that the responsibility for the respective services lies with the same undertaking. Where ticketing was a standalone service, competition would be a factor. Overall, I find the respective services to be of medium similarity.

84. I compare “Booking of seats for entertainment events”, “Ticket information services for entertainment events”, “Booking of seats for shows ...”, “Ticket reservation and booking services for entertainment events” and “Ticket procurement services for entertainment events” with the opponent’s “Organization of fashion shows for entertainment purposes”. While ticketing is a discrete activity which differs in nature, purpose, and method of use from the organisation of a fashion show as a whole, such organisation can extend to ticketing. Where this is the case, the trade channels would converge and there would be complementarity in that the respective services are important to each other, and the average consumer may think that the responsibility for the respective services lies with the same undertaking. Where ticketing was a standalone service, competition would be a factor. Overall, I find the respective services to be of medium similarity.

85. I compare “Ticket reservation for cultural events” with the opponent’s “Music festival services”. While ticketing is a discrete activity which differs in nature, purpose, and method of use from the running of a music festival as a whole, running a music festival includes ticketing. Where this is the case, the trade

channels would converge and there would be complementarity in that the respective services are important to each other, and the average consumer may think that the responsibility for the respective services lies with the same undertaking. Where ticketing was a standalone service, competition would be a factor. Overall, I find the respective services to be of medium similarity.

86. I compare "Preparing subtitles for live theatrical events" with the opponent's "Publishing of scripts for theatrical use". They differ in nature, the former appearing on screen and the latter being hard copy material. They have something in common in method of use and purpose in that they are both read, and they both aim to further the understanding of a theatrical performance. While they are separate disciplines in terms of how they are produced, there may be some commonality of trade channels where a particular business focussed on serving theatres. They are not complementary, nor are they in competition. Overall, I find the respective services to be of medium similarity.

87. I compare "Conducting of educational events", "Organisation of educational events", "Arranging of educational events" and "Arranging and conducting of educational events" with "Club services [... education]". The respective services are similar in nature, albeit the applicant's services are one-off events, whereas the opponent's services offer a more fixed facility. Both would be experienced in a classroom-style setting. Both are educational in purpose. There would be some convergence of trade channels. The services are not strictly complementary, but they are in competition as between a consumer deciding between a particular educational event and a more long-term educational commitment. I find the respective services to be of medium similarity.

88. I compare "Wine tasting events for educational purposes" with the opponent's "Club services [... education]". Club services for educational purposes could cover subjects like history, but they could also include wine tasting about which there is a considerable body of knowledge. To that extent, they have something in common in terms of method of use - general educational club

services and a wine tasting event for educational purposes would both be experienced in a classroom-style setting. Both are educational in purpose. There would be some convergence of trade channels. The services are not complementary and are only in competition where wine is the subject matter. I find the respective services to be of low similarity.

89. I compare "Sound engineering services for events", "Lighting technician services for events" and "Video editing services for events" with the opponent's "Live musical performances." The applicant's services have specific technical natures and methods of use. While these technical services are an important part of live musical performances (such performances frequently featuring a video element), the average consumers are different (for the former they are businesses putting on live musical performances and for the latter they are members of the public). They are not complementary, nor are they in competition. I find these services to be dissimilar. I have considered the other terms in the opponent's specification, and I can see no other point of similarity which would put the opponent in a stronger position.

90. I compare "Providing information on congress events" with the opponent's "Management of events for sporting clubs" which appears to be the opponent's best case. However, the respective services relate to different types of events. Congress events are conference events where organisations gather in large numbers, often to make decisions. The opponent's service is for sporting events. The respective services differ in nature, purpose and method of use and would attract different consumers. Information on conferences would be obtained through different trade channels than a sporting events management service. They are neither complementary, nor are they in competition. The respective services are dissimilar. I have considered the other terms in the opponent's specification, and I can see no other point of similarity which would put the opponent in a stronger position.

91. I compare "Production of sporting events for film", "Production of sporting events for television", "Production of sporting events for radio" and "Production of esports events for television" with the opponent's "Management

of events for sporting clubs” which appears to be the opponent’s best case. However, while the management of events for sporting clubs would involve liaising with film production and television and radio companies if the event was being professionally filmed or broadcast, I consider the connection between the respective services to be tenuous. Film production and broadcasting are highly specialised industries and not something that would ordinarily be carried out by an events management company. I consider the respective services to differ in nature, purpose and method of use. The applicant’s specialised services would be obtained through different trade channels than a sporting events management service. They are neither complementary, nor are they in competition. The respective services are dissimilar. I have considered the other terms in the opponent’s specification, and I can see no other point of similarity which would put the opponent in a stronger position.

92. I compare “Organization of cosplay entertainment events” with the opponent’s “Organization of fashion shows for entertainment purposes”. Cosplay is a form of fancy dress, typically involving dressing up as a character from a film or television programme. Film and television studios sometimes commission cosplay events as commercial ventures for fans. While both services have the broad purpose of entertainment, fashion shows and cosplay events are distinctly different in nature and are only superficially similar in terms of method of use to the extent that both involve the donning of noteworthy clothing. The trade channels would differ in that the fashion and film and television industries are distinct sectors. The services are not complementary, nor are they in competition. I find the respective services to be dissimilar. I have considered the other terms in the opponent’s specification, and I can see no other point of similarity which would put the opponent in a stronger position.

93. As some degree of similarity between the goods and services is required for there to be a likelihood of confusion², the opposition fails in respect of the following services:

Class 35 Business management of retail outlets; Management of a retail enterprise for others; Business management of wholesale and retail outlets; Arranging and conducting sales events for livestock; Arranging and conducting sales events for cattle.

Class 41 Sound engineering services for events; Lighting technician services for events; Video editing services for events; Providing information on congress events; Production of sporting events for film; Production of sporting events for television; Production of sporting events for radio; Production of esports events for television; Organization of cosplay entertainment events.

The average consumer and the nature of the purchasing act

94. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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

95. The average consumer for clothing is a member of the public. Clothing ranges widely in cost. The amount of deliberation that is required in purchasing a particular item varies. Overall, I consider the level of attention that would be paid during the purchasing process to be medium.
96. While some clothing purchases might require help from a shop assistant, and therefore I do not rule out verbal considerations, visual factors will dominate as the average consumer scrutinises clothes on shelves and on hangers (or online equivalents).
97. For the retail services, the average consumer will be a member of the public. Factors in the selection process will be stock and the price of goods offered by comparison with other retailers. For bricks and mortar establishments, the experience and knowledge of the staff will have a bearing on the purchasing process, whereas for online retail services, delivery arrangements will be an important consideration. Overall, the level of attention paid during the purchasing process will be medium.
98. Visual considerations will be an important part of the selection process for retail services. Physical retail services are most likely to be selected having considered promotional material and signage. For online retail services, these are likely to be chosen after viewing online advertising or search engine links. However, such services are also likely to be the subject of word-of-mouth recommendations which means that verbal factors cannot be discounted.
99. Marketing services will be purchased by business people who will consider the cost and the length and range of a given marketing campaign. The purchase of such services may involve entering into a contract. The level

of attention paid during the purchasing process will be of at least a medium level.

100. Visual factors will dominate when business people peruse the websites of prospective marketing companies. Verbal elements may play a part when meetings are requested, and terms and conditions are discussed.
101. In relation to the sporting events at issue where a significant proportion of average consumers are sporting club officials, they will scrutinise the websites of events organisations to satisfy themselves that all the different aspects of the prospective event will be taken care of. They will also want to know about pricing. Details are important for such a service. A contract may be entered into, but such a service will at least be invoiced for. Overall, the level of attention paid during the purchasing process will be of at least a medium level.
102. Visual elements will dominate as the sporting club official looks at the websites of prospective events companies. However, verbal considerations may play a role when a meeting is requested to discuss the details of the service.
103. In relation to the sporting, cultural, educational, and entertainment events at issue where the average consumer is a member of the public, they will scrutinise the websites of events organisers to check what the event consists of and to ascertain what the ticket prices are. Consequently, what is being offered and the price will be thought about. While some events will be modestly priced, others will be in the high range. Overall, the level of attention paid during the purchasing process will be of a medium level.
104. Visual elements will dominate, with verbal factors playing a minor role.

Likelihood of confusion

105. 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

106. Earlier in this decision (except for those services that I have determined to be dissimilar), I found the goods and services to be either identical (in some cases with a fallback that they are at least highly similar), highly similar, or of medium or low similarity. I found the earlier mark to be of a low level of inherent distinctiveness in relation to the opponent's Class 41 sport-related club services and yachting terms, and of a medium level for the remaining goods and services. I did not find evidence of enhanced distinctiveness.

107. The average consumer of the parties' goods and services, a member of the public, will pay a medium level of attention during the purchasing process when it comes to clothing, a variety of retail services, and sporting, cultural, educational, and entertainment events. For marketing and events

services, where the average consumer is a business person, and for those sporting events where sporting club officials form a significant proportion of average consumers, the level of attention paid will be at least medium. For all of the purchasing processes considered, visual considerations would dominate, but verbal factors are not ruled out entirely.

108. Given that the marks are identical, I find that there would be a likelihood of direct confusion for all those goods and services that I have found to be identical or similar, this finding including those services that I have found to be of low similarity. There is no minimum threshold level of similarity that must be shown as it is sufficient that some similarity exists in order to consider the likelihood of confusion.³ I consider that the distance between the goods and services which are similar to only a low degree would be offset by the identity of the marks.

109. Although I have found a likelihood of direct confusion based on my notional assessment, I will mention that the opponent has filed evidence of actual confusion. This evidence is in paragraph 4 of Jan Simmonds' second witness statement and exhibits JS7 and JS8, whereby a brand agency and a clothing company contacted the opponent with a view to working with it in the mistaken belief that they had seen the opponent's mark being used by the opponent. The brand agency and clothing company had seen the applicant's use of the sign "Soho Yacht Club" in association with a piece of work that the applicant did with Chelsea Football Club in relation to its third kit. This is documented in the applicant's own evidence – Exhibit HC6 – where photographs are captioned "It's a West London Thing as Soho Yacht Club Presents Chelsea's New Third Kit" and social media extracts include a reference to "local fashion collective @sohoyachtclub".

110. The respective marks in this case are identical and the goods at issue are identical terms for clothing. I consider that the documentation filed shows

³ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

evidence of actual confusion in relation to clothing, and this corroborates my finding of direct confusion based on my notional assessment.

CONCLUSION

111. The opposition succeeds in relation to the following goods and services:

Class 25 Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing.

Class 35 Retail services relating to jewelry; Retail services relating to furniture; Retail services relating to flowers; Retail services relating to furs; Retail services relating to accumulators; Retail services relating to candy; Retail services relating to food; Retail services relating to clothing; Retail services for computer software; Retail services relating to batteries; Retail services connected with stationery; Retail services in relation to jewellery; Retail services in relation to headgear; Retail services

in relation to bags; Retail services in relation to furnishings; Retail services in relation to cocoa; Retail services relating to alcoholic beverages; Retail services relating to home textiles; Retail services in relation to toiletries; Retail services in relation to umbrellas; Retail services in relation to luggage; Retail services in relation to tableware; Retail services in relation to toys; Retail services in relation to desserts; Retail services in relation to coffee; Retail services in relation to beer; Retail services relating to automobile accessories; Retail services relating to sporting goods; Mail order retail services for clothing; Online retail services relating to jewelry; Online retail services relating to handbags; Retail services relating to fragrancing preparations; Retail services in relation to bicycles; Retail services in relation to clothing; Retail services in relation to threads; Retail services in relation to games; Retail services in relation to sorbets; Online retail services relating to toys; Retail services in relation to footwear; Retail services in relation to confectionery; Retail services in relation to chocolate; Retail services in relation to teas; Online retail services relating to luggage; Online retail services relating to clothing; Retail services in relation to sanitation equipment; Retail services in relation to sporting equipment; Retail services in relation to art materials; Retail services in relation to sporting articles; Mail order retail services related to beer; Retail services in relation to pet products; Retail services in relation to stationery supplies; Online retail store services relating to clothing; Retail services in relation to fashion accessories; Retail services in relation to bicycle accessories; Mail order retail services for clothing accessories; Event marketing; Promotion of special events; Marketing services relating to esports events; Arranging and conducting of marketing events; Arranging and conducting of promotional events; Advertising services relating to esports events; Promotion of sports competitions and events; Arranging

and conducting of advertising events; Promotion services relating to esports events; Arranging promotion of charitable fundraising events; Organisation of events for commercial and advertising purposes; Arranging and conducting marketing promotional events for others.

Class 41 Dance events; Organising gymnastics events; Sporting event organization; Organising sporting events; Organising dancing events; Special event planning; Organisation of musical events; Special event planning consultation; Arranging of sporting events; Organising of sports events; Conducting of educational events; Organisation of cycling events; Timing of sports events; Organising of recreational events; Organisation of cultural events; Organization of sporting events; Organisation of educational events; Arranging of educational events; Conducting of cultural events; Organisation of esports events; Organising community sporting events; Provision of recreational events; Organising of football events; Musical events (Arranging of -); Conducting of sports events; Organisation of sporting events; Organising of sporting events; Provision of sporting events; Organisation of entertainment events; Sports events (Timing of -); Gymnastics events (Organising of -); Arranging of musical events; Organization of dancing events; Production of sporting events; Handicapping for sporting events; Arranging of cultural events; Conducting of entertainment events; Production of esports events; Organising community cultural events; Handicapping services for sporting events; Providing facilities for sports events; Organising events for entertainment purposes; Organisation of automobile racing events; Organising of motor racing events; Ticket reservation for cultural events; Conducting of live esports events; Organizing cultural and arts events; Ice-skating events (Organising of -); Publication of calendars of events; Organising

events for cultural purposes; Conducting of live entertainment events; Production of live entertainment events; Conducting of live sports events; Horse jumping events (Organising of -); Organisation of vehicle racing events; Ticketing and event booking services; Presentation of live entertainment events; Organizing community sporting and cultural events; Organisation of entertainment and cultural events; Arranging and conducting of educational events; Organising of sports and sports events; Wine tasting events for educational purposes; Management of events for sporting clubs; Organisation of sporting events and competitions; Organising of sports competitions and events; Ticket procurement services for entertainment events; Ticket procurement services for sporting events; Booking of seats for entertainment events; Ticket information services for esports events; Organization of sporting events and competitions; Preparing subtitles for live theatrical events; Organization of events for cultural purposes; Arranging and conducting of sports events; Time recording services for sporting events; Provision and management of sporting events; Ticket information services for entertainment events; Ticket information services for sporting events; Organisation of stock car racing events; Arranging and conducting of entertainment events; Organizing and conducting college athletic events; Entertainment services relating to sporting events; Services for the organisation of football events; Organisation of sporting competitions and sports events; Provision of information relating to sporting events; Entertainment services in the nature of skating events; Ticket reservation and booking services for esports events; Disc jockeys for parties and special events; Organising of sports competitions and sports events; Entertainment provided during intervals of sporting events; Arranging and conducting of live entertainment events; Services for the organisation of sports

events; Rental of equipment for use at athletic events;
Entertainment services provided during intervals at sports events; Ticket reservation and booking services for sporting events; Disc jockey services for parties and special events; Organising of sports events and of sports competitions; Booking of seats for shows and sports events; Ticket reservation and booking services for entertainment events; Organisation of automobile rallies, tours and racing events; Organization of sporting events and competitions, involving animals.

112. The application will proceed to registration for the following services:

Class 35 Business management of retail outlets; Management of a retail enterprise for others; Business management of wholesale and retail outlets; Arranging and conducting sales events for livestock; Arranging and conducting sales events for cattle.

Class 41 Sound engineering services for events; Lighting technician services for events; Video editing services for events; Providing information on congress events; Production of sporting events for film; Production of sporting events for television; Production of sporting events for radio; Production of esports events for television; Organization of cosplay entertainment events.

COSTS

113. As the more successful of the two parties in this case, I would have considered making an award in favour of the opponent in line with the normal scale of costs. However, in writing to the Tribunal to confirm that it would be making no further submissions, the opponent stated that it had “chosen not

seek costs other than the statutory ones". I take that to be a reference to the official fee incurred and accordingly I award the opponent costs of £100.

114. I order Soho Yacht Club Ltd to pay Carr Media Limited £100. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of July 2023

JOHN WILLIAMS
For the Registrar