O/0834/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003742107
BY GIBSON BRANDS, INC.
TO REGISTER:

KRAMER

AS A TRADE MARK IN CLASS 9

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 433183 BY
KRAMER ELECTRONICS LTD.

BACKGROUND AND PLEADINGS

1. On 12 January 2022, Gibson Brands, Inc. ("the applicant") applied to register the trade mark shown on the cover of this decision in the UK for the following goods:

   Class 9: Downloadable multimedia file containing artwork, text, audio, and video relating to music and entertainment authenticated by non-fungible tokens.

2. The applicant's mark was published for opposition purposes on 4 February 2022 and, on 4 May 2022, it was opposed by Kramer Electronics Ltd. ("the opponent"). The opposition is based on section 5(2)(a) of the Trade Marks Act 1994 ("the Act") and is reliant upon the following earlier mark:

   KRAMER
   UK registration no: 801454776[1]
   Filing date 12 December 2018; registration date 20 August 2019
   Priority date 21 November 2018
   Relying on all goods, namely:

   Class 9: Apparatus and instruments for checking, supervision, monitoring, viewing, recording, transmission, processing or reproduction of sound and images; apparatus and instruments for checking, supervision, monitoring, viewing, recording, processing, reproduction, controlling and transmission of video, audio and communication signals and information via wire or wireless means; video-audio signal distributors; video-audio signal switchers and matrix switchers; video and audio enhancers; video and audio processors; radio frequency processors; special effects generators; video encoders and decoders; electronic video signal

[1] The opponent's mark is a comparable trade mark based on a pre-existing International Registration that designates the EU (being IR no 01454776). 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 IRs designating the EU.

scalers; scan converters; video standard converters; video time base correctors; computer genlock (generator locking) equipment, namely, genlock (generator locking) device for graphics and text overlay; computer controlled video equipment, namely, video matrix and processing control panels; computer interface products, namely, TTL (transistor-transistor logic) analogue encoders, TTL (transistor-transistor logic) to analogue converters, TTL (transistor-transistor logic) genlock (generator locking) encoder cards; room control devices, namely, electric switch wall plates and table bus bars with infra-red, ethernet, wireless network and controlling devices; audio signal defect correctors; video line amplifiers; twisted pair signal transmitters and receivers; video screen splitters and video time base signal delay correctors; electrical cables and wires; amplifiers; microphones; loudspeakers; centrally-controlled audio-video system comprised of audio amplification providing solutions for the integration of media and control in classrooms, training rooms and presentation rooms, comprising wall or ceiling-mounted multi-media projectors, wall or ceiling audio speakers, computer software for graphics videos, computer hardware for graphics videos, display screens, and optionally, DVD players; display screens; furniture-mounted connection bus featuring a power source, universal power sockets, video, audio, telephone and other network connectors; furniture-mounted connection buses featuring a power source, universal power sockets, active or passive video, audio, telephone and other network connectors; controlled audio and video apparatus and fittings therefor, namely, electric, electronic, matrix and video-audio signal switches, audio and video processors, microphones, loudspeakers and display screens for producing and selectively transmitting audio and video in enclosed spaces; software for controlling audio, video and projecting accessories and computers in classrooms, boardrooms, conference rooms and

auditoriums, enabling selective connection of input sources of audio and video signals, such as laptops and DVD's, for providing an interface and facilitating connection and controlled display of a plurality of such sources; computer operating software for the afore-mentioned products; parts and fittings for the afore-mentioned products.

3. The opponent's pleaded case is that, as a result of the identity between the respective marks and the similarity of the respective goods, there exists a likelihood of confusion on the part of the public. The applicant filed a counterstatement wherein it noted that the marks were the same in appearance as they are both written in a non-stylised manner without devices. While not expressly stated, I take this is an acceptance that the marks are identical. As for the applicant's position in respect of the goods at issue, it argues that they are not similar.

4. The opponent is represented by Abel & Imray LLP and the applicant is represented by Allen & Overy LLP.[2] Both parties filed evidence with the opponent also electing to file evidence in reply. I note that the parties also filed written submissions (with the opponent also filing what it referred to as written observations in reply) during the evidence rounds. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

5. 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.

[2] Allen & Overy LLP were appointed as representatives of the applicant by way of a Form TM33 dated 10 May 2023. The change in representatives was confirmed to the parties by the Tribunal on 9 June 2023.

EVIDENCE

6. The opponent's evidence came in the form of the witness statements of Mr Matthew Smith dated 8 November 2022 and 6 March 2023, the latter being that which was filed in reply to the applicant's evidence. Mr Smith is a Chartered Trade Mark Attorney at the opponent's representative firm and is, therefore, duly authorised to make a statement on the opponent's behalf. His first statement is accompanied by four exhibits, being MPS1 to MPS4, and his second is accompanied by a further seven exhibits, being MPS5 to MPS11.

7. The applicant's evidence came in the form of the witness statement of Matthew Murphy dated 21 December 2022. Mr Murphy is a solicitor and was previously the legal representative of the applicant and, at the time, was duly authorised to file evidence on the applicant's behalf.[3] Mr Murphy's witness statement is accompanied by six exhibits, being MM1 to MM6.

8. As set out above, both parties have filed various forms of submissions during these proceedings. I do not intend to summarise the evidence or submissions of the parties at this stage but will, where appropriate, discuss them further below.

PRELIMINARY ISSUES

9. Throughout the course of these proceedings, the applicant has filed evidence and submissions in respect of its position that the goods are dissimilar. While some of these are relevant to the goods comparison, some are of no assistance to the present case whatsoever. I consider it necessary to discuss these arguments as preliminary issues and will do so below.

[3] I note that the witness evidence makes reference to being authorised by the opponent, however, this appears to be a typographical error.

The ’GIBSON’ brand

10. A substantial proportion of the applicant’s evidence relates to the ‘GIBSON’ brand of guitars. The applicant is relying on an alleged association by the consumer between its ‘KRAMER’ and ‘GIBSON’ brands. It is argued that such an association means that the average consumer would not be confused between the ‘KRAMER’ brand of the applicant and the ‘KRAMER’ brand of the opponent because the applicant’s brandings are so closely aligned. The applicant submits that this means that there will be no perceived economic connection between the parties.

11. I do not intend to go over the evidence in full on this point but note that it is, for the most part undated[4] and includes print-outs seemingly taken from websites based outside of the UK.[5] Such issues, in my view, render the evidence irrelevant. Even if it did point to the position in the UK as at the relevant date, I fail to see how the present argument offers any assistance to the applicant. Not only are the assessments I must make throughout the course of this decision notional ones (meaning that the intention of the applicant as to how it intends to use its goods, being in its ‘Gibson App’, is of no relevance) but the evidence is far from compelling in demonstrating that an average consumer would make an immediate association between the applicant’s proposed use of ‘KRAMER’ and its ‘GIBSON’ brand. For the avoidance of doubt, I will say no more about this argument.

Reference to earlier ‘KRAMER’ marks

12. In its counterstatement, the applicant makes reference to numerous ‘KRAMER’ marks that have been registered in the UK for various goods and services. The applicant sets out that there are marks on the register that are owned by both the applicant and the opponent as well as various third parties. In raising this point, the

[4] On this point, I note that the evidence is either undated or is in the form of evidence with a copyright date of 2022. While the relevant date for these proceedings is in 2022, it is 12 January of that year. As a result, it is more likely than not that the evidence dated generally as ‘2022’ is after that date.
[5] See, for example, pages one to eight of MM1 which is a print-out taken from Gibson.com which appears to be the French version of the site (see the reference to ‘fr-FR’ in the domain name and the use of the French language throughout). In addition, the Apple App Store print-out at page nine of MM1 makes reference to purchase in US dollars.

applicant made reference to one of its own registered marks, being UK00002121523, which was registered in the UK on 25 July 1997. In addition, the applicant has filed evidence showing the trade mark registry entries for various 'KRAMER' marks that the applicant has registered in the past.[6] The opponent argues that the reference to these marks is irrelevant. In response, the applicant argued further that the presence of the earlier marks of the applicant proves that the applicant's KRAMER brand has a longer history and is much more reputable in the field of musical instruments. Such an argument can potentially be used to support an argument that the ongoing use of the 'KRAMER' branding by the applicant on the marketplace is such that there is a peaceful co-existence of the marks and/or honest concurrent use by the parties of their respective marks. If proven, it can defeat an otherwise justified opposition by diminishing the likelihood of confusion between the marks.[7] However, the applicant has not provided any evidence in support of such a claim.[8] I note that there is evidence of a wide range of guitars but these are not at issue in the present case so I fail to see how previous sales of such (if evidence of such had been provided, which it had not) could support such an argument.

13. Lastly, I have given consideration as to whether this point (particularly the existence of several other entities using the name 'KRAMER') was raised in order to support a claim that the distinctive character of 'KRAMER' has been diluted as a result of the widespread use of the same. It does not appear to me that this point was raised in support of such an argument. However, for the avoidance of doubt, if it had, it would have been of no assistance either. As per the case of *Zero Industry Srl v OHIM*, Case T-400/06, the mere existence of a number of trade marks that contain the word 'KRAMER' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. There is no evidence of use of any of these marks on the marketplace

[6] MM5
[7] See the cases of *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09 and *Victoria Plum Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch).
[8] On this point, the above case law sets the bar fairly high in that it requires, for example, co-existence over a long period of time on the market concerned (see *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 P)

that could be said to point towards a weakening of the distinctive character of 'KRAMER'.

Class 9 goods of the applicant and how they will be used

14. There is a lengthy discussion put forward by the applicant in respect of how its class 9 goods will be used. I will not repeat this in full but, in short, the applicant sets out that the goods at issue will be viewed and accessed via its own application which it refers to as the 'Gibson App'. As such, the applicant claims that the consumer will clearly be aware that the KRAMER branded goods therein are associated with the KRAMER guitar made by Gibson and, as a result, will not be confused into thinking it is the same or connected to the opponent's mark. While this is noted, the goods comparison I must make it a notional one based on the terms as applied for. The way in which the applicant intends to use the mark is of no relevance to the assessment that I must make. I appreciate that such an argument would carry weight if it was the case that the term reflected such an intention. However, it does not and is, therefore, disregarded.

Additional marks of the applicant

15. The applicant has filed evidence of a number of trade marks for other marks in its portfolio, such as GIBSON, EPIPHONE, LES PAUL, FLYING V and EXPLORE.[9] The applicant claims that these are the applicant's famous guitar brands and their registration for goods identical to the ones at issue here demonstrate that they will be used in and accessed within the Gibson App. While this argument is noted, as is the fact that these marks are registered for the same set of goods as those at issue here, I struggle to see how it is relevant to the present decision. Put simply, I fail to see how the existence of these marks and how they may be used has any impact on the present proceedings, which deals with the mark 'KRAMER'. I will, therefore, say no more about it.

[9] MM6

DECISION

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

16. Section 5(2)(a) of the Act is as follows:

> "5(2) A trade mark shall not be registered if because-
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark."

17. 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."

18. The trade mark relied on by the opponent qualifies as an "earlier trade mark" for the purposes of this decision since it was applied for at an earlier date than the applicant's mark.[10] The opponent's mark did not complete its registration process prior to five years before the filing date of the applicant's mark. As such, it is not subject to proof of use pursuant to section 6A of the Act meaning that the opponent can rely upon all of the goods for which both marks are registered.

19. 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*

[10] See Section 6(1)(a) of the Act

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.

Identity of the marks

20. Both of the marks at issue are word only marks that consist solely of the word 'KRAMER'. Consequently, regardless of whether the applicant intended to concede the point, the marks are plainly identical.

Distinctive character of the opponent's mark

21. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the Court of Justice of the European Union ("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)."

22. 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.

23. As set out above, the opponent's mark is a word only mark that consists solely of the word 'KRAMER'. As far as I understand it (and I have nothing before me to suggest otherwise), the word 'KRAMER' has no meaning to the average consumer in the UK and will simply be viewed as a made-up word. It is neither descriptive nor allusive of the goods for which it is registered. As a result (and following what I have said in the preceding paragraph), I am of the view that the opponent's mark enjoys a high degree of inherent distinctive character.

Comparison of goods

24. The goods of the applicant are set out at paragraph one above. The goods of the opponent are set out at paragraph two above.

25. When making the comparison assessing the similarity of the goods, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the 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".

26. 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.

27. 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 OHIM*, Case T-325/06, the General Court stated that "complementary" means:

> "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

28. Given the identity of the marks at issue, the arguments of the parties focused mainly on the similarity of the goods. I note that these arguments are detailed and extensive. The applicant's position is, in short, that the goods are dissimilar because the goods of the applicant do not have a physical form and neither do they require a tangible medium carrier. Further, the applicant argues that the goods are not similar because they differ in terms of format, function, applications, sales channels and technicalities.

29. As for the opponent, I note that it accepts that its own goods are tangible whereas the applicant's are not. However, it argues that this is irrelevant on the basis that average consumers are in the habit of expecting tangible and intangible goods to be produced by the same undertakings. Further, the opponent argues that the goods are similar because they are complimentary, overlap in trade channels and are used, and relevant, to the same industry. The opponent has filed evidence in support of its various arguments as to the similarity of the goods and I consider it necessary to assess this before moving to conduct the actual comparison at issue.

The opponent's evidence

30. In support of the argument that the goods at issue are complimentary, the evidence firstly sets out that non-fungible tokens ("NFT") are viewable on televisions.[11] While noted, this evidence consists of articles that are dated after the relevant date.[12] The first item of evidence relates to a Samsung television that the article confirms is 'set' to be launched, implying that even at the date of the article (which is after the relevant date), the television was not on the market place. Within this evidence there are further articles that relate to an LG television that the article states is aimed at US users. As was the case with the aforementioned article, this is dated after the relevant date. Even discounting the fact the evidence is after the relevant date and does not appear to represent the trade in the UK, it covers just two examples of the practice taking place. In my view, such evidence is not capable of supporting an argument that these goods are complementary. While that may be the case, that does not mean that I cannot find the goods to be complimentary, a point that I will consider further in my assessment below.

31. The evidence goes on to state that the opponent's goods also relate to the music and entertainment industries. This evidence is adduced to show that the opponent's goods are not excluded from relating to the same industries as those expressly covered by the applicant's term. The evidence consists of print-outs from its own website that shows appliances such as amplifiers, speakers and other audio accessories and also discusses 'live event solutions' for entertainment shows.[13] This evidence is undated but shows a copyright date of 2022 which, as above, is to be treated as if it is from after the relevant date. This evidence is, therefore, of no assistance to the opponent as it does not reflect the position as at the relevant date. Having said that, the opponent's specification is not limited in any way and can, therefore, be said to cover a range of class 9 goods that can be

[11] MPS1
[12] Some of the articles provided are explicitly dated after the relevant date. Some include copyright dates of 2022. For the avoidance of doubt, where any evidence consists of a copyright date of 2022, it will be treated as being after the relevant date. This is on the basis that the relevant date is 12 January 2022 so it is more likely than not that the evidence is from after that date. In the event that it is not, I consider it reasonable to expect the opponent to have confirmed as such.
[13] MPS2 and MPS3

used in the music and entertainment industries. As such, no evidence on this point was required.

32. The opponent has also filed evidence that shows companies such as Apple, Google, Microsoft and Sony producing and selling both physical tangible devices and hardware as well as intangible items such as software and multimedia files.[14] The evidence also includes examples of Apple, Amazon and Sky producing its own media content for Apple TV, Amazon Prime and Sky Originals, respectively.[15] Further on this point, the evidence shows that Apple TV, Amazon Prime and Sky Original content can be viewed on physical devices such as the iPhone, Amazon's Fire TV and Sky Glass, respectively.[16] While this evidence is noted (some of it is after the relevant date), I fail to see how it applies to the present case. I appreciate that it may be common in the trade for companies to produce both tangible and non-tangible goods as explained by the opponent. Further, I also accept that some of these technology companies also have production studios for television and film. However, the issue at hand here relates to multimedia files that are authenticated by NFTs and I don't see that this evidence would support such an argument that it is common in the trade for a company that produces physical items of technology would also produce and sell NFT authenticated multimedia. In any event, this evidence covers just a limited number of examples that relate to very large multinational companies engaging in the production of television programs and films and the sale of technological devices. I do not consider that such a limited amount of evidence is indicative of a practice that is common in the trade.

33. Lastly, I note that the opponent's evidence includes a print-out from Wikipedia regarding NFTs.[17] This evidence is undated and, by virtue of being a Wikipedia article, I must treat it with some caution.[18] Having said that, I note that it does offer an explanation as to what an NFT is. It states that:

[14] MPS4
[15] MPS5, MPS7 and MPS9
[16] MPS6, MPS8 ad MPS10
[17] MPS11
[18] This is on the basis that, as far as I understand it, Wikipedia is a community based encyclopaedia that any user can contribute to meaning that the content may be unverified.

"A non-fungible token (NFT) is a unique digital identifier that cannot be copied, substituted or subdivide, that is recorded in a blockchain, and that is used to certify ownership and authenticity. The ownership of an NFT is recorded in the blockchain and can be transferred by the owner, allowing NFTs to be sold and traded."

34. The evidence goes on to explain that "Digital art is a common use case for NFTs. High-profile auctions of NFTs linked to digital art have received considerable public attention." On the point of the meaning of an NFT, I note that the opponent's evidence regarding the Samsung TV discussed above also includes a brief explanation that, "A NFT (non-fungible token) is a unique, non-interchangeable digital asset secured by blockchain technology that allows you to explore the new world of art that transcends the boundaries between digital space and reality."[19]

Goods comparison

35. Before considering the necessary comparison of the goods, I will first consider what it is that the applicant's term actually covers. As above, the applicant's goods are "downloadable multimedia file containing artwork, text, audio, and video relating to music and entertainment authenticated by non-fungible tokens." In essence, this term covers ordinary downloadable multimedia files that can be either artwork, text, audio and video that relate to music and entertainment. While the construction of the term sets out that the files are authenticated as NFTs it is my view that, for the purposes of this comparison, this does not necessarily alter what goods the term actually covers, i.e. downloadable multimedia files.

36. The opponent's specification is broad and covers a wide range of goods in class 9. It is clear to me that a majority of these goods have no obvious degree of similarity with the applicant's goods. While I do not intend to list all of the plainly dissimilar goods in full here but, for example, I refer to goods such as "electronic video signal scalers", "DVD players" and "video-audio signal switchers and matrix

[19] MPS1

switchers". It is my view that these goods not require any further explanation as to why they are dissimilar and, instead, I will simply say that there is no obvious reason as to why they would be. Having said that, I note that the opponent's specification includes the terms "apparatus and instruments for […] viewing [...] sound and images", "apparatus and instruments for […] viewing […] video […] and information via wire or wireless means" and "display screens". The specification also covers "computer operating software for the afore-mentioned products." It is my view that these goods are not so obviously dissimilar so require further consideration, which I will do below.

Apparatus and instruments for […] viewing [...] sound and images; apparatus and instruments for […] viewing […] video […] and information via wire or wireless means; display screens; computer operating software for the afore-mentioned products.

37. The above mentioned goods of the opponent can be said to cover a wide range of devices so long as those devices can be used for viewing sounds and images. The broad nature of this term means that it can cover goods such as televisions, computer monitors and video tablets, for example. The opponent's position is that the viewing of the applicant's goods depends, fundamentally, on the apparatus that can display these files. Before moving to address the more complex arguments raised by the opponent in relation to complementarity and trade channels, I will first consider the remaining factors as set out in *Treat* (cited above).

38. I do not consider that there is any obvious level of overlap in nature or methods of use between these goods. I make this finding on the basis that the applicant's goods are multimedia files whereas the opponent's goods are either physical goods or items of software. They are clearly different types of goods that will be used differently. As for purpose, the aim of the applicant's goods is to be viewed, read, watched or listened to. As NFTs, it is also possible that these goods are used for investment and/or trading purposes on the basis that, as far as I understand it, NFTs are popular goods that are used in the same way as cryptocurrencies.[20] As

[20] While this may be a purpose of an NFT, it is not the sole purpose and is of no real assistance here so I will say no more about it.

for the opponent's physical goods, I appreciate that they may be used to display the goods of the applicant. However, this does not mean that the purpose of displaying this goods is the same as the purpose of the goods themselves. As such, I do not consider that the goods of the applicant share a similar purpose to the opponent's physical goods. As for the opponent's software goods, these are specifically reserved for operating software of the aforementioned devices. Their purpose is, therefore, to assist in operating the device. This is plainly not the same purpose as the applicant's goods. Lastly, while the goods are clearly not in competition, I do consider that there is an overlap in user. This is on the basis that someone who wishes to view an NFT (or the media authenticated by the NFT) is likely to be a member of the general public at large which is also the userbase for the opponent's goods.

39. In respect of complementarity, the opponent claims that it has submitted observations and evidence that demonstrates that the opponent's products are used to view the applicant's goods. While this is noted, I have set out above that the evidence is of no assistance to the opponent's case as it is (1) after the relevant date and does not relate to the UK market and (2) covers only a very limited example of NFTs being viewed on televisions. Without anything further, I am not willing to infer that this is common in the trade. So while I do not consider the evidence is suitable to show a level of complementarity between televisions and NFTs, this doesn't mean that the complementary argument fails. This is because it is possible that there exists a level of complementarity between other types of devices covered by the opponent's goods and the applicant's goods, such as handheld tablets or display screens, for example. I will proceed to consider this point below.

40. I appreciate that, as submitted by the opponent (and as confirmed by the case of *Kurt Hesse*, which is cited above) complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between the goods. Further, in considering the test set out in *Boston* (cited above), I appreciate that, in these circumstances, the goods at issue can be said to be important and/or indispensable to one another on the basis that the downloadable multimedia files

covered by the applicant's term does require some form of physical device (such as those covered by the opponent's specification) in order to be viewed. However, even acknowledging both of these points, I do not consider that the second step of the test set out in *Boston* has been satisfied. Upon viewing the applicant's goods on an electronic device, I do not consider that the average consumer will necessarily believe that the same undertaking is responsible for both the multimedia file and the device itself. I do not consider it controversial to suggest that there are a vast number of undertakings that provide video, artwork and sound files for viewing on a wide range of compatible (and economically unconnected) devices and the customer will be well aware of such.[21] In those circumstances, I see no reason why a consumer would believe that just because the multimedia file is compatible with and displayed on a device of the opponent, only one party is responsible for both. If it was the case that any electronic file was complementary to any electronic device upon which that file could be viewed, this would offer owners of marks registered for such devices far too broad a scope of protection. I, therefore, find that these goods are not complementary.

41. I turn now to consider the issue of an alleged overlap in trade channels. As I have discussed above, the opponent argues that its evidence points to technology companies also offering intangible goods such as computer software and multimedia files. While I have accepted that it may very well be the case that companies like Apple (being one referred to in the evidence) do offer their own types of software and multimedia files and produce their own television shows and films, I have nothing to suggest that those same companies also offer NFTs (or the media authenticated by the NFT). Even if the evidence before me did cover the issue of NFTs, the evidence covers a very limited number of companies and is hardly indicative of such a practice being common in the trade. Due to the technical nature of the goods before me, it is my view that any finding of an overlap in trade channels between them is one that can only be reached on the basis of sufficiently solid evidence. For the reasons set out above, the evidence in support of any

[21] On this point, I am conscious not to assume my own knowledge is more widespread than it is but, in accordance with the case of *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08, I do not consider this to be a serious point of dispute

overlap in trade channels is of no assistance. As such, I conclude that an undertaking that produces and sells various technological devices/operating software is not likely to be one that also operates in creating and selling multimedia files that are authenticated as NFTs, or vice versa. Further, I do not consider that such goods will be sought from the same distribution channels. As such, I do not consider that there is any overlap in trade channels between these goods.

42. To confirm, I have found above that there is no overlap in nature, method of use, purpose or trade channels between the goods at issue. Further, I do not consider that the goods are competitive in nature and neither are they complementary. While I have found there to be an overlap in user, I do not consider that this alone is sufficient to warrant a finding that there is any degree of similarity between the goods at issue, particularly given the broad userbase of the opponent's goods. As a result, I consider that the goods at issue are dissimilar.

43. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, this means that the opposition aimed against those goods will fail.[22] Given my findings above in that none of the goods at issue are similar, it follows that the opposition must fail in full.

CONCLUSION

44. The opposition has failed in its entirety and, subject to any appeal, the applicant's mark may proceed to registration for all goods applied for.

COSTS

45. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While the applicant did file evidence, I found this to be of very little assistance to the present case. It would, therefore, be ordinary for no costs award to be made in respect of

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

the evidence rounds. That being said, the applicant was still required to consider the opponent's evidence and I am of the view that some costs award should be made in order to reflect this. In the circumstances, I award the applicant the sum of **£500** as a contribution towards its costs. The sum is calculated as follows:

Considering the notices of opposition and filing a counterstatement in respect of the same:	£200
Considering the evidence of the opponent:	£300
Total:	**£500**

46. I hereby order Kramer Electronics Ltd. to pay Gibson Brands, Inc. the sum of £500. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of September 2023

A COOPER
For the Registrar