

O/0974/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003758833

BY COMPLETE SERVICE MANAGEMENT LTD

TO REGISTER THE TRADE MARK:

CSM

IN CLASSES 16 AND 40

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 434138

BY CSM SPORT AND ENTERTAINMENT LLP

BACKGROUND AND PLEADINGS

1. On 24 February 2022, Complete Service Management Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 11 March 2022 and registration is sought for the goods and services set out in paragraph 21 below.

2. On 13 June 2022, the application was opposed by CSM Sport and Entertainment LLP based upon sections 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(a) of the Act, the opponent relies upon the following trade mark:

CSM

UKTM no. 3269881

Filing date 10 November 2017; registration date 6 April 2018

(“the First Earlier Mark”)

3. Under section 5(2)(b) of the Act, the opponent relies upon the following trade mark:



UKTM no. 3272046

Filing date 21 November 2017; registration date 6 April 2018

(“the Second Earlier Mark”)

(together “the earlier marks”)

4. Under sections 5(2)(a) and (b), the opponent relies upon all services for which the earlier marks are registered as set out in the Annex to this decision. The opponent claims that the First Earlier Mark and the application are identical, and the Second Earlier Mark and the application are similar, and that both parties’ marks are applied

for/registered for similar goods and services. The result, the opponent claims, is that there is a likelihood of confusion.

5. Under section 5(3) of the Act, the opponent claims that the earlier marks have a reputation for the services underlined in the Annex to this decision. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character or repute of the earlier marks.

6. Under section 5(4)(a) of the Act, the opponent relies upon signs identical to those for which the earlier marks are registered, which it claims to have used throughout the UK since 1 January 2012. It also relies upon the sign **CSM LIVE** and the following sign, both of which it claims to have used throughout the UK since 1 January 2017:



7. The opponent claims to have used all four signs relied upon in relation to: “the organising of live events, the supply of advertising, wayfinding, signage and branding for live events, along with the provision of printing services in connection with those events”. The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

8. The applicant filed a counterstatement denying the grounds of opposition. In particular, the applicant denies that the goods and services are identical or similar.

9. The applicant is represented by Appleyard Lees IP LLP and the opponent is represented by Reddie & Grose LLP.

10. Both parties filed evidence in chief. The opponent did not file evidence in reply. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

11. The opponent filed evidence in chief the form of the witness statement of Sarah Riggott dated 14 December 2022, which is accompanied by 27 exhibits. Ms Riggott is the Chief Marketing Officer for the opponent, for whom she has worked since March 2011.

12. The applicant filed evidence in the form of the witness statement of Samuel James Turton dated 15 February 2023, which is accompanied by 5 exhibits. Mr Turton is the representative for the applicant in these proceedings.

13. The applicant filed written submissions in lieu dated 5 May 2023.

14. The opponent filed undated written submissions in lieu on 10 May 2023.

15. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

RELEVANCE OF EU LAW

16. 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 upon 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.

DECISION

Sections 5(2)(a) and (b)

17. Section 5(2) of the Act reads 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 trade mark is protected

(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.”

18. Section 5A of the Act is as follows:

“5A 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.”

19. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not completed their registration process more than 5 years before the application date of the mark in issue, they are not subject to the proof of use provisions of section 6A of the Act. Consequently, the opponent can rely upon all of the services identified.

20. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods and services

21. All of the services upon which the opponent relies are set out in the Annex to this decision. However, I note that in its written submissions in lieu, the opponent has identified particular terms that it considers to be similar to the applicant's specification. I have set only those services out in the table below, as they appear to reflect what the opponent considers to be its best case:

| Opponent's services | Applicant's goods and services |
|---|--|
| <u>Class 35</u> Advertising; publicity services; arranging and conducting marketing promotional events for others; organising of events for commercial and advertising purposes. | <u>Class 16</u> Printed Matter; Stationery; Prints; Printed publications; Publications (Printed -); Art prints; Print wheels; Printed timetables; Printing sets; Printed newsletters; Printed invitations; Photographs [printed]; Photo prints; Printed curricula; Printed lessons; Printed vouchers; Printed tables; Printed |
| <u>Class 37</u> | |

| | |
|---|---|
| <p>Erection of temporary constructions for outdoor events.</p> | <p>booklets; Printed cards; Printed programmes; Printed music; Printed matter; Printed periodicals; Forms, printed; Printed forms; Photographic prints; Printing paper; Printing papers; Printed questionnaires; Printed brochures; Printed stationery; Giclee prints; Printed patterns; Printed guides; Printed calendars; Timetables (Printed -); Printed reports; Printed advertisements; Printed flyers; Printing type; Printing fonts; Print characters;</p> |
| <p><u>Class 41</u> Productions of sporting and cultural events for television, film, radio and other communication media; organisation of sports events and sports tournaments, cultural events; issuing tickets for entertainment, shows, sports events.</p> | <p>Graphic prints; Pictorial prints; Printed lectures; Color prints; Printed manuals; Canvas prints; Printed menus; Prints [engravings]; Engravings [prints]; Printing blocks; Print blocks; Lithographic prints; Printed charts; Printed tickets; Printed awards; Printed certificates; Printed coupons; Printed books; Printed horoscopes; Printed photographs; Print letters; Printing characters; Printed visuals; Printed emblems; Cartoon prints; Printed diagrams; Printed plans; Printed leaflets; Printed pamphlets; Printed diplomas; Printed luggage labels; Adhesive printed labels; Galley racks [printing]; Printed recipe cards; Silk screen prints; Printed periodical publications; Printed paper labels; Printed price lists; Printed informational flyers.</p> |
| <p><u>Class 42</u> Design services; graphic designing, construction design.</p> | |

| | |
|--|---|
| | <p><u>Class 40</u> Printing; Screen printing; Offset printing; Wool printing; Silkscreen printing; Textile printing; Letterpress printing; Printing (Lithographic -); Printing (Offset -); Printing services; Lithographic printing; Offset printing services; Stationery printing services.</p> |
|--|---|

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

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

24. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

Class 16

25. It appears from the opponent’s written submissions in lieu, that there are four elements to its case on similarity in respect of the applicant’s class 16 goods:

- a) Advertising/publicity businesses often provide printed matter (such as signs, boards, banners etc.) meaning that there is similarity of trade channels and complementarity between the goods and services.
- b) Providers of sporting and other events often provide printed matter to customers for the promotion of those events (such as signs, boards, banners etc.) meaning that there is overlap in trade channels and complementarity.

- c) Businesses engaged in issuing tickets for entertainment shows and events will also be responsible for providing the tickets themselves (being printed matter), resulting in an overlap in trade channels and complementarity.
- d) Businesses engaged in selling printed matter will overlap with those responsible for erecting temporary constructions for outdoor events and signs and the goods and services are complementary.

26. I do not accept that there is any meaningful overlap in trade channels between providers of events and the applicant's goods. The fact that pamphlets may be circulated (or tickets issued) for sporting events, does not mean that the business is engaged in the market for those particular goods; they are simply circulating/issuing them for the purposes of facilitating their event or promoting it. I do, however, accept that there will be complementarity and an overlap in trade channels between *issuing tickets for entertainment, shows, sports events* and printed matter to the extent that the latter includes tickets, because the same business is likely to be perceived as responsible for both the goods and the service and they are important or indispensable for each other. Clearly, the nature, purpose and method of use will differ. There will be an overlap in user. Consequently, I consider there to be a medium degree of similarity in relation to the following goods in the applicant's specification:

Printed matter; Printed matter; Printed tickets.

27. I also accept that there is some (albeit limited) overlap in trade channels between some printed materials (to the extent that they consist of advertising/publicity matter) and businesses engaged in *advertising* and *publicity services*. However, I do not consider the goods and services to be complementary, as one is not important or indispensable for the other. Clearly, the user will overlap. However, the nature, method of use and purpose of the goods and services differ. I do not consider there to be any meaningful competition. I consider the following goods in the applicant's specification to be similar to the opponent's services to a low degree:

Prints; Printed publications; Publications (Printed -); Printed newsletters; Printed vouchers; Printed booklets; Printed programmes; Printed periodicals;

Printed questionnaires; Printed brochures; Printed guides; Printed advertisements; Printed flyers; Printed visuals; Printed leaflets; Printed pamphlets; Printed periodical publications; Printed informational flyers.

28. As for the remaining goods in class 16 of the applicant's specification, I can see no basis for finding an overlap in trade channels, nature, purpose or method of use with the opponent's services. As noted by the applicant, these goods will typically be sold through stationary retailers or specialist print outlets. There is no competition or complementarity. Further, I have no submissions from the opponent to explain why any such overlap would exist. Consequently, I consider the following goods and services to be dissimilar:

Stationery; Art prints; Print wheels; Printed timetables; Printing sets; Printed invitations; Photographs [printed]; Photo prints; Printed curricula; Printed lessons; Printed tables; Printed cards; Printed music; Forms, printed; Printed forms; Photographic prints; Printing paper; Printing papers; Printed stationery; Giclee prints; Printed patterns; Printed calendars; Timetables (Printed -); Printed reports; Printing type; Printing fonts; Print characters; Graphic prints; Pictorial prints; Printed lectures; Color prints; Printed manuals; Canvas prints; Printed menus; Prints [engravings]; Engravings [prints]; Printing blocks; Print blocks; Lithographic prints; Printed charts; Printed awards; Printed certificates; Printed coupons; Printed books; Printed horoscopes; Printed photographs; Print letters; Printing characters; Printed emblems; Cartoon prints; Printed diagrams; Printed plans; Printed diplomas; Printed luggage labels; Adhesive printed labels; Galley racks [printing]; Printed recipe cards; Silk screen prints; Printed paper labels; Printed price lists.

Class 40

29. In relation to the applicant's class 40 services, the opponent's submissions regarding similarity with its own services can be summarised as follows:

- a) There is an overlap in trade channels between businesses that organise events and businesses that provide printing services, and they are complementary,

because event organisers “need to supply printed materials for the purpose of promoting events [...] any may provide large scale printing services direct to their customers”.

- b) Businesses that offer design services also often offer printing services and the user will be the same.

30. In my view, by far the stronger of these two arguments is that businesses engaged in design services will also often offer printing services. In this regard, I note that the applicant submits as follows:

“A. The respective services have a different relevant public. Whilst both services target primarily business consumers, the respective services address very different needs. The Opposed Class 40 services are intended to assist consumers with their printing needs, whereas the Class 42 services are targeted at a consumer seeking assistance with the design of websites, facilities and architecture;

B. The respective services have a different purpose and method of use. The Class 40 services are used by consumers/businesses seeking assistance with their printing needs, whereas the Class 42 services are intangible services used by a consumer seeking assistance with the design of websites, facilities and architecture;

C. The respective services have different distribution channels. The Class 40 services are typically provided by specialist printing/print management companies. A consumer would not be able to access the Class 42 services relied upon by the Opponent through these distribution channels. The Class 42 services are typically offered by companies specialising in the design of websites, facilities and architecture (for example, Wix (websites design));

D. For the same reasons as discussed in point C, the respective services have different commercial origins. It is highly unlikely that these services would emanate from the same undertaking;

E. The respective services are not complementary. A consumer/business would not typically acquire web design/architecture services at the same time that they need printing services, and the respective services are by no means indispensable to each other;

F. The respective services are not in competition, given that the services cannot be said to be alternatives to each other.”

31. The applicant’s submissions are premised upon the view that the opponent’s design services are limited to web, facility and/or architecture design. I do not consider that to be the case. The opponent’s specification covers “design services” at large, which could include a whole host of design services (from interior design to design of promotional materials). I do accept that there will be some instances of overlap in trade channels where businesses offer both the design services and the printing services. Nonetheless, I do not consider that they are important or indispensable for each other, such that there is complementarity within the meaning of the case law. The method of use, nature and purpose of the services differ. Clearly, there is potential for an overlap in user. Consequently, the following services are similar to the opponent’s services to a low degree:

Printing; Screen printing; Offset printing; Wool printing; Silkscreen printing; Textile printing; Letterpress printing; Printing (Lithographic -); Printing (Offset -); Printing services; Lithographic printing; Offset printing services; Stationery printing services.

32. For the avoidance of doubt, in reaching my findings set out in this section of my decision, I have considered whether any other terms in the opponent’s specification (other than those identified in its submissions) would have put it in any stronger position. I do not consider that they would.

33. As some degree of similarity is required for there to be a likelihood of confusion, the opposition under this ground must fail in relation to those goods and services that I have found to be dissimilar.¹

The average consumer and the nature of the purchasing act

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

35. The average consumer for the goods and services will be either a member of the general public or a business user. The goods and services are likely to vary significantly in cost. However, factors such as materials used, quality of printing, cost and/or customer services standards are likely to be taken into consideration when purchasing the goods and services. In my view, the level of attention paid during purchasing process will vary from medium (or average) to relatively high.

36. The goods and services are likely to be selected following perusal of physical signage on premises, product packaging or online equivalents. Consequently, I consider visual considerations are likely to dominate the purchasing process.

¹ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

However, I do not discount aural considerations given that advice may be sought from sales assistants and word-of-mouth recommendations may be made.

Comparison of trade marks

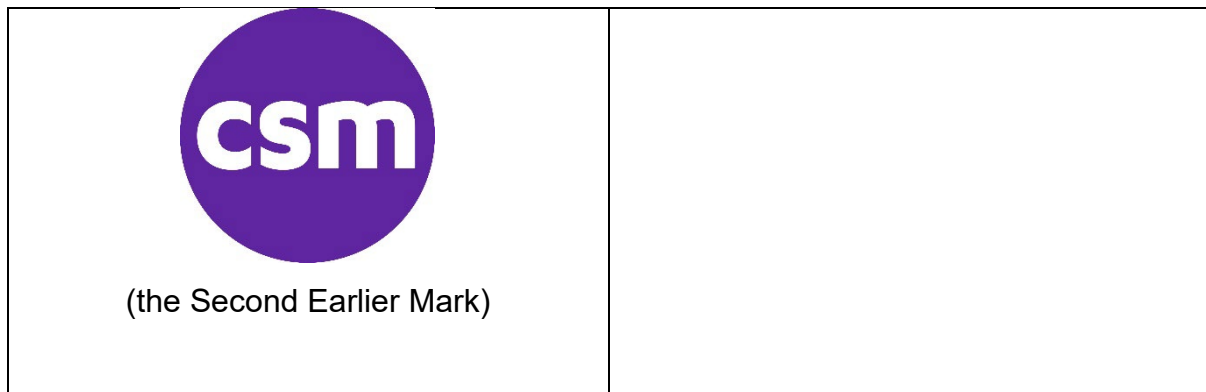
37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed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

38. 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.

39. The respective trade marks are shown below:

| Opponent's trade marks | Applicant's trade mark |
|---------------------------------|-------------------------------|
| CSM (the First Earlier Mark) | CSM |



The 5(2)(a) comparison

40. The First Earlier Mark and the applicant's mark are plainly identical.

The 5(2)(b) comparison

41. The First Earlier Mark consists of the letters CSM. It is in that combination that the overall impression lies. The Second Earlier Mark consists of the letters CSM, presented in a white font on a purple circular background. The letters CSM play the greater role in the overall impression, with the use of colour and the background playing a lesser role.

42. Visually, the marks overlap to the extent that they both consist of the letters CSM. The applicant's mark is word only and so could be used in any colour or font. However, the circular background in the Second Earlier Mark is a point of visual difference. The marks are visually similar to a high degree.

43. Aurally, both marks will be pronounced SEE-ESS-EMM. They are aurally identical.

44. Conceptually, the marks are both likely to be perceived as acronyms, with no particular meaning. The conceptual position is, therefore, neutral.

Distinctive character of the earlier trade marks

45. 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-2779, 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).”

46. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of them.

47. The First Earlier Mark consists of the letters CSM. The applicant filed evidence showing that a search for the mark CSM in the Register returned 86 results in the relevant classes.² The evidence includes the parties’ marks, as well as others. However, I note that many of these are removed, expired, withdrawn or dead marks. Further, the results include various other marks (such as MSC, d-smc). Only two

² Exhibit SJT1 and SJT2

examples of businesses actually using the mark CSM in the marketplace have been provided.³ One is in relation to a parcel delivery service, which is clearly a different field to those with which this opposition is concerned. The second is a business in the marketing industry, which is plainly relevant. However, the print out is undated and, in any event, I do not consider that an example of one business using the mark CSM in the same field as the opponent is sufficient to justify a finding that those letters are of lower distinctiveness. In my view, the First Earlier Mark is of medium (or average) distinctiveness. I do not consider that the use of colour, font and background in the Second Earlier Mark materially increases its distinctiveness. Consequently, the same finding applies to that mark.

48. The opponent has filed evidence of use; Ms Riggott states that the opponent is:

“a global marketing agency, providing a range of marketing consultancy services to companies, including advising on communications, PR and marketing campaign management.”

49. She also explains that:

“7. CSM Live is a division of the Company and is an industry leading environmental branding, signage and live event business, working across sport, entertainment, retail and brands. [...]”

8. CSM Live provides look, feel and wayfinding for major sporting and entertainment events and offers a comprehensive service from initial concept and design through to printing and production, project management and onsite implementation.

9. The signage and wayfinding for these events is printed and produced at CSM’s production facility in Orpington. [...]”

³ Exhibits SJT3 and SJT5

50. I note that some of the opponent's evidence relates to the opponent's activities after the relevant date (or is undated) and some of it is not clearly related to the UK market. For example, the opponent has provided advertising expenditure relating to the CSM and CSM Live brands, as follows:

| £ 000s | 2016 | 2017 | 2018 | 2019 | 2020 | 2021 | 2022 |
|-------------|-------|-------|-------|-------|------|------|-------|
| CSM | 1,192 | 1,385 | 1,243 | 1,092 | 770 | 794 | 1,385 |
| CSM Live UK | 102 | 115 | 162 | 169 | 55 | 69 | 185 |

However, Ms Riggott describes the opponent as a global marketing agency, and no breakdown is provided as to what proportion of the CSM (as opposed to CSM Live UK) figures relate to the UK market. I note that there is evidence of advertising activities undertaken by the opponent, including advertising at the Sports Industry Awards since 2017.⁴

51. I note that in relation to the UK market, the opponent has provided evidence that it supplied signage for events such as the Radox Grand National at Aintree racecourse (for a number of years leading up to the relevant date), the 2019 FA Cup Semi-Finals and Finals and the 2018 Hockey World Cup.⁵ I note that there is also evidence of signage being made for other events (PGA Championships and Chelsea Flower Show) but dates for these events have not been provided.⁶ Invoices have been filed to show the charges made in relation to some of these events; they describe the work undertaken as the production of various signs and branding.⁷ I also note that there is one instance of a charge for installation.⁸

52. In relation to revenue for services offered under CSM in the UK, it was over £40million in 2020 and over £57million in 2021. The revenue for services offered under the CSM Live in the UK was over £4million in 2020 and over £21million in 2021.

⁴ Exhibit SR19

⁵ Exhibits SR5 to SR10

⁶ Exhibit SR11

⁷ Exhibits SR6 and SR8

⁸ Exhibit SR8

53. The opponent has won a number of awards such as Best Business Serving Sport in 2018 and nominations at The Field Marketing & Brand Experience Awards 2019.⁹

54. Two articles provide details about the services of the opponent, which state:¹⁰

“Alongside bringing tournaments to life, we have worked with teams and clubs such as the Lionesses, West Ham United and Leicester City FC – offering our unique full service – from consulting, defining strategy, and designing dynamic football branding, through to print production and bespoke builds.”

“CSM Live explains that Lidl was particularly interested in promoting their position as a Leader in ‘gin-novation’, leveraging their award-winning Hortus Gin. CSM Live created an innovative and immersive experience, promoting the Hortus Gin range in a unique and engaging manner. The Lidl House of Hortus was officially launched in Soho, with additional events located in Cardiff and Edinburgh. The result of the event was an overwhelming positive media response with extensive coverage spanning across major media outlets and a signage uptake on social media channels with the #LidlHouseofHortus social campaign.”

55. There are clearly issues with the opponent’s evidence. For example, no breakdown has been provided for the opponent’s advertising spend for the UK market for the CSM (as opposed to CSM Live) mark and no market share figures have been provided. However, there is evidence of the opponent engaging in advertising activity in the UK and the opponent’s revenue figures are substantial. The opponent has also won a number of awards. In my view, the biggest issue for the opponent is that the use shown covers a range of services. These include production/printing of signage, installation of signage, event production for advertising purposes and brand consultancy. However, no information is provided by the opponent about what proportion of their revenue is generated from each or any of these parts of the business. Without further information about what proportion of its business activities relate to each of these

⁹ Exhibits SR12 and SR14

¹⁰ Exhibits SR13 and SR14

different services, it is impossible to assess in relation to what services (if any) the distinctiveness of the marks has been enhanced.

Likelihood of confusion

56. 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 them 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 marks, 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 has retained in his mind.

57. I have found as follows:

- a) The goods and services vary from being similar to a low degree to similar to a medium degree (except where I have found them to be dissimilar).
- b) The average consumer for the goods and services will be a member of the general public or a professional user, who will pay at least a medium degree of attention during the purchasing process.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The First Earlier Mark and the applicant's mark are identical.

- e) The Second Earlier Mark and the applicant's mark are visually highly similar, aurally identical and conceptually neutral.
- f) The First and Second Earlier Mark are inherently distinctive to a medium (or average) degree.

58. Given the high degree of similarity (or identity) between the marks, I am satisfied that they are likely to be mistakenly recalled or misremembered as each other where they are used on goods and services that are similar. For those goods and services, there is a likelihood of direct confusion.

59. In relation to the Second Earlier Mark, if the different presentation is recognised by the average consumer, it will just be seen as an alternative mark being used by the same or economically linked undertakings where the goods and services are similar. Consequently, there is a likelihood of indirect confusion.

60. The opposition based upon sections 5(2)(a) and 5(2)(b) succeeds in relation to the following goods and services only:

Class 16 Printed Matter; Prints; Printed publications; Publications (Printed -); Printed newsletters; Printed vouchers; Printed booklets; Printed programmes; Printed matter; Printed periodicals; Printed questionnaires; Printed brochures; Printed guides; Printed advertisements; Printed flyers; Printed tickets; Printed visuals; Printed leaflets; Printed pamphlets; Printed periodical publications; Printed informational flyers.

Class 40 Printing; Screen printing; Offset printing; Wool printing; Silkscreen printing; Textile printing; Letterpress printing; Printing (Lithographic -); Printing (Offset -); Printing services; Lithographic printing; Offset printing services; Stationery printing services.

Final remarks

61. For the avoidance of doubt, my finding would have been the same even if I had found the distinctiveness of the First and Second Earlier Marks to have been enhanced through use to between a medium and high degree in relation to brand design services, organising of events for advertising purposes and/or signage installation services (which, in my view, is the opponent's best case on the evidence filed). This is because the distance between the applicant's remaining goods and the services for which the opponent would have been able to demonstrate enhanced distinctiveness (at best) would be sufficient to offset the impact of the enhancement.

62. In this regard, and for the avoidance of doubt, although I noted above that there is also evidence of use in relation to production/printing of signage, that service is not covered by the specifications of the First and Second Earlier Mark. Although the signage may be used for advertising, its production/printing is not an advertising service in itself. Consequently, I do not consider that this assists the opponent.

Section 5(3)

63. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

64. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

65. I can deal with this ground relatively swiftly. For the reasons set out above, my primary finding is that the opponent’s evidence is not sufficient to establish the requisite reputation. However, even if I had found that the opponent had a modest reputation in relation to brand design services, organising of events for advertising purposes and/or signage installation services (which, in my view, is the opponent’s best case on the evidence filed), it would still not have put the opponent in any stronger position than it is under section 5(2). This is because the distance between this narrower range of services and the goods and services of the application that survived the section 5(2) ground is sufficient to avoid a link being made in the minds of the relevant public, notwithstanding the opponent’s (modest, at best) reputation. Consequently, this ground does not improve the opponent’s position and I decline to consider it any further.

Section 5(4)(a)

66. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

67. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

68. I can also deal with this ground relatively swiftly. Clearly, the opponent had a reasonably significant trade and, consequently, had goodwill at the relevant date. However, again, the same difficulty applies in relation to identifying what services that goodwill relates to. Even if I had found that the opponent had a modest but protectable goodwill for “the organising of live events, the supply of advertising, wayfinding, signage and branding for live events, along with the provision of printing services in connection with those events” (which are the only services that the opponent relies upon under this ground), it would not have put the opponent in any stronger position. This is because, the goods that survived the section 5(2) ground are too far removed from the services for which the opponent (at best) could demonstrate goodwill, resulting in no misrepresentation or damage.

69. The opposition based upon section 5(4)(a) is dismissed.

CONCLUSION

70. The opposition is successful in relation to the following goods and services for which the application is refused:

Class 16 Printed Matter; Prints; Printed publications; Publications (Printed -); Printed newsletters; Printed vouchers; Printed booklets; Printed programmes; Printed matter; Printed periodicals; Printed questionnaires; Printed brochures; Printed guides; Printed advertisements; Printed flyers; Printed tickets; Printed visuals; Printed leaflets; Printed pamphlets; Printed periodical publications; Printed informational flyers.

Class 40 Printing; Screen printing; Offset printing; Wool printing; Silkscreen printing; Textile printing; Letterpress printing; Printing (Lithographic -); Printing (Offset -); Printing services; Lithographic printing; Offset printing services; Stationery printing services.

71. The opposition is unsuccessful in relation to the following goods for which the application may proceed to registration:

Class 16 Stationery; Print wheels; Printed timetables; Printing sets; Printed invitations; Photographs [printed]; Photo prints; Printed curricula; Printed lessons; Printed tables; Printed cards; Printed music; Forms, printed; Printed forms; Photographic prints; Printing paper; Printing papers; Printed stationery; Giclee prints; Printed patterns; Printed calendars; Timetables (Printed -); Printed reports; Printing type; Printing fonts; Print characters; Graphic prints; Pictorial prints; Printed lectures; Color prints; Printed manuals; Canvas prints; Printed menus; Prints [engravings]; Engravings [prints]; Printing blocks; Print blocks; Lithographic prints; Printed charts; Printed awards; Printed certificates; Printed coupons; Printed books; Printed horoscopes; Printed photographs; Print letters; Printing characters; Printed emblems; Cartoon prints; Printed diagrams; Printed plans; Printed diplomas; Printed luggage labels; Adhesive printed labels; Galley racks [printing]; Printed recipe cards; Silk screen prints; Printed paper labels; Printed price lists.

COSTS

72. As the parties have enjoyed a roughly equal degree of success, I direct that each party bear their own costs.

Dated this 16th day of October 2023

S WILSON

For the Registrar

ANNEX

Class 35

Advertising; business administration; business management; business feasibility studies; business appraisals; marketing studies, market assessment and market research services; writing of business reports, publicity texts, business project reports; economic forecasting services; public relations and publicity services; arranging and conducting marketing promotional events for others; sales promotion for others; organising of events for commercial and advertising purposes; rental of advertising time on communication media; business services relating to the provision of sponsorship; sponsorship search services; negotiation and procurement of contracts for others; copywriting; provision of information, advice and consultancy on all the foregoing.

Class 36

Conducting financial feasibility services; financial assessment services; financial sponsorship services; provision of information, advice and consultancy on all the foregoing.

Class 37

Building construction services; installation services; erection of temporary constructions for outdoor events; constructions of screens; erection of signs; painting and repair of signs; provision of information, advice and consultancy on all the foregoing.

Class 38

Telecommunications; broadcasting radio, television; electronic mail services; message sending; teleconferencing services; delivery of messages by electronic media; chat room services for social networking; providing access to platforms and portals on the Internet; provision of information, advice and consultancy on all the foregoing.

Class 39

Transport of goods; travel arrangement; ticket reservation services for travel or tours; issuing of tickets for travel or tours; provision of information, advice and consultancy on all the foregoing.

Class 41

Sporting and cultural activities; organisation of competitions (educational/entertainment); organisation of exhibitions for cultural purposes; arranging and conducting of conferences, congresses, seminars and workshops; conducting of conferences; writing of texts (other than publicity texts); productions of sporting and cultural events for television, film, radio and other communication media; organisation of sports events and sports tournaments, cultural events; booking, reservation and issuing tickets for entertainment, shows, sports events; booking of performing artists and sports personalities for events (services of a promoter); hospitality services (entertainment); rental, syndication, distribution of television programmes; provision of information, advice and consultancy on all the foregoing.

Class 42

Conducting of feasibility studies (except business feasibility studies); design services relating to signs; design services; graphic designing, architectural design, construction design, design of sport and entertainment facilities; design, hosting, maintenance and updating of websites for others; hosting web portals; provision of information, advice and consultancy on all the foregoing.

Class 43

Hospitality services (accommodation, food and drink); accommodation reservation services; arranging for the provision of catering services; making of reservations for catering services; rental of meeting rooms; provision of information, advice and consultancy on all the foregoing.

Class 45

Granting of licenses on intellectual property including copyright works; provision of information, advice and consultancy on all the foregoing.