

BL O/1118/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3826717

BY

ANTHONY GEORGE MICHAEL

TO REGISTER THE TRADE MARK:

MN8

IN CLASSES 9 AND 41

-AND-

THE OPPOSITION THERETO UNDER No. 600002690

BY


MICHAEL DOUGLAS

Background and pleadings

1. Anthony George Michael (“**the Applicant**”) applied to register the trade mark ‘MN8’ in the UK on 6 September 2022. It was accepted and published in the Trade Marks Journal on 14 October 2022 in respect of goods and services in Classes 9 and 41.

2. Included in the applied-for Class 9 specification are computer hardware and software goods, music recordings, downloadable virtual goods, and apparatus and instruments for the recording, reproduction and transmission of sound, images, video and data. Included in the applied-for Class 41 specification are entertainment services, musical performances, music production services, the organising, arranging and conducting of live music concerts and performances, as well as education services relating to the fields of music, dance and acting. The applied-for goods are laid out in their entirety at paragraph 18 of this decision.

3. Michael Douglas (“**the Opponent**”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition is based on the Opponent’s trade mark shown below, which is registered in respect of goods and services in Classes 9 and 41:

Representation of the trade mark:	
Registration Number:	3807785
Filing date:	10 July 2022
Registration Date:	14 October 2022

4. For the purposes of the opposition, the Opponent relies on all the goods and services for which its mark is registered, which includes a variety of goods in Class 9 such as music recordings, downloadable software, namely virtual goods, downloadable music files and portable music players; and a variety of services in Class 41 including music recording, music concerts, music entertainment services,

production and publication of music, as well as teaching of music. The applied-for goods are laid out in their entirety at paragraph 18 of this decision.

5. By virtue of its earlier filing date, the trade mark upon which the Opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act.

6. The Opponent claims that the respective marks are similar and that the respective goods and services are similar, giving rise to a likelihood of confusion.

7. The Applicant filed a counterstatement denying the claims.

8. This is an opposition to which the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 applies, deemed a 'Fast Track' opposition which does not include the routine filing of evidence.¹ Neither party sought leave to file evidence nor made any request to be heard and neither party elected to file submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers.

9. The Opponent is represented by Battens Solicitors Limited. The Applicant has no professional legal representation in these proceedings.

10. 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. That is why this decision continues to refer to the case law of the EU courts.

DECISION

Legislation and Case Law

11. Section 5(2)(b) and 5A of the Act are as follows:

“5(2) A trade mark shall not be registered if because-

[...]

¹ Other than proof of use evidence, which is not a requirement in the present proceedings.

(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”.

“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.”

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

Comparison of goods and services

13. Section 60A of the Act provides:

- “(1) For the purpose of this Act goods and services-
- (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification
 - (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*,² (“**Meric**”), the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa (this principle equally applies to services).

15. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia: the physical nature of the goods and services; their intended purpose; their method of use / uses; who the users of the goods and services are; the trade channels through which the goods and services reach the market; in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors); or whether they are complementary to each other.³

16. 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*”.⁴

17. When interpreting the terms in a specification I bear in mind:

- (1) that it is “*necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise*”, although “*where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the*

² Case T- 133/05.

³ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

⁴ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82. Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity – see *Kurt Hesse v OHIM*, Case C-50/15 P.

language unnaturally so as to produce a narrow meaning which does not cover the goods in question”,⁵

(2) where “the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services”;⁶

(3) the following applicable principles of interpretation:

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

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

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

(4) A term which cannot be interpreted is to be disregarded.”⁷

18. The competing goods and services are set out below:

<u>Class 9</u>	
Opponent:	Music recordings; Musical recordings; Music tapes; Downloadable software, namely virtual clothing; Downloadable software, namely virtual bags; Downloadable software, namely virtual currency; Downloadable software, namely non-fungible tokens; Downloadable music files; Portable music players; Musical video recordings; Musical instrument amplifiers; Downloadable software, namely virtual clothing for use in computer games.
Applicant:	Computers and computer peripheral devices; computer hardware; computer software; mobile applications; downloadable application

⁵ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

⁶ *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

⁷ See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

	<p>software; downloadable software and applications relating to music, musical entertainment, musical artists, groups and bands; downloadable digital files authenticated by non-fungible tokens; downloadable virtual goods, namely, virtual clothing, footwear, headwear and bags; media content; recorded and downloadable media; downloadable digital media and recordings containing sound, images, text, information, signals or software; audio recordings; video recordings; audio and video recordings downloaded or stored on electronic, optical or magnetic data media; music recordings; downloadable music files; digital music or sound files downloadable from the Internet; downloadable videos; audio or sound files in MP3 format; video files in MP4 format; pre-recorded music compact discs; optical discs featuring music; CDs, DVDs, LP records, tapes and cassettes; pre-recorded CDs, DVDs, LP records, tapes and cassettes; pre-recorded music videos; downloadable films; motion picture films; photographs and stills in electronic form; electronic and downloadable publications; printed matter in electronic form; e-books; audio books; podcasts; video podcasts; blank digital or analogue recording and storage media; data storage devices and media; media streaming devices; audio players; video players; portable music players; headphones; in-ear headphones; earbuds; speakers; amplifiers; hi-fi sound systems; high fidelity audio apparatus; apparatus and instruments all for the recording, reproduction and transmission of sound, images, video and data; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; electronic bulletin boards; encoded gift cards; sunglasses; eyewear; parts and fittings for all the aforesaid goods.</p>
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<u>Class 41</u>	
Opponent:	Artistic management of performing artists; Artistic direction of performing artists; Recording services; Record mastering; Music recording; Audio recording services; Recording of music; Video recording services; Music concerts; Live musical concerts; Live music concerts; Organisation of music concerts; Musical concerts

	<p>by television; Pop music concerts (Organisation of -); Concert booking; Concert services; Management of concerts; Arranging of concerts; Singing concert services; Organisation of concerts; Entertainment by means of concerts; Arranging and conducting of concerts; Music publishing and music recording services; Musical performances; Arranging, conducting and organisation of concerts; Music production; Music publishing; Music performances; Musical entertainment; Music festival services; Musical education services; Live musical performances; Music publishing services; Musical entertainment services; Performance of music; Teaching of music; Live music performances; Music group services; Musical performance services; Live music services; Music competition services; Instruction in music; Live music shows; Production of music; Publication of music; Publishing of music; Music entertainment services.</p>
<p>Applicant:</p>	<p>Entertainment services; musical entertainment; musical performances; live musical performances; music concerts; music festival services; music group services; disc jockey services; provision and production of live entertainment, live performances and live shows; organising, arranging and conducting live music concerts and performances; organisation of musical entertainment; entertainment services relating to musical entertainment, musical artists, groups and bands; audio, video and multimedia production, and photography; music production services; production of music, musical recordings, musical performances and concerts; production of radio and television programmes, films, shows, and/or recordings of sound, music or images; production of podcasts; provision of entertainment via podcast; music composition services; music recording services; music recording studio services; publishing services; electronic publishing services; music publishing services; providing online, non-downloadable electronic publications, digital media and recordings, digital music, books and journals; provision of non-downloadable media and recordings containing sound, images, text, information, signals or software; providing online music, not downloadable; providing online videos, not downloadable; provision of online entertainment; club (discotheque) services; night clubs and night club services; provision of online information</p>

	relating to musical entertainment, musical artists, groups and bands; organisation of competitions and tournaments; provision of online games; sporting and cultural activities; education, training, teaching and coaching services; organising, arranging and conducting educational and training courses, classes, lectures, seminars, webinars, fairs, hackathons, events, workshops, conventions, tutorials, online courses and conferences; education services relating to the fields of music, dance and acting; provision of training relating to the fields of music, dance and acting; instruction in music; advisory, consultancy and information services relating to the aforesaid services.
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Class 9

19. The contested list of goods can loosely be grouped in the following categories:

- Software
- Virtual goods
- Music / audio / video recordings
- Audio / video players and peripheral devices
- Computers and computer hardware
- Printed matter in electronic form
- Digital and analogue storage media
- Eyewear

20. Many of the respective terms are either identical; plainly identical as they are synonymous; identical on the principle outlined in *Meric*; or similar when applying all the relevant factors of comparison. I have set out the details below:

(1) The following goods appear in both parties' specifications and are therefore **identical**:

“music recordings; downloadable music files; portable music players”.

(2) The following goods are synonymous and are self-evidently **identical**:

Opponent	Applicant
<i>“Downloadable software, namely virtual clothing; Downloadable software, namely virtual bags”</i>	<i>“Downloadable virtual goods, namely, virtual clothing, [...] and bags”</i>
<i>“Musical video recordings”</i>	<i>“Pre-recorded music videos”</i>

(3) The following goods are **identical** on the principle outlined in *Meric*, either because the Opponent’s terms are broad terms that encompass the Applicant’s terms, or vice versa:

Opponent	Applicant
<i>“Downloadable software, namely virtual clothing; Downloadable software, namely non-fungible tokens”</i>	<i>“Computer software; mobile applications; downloadable application software”</i>
<i>“Downloadable music files”</i>	<p><i>“Downloadable digital files authenticated by non-fungible tokens”</i></p> <p>I note that the ‘downloadable files’ are the assets to which the non-fungible tokens relate, and the assets can include things such as digital music.⁸ While the construction of the term sets out that the files are authenticated by non-fungible tokens it is my view that, for the purposes of this comparison, this does not alter what goods the term actually covers, i.e. ‘downloadable digital files’. With this in mind, I consider</p>

⁸ See the Registry’s Practice Amendment Notice 2/23 in relation to non-fungible tokens.

	<p>the Applicant’s term is a broad term which encompasses the Opponent’s “downloadable music files” (which are digital files).</p>
<p><i>“Music recordings; Musical recordings; Downloadable music files”</i></p> <p>I note that music recordings are by their very nature a recording of sound, and as such, would fall within the broad category of an audio recording.</p>	<p><i>“Audio recordings; audio [...] recordings downloaded or stored on electronic, optical or magnetic data media; digital music or sound files downloadable from the Internet; audio or sound files in MP3 format; downloadable digital media and recordings containing sound [...]; pre-recorded music compact discs; optical discs featuring music; pre-recorded CDs, [...] LP records”</i></p>
<p><i>“Music tapes”</i></p>	<p><i>“Pre-recorded [...] tapes and cassettes”</i></p>
<p><i>“Musical video recordings”</i></p>	<p><i>“Video recordings; [...] video recordings downloaded or stored on electronic, optical or magnetic data media; downloadable videos; video files in MP4 format; pre-recorded [...] DVDs [...]”</i></p>
<p><i>“Music recordings; Musical recordings; Downloadable music files; Musical video recordings”</i></p>	<p><i>“Media content; recorded and downloadable media”</i></p>
<p><i>“Musical video recordings; Downloadable music files; Downloadable software, namely non-fungible tokens; Downloadable software, namely virtual clothing; Downloadable software, namely virtual bags”</i></p>	<p><i>“Downloadable digital media and recordings containing [...] images, text, information [...] or software”</i></p>

<p><i>“Portable music players”</i></p>	<p><i>“Audio players; hi-fi sound systems; high fidelity audio apparatus; apparatus and instruments all for the recording, reproduction and transmission of sound [...]; media streaming devices”</i></p>
<p><i>“Musical instrument amplifiers”</i></p>	<p><i>“Amplifiers”</i></p>
<p><i>“Downloadable music files”</i></p>	<p><i>“Electronic and downloadable publications”</i></p> <p>To the extent that the Applicant’s term is not limited to a specific format of publication, which in essence makes the term extremely broad, because ‘publications’ could refer to books, music and even software, I consider the goods to be <i>Meric</i> identical. This is on the basis that the ‘publications’ could be music capable of being downloaded or electronic music files for example. As will be shown later in my decision, ‘publishers’ encompass ‘music publishers’.</p>

(4) The following terms are **similar** for the reasons set out below:

(a)	Opponent	Applicant
	<p><i>“Downloadable software, namely virtual clothing; Downloadable software, namely virtual bags; Downloadable software, namely virtual clothing for use in computer games.”</i></p>	<p><i>“Downloadable virtual goods, namely, virtual [...] footwear [and] headwear”</i></p>

Whilst I appreciate that clothing and bags are different from footwear and headwear in their physical forms, the very nature of the virtual goods are the same since they essentially consist of data. The respective goods also overlap in purpose since they are all virtual ‘wearable’ goods that can be used within a virtual environment, for example, to adorn a virtual character in a computer game, as such they may also overlap in their method of use. They would likely share the same trade channels as well as the same user. In addition, there may be a degree of competition between them as a consumer may select one instead of the other. The goods are similar to a **medium to high degree**.

(b)

Opponent	Applicant
<i>“portable music players”</i>	<i>“headphones; in-ear headphones; earbuds; speakers”</i>
<p>The respective goods would likely have the same user and they would likely share the same trade channels. They are also complementary, in the sense that one is indispensable or important for the use of the other in such a way that the average consumer is likely to consider that they come from the same undertaking. For example, a portable music player is important for the use of headphones or speakers. The respective goods are similar to a low degree.</p>	

(c)

Opponent	Applicant
<i>“Music recordings; Musical recordings; Musical video recordings; Music tapes”</i>	<i>“CDs, DVDs, LP records, tapes and cassettes; blank digital or analogue recording and storage media; data storage devices and media”</i>
<p>The Applicant’s goods are data carriers where audio (including music) and/or video data can be recorded. ‘Music recordings’ and ‘music video recordings’ are broad in the sense that they are not limited by the medium on which they are recorded, therefore they could be made available on the various storage media contained in the Applicant’s specification. Whilst the Applicant’s term does not specify that the goods are pre-</p>	

recorded, I nonetheless consider the respective goods to be similar. This is because there is an overlap in nature and purpose, there may also be an overlap in the user and in the use of the respective goods. The goods may also share the same trade channels and may also be complementary to each other. The respective goods are similar to a **medium** degree.

(d)

Opponent	Applicant
<i>“Portable music players”</i>	<i>“video players; apparatus and instruments all for the recording, reproduction and transmission of [...] images, video and data”</i>
<p>There is overlap in purpose and nature between these respective goods, since the Opponent’s ‘portable music players’ would be capable of recording, reproducing and transmitting data, in addition, there is nothing that limits them to being solely audio players, and I consider it likely that they would also be devices capable of playing videos such as music videos. As such, I consider there would also be an overlap in use and user. The respective goods are likely to share the same trade channels and they may be in competition with each other. These goods are similar to a low to medium degree.</p>	

(e)

Opponent	Applicant
<i>“Music recordings; Musical recordings; Musical video recordings”</i>	<i>“podcasts; video podcasts”</i>
<p>These overlap in nature, since a podcast can be in video format and podcasts can be digital audio files of music. The goods also overlap in their intended purpose since podcasts are goods that are consumed as a form of entertainment, and there is also an overlap in method of use and user. They may also reach the market through the same trade channels and there may also be a degree of competition between the goods. These goods are similar to a medium degree.</p>	

(f)

Opponent	Applicant
<i>“Downloadable music files; Musical video recordings”</i>	<i>“downloadable films; motion picture films”</i>
<p>To the extent that the Opponent’s music files and musical video recordings are goods which are consumed as a form of audio and audiovisual entertainment, I consider there to be a degree of similarity between the respective goods. This is because the goods overlap in purpose and as such may also overlap in use and user. The goods are likely to reach the market through the same trade channels, for example, a downloadable music file may reach the market through the same trade channels as a downloadable film. There is also a degree of competition between the respective goods since the consumer may select one above the other. These goods are similar to a low degree.</p>	

(g)

Opponent	Applicant
<i>“Music recordings; Downloadable music files”</i>	<i>“Downloadable software and applications relating to music, musical entertainment, musical artists, groups and bands”</i>
<p>To the extent that the Applicant’s goods relate ‘music’, I consider there to be a similarity between the respective goods on the basis that the goods are complementary as one is indispensable or important for the use of the other in such a way that the average consumer may likely consider they come from the same undertaking. For example, the Applicant’s goods can relate to computer software capable of processing digital music files and allowing users to listen to music recordings. The respective goods are similar to a low degree.</p>	

(5) The remaining contested goods are as follows:

“Computers and computer peripheral devices; computer hardware; downloadable digital media and recordings containing [...] signals [...]; photographs and stills in electronic form; printed matter in electronic form;

e-books; audio books; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; electronic bulletin boards; encoded gift cards; sunglasses; eyewear; parts and fittings for all the aforesaid goods.”

Having applied all the relevant comparison criteria, I find no sufficient overlap to justify a finding of similarity between these contested goods and the Opponent’s goods and services. These goods are **dissimilar**.

Class 41

21. The respective parties’ services both cover a wide array of entertainment services, predominantly focused on music entertainment services.

22. The contested list of services can loosely be grouped in the following categories:

- Entertainment services
- Musical entertainment
- Music production
- Publishing services
- Recording services
- Competitions
- Education

23. Many of the respective terms are either identical; plainly identical as they are synonymous; identical on the principle outlined in *Meric*; or similar when applying all the relevant factors of comparison. I have set out the details below:

(1) The following services appear in both parties’ specifications and are therefore **identical**:

“Musical entertainment; Musical performances; live musical performances; music concerts; music festival services; music group services; music publishing services; Music recording services; Instruction in music”

(2) The following services are synonymous and are self-evidently **identical**:

Opponent	Applicant
<i>“Music production; production of music”</i>	<i>“Music production services; production of music [...]”</i>
<i>“[...] Music recording services; Music recording; Recording of music; Recording services”</i>	<i>“Music recording studio services”</i>

(3) The following services are **identical** on the principle outlined in *Meric*, either because the Opponent’s terms are broad terms that encompass the Applicant’s terms, or vice versa:

Opponent	Applicant
<i>“Entertainment by means of concerts; Musical entertainment; Music entertainment services; Music performances; Music group services; Musical performance services; Live music shows”</i>	<i>“Entertainment services; disc jockey services; entertainment services relating to musical entertainment, musical artists, groups and bands”</i>
<i>“Live music concerts; Live music performances; Live music services; Live music shows; Music production; Production of music”</i>	<i>“Provision and production of live entertainment, live performances and live shows”</i>
<i>“Organisation of music concerts; Arranging of concerts; Pop music concerts (Organisation of -); Arranging, conducting and organisation of concerts; Musical entertainment services; Musical performance services; Live music performances; Live music shows”</i>	<i>“Organising, arranging and conducting live music concerts and performances; organisation of musical entertainment; organising, arranging and conducting [...] events [...]”</i>

<p><i>“Performance of music; Live musical performances; Live music shows; Live music concerts; Singing concert services; Concert services”.</i></p>	<p><i>“[...] cultural activities”</i></p>
<p><i>“Music production; production of music; Music recording; Audio recording services; Recording of music; [...] music recording services; Musical performances; Musical performance services; Concert services; Arranging, conducting and organisation of concerts; Music entertainment services.”</i></p>	<p><i>“Production of [...] musical recordings, musical performances and concerts; production of [...] recordings of sound, music [...]”</i></p>
<p><i>“Music production; production of music; Audio recording services; Video recording services; Recording services; Musical concerts by television; Music entertainment services.”</i></p>	<p><i>“Production of radio and television programmes, films, shows, and/or recordings of [...] images; audio, video and multimedia production [...]”</i></p>
<p><i>“Production of music”</i></p>	<p><i>“Music composition services”</i></p>
<p><i>“Music publishing services; music publishing; Publication of music”.</i></p>	<p><i>“Publishing services; electronic publishing services”</i></p> <p>I note that the Applicant’s terms are extremely broad, as they can encompass numerous publishing services such as ‘book publishing’, ‘newspaper publishing’, ‘music publishing’ and ‘publishing of interactive computer and video game software’ for example,⁹ in addition to the publication of material in</p>

⁹ All being terms contained in Class 41 in the Nice Classification system.

	electronic form rather than on paper.
<i>“Music publishing services; Music publishing; Publication of music; Publishing of music; Recording services; Music recording; Audio recording services; Music entertainment services”</i>	<i>“Providing online, non-downloadable electronic publications, digital media and recordings, digital music [...]”</i>
<i>“Music competition services”</i>	<i>“Organisation of competitions and tournaments”</i>
<i>“Teaching of music; Instruction in music”</i>	<i>“Education services relating to the fields of music [...]; provision of training relating to the fields of music [...]; Education, training, teaching and coaching services; organising, arranging and conducting educational and training courses, classes, lectures, seminars, webinars, [...] workshops, [...] tutorials, online courses [...]”</i>
<i>“Musical entertainment; Music entertainment services”</i>	<i>“Provision of online entertainment”</i>
<i>“Musical entertainment; Music entertainment services”</i>	<i>“Providing online music, not downloadable”</i> I interpret the Applicant’s service as an entertainment service in the form of the provision of music online. As such, I consider this service falls within the Opponent’s terms.

(4) The final term in the Applicant’s specification is *“advisory, consultancy and information services relating to the aforesaid services”*. These are

encompassed in the Opponent's Class 41 services and are therefore **identical** to the Opponent's services on the principle outlined in *Meric*.

(5) The following terms are **similar** for the reasons set out below:

(a)

Opponent	Applicant
<i>"Music festival services"</i>	<i>"Organising, arranging and conducting [...] fairs [...]"</i>
<p>They overlap in nature and purpose, since both are gatherings for entertainment that feature a variety of amusements, including musical performances for instance. The respective services may therefore overlap in use and user. They may also be in competition with each other. These services are similar to a low to medium degree.</p>	

(b)

Opponent	Applicant
<i>"Music production"</i>	<i>"Production of podcasts"</i>
<p>These services overlap in purpose and nature, since they are both services for the production of a form of audio entertainment, as such, I consider there may also be an overlap in method of use and user. They may also overlap in trade channels since the same undertakings that produce podcasts may also produce music, and finally, there may also be a degree of competition between them as the consumer may choose to make their music content available via a podcast as opposed to via a more conventional music production route. These services are similar to a low to medium degree.</p>	

(c)

Opponent	Applicant
<i>"Musical entertainment"</i>	<i>"Provision of entertainment via podcast"</i>
<p>Podcasts cover a wide genre of entertainment, including music; and podcasts can also be dedicated to playing music. As such, they can be considered as a form of music entertainment albeit in the form of a podcast. With this in mind, I consider these services to overlap in purpose</p>	

and nature, they may also have the same use and user. They may share the same trade channels and they may also be in competition with each other as a consumer may select one service above the other. They are similar to a **high degree**.

(d)

Opponent	Applicant
<i>“Teaching of music; Instruction in music”</i>	<i>“Education services relating to the fields of [...] dance and acting; provision of training relating to the fields of [...] dance and acting”</i>
<p>Education and training services in the fields of music, dance and acting all involve instruction in performing arts and are often provided by theatre schools, stage schools and / or performing arts schools. The respective services therefore overlap in purpose, they would also have the same use (i.e. they would be used by consumers to study performing arts), and would overlap in user. There may also be a degree of competition between them as a consumer may favour music instruction above acting and dancing. They are also complementary services since it is not uncommon for musical theatre performers for example, to be trained in all three disciplines (music, dance and acting) by one institute. The average consumer is therefore likely to believe that the respective services are provided by the same undertaking. These services are therefore similar to a medium to high degree.</p>	

(e)

Opponent	Applicant
<i>“Music entertainment services; Live music services; Music performances”</i>	<i>“Club (discotheque) services; night clubs and night club services”</i>
<p>The respective services are all entertainment services which have the same purpose since discotheques and nightclubs are public venues which play live or recorded music for people to listen to and/ or dance to (disk jockeys performing in night clubs for example is a kind of live music service). The respective services would therefore overlap in their method</p>	

of use and user, and would likely be in competition with each other. These services are similar to a **medium degree**.

(f)

Opponent	Applicant
<p><i>“Musical entertainment; Music entertainment services; Recording services; Music recording; Audio recording services; Video recording services”</i></p>	<p><i>“Providing online videos, not downloadable; provision of non-downloadable media and recordings containing sound, images, text, information [...]”</i></p>
<p>To the extent that ‘videos’ in the Applicant’s term would encompass music videos, and to the extent that ‘media and recordings containing sound, images, text and information’ would encompass the provision of audio recordings and video recordings, I consider the Applicant’s terms to be identical to the Opponent’s terms on the principle outlined in <i>Meric</i>.</p> <p>In the alternative, they are at least highly similar, since the provision of music entertainment for example would likely encompass the provision of music videos, which are likely to be made available online; and recording services would also likely encompass the provision of ‘<i>media and recordings containing sound, images, text, information</i>’. As such, the respective services identified above overlap in nature and purpose, they would also share the same user and have the same use i.e. they could be used as a form of musical entertainment. They may also share the same trade channels and may be in competition with each other.</p>	

(g)

Opponent	Applicant
<p><u>Class 9</u></p> <p><i>“Downloadable software, namely virtual clothing for use in computer games.”</i></p>	<p><u>Class 41</u></p> <p><i>“Provision of online games; provision of non-downloadable media and recordings containing [...] software”</i></p>
<p>Whilst I acknowledge that the comparison being made is between a goods on the one hand and services on the other, it is my opinion that there exists a complementarity between the respective goods and services</p>	

such that there is a degree of similarity between them. This is because the goods and services are closely connected as one is important for the use of the other and the average consumer may believe that the goods and services come from the same undertaking i.e. that the undertaking providing the online games (or non-downloadable media containing software) is also selling the downloadable software to use in the game (or other non-downloadable media / recordings). As such the respective goods and services are similar to a **low degree**.

(h)

Opponent	Applicant
<i>“Musical entertainment; Music group services; Music publishing services; Artistic management of performing artists”</i>	<i>“Provision of online information relating to musical entertainment, musical artists, groups and bands”</i>
<p>The respective services are likely to share the same trade channels and user and there exists a degree of complementarity between them, since the average consumer may believe that the undertaking which provides <i>“Musical entertainment; Music group services; Music publishing services; Artistic management of performing artists”</i> is the same undertaking which provides information services relating to <i>“musical entertainment, musical artists, groups and bands”</i>. The respective services are similar to a low degree.</p>	

(6) The remaining contested services are as follows:

“[...] photography; providing online, non-downloadable [...] books and journals; provision of non-downloadable media and recordings containing [...] signals; sporting [...] activities; organising, arranging and conducting [...] hackathons, [...] conventions [and] conferences”

Having applied all the relevant comparison criteria, I find no sufficient overlap to justify a finding of similarity between these contested services and the Opponent’s goods and services. These services are **dissimilar**.

Conclusions on the goods and services comparison

24. I have found that some of the applied-for goods and services are dissimilar to the Opponent's, whilst the remainder are identical or similar to varying degrees. Since some similarity between the goods and services is required for the purposes of a section 5(2)(b) claim, the opposition must fail in respect of the dissimilar goods and services identified above,¹⁰ namely:

Class 9

“Computers and computer peripheral devices; computer hardware; downloadable digital media and recordings containing [...] signals [...]; photographs and stills in electronic form; printed matter in electronic form; e-books; audio books; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; electronic bulletin boards; encoded gift cards; sunglasses; eyewear; parts and fittings for all the aforesaid goods.”

Class 41

“[...] photography; providing online, non-downloadable [...] books and journals; provision of non-downloadable media and recordings containing [...] signals; sporting [...] activities; organising, arranging and conducting [...] hackathons, [...] conventions [and] conferences”

25. I therefore proceed to consider a likelihood of confusion only in relation to the goods and services that I have found to be identical and/or similar.

The average consumer and the nature of the purchasing act

26. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is

¹⁰ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (case of the CJEU); and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

typical.¹¹ It is therefore necessary to determine who the average consumer of the goods and services is, and how the consumer is likely to select them. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.¹²

27. In the present case, the goods and services found to be identical or similar (to varying degrees) are directed at the public at large and at a professional public with specific knowledge or expertise.

28. The goods will be selected either in stores, online, from brochures/ catalogues or over the phone. A similar process will also apply to the selection of the services, where the consumer will select them either online, from brochures or over the phone. Therefore visual and aural considerations will both apply in the selection of the goods and services.

29. The public's degree of attentiveness may vary from medium to high, depending on, the price and specialised nature of the goods and services; and the terms and conditions of the services rendered.

Comparison of marks

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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


¹¹ *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), paragraph 60; also see *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98, as to what “average” means

¹² *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

31. It would be wrong, therefore, to dissect the trade marks artificially, 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.

32. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	MN8

Overall impression

33. The earlier mark is figurative mark which comprises of the alphanumeric sequence of the letters ‘MN’ followed by the number ‘8’ presented in a stylised font. The characters are displayed in white and on a black background, each being spaced by a thin white line. Despite this being a figurative mark, the stylisation plays a lesser role, such that the overall impression of the mark is dominated by ‘MN8’.

34. The contested mark is a ‘word only’ mark which consists of the alphanumeric sequence of the letters ‘MN’ followed by the number ‘8’. The overall impression of the mark lies in that alphanumeric sequence.

Visual comparison

35. I note that a word mark protects the word itself and the comparison must be made on the basis of the word, not any particular presentation of the word. The protection of a word mark is not limited by any features such as capitalisation or the typeface which

appears on the Register,¹³ as such those features do not provide a point of distinction when comparing a word-only mark with a figurative mark, where the figurative mark comprises of words in a stylised font.¹⁴

36. Whilst the marks visually coincide in the alphanumeric sequence 'MN8' (which is identical in both marks), the stylisation of the earlier mark cannot be overlooked in the visual comparison as the stylisation has visual impact which goes beyond it being merely a 'word in a stylised font'. I therefore find that overall, the marks are visually similar to a high degree (as opposed to being identical).

Aural comparison

37. 'MN8' would be pronounced as though there were full stops after each character i.e. 'M. N. 8.', and each character will be pronounced in the ordinary way, i.e. 'EM – EN – EIGHT'. Aurally, the marks are identical.

Conceptual comparison

38. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹⁵ The parties have not made any submissions in relation to the concept of 'MN8'. In my opinion, the average consumer is likely to perceive it as a meaningless sequence of letters and a number, in which case the respective marks are conceptually neutral.

Distinctive character of the earlier mark

39. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion

¹³ See the comments of Iain Purvis KC, sitting as the Appointed Person in the following two cases: *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14, paragraph 21; and *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraph 37.

¹⁴ *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22.

¹⁵ This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

may be.¹⁶ Although it is the distinctive character of a component that is similar between the marks that is particularly relevant.¹⁷

40. 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.

41. The Opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, and has filed no evidence of use, therefore I only have the inherent distinctiveness of the mark to consider.

42. In *Kunze Folien GmbH v Kartell UK Limited*,¹⁸ Mr Iain Purvis KC sitting as the Appointed Person, referred with approval to the decision of *Alfa-Beta Vassilopoulos AE v Agro de Bazan*,¹⁹ in which the Board of Appeal considered the letters 'AB' in a stylised form against 'AB' in a different stylised form, for the same goods. The Board of Appeal stated as follows:

“As to the distinctive character of the letter combination ‘AB’ in the earlier marks and of the contested mark, [...] it should be noted that letters or letter combinations of two or three letters are inherently weak, given the limited number of letters in the alphabet, the great number of meanings that acronyms and abbreviations may have and the fact that consumers frequently encounter abbreviations and letter combinations of all kinds in everyday life and business as generic abbreviations but not as marks.”

43. I find that the earlier mark is not particularly distinctive because the mark merely consists of the three character alphanumeric sequence 'MN8'. Whilst I do not overlook the stylisation of the mark, I do not find that the stylisation elevates the distinctive character of that sequence, such that I consider the distinctive character of the mark to be inherently low.

¹⁶ *Sabel v Puma*.

¹⁷ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38 and 39.

¹⁸ BL O/085/14, paragraph 29

¹⁹ Case R 82/2011-4 of the Board of Appeal of OHIM (now the EUIPO), paragraph 16

I note however that even where an earlier trade mark is deemed to have a weak distinctive character, that does not preclude a finding of a likelihood of confusion per se.²⁰

Conclusions on Likelihood of Confusion

44. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.²¹ I must also consider the average consumer of the services, the nature of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.²²

45. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.²³ The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.²⁴

46. Confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark.²⁵

²⁰ *L'Oréal SA v OHIM*, Case C-235/05 P, paragraphs 42 and 45.

²¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

²² *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

²³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

²⁴ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

²⁵ See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion

47. I have found that the applied-for goods and services still in play are identical or similar (to varying degrees) to the Opponent's goods and services; that the average consumer will be paying a medium to high degree of attention when selecting those goods and services (although the degree of attention will vary according to the goods and services); and that visual and aural considerations will both apply in the selection process.

48. I have found the competing marks to be visually highly similar and aurally identical; and that they are conceptually neutral.

49. I have also found that the stylisation of the earlier mark plays a lesser role in the overall impression of the mark, such that the overall impression of the mark is dominated by 'MN8'. Finally, I have found that the distinctiveness of the earlier mark is low to medium on an inherent basis.

50. Taking all the above factors into consideration, and allowing for imperfect recollection, whilst bearing in mind the principle of interdependency, I find that the average consumer – or at least a significant proportion thereof – will mistake one mark for the other and be directly confused as to the origin of the goods and services.

OUTCOME

51. The opposition under section 5(2)(b) of the Act is partially successful. Subject to any appeal, the contested trade mark application shall proceed to registration only in respect of the following goods and services in Classes 9 and 41:

Class 9

“Computers and computer peripheral devices; computer hardware; downloadable digital media and recordings containing signals; photographs and stills in electronic form; printed matter in electronic form; e-books; audio books; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; electronic bulletin boards; encoded gift cards; sunglasses; eyewear; parts and fittings for all the aforesaid goods.”

Class 41

“Photography; providing online, non-downloadable books and journals; provision of non-downloadable media and recordings containing signals; sporting activities; organising, arranging and conducting hackathons, conventions and conferences.”

COSTS

52. The Opponent has been partially successful and is entitled to a contribution towards its costs. In the circumstances, I award the Opponent the sum of £300, based on the scale set out in Tribunal Practice Notice (2/2016), as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£100
Preparing the statement of grounds and considering the counterstatement	£200
TOTAL	£300

53. I therefore order Anthony George Michael to pay Michael Douglas the sum of **£300**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of November 2023

Daniela Ferrari

For the Registrar