

O/0861/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3797817
BY BETTYS & TAYLORS GROUP LIMITED**

TO REGISTER:

BETTYS

AS A TRADE MARK IN CLASSES 9, 35, 41, 43

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 600002678 BY
REAL BETIS BALOMPIÉ, S.A.D.**

BACKGROUND AND PLEADINGS

1. On 10 June 2022, Bettys & Taylors Group Limited (“the applicant”) applied to register **BETTYS** as a trade mark in the United Kingdom in respect of goods and services in Classes 9, 35, 41 and 43 of the Nice Classification. A full specification can be found in the Annex to this decision.

2. On 23 December 2022, the application was opposed by Real Betis Balompié, S.A.D. (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) using the fast track procedure. Consequently, the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, SI 2013 No. 2235 (“the Fast Track Rules”), applies to these proceedings.

3. In the box where the opponent is required to state the goods and services that are being opposed, it has ticked “Some goods and services” and elaborated as follows:

- Class 09: Downloadable software
- Class 35: Retail services and online retail services connected with goods in class 09.
- Class 41: Entertainment and educational services.
- Class 43: Restaurant and catering services

4. These terms are not those included in the specification. I shall return to this point later.

5. The opponent is relying on UK Trade Mark (“UKTM”) No. 912905791, which is shown below:



6. This is a UK comparable mark with a filing date of 26 May 2014 and a registration date of 20 November 2014. It is registered for goods and services in Classes 6, 9, 16, 25, 35 and 41 and the opponent is relying on the following goods and services:

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, CD-ROMs; Electronic publications, downloadable; Magnetic card; Recording discs; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment and computers; Fire-extinguishing apparatus.

Class 35

Recording and transcription of written communications; Layout services for advertising purposes; Collecting information for business; Systematization of information into computer databases; Commercial or industrial management assistance; Business administration; Office functions; Advertising; Retailing in shops and via global telematic networks of instructional and teaching material, books, stationery, CD-ROMs, DVDs and computer applications; Retailing in shops and via global telematic networks of promotional goods, namely keyrings, badges, pins, leatherware and gift items of leather and imitations of leather, jewellery, horological instruments, decorative items of glass, porcelain, earthenware and terra-cotta, decorative items of leather and imitations of leather and animal skins, hides, ready-made clothing and headgear; Import-export; Business representations and exclusive sales of books, stationery, CD-ROMs, DVDs and computer applications; Import and export of keyrings, badges, pins, leatherware and gift items of leather and imitations of leather, jewellery, horological instruments, decorative items of glass, porcelain, earthenware and terra-cotta, decorative items of leather and imitations of leather and animal skins, hides, ready-made clothing and headgear; Marketing studies and business

appraisals; Organization of trade fairs and shows for commercial or advertising purposes.

Class 41

Provision of tuition; Providing of training; Entertainment; Sporting and cultural activities; Arranging of trade fairs and exhibitions for cultural or educational purposes; Publication of books and texts, other than publicity texts; Providing on-line publications, not downloadable; Arranging and conducting of competitions (education or entertainment), organisation of awards; Colloquiums, conferences and congresses; Providing museum facilities (presentation, exhibitions); Production of shows and live theatre productions.

7. The above mark qualifies as an earlier mark under section 6(1) of the Act. As it completed its registration procedure more than five years before the application date for the contested mark, and this is a fast track opposition, it was required to file evidence of use as part of the notice of opposition and statement of grounds. I shall refer to it where appropriate during the course of my decision.

8. The opponent claims that the dominant and distinctive element of its earlier mark is “Betis” and that this is very highly similar to the contested mark, and that *“those goods and services covered by classes 9, 35, 41 and 43”* are similar and complementary to the goods and services listed in paragraph 3 above. It continues:

“Therefore, the public will be likely to think that the Applicant’s and the Opponent’s services have the same origin, causing the registration and use of the contested trademark likelihood of confusion and association and a detriment to the distinctive character of my undertaking’s trademark. Therefore the registration of the contested trademark will constitute an infringement of those sections in Trademark Act in force and, of course, my undertaking and consumers’ rights.”

9. This answer was given to Q12 of the form TM7F. However, in the answer to Q1, it says that *“The goods and services the earlier registered trademark that are relied upon for the opposition are those comprised in classes 09, 35, and 41, that are highly similar*

and complementary to all those goods and services claimed by the contested trademark" (my emphasis).

10. The applicant filed a defence and counterstatement denying any similarity between the marks and between the parties' goods and services. It also denied that the opponent had shown that it had genuinely used the mark in relation to the goods and services relied on. Further, it denied that the opponent has a reputation in the UK and that use of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponent's earlier mark.

11. I have already mentioned that the opponent filed evidence with its notice of opposition and statement of grounds. The effect of Rules 6 and 20(4) of the Fast Track Rules is that parties must seek leave to file further evidence. None was sought.

12. 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. Only the applicant filed written submissions. These are dated 9 June 2023.

13. In these proceedings, the opponent is represented by Iberpatent and the applicant by HGF Limited.

PRELIMINARY ISSUES

14. The opponent's pleadings are deficient in two aspects. The first of these is a lack of clarity as to the goods and services that are being opposed. The second is a confusion as to whether the opponent has intended to make a pleading under section 5(3). The opponent has claimed that there will be a detriment to the distinctive character of the earlier trade mark. This is a form of damage under section 5(3). The applicant filed a general defence against a section 5(3) claim. Fast-track oppositions are restricted to actions brought under section 5(1) and/or 5(2) only. For a section 5(3) claim, the opposition would have needed to be converted to a standard opposition.

15. I have the power under Rule 62(1) of the Trade Marks Rules, SI 2008 No. 1797, to seek clarification from the opponent on the nature of its pleadings. However, for reasons that will become clear, I do not consider that this will assist the opponent. I shall therefore proceed with my assessment of the opposition.

DECISION

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

“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, or

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

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

17. I have already noted that the opponent was required to show that it had used the earlier mark, or had proper reasons for non-use. For reasons that will become clear, I do not consider that the issue of proof of use will be determinative in these proceedings. I shall therefore conduct my assessment on the basis that the opponent can rely on the full breadth of its specification.

18. In considering the opposition, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation 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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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

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

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

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


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

Comparison of marks

19. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: see *SABEL*, paragraph [23]. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60.

20. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components: see *SABEL*, paragraph [23]. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, paragraph [34].

21. The respective marks are shown below:

Contested mark	Earlier mark
<p>BETTYS</p>	

22. The contested mark consists of a six-letter word. Despite the absence of an apostrophe between the “Y” and the “S”, I consider that the average consumer is likely to perceive the word as a possessive, referring to something belonging to a person called Betty. The overall impression of the mark lies in the word itself.

23. The earlier mark is a complex mark comprising figurative and verbal elements. The verbal element will be seen as three words, because of the use of bold for the middle “Betis”; on either side of this word are “Real” and “Balompié”. The average consumer will recognise the first word as a word in the English language. Those who have some knowledge of Spanish might understand it to mean “Royal”, but I must consider the average consumer and at least a significant proportion of those consumers would not have this knowledge. The second words will be perceived to have been invented or to be foreign words with no understandable meaning to the average consumer. The words are shown in a dark green. The colour is used in the device, which consists of a triangle containing vertical green and white stripes, on which is a white circle containing a small green device which might bring the letter “B” to the mind of the viewer. The circle and triangle are surrounded by a gold border. On the top of the device is a crown in gold and red. The device is large and appears at the top of the mark. Words are, in general, more distinctive than figurative elements of marks (see, for example, *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph [37]), so I consider that the words here make the greatest contribution to the overall impression of the mark, with that of “Betis” being slightly larger because of its presentation in bold. However, the contribution made by the device is far from negligible, given its size.

24. The opponent's submissions on similarity depend on focusing on the word "Betis". However, the law is clear that the average consumer views the mark as a whole. That is the approach I shall take in my comparison.

25. I accept that both marks contain a word that begins with "BET" and ends in "S", but the additional elements in the earlier mark, which, I have found, contribute to its distinctive character, mean that I find the marks to be visually dissimilar. Turning to the aural comparison, the contested mark is likely to be pronounced as "BET-TEES", with the earlier mark pronounced as "REEL-BET-TIS-BAL-OM-PY", "RAY-AL-BET-TIS-BAL-OM-PEE-AY" or some combination. However, it is pronounced, the earlier mark is considerably longer and the shared "BET" sound and similar "TEES/TIS" are not sufficient for me to find that they are aurally similar.

26. Conceptually, the contested mark will bring to mind a woman named Betty. The earlier mark has little conceptual content for an English speaker. The crown at the top may suggest a royal connection or give an air of prestige, but there is nothing else for the mind to latch on to. I find that the marks are conceptually dissimilar.

27. Having found that the marks are dissimilar, the opposition under section 5(2)(b) fails.

FINAL REMARKS

28. Because I have found the marks to be dissimilar, I see no reason to put the opponent to the additional cost of clarifying which of the goods and services it is opposing. It would not be to its advantage. Likewise, a claim under section 5(3) cannot succeed unless the marks are similar, so this is another clarification that would ultimately result in an increased level of costs without assisting the opponent.

OUTCOME

29. The opposition has failed and Application No. 3797817 may proceed to registration for all the goods for which it is registered.

COSTS

30. The applicant has been successful and is entitled to a contribution towards the costs of these proceedings in line with the scale set out in Tribunal Practice Notice (“TPN”) No. 2/2016. TPN No. 2/2015 states that costs in fast track opposition proceedings are capped at £500, minus any official fee. The award is calculated as follows:

<i>Preparing a statement and considering the other side’s statement</i>	£200
<i>Preparation of written submissions in lieu of a hearing</i>	£300
TOTAL	£500

31. I therefore order Real Betis Balompié, S.A.D. to pay Bettys & Taylors Group Limited the sum of £500. This sum should be paid within 21 days of the expiry of the appeal period or, if there is no appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 12th day of September 2023

Clare Boucher
For the Registrar,
Comptroller-General

ANNEX: Specification of UKTM(A) 3797817

Class 9

Downloadable software, namely virtual food and drink products; Downloadable software, namely virtual baked goods, confectionary, hampers of foods and drinks, books, tea pots, tea caddies, biscuit tins, mugs, cups, reusable cups, tote bags, shopping bags, crockery, glassware; downloadable digital media; digital media, namely, digital tokens, digital collectibles and digital art; digital assets in the form of digital graphics, literature, text, audio, video, music and/or multimedia; Downloadable non-fungible tokens (NFTs) being downloadable computer code for authentication of digital files; digital tokens; digital collectibles in the form of non-fungible tokens (NFTs); digital assets in the form of digital graphics, literature, text, audio, video, music and/or multimedia authenticated by non-fungible tokens (NFTs); digital tokens used with blockchain technology to represent virtual goods for use online and in online virtual worlds; Downloadable non-fungible tokens being downloadable computer code for authentication of digital files.

Class 35

Retail services and online retail services connected with the sale of downloadable software, namely, virtual food, virtual drinks, virtual tea and coffee, virtual baked goods, virtual confectionary, virtual hampers of foods and drinks, virtual books, virtual tea pots, virtual tea caddies, virtual biscuit tins, virtual mugs, virtual cups, virtual reusable cups, virtual tote bags, virtual shopping bags, virtual crockery, virtual glassware; retail services and online retail services connected with food, drinks, tea, coffee, baked goods, confectionary, hampers of foods and drinks, books, tea pots, tea caddies, biscuit tins, mugs, cups, reusable cups, tote bags, shopping bags, crockery, glassware; retail services and online retail services connected with the sale of downloadable multimedia files and non-fungible tokens, namely, downloadable non-fungible tokens being downloadable computer code for authentication of digital files.

Class 41

Entertainment services, namely, virtual events; entertainment services, namely, operating a virtual restaurant offering virtual food, beverages; entertainment services, namely operating a virtual shop; bakery and cooking classes, including such classes

provided online for entertainment or education; virtual cooking and bakery classes for entertainment or education; food and drink tasting for entertainment or education; virtual food and drink tasting for entertainment or education.

Class 43

Operating a virtual café, tearoom, snack bar, catering truck restaurant; virtual food and drink services; virtual catering; operating a virtual café, tearoom, snack bar, catering truck restaurant serving actual food and beverages; virtual food and drink services; virtual catering.