

**O/0777/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003825464**

**BY TECH CIRCUS LTD**

**TO REGISTER:**

**TECH CIRCUS**

**AS A TRADE MARK IN CLASSES 9, 35, 41 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. OP600002655 BY**

**CIRCUS BELGIUM S.A.**

## BACKGROUND AND PLEADINGS

1. On 1 September 2022, Tech Circus Ltd (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK (“the applicant’s mark”). The application was published for opposition purposes on 16 September 2022 and registration is sought for the following goods and services:

Class 9: Interactive software; Downloadable software for use in the fields of network conferencing services, video conferencing services, video teleconferencing and web conferencing services; Educational software; podcasts.

Class 35: Organising and hosting online business events and conferences for participants to conduct, watch and participate in audio and video presentations for business and commercial purposes; Arranging and conducting trade fairs and exhibitions for business and commercial purposes; Arranging and conducting of marketing events; Arranging and conducting of promotional events; Marketing services; Marketing advice; Marketing consulting; Writing of publicity texts; Recruitment of services; Recruitment advertising; Ticket reservation and booking services for business events and conferences.

Class 41: Arranging and conducting of training courses and conferences; Organisation of exhibitions and trade fairs for educational purposes; Education and instruction services; Organising and hosting online conferences for participants to conduct, watch and participate in audio and video presentations for educational purposes; Organising of entertainment events; Arranging and conducting workshops and seminars; Organising and conducting classes, seminars, symposiums, conferences and exhibitions; Education services; Education courses; Educational demonstrations; Educational information; Education, teaching and training provided via telecommunications networks, by online

delivery and by way of the Internet; Writing services for blogs; Writing of texts other than publicity texts; Creation of podcasts; Production of podcasts; Ticket reservation and booking services for education and entertainment events.

Class 42: Website design; Creating websites; Website development services; Website hosting services; Maintenance of websites; Building and maintaining websites; Building online event platforms; Platform as a Service [PaaS]; Commissioned writing; Technical writing; Hosting of podcasts.

2. On 5 December 2022, the applicant's mark was opposed under the fast track procedure by CIRCUS BELGIUM S.A. ("the opponent"). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), is reliant upon the following trade mark:

The logo for 'Circus' features a stylized red 'C' with a white dot above it, followed by the word 'ircus' in a bold, black, sans-serif font.

UK registration no. 918025773<sup>1</sup>

Filing date 13 May 2019; registration date 20 October 2020

Relying on all goods and services, namely:

Class 9: Casino game software; Betting software; Data processing computer software relating to sports information; Data recording systems; Recording substrates [magnetic]; Phonograph records; Mechanisms for coin-operated apparatus; Smart cards [integrated circuit cards]; Hard discs; Videodiscs; Videodiscs; Radio cassette tape recorders; Video cassettes; Audio tapes; Encoded magnetic cards; Printed cards [magnetic]; Electronic key cards; Tablet computers; Electronic apparatus enabling the

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<sup>1</sup> The opponent's mark is a comparable trade mark based on the opponent's pre-existing EUTM, being EUTM no. 018025773. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

consultation, completion and validation of forms and grids for forecasts, bets, games and competitions; Electronic purse systems; Recorded games programs for controlling bets; Computer programs for paying players online; Website development software; Computer software for creating dynamic websites; Sound transmitting apparatus; Apparatus for the transmission of images; Apparatus for recording images; Sound recording apparatus; Computer terminals; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs; DVDs; Mechanisms for coin-operated apparatus; Cash registers; Calculators; Data processing equipment; Computers; Audio- and video-receivers; Audiovisual teaching apparatus; Coin-operated mechanisms for television sets; Memory cards; Flash memory cards; Online and downloadable authentication software; Computer software for the purpose of monitoring online communications and chat room conversations and alerting third parties to the contents; Computer software for monitoring the use of computers and the internet by children; Computer software relating to online protection and online security; Telecommunications apparatus enabling connection to databases; Network termination equipment; Modems; Computer software and computer programs for distribution to, and for use by, viewers of a digital television channel for the viewing and purchase of goods and services; computer quiz software; Computer programs for interactive quiz games; Portable and/or hand-held electronic devices for receiving, playing and transmitting music, sounds, text, signals, information and codes; Electronic publications, downloadable; Video screens; Read-only memory cartridges, CD-ROMs, cards and discs, integrated circuit cards, memory carriers, recording media, all pre-recorded featuring quizzes; Parts and fittings of all the aforesaid goods.

Class 28: Card games; Counters for games; Card games; Dice for games; Layout cloths for casino type games such as poker, Roulette; Casino fittings namely roulette tables, roulette wheels; Betting terminals; Casino games with or without prize payouts, automated gaming machines and amusement machines, in particular for commercial use, in casinos and amusement arcades, or games of chance with prize payouts via the Internet and via telecommunications networks, games of chance with prize payouts for use on networked gaming equipment; Fruit machines; Housings for slot machines and gaming machines; Gambling machines; Quizzes adapted for use with television receivers and screens or with video monitors or with computer screens; Scratch cards for playing lottery games.

Class 41: Providing amusement arcade services; Casino facilities [gambling] (Providing -); Providing on-line publications (not downloadable); Education and entertainment services by means of radio, and online databases; Providing on-line publications (not downloadable); publishing of online dictionaries, encyclopaedias, and reference texts; provision of online publications, including newspapers, magazines (periodicals), comics, journals (publications), books, user manuals, instructional and teaching materials; Production, presentation, and distribution of radio programmes; Production, presentation and providing of quizzes; Video on demand and near on demand sports services; Credit betting, gaming, gambling, lottery or bookmaking services; Credit card betting, gaming, gambling, lottery or book making services; Organising and conducting lotteries; Electronic betting, gambling, lotteries or bookmaking services provided via the internet, or via a global computer network, online from a computer network database, or via telephony, including mobile telephones, via a television channel including a television channel distributed by satellite, terrestrial or cable television broadcast; Interactive poker games and gaming including single and multi player gaming

formats; Presentation and production of poker tournaments and games; Publishing of electronic publications; Videotaping; providing information relating to the news and sports; Information and advice relating to radio programmes, music and sport; Factual information services relating to radio programmes, news and sport; Arranging of conferences; Rental of equipment for games rooms and casinos; Online card games; Advice and information relating to casino game competitions, sports, sports competitions and entertainment, competitions, lotteries, sports betting and sports forecasting; Providing of assistance to players in the field of games, lotteries, sports betting and sports forecasting (providing of training).

("the opponent's mark")

3. The opponent claims that the applicant's mark is similar to its own and is to be registered for identical or similar goods and services. As such, the opponent claims that there is a likelihood of confusion on the part of the relevant public, which includes the likelihood of association. The applicant has filed a counterstatement denying the claims made.
4. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
5. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.
6. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal

with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Both parties filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers. I note that the applicant is represented by Harper James and the opponent is represented by Trademark Tonic Limited.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **PRELIMINARY ISSUE**

8. In its written submissions in lieu, the opponent has included images of its website and the games offered on it. This constitutes an attempt to file evidence within written submissions. Nothing turns on this issue as the evidence does not add anything to the opponent's claim, however, I consider it necessary to confirm that this will be given no consideration. As set out above, neither party sought permission to file evidence and attempting to include evidence in written submissions is not appropriate in any Tribunal proceedings, particularly fast track proceedings where it was the opponent that elected to adopt said procedure. For the avoidance of doubt, I will still consider the written submissions insofar as they constitute submissions and not evidence of fact.

## **DECISION**

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

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

“(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 or association with the earlier trade mark.”

10. 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.”

11. 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.

12. 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 application date of the contested mark, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods and services for which its mark is registered.

13. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”), Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:*

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

### **Comparison of goods and services**

14. The applicant's goods and services are set out at paragraph one above. The opponent's goods and services are set out at paragraph two above.

15. 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:

"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".

16. 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;
- (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.

17. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (though it equally applies to services) are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

18. In its counter statement, the applicant made comments in respect of the comparison of the goods and services and argued that the opponent's mark is not registered for services in class 35 and 42. While the applicant maintained that the opponent has no goods and services identical or similar to those services, I wish to point out that, as per section 60A of the Act, goods and services are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.<sup>2</sup> Therefore, the existence of services (or goods for that matter) in different classes is not determinative and I will

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<sup>2</sup> Conversely, section 60A also states that goods and services are not to be found similar just because they fall in the same class of the Nice Classification.

proceed in conducting a full comparison based on the factors set out in the case law above.

19. I note that both parties have made submissions in respect of the goods and services comparison. While I do not intend to reproduce them in full here, I confirm that I have taken them into account.

### Class 9

20. “Interactive software” in the applicant’s specification is a broad term that cover any type of software that a user can interact with. The term is not limited in any way so can, therefore, be used for any purpose such as casino or betting software. I note that the opponent’s mark is registered for “casino game software” and “betting software” and it is my understanding that such software is commonly interactive in that the user interacts with it in order to place a bet or gamble on a game. Therefore, I consider that the opponent’s more specific types of software fall within the applicant’s broader term. As a result, these goods are identical under the principle outlined in *Meric*.

21. The applicant’s “downloadable software for use in the fields of network conferencing services, video conferencing services, video teleconferencing and web conferencing services” is a term that has a specific purpose which does not overlap with the purpose of the opponent’s software goods. As above, the opponent’s goods cover software for casino games and betting. However, it also includes software relating to website development, sports information authentication, monitoring online communications (including that specifically aimed at protecting children online), online security, digital television and computer quizzes. It is my view that the opponent’s best position is its “computer software relating to online protection and online security”. This is on the basis that conferencing software is likely to include security features. While noted, I remind myself that this alone is not sufficient to give rise to a level of similarity.<sup>3</sup> Looking

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<sup>3</sup> *Les Éditions Albert René v OHIM*, Case T-336/03

at the factors set out in the case law, I am of the view that the nature of the goods at issue may overlap on the basis that they are software goods. However, the method of use for each type of software is likely to differ, so too are their purposes on the basis that one aims to provide security whereas the other allows the user to partake in conferences. Further, the user bases targeted by the parties' goods differ meaning that there is also no overlap in user but, even if there is, any overlap is superficial given the broad user base for the parties' goods. As for trade channels, I appreciate that large software companies may offer both types of software, however, I have nothing before me to suggest that this practice is common in the trade. Without such, I am unwilling to make such an inference. Lastly, the goods are not in competition and neither are they complementary on the basis that they are not important or indispensable to one another.<sup>4</sup> Taking all of this into account, I am of the view that these goods are similar to a very low degree.

22. "Educational software" in the applicant's specification is, again, a specific type of software and its purpose is distinct from the software in the opponent's specification. Following the same logic set out in the preceding paragraph, I am of the view that these goods are similar to the opponent's software goods to only a very low degree. That being said, it is my view that the opponent's "education [...] services by means of radio, and online databases" offers a greater degree of similarity to "educational software". As one is a service and one is a good, there is no overlap in nature or method of use. However, the user base overlaps on the basis that the goods and services are targeted at those looking to obtain education. Further, the purpose of the goods and services are the same, i.e. to educate. There is also an overlap in trade channels as an education provider is likely to offer educational software and education in the form of a service (be that online or via radio). Lastly, there is a degree of competition between the goods and services because a user may choose to download software for education over seeking to subscribe to an online service in relation to the same, or vice versa. As a result, I consider that these goods are similar to an above medium degree.

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<sup>4</sup> See *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

23. It is my view that “podcasts” in the applicant’s specification has no counterpart in the opponent’s class 9 list of goods and is, therefore, dissimilar to those goods. While that may be the case, this does not conclude matters. For the sake of completeness, I have given considering to whether it shares any degree of similarity with “production, presentation, and distribution of radio programmes” in the opponent’s specification. While radio programmes are commonly broadcast live over radio frequencies, it is my understanding that they are often repackaged into podcasts and released online for the user to listen to at their convenience. As such, I consider that there is an overlap in trade channels between the goods and services. This is because an undertaking that produces, presents and distributes a radio show is likely to also be the undertaking that provides the podcast to the user. While that may be the case, the nature and method of use for the goods and services are clearly different. As for the purpose, I consider that this differs too as one is a service that aims to produce, present and distribute whereas the other’s purpose is simply to be a good that is listened to by the user. As for the user, these differ as those obtaining the opponent’s service will be business users whereas those seeking the applicant’s podcasts will be members of the general public. Lastly, the goods and services are not in competition and neither are they complementary on the basis that, while some undertakings may offer both, the production, presentation and distribution of a radio show is not important or indispensable to a podcast, and vice versa. While I have found there to be an overlap in trade channels, I do not consider it sufficient to warrant a finding that these goods and services are similar to any degree. They are, therefore, dissimilar.

#### Class 35

24. The opponent’s position in respect of these services is that they are complementary to a range of services in the field of entertainment and education in its class 41 range of services. I note that the opponent’s specification consists of “arranging of conferences”. As a service in class 41, this service expressly excludes the organisation of conferences for commercial and promotional

purposes.<sup>5</sup> This is the specific nature of the applicant's various organisational services in class 35, namely:

Organising and hosting online business events and conferences for participants to conduct, watch and participate in audio and video presentations for business and commercial purposes; arranging and conducting trade fairs and exhibitions for business and commercial purposes; arranging and conducting of marketing events; arranging and conducting of promotional events.

25. In comparing these services, there is some broad overlap in nature and method of use as all of the services relate to the arranging or organisation of something and will be sought in the same way. In addition, there is some overlap in core purpose too as, again, both parties' services offer to arrange or organise something. That being said, any overlap here is superficial given the different purposes of those events. As for the remaining overlaps, I consider that the user and trade channels differ because those looking to organise events for commercial or marketing purposes are not the same as those looking for organisation of conferences in class 41. The same goes for trade channels in that an undertaking that offers services in relation to commercial/promotional services is unlikely to offer them for the purposes covered by class 41 services. On this point, I note that I have nothing before me to suggest otherwise. Taking all of this into account, I am of the view that the broad overlap in nature and method of use together with the superficial overlap in purpose is only sufficient to warrant a finding that these services are similar to a low degree.

26. I have nothing before me to suggest that a provider of services for the arranging of conferences would also offer ticket reservation and booking services for business events and conferences. It is my view that such a service would commonly be offered by a third party specialist and I have nothing before me to suggest otherwise. So while I appreciate that a user looking to seek the opponent's "arranging of conferences" would also look to obtain services for "ticket reservation and booking services for business events and conferences", I see no reason why

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<sup>5</sup> On this point, see the explanatory notes of class 41 services in the Nice Classification

any other factors would overlap. The nature, methods of use and purposes all differ. The goods are not competitive and while the reservation and booking service may be important or indispensable to the actual conference itself, the issue here is whether it is important/indispensable to the arrangement service for the same. I do not consider that it is and have nothing before me to suggest otherwise. Overall, I do not consider that the overlap in user is sufficient to give rise to any degree of similarity. These services are, therefore, dissimilar.

27. Lastly, I see no obvious reason why any of the goods or services of the opponent would be similar to any degree with the remaining class 35 services of the applicant, being “marketing services”, “marketing advice”, “marketing consulting”, “writing of publicity texts”, “recruitment of services” and “recruitment advertising”. These goods are, therefore, dissimilar.

#### Class 41

28. As I have already discussed above, the opponent’s mark is registered for “arranging of conferences”. By virtue of being registered as a service in class 41, it is likely that these cover conferences for educational and entertainment purposes. Further, there is nothing limiting this service as such and neither is there anything that suggests the services cannot be provided online. Therefore, I find that “organising and hosting online conferences for participants to conduct, watch and participate in audio and video presentations for educational purposes” in the applicant’s specification falls within the opponent’s broader term. These goods are, therefore, identical under the principle outlined in *Meric*.

29. As set out above, the opponent’s service of “arranging of conferences” can cover conferences for entertainment purposes. Given that the term organising and arranging are synonymous terms used to describe the same service, I am of the view that the opponent’s service can encompass the applicant’s “organising of entertainment events” service. As a result, I find that these services are identical under the principle outlined in *Meric*.

30. The following services of the applicant are broad organisation or arranging services that relate specifically to educational events:

Arranging and conducting workshops and seminars; Organising and conducting classes, seminars, symposiums, conferences and exhibitions; Organisation of exhibitions and trade fairs for educational purposes; Arranging and conducting of training courses and conferences.

31. They are not actually services for the provision of education so, therefore, are not the same as the opponent's "education and entertainment services by means of radio, and online databases". However, the opponent's specification does include "arranging conferences". There is no limitation preventing this service from covering the arranging of educational conferences. Therefore, where the applicant's services covering the arranging and organisation of education conferences, they are identical under the principle outlined in *Meric* to the opponent's service. So while the other services relating to trade fairs, training courses or seminars, for example, are not identical to the opponent's services, I do consider them to be similar. This is because, in the context of arranging educational conferences, the opponent's service overlaps in user and trade channels and also overlaps broadly in purpose (in that all of the services aim to arrange some education related event). Further, the services may be somewhat competitive in that a user looking to arrange an educational event may wish to conduct it via a conference over doing it via a seminar or trade fair, or vice versa. As a result, I consider that these services are similar to a medium degree.

32. The applicant's specification consists of a range of broad education services, namely "education and instruction services", "education services", "education courses" and "education, teaching and training provided via telecommunications networks, by online delivery and by way of the Internet". The opponent's mark is registered for "education [...] services by means of radio, and online databases". Given that there is no limitation in the applicant's services to prevent them being provided via radio and online databases, the opponent's services can be said to fall within them. As a result, these services are identical under the principle outlined in *Meric*.

33. While the opponent's educational service is limited to radio and online databases, there is nothing preventing it from covering educational demonstrations and educational information. As a result, I consider that "educational demonstrations" and "educational information" in the applicant's mark are sufficiently broad enough to be provided via radio or online databases and, therefore, envelop the opponent's "education [...] services by means of radio, and online databases" services. Conversely, it could be said that the opponent's services are broader than that of the applicant and, therefore, the applicant's goods fall within the opponent. Regardless, I find that these services are identical under the principle outlined in *Meric*,

34. I have discussed a potential overlap between podcasts and the opponent's "production, presentation, and distribution of radio programmes" at paragraph 23 above. Following the same logic discussed in that paragraph, I find that there is some degree of similarity between the opponent's services and the applicant's "production of podcasts". Above, I found that the only overlap between the applicant's goods and the opponent's service was in respect of trade channels. While that is applicable here, I find that there are additional overlaps in respect of nature and user. This is on the basis that the services both include production services and a user looking for production of a podcast may also seek production of a radio programme (on the basis of the logic that a radio programme may also be formatted and released as a podcast). In addition, there is some overlap in purpose because both services aim to produce an audio programme. While the exact nature of the programme may differ as one relates to podcasts and the other to radio, there is still a broad level of overlap here. Taking all of this into account, I am of the view that these services are similar to a medium degree.

35. While I have found a degree of similarity between the services discussed in the preceding paragraph, the same finding does not necessarily apply in respect of the applicant's "creation of podcasts". I appreciate that the user and trade channels will overlap in that someone looking to for production, presentation and distribution of a radio show will also look to create a podcast of said radio show (following the logic discussed above) and that such services are likely to be sought from the same

undertaking. However, the purposes and nature of the services differ and one is for the creation of the podcast whereas the other aims to produce, present and distribute a radio show. Overall, I consider that these services are similar to a low degree.

36. I see no obvious reason why “writing services for blogs” and “writing of texts other than publicity texts” in the applicant’s specification would overlap to any degree with any of the opponent’s goods or services. I note that the opponent’s specification includes goods and services relating to downloadable publications, which will obviously include articles that include writing. However, this is not the same as the provision of writing and I do not consider that this alone is enough to suggest that they are similar to any degree. These goods are, therefore, dissimilar.

37. While assessed in different classes, I am of the view that the findings made at paragraph 26 above can be said to apply to a comparison between the opponent’s services and “ticket reservation and booking services for education and entertainment events”. As such, I consider that these services are dissimilar.

#### Class 42

38. While the applicant’s “website design”, “creating websites”, “website development services”, “building and maintaining websites” and “building online event platforms” are services, I am of the view that they share a degree of similarity with the opponent’s “website development software”. I appreciate that the nature and methods of use differ, however, I am of the view that these goods overlap in trade channels and purpose. This is on the basis that the goods and services are likely to be offered by the same undertakings and can all be used to assist the user in building or designing a website. As for user, I am of the view that those looking to create or design a website would either choose to download the software themselves or seek the assistance of a service provider. So while the user may not overlap, the goods and services are competitive. Taking all of this into account, I am of the view that the goods and services are similar to a medium degree.

39. As for the applicant's "website hosting services" and "maintenance of websites", I will compare these to the same goods of the opponent as assessed in the preceding paragraph. So while I appreciate that the same overlap trade channels will exist, I do not consider that the purposes will. Having said that, I am of the view that these goods and services are not competitive but there is an overlap in user as those seeking to use the opponent's software goods are also likely to seek the hosting and maintenance services covered by the opponent's terms. Taking into account the overlap in user and trade channels, I find that these goods are similar to a low degree.

40. It is my understanding that "platform as a service [PaaS]" in the applicant's specification is a service that provides access to a platform that is hosted on the cloud and is used for the developing, managing, maintaining and running applications. Such a platform is, therefore, used for applications that assist the user in creating software. While the opponent's specification consists of software relating to website sign, there are no goods or services that cover (or relate to) creating the software itself. I see no reason why a platform as a service would be similar to different types of software just because they relate to computing. I, therefore, find that these services are dissimilar to any of the goods and services in the opponent's specification.

41. Following the same logic discussed at paragraph 36 above when considering the provision of writing services, I reach the same finding here in respect of "commissioned writing" and "technical writing" in that they are dissimilar to any of the opponent's goods or services.

42. I have discussed throughout this decision the link between production, presenting and distribution of radio programmes and goods and services relating to podcasts. Using the same reasoning discussed throughout (in that a radio show may be formatted and released as a podcast), I am of the view that there is some overlap in trade channels between "hosting of podcasts" in the applicant's specification and "production, presentation, and distribution of radio programmes" in the opponent's. This is on the basis that a radio production company may also host podcasts (on their websites, for example). However, I am of the view that this is

where the similarity ends. The users are different in that someone looking for the hosting of an already produced podcast would not seek the production, presentation and distribution of a radio programme. Further, the nature, method of use and purposes all differ. Finally, the goods and services are not in competition or complementary. As a result, I consider that these goods and services are dissimilar.

43. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, the opposition aimed against dissimilar goods and services will fail.<sup>6</sup> Those goods and services that I have found dissimilar are set out below and, for the avoidance of doubt, the opposition against them fails at this stage.

Class 9: Podcasts.

Class 35: Ticket reservation and booking services for business events and conferences; marketing services; marketing advice; marketing consulting; writing of publicity texts; recruitment of services; recruitment advertising.

Class 41: Writing services for blogs; writing of texts other than publicity texts; ticket reservation and booking services for education and entertainment events.

Class 42: Commissioned writing; technical writing; hosting of podcasts; platform as a service [PaaS].

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

44. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v*

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<sup>6</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

*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 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.”

45. I have submissions from the applicant regarding the identity of the average consumer. In making its submissions, it refers to the way in which the parties describe themselves on their respective websites. While noted, this is of no assistance. The identity of the average consumer is a notional assessment based on the terms in the specifications before me. So while I appreciate the targeted consumer groups of the specific parties, this will only be relevant to my assessment if it is reflected in the specifications. The same applies to the applicant’s assertions that its goods and services are expensive and, as such, the consumer will pay a higher degree of attention.

47. I am of the view that the average consumer base for the parties goods will be split into two separate groups, being members of the general public at large and business users. For example, some software goods and podcasts will be sought by members of the general public whereas the range of organisational services will be sought by business users. There are also types of services (such as educational services) that will be aimed at both sections of the average consumer base. For those goods and services selected by members of the public, I find that they will be available via general online retailers, be that general (for downloadable software, for example) or specialist (for educational services, for example). For business users, the goods and services will be selected at specialist retailers, be that physical stores or online. Regardless of who the consumer is, the purchase/selection process will involve primarily visual considerations. However, I

do not discount the aural element playing a role in the form of advice from sales representatives or word of mouth recommendations.

46. For the most part, I do not consider that the goods and services at issue are everyday items meaning that the purchase of these goods will take place on an infrequent basis. However, I appreciate that some of the software goods will be selected more frequently. The goods and services at issue are likely to range in cost from relatively inexpensive items such as software (which may be either low cost or, in some circumstances, free) to expensive services such as the organisation of conferences. Turning to the level of attention, I consider that this will vary considerably. This is on the basis that some free (or low cost) items of software and podcasts will be selected with a low degree of attention. However, the majority of goods and services will be selected with a medium degree of attention as the consumer, for software goods for example, is likely to consider things such as compatibility of software and its functions. For some educational services for example, the consumer will consider factors such as expertise of provider, delivery method of the education (be that online or in person, for example) and qualifications provided. I also appreciate that there are some services that will attract a higher degree of attention (but not the highest) for various organisational services. On this point, conferences can be large in scale and involve the selection of venues and presenters, organisation of booths and seminars and the selection of security and catering. To confirm, I consider that the degree of attention for the goods and services at issue will range from low to high (but not the highest).

### **Comparison of the marks**


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

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

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

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

50. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
	TECH CIRCUS

51. I have detailed submissions from both parties in respect of the marks comparison. As was the case with the goods and services comparison above, I do not intend to reproduce them here but confirm that I have taken them into account.

52. The applicant's mark is a word only mark that consists of the words 'TECH CIRCUS'. There are no other elements that contribute to the overall impression of the mark, which lie in the words themselves. The opponent's mark is a figurative word mark that consists of the word 'Circus' in a standard bold typeface, albeit displayed in different colours, with the letters 'Ci' presented in red and the letters 'rcus' presented in black. The overall impression of this mark is dominated by its

word element and while the use of colour will be noticed, it has very little impact on the mark as a whole.

53. Visually, both marks consists of the word 'CIRCUS'. While presented in a bold typeface in title case in the opponent's mark and in upper case letters in the applicant's mark, this is of no consequence to the visual comparison. This on the basis that a word mark is capable of being presented in any standard typeface and in upper case, lower case and any customary combination of the two. As such, there is nothing preventing the applicant's mark being presented in the same typeface as the opponent's and in title case. In addition, I remind myself that marks registered in black and white are capable of being used in any colour. However, this does not extend to contrived colour splits. Therefore, the applicant's mark may be presented in either black or red but it is not capable of being presented using the same colour split as that used by the opponent. As a result, the use of colour is a point of visual difference between the marks (albeit not a significant one given the role it plays in the opponent's mark). The marks differ further in the presence of the word 'TECH' at the beginning of the applicant's mark. As the average consumer tends to focus on the beginning of marks,<sup>7</sup> this will be viewed as a significant point of difference. That being said, the shared use of 'CIRCUS' will still be noticed, particularly given that it is the sole word element of the opponent's mark. Taking all of this into account, I am of the view that the marks are visually similar to a medium degree.

54. Aurally, the applicant's mark consists of three syllables that will be pronounced in the ordinary way. As for the opponent's mark, this consists of two syllables that will also be pronounced in the ordinary way. The pronunciation of 'CIRCUS' will be identical across both marks and I note that it forms the largest aural element of the applicant's mark (albeit not considerably) and the sole aural element of the opponent's mark. The only point of aural difference is the one syllable in the applicant's mark, being 'TECH'. Despite the fact that the point of aural difference sits at the beginning of the applicant's mark, it is not enough to offset the point of aurally identity of the longer aural elements. Taking all of this into account, I

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<sup>7</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

consider that these marks are aurally similar to between a medium and high degree.

55. The submissions of the opponent set out that the word 'TECH' is often used as an abbreviation for 'technology'. I agree and find that the average consumer would be aware of this. The opponent also submits that 'TECH' suggests advanced, high-quality and sophisticated products or services so is, therefore, low in distinctive character. On this point I disagree. Firstly, technological goods do not have to be particularly sophisticated and are not always indicative of a high quality. Primarily however, I consider that in the context of the applicant's mark, 'TECH' will be viewed in conjunction with the word 'CIRCUS' (the concept of which will be widely known) and allude to 'a circus of technology'. As for the opponent's mark, this is just the word 'Circus' and the concepts of this will, as above, be widely understood. The use of colour will have no impact on the concept of the mark. In comparing the marks, the concept of a circus will run through them both and function as a point of conceptual identity. However, this will be offset somewhat by the allusion to a circus that is technological in nature in the applicant's mark. No such concept will be attributed to the opponent's mark. As a result, I consider that the marks are conceptually similar to a medium degree.

### **Distinctive character of the opponent's mark**

56. 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).”

57. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness nor has it filed any evidence to that effect. Therefore, I have only the inherent position to consider.

58. The opponent’s mark is, as discussed above, a figurative word mark, being ‘Circus’, which is presented in a standard typeface with the letters ‘Ci’ in red and the letters ‘rcus’ in black. In making its submissions in respect of the conceptual comparison of the marks at issue, the opponent suggests that ‘Circus’ is highly distinctive in relation to games, video games and online gaming. This is not the case. If anything, I am of the view that ‘Circus’ would be on the lower end of the scale for such goods. Having said that, I remind myself that the opponent’s goods that relate to online gaming that are at issue here relate to casino games and I do not consider that ‘Circus’ would be descriptive or allusive to these. Further, the opponent’s class 28 goods are not at issue so this point is not relevant. Instead, the goods at issue relate mainly to computer software relating to website design and online security and the services at issue relate to education and organisation of events. I do not consider that ‘Circus’ is descriptive or allusive to any of these. That being said, it is an ordinary dictionary word with a well-known meaning and use of such is not remarkable from a trade mark perspective. As such, I consider

that the word itself enjoys a medium degree of inherent distinctive character. While the use of colour will be noted, it is not something that I consider will contribute to the distinctive character of the mark beyond that which is created by the word itself.

### **Likelihood of confusion**

59. 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 earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he or she has retained in their mind.

60. I have found the goods and services to range from being identical to similar to a very low degree. I have found the average consumer for the goods and services to be both members of the public and business users who will select the goods by primarily visual means, although I do not discount an aural component. I have concluded that the level of attention paid by the average consumer will range from a low to a higher (but not the highest) degree. I have found the marks to be visually and conceptually similar to a medium degree and aurally similar to between a medium and high degree.

61. Taking all of these factors into account and even bearing in mind the principle of imperfect recollection, I see no reason why the average consumer would overlook the use of the word 'TECH' at the beginning of the applicant's mark. As a result, I

consider that the average consumer will be able to accurately recall and remember which mark was which. Consequently, I do not consider that there exists a likelihood of direct confusion, even in circumstances where the marks are viewed on identical goods and services or in circumstances where the average consumer pays a lower degree of attention.

62. I turn now to consider a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., 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)".

63. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

64. As I have set out above, the average consumer will notice the differences between the marks. It is now necessary to consider whether, upon noticing those differences, the average consumer would believe that the marks originate from the same or economically linked undertakings. In the present case, I am of the view that the average consumer would consider the common element, being the word 'CIRCUS', as a reference to the identity of the undertaking responsible for the goods or services at issue. This is on the basis that the word 'TECH' will, in my view, be seen as an indication that the 'CIRCUS' brand has extended into producing and selling goods and services that (1) relate to technology, (2) are provided via technological means or (3) take advantage of the latest advancements in technology. As a result, I consider that the differences between the marks will be seen as either indications of a sub-brand or brand extensions of each other. I make this finding whilst also bearing in mind that 'CIRCUS' is not necessarily remarkable from a trade mark perspective (because it is a common dictionary word), however, it is not descriptive or allusive of the goods or services at issue. Therefore, I do not consider that its shared use will be viewed as coincidental. I

have also borne in mind the fact that indications of brand extensions or sub-brands are commonly displayed at the end of marks, however, I do not consider this to be determinative. As a result, I am of the view that it is possible for the consumer to form such an impression of a sub-brand or brand extension regardless of the location of the different element. Lastly, I do not consider that the use of a colour split in the opponent's mark and its absence in the applicant's mark will distract from the above findings. Taking all of this into account and even bearing in mind the comments of Arnold LJ in the preceding paragraph, I find that there is a likelihood of indirect confusion between the marks at issue.

65. While I consider that the above finding will apply regardless of the level of attention paid by the consumer, I do not consider that it extends to circumstances where the marks are viewed on goods and services that are similar to a low degree (or to a very low degree, for that matter). Having taken into account the interdependency principle, I do not consider that the level of similarity between the marks is at a high enough level to offset the low degree of similarity between those goods and services. Therefore, the likelihood of indirect confusion only applies in respect of those goods and services that are similar to a medium degree and above.

## **CONCLUSION**

66. The opposition has partially succeeded and, subject to any appeal, the application is refused for the following goods and services:

Class 9: Interactive software.

Class 41: Arranging and conducting of training courses and conferences; organisation of exhibitions and trade fairs for educational purposes; education and instruction services; organising and hosting online conferences for participants to conduct, watch and participate in audio and video presentations for educational purposes; organising of entertainment events; arranging and conducting workshops and seminars; organising and conducting classes, seminars, symposiums, conferences and exhibitions;

education services; education courses; educational demonstrations; educational information; education, teaching and training provided via telecommunications networks, by online delivery and by way of the internet; production of podcasts.

Class 42: Website design; creating websites; website development services; building and maintaining websites; building online event platforms.

67. Given that the opposition was unsuccessful against some goods and services, the application may, subject to any appeal, proceed to registration for the following goods and services:

Class 9: Downloadable software for use in the fields of network conferencing services, video conferencing services, video teleconferencing and web conferencing services; podcasts.

Class 35: Organising and hosting online business events and conferences for participants to conduct, watch and participate in audio and video presentations for business and commercial purposes; Arranging and conducting trade fairs and exhibitions for business and commercial purposes; Arranging and conducting of marketing events; Arranging and conducting of promotional events; Marketing services; Marketing advice; Marketing consulting; Writing of publicity texts; Recruitment of services; Recruitment advertising; Ticket reservation and booking services for business events and conferences .

Class 41: Writing services for blogs; writing of texts other than publicity texts; ticket reservation and booking services for education and entertainment events; creation of podcasts.

Class 42: Commissioned writing; technical writing; hosting of podcasts; website hosting services; maintenance of websites; platform as a service [PaaS].

## **COSTS**

68. On balance, I consider that the parties have enjoyed a roughly equal degree of success in these proceedings. Taking this into account and also bearing in mind that fast track opposition proceedings were introduced to provide a cheaper means for parties to engage in Tribunal proceedings, I do not consider that a costs award is necessary. As a result, I hereby make no order as to costs. Instead, direct that the parties are to bear their own costs of these proceedings.

**Dated this 14th day of August 2023**

**A COOPER**

**For the Registrar**