O/1185/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003756176

BY ANTHONY PRICE

TO REGISTER THE TRADE MARK:

Samba Soccer School

IN CLASS 41

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 433946

BY ANIL SINGH BAGGA

BACKGROUND AND PLEADINGS

1. On 17 February 2022, Anthony Price ("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 4 March 2022 and registration is sought for the following services:

Class 41 Soccer schools; Football coaching sessions; Provision of educational entertainment services for children in after school centres; Individual football coaching sessions.

2. On 1 June 2022, the application was opposed by Anil Singh Bagga ("the opponent") based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under section 5(2)(b) of the Act, the opponent relies upon the following trade mark:

UKTM no. 3015607
Filing date 26 July 2013; registration date 1 November 2013
Relying on all services for which the mark is registered, namely:

Class 41 Entertainment in the nature of soccer games; Soccer camps; Sports coaching services; Sports tuition, coaching and instruction; Coaching; Coaching services for sporting activities; Sports coaching; Coaching in the field of sports; Organization of soccer games; Coaching [training]; Soccer camps; Sport camps; Summer camps [entertainment and education]; Education services; Education; Entertainment in the nature of football games; Entertainment in the nature of soccer games; Entertainment services provided by a music group; Entertainment services provided on-line from a computer database or the internet; Entertainment, education and instruction services;

Entertainment, sporting and cultural activities; Entertainment in the nature of soccer games; Organization of soccer games.

3. The opponent claims that the marks are similar and the services are identical or similar, with the result that there is a likelihood of confusion.

4. Under section 5(4)(a) of the Act, the opponent relies upon the sign **Samba Soccer School** which he claims to have used throughout the UK since 29 April 2010 in relation to the same services as listed in paragraph 2 above.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

6. The applicant is represented by Mathys & Squire LLP and the opponent is represented by Briffa.

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

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in chief in the form of a witness statement in his own name dated 14 November 2022, which is accompanied by 9 exhibits.

9. The applicant filed evidence in chief in the form of a witness statement in his own name dated 23 February 2022, which is accompanied by 2 exhibits.

10. The opponent filed written submissions in lieu dated 14 June 2023.

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

RELEVANCE OF EU LAW

12. 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.

PRELIMINARY ISSUE

13. In his Form TM8, the applicant stated as follows:

> "4. By way of background, it is relevant that the Applicant began using the mark 'Samba Soccer School' at least as early as 2009 and traded as Samba Soccer School in the provision of class 41 services, including soccer training for youth groups and in conjunction with local authority schemes across the Midlands. The Applicant, trading as Samba Soccer School registered the mark under No. 2580019 with effect from 3 May 2011.
>
> 5. This registered mark 'samba soccer school' was continually used but inadvertently allowed to lapse with final effect on 3 May 2022. The Applicant did not receive renewal reminders and having contracted the IPO when realising that the registration had lapsed was advised to refile (rather than seek to restore which at the time of the Application remained possible). The Applicant therefore is in an unfortunate position having lost a registration owned for 10 years and which predated the registration upon which the Opponent now seeks to rely."

14. I sympathise with the applicant's position. However, I must take the marks based upon their priority according to their respective filing dates for the purposes of section 5(2)(b) of the Act. If the applicant thought that he had earlier rights in the applied-for mark that he could have relied upon to invalidate the earlier mark then he should have applied to invalidate it. He has not done so. He has also not pleaded an honest concurrent use defence. Consequently, the applicant's prior use does not assist him

for the purposes of the section 5(2)(b) ground of opposition. I will return to the relevance of the applicant's prior use to the section 5(4)(a) ground below.

DECISION

Section 5(2)(b)

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

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

16. 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."

17. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years before the application date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

18. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

> "(1) This section applies where:
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if –
>
> (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
>
> (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.
>
> (4) For these purposes -

a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

19. Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

20. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the application in issue i.e. 18 February 2017 to 17 February 2022.

21. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology*

Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are underway, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation

has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

22. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

23. I note the following from the opponent's evidence:

a) The opponent explains that he began trading as 'Samba Soccer' in 2010 as a sole trader and later incorporated Samba Soccer Schools Global LTD ("the company") on 24 July 2013. Since then, the company has been trading as a football academy and has had an exclusive licence of the earlier mark since it was registered.

b) The opponent has provided a number of booking confirmations which display the earlier mark and which are dated within the relevant period.[1] These show 8 bookings.

c) Examples of social media posts have been provided which are dated 2017 to 2020 and display the following mark:[2]

[1] Exhibit ASB4
[2] Exhibit ASB9

d) The company's turnover figures are as follows, with each year referring to the company's financial year being 31 July to 1 August:

2017	£81,683.58
2018	£86,952.17
2019	£127,235.91
2020	£140,429.40
2021	£312,641.80
2022	£481,975.28

24. I bear in mind that there are examples of other marks being used by the opponent which are not acceptable variants of the earlier mark relied upon. However, taking the evidence as a whole into account, I am satisfied that there is enough evidence to establish that the opponent has been attempting to create or maintain a share in the market for the earlier mark in relation to a football school. This would be covered by the broad category of "entertainment, sporting and cultural activities" and would be a sub-category of those services. For reasons that will become clear, it is not necessary for me to consider whether the opponent can rely upon any of the other/broader terms in his specification. Consequently, I will proceed on the basis that a fair specification is as follows:

Class 41 Football schools.

Section 5(2)(b) – case law

25. 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 services

26. In light of my findings above, the competing services are as follows:

Opponent's services	**Applicant's services**
Class 41 Football schools.	Class 41 Soccer schools; Football coaching sessions; Provision of educational entertainment services for children in after school centres; Individual football coaching sessions.

27. 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 Lernsysterne 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."

Soccer schools; football coaching sessions.

28. These services are self-evidently identical to “football schools” in the opponent’s specification.

Provision of educational entertainment services for children in after school centres; Individual football coaching sessions.

29. In my view, these services are identical on the principle outlined in *Meric* to “football schools” in the opponent’s specification. If I am wrong in this finding, then the services will overlap in nature, purpose, method of use, trade channels and user and will be in competition. Consequently, they are highly similar.

The average consumer and the nature of the purchasing act

30. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the 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.”

31. The average consumer for the services will be a member of the general public. The cost of the services is likely to be relatively low and they are likely to be reasonably frequent purchases. However, factors such as service standards, skills of coaches and suitability for a child’s particular age/ability level are likely to be taken into account.

Consequently, I consider that a medium degree of attention will be paid during the purchasing act.

32. The services are likely to be purchased following perusal of signage on physical premises, advertisements and websites. Consequently, visual considerations will dominate the purchasing process. However, I do not discount that there will be an aural component to the purchase given that word-of-mouth recommendations may be made.

Comparison of trade marks

33. It is clear from *Sabel* 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 mark, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("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."

34. 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.

35. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	Samba Soccer School

36. The applicant's trade mark consists of the words SAMBA SOCCER SCHOOL, in title case. The overall impression lies in the combination of these words, with the word SAMBA being more distinctive. The opponent's mark consists of the words SAMBA SOCCER, in a navy upper case font, one on top of the other, and divided by a thin horizontal line. To the left of the words is a colourful football device, containing the letters SSS. The words SAMBA SOCCER play the greater role due to their size and the fact that the eye is naturally drawn to the word element. However, the word SAMBA is more distinctive. The device plays a slightly lesser role.

37. Visually, the marks overlap in the presence of the words SAMBA SOCCER. They differ in the presence of the word SCHOOL in the applicant's mark and the device in the opponent's mark. They also differ in that the words are presented one on top of the other in the opponent's mark. I note that the applicant's mark is presented in title case, but as it is a word only mark, it can be presented in any font/case. I consider the marks to be visually similar to between a medium and high degree.

38. Aurally, the applicant submits that the opponent's mark will be pronounced ESS-ESS-ESS-SAM-BA-SOCK-ERR due to the letters SSS incorporated into the device. I disagree. In my view, the letters SSS in the device are so small that they will either be missed altogether by the average consumer or will be viewed as part of the device and, therefore, not articulated. In my view, the opponent's mark will be articulated as SAM-BA-SOCK-ERR. The applicant's mark will be pronounced SAM-BA-SOCK-ERR-SKOOL. They are aurally highly similar.

39. Conceptually, the word SAMBA in both marks is likely to be recognised as a type of dance and will be attributed the same meaning in both marks. The word SOCCER will be understood as synonymous for football and will be attributed the same meaning

in both marks. The device in the opponent's mark reinforces the football message. I recognise that the word SCHOOL in the applicant's mark is a point of difference, albeit not a distinctive one. At the very least, the marks are conceptually highly similar.

Distinctive character of the earlier trade mark

40. 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 1-2779, 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)."

41. 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 it.

42. I will begin by assessing the inherent distinctiveness of the earlier mark. The earlier mark consists of the words SAMBA SOCCER, presented in a navy font one on top of the other, alongside a colourful football device. In my view, the words (which are the common element) are inherently distinctive to a medium degree. The football device adds to the distinctiveness of the mark, resulting in it being inherently distinctive to between a medium and high degree overall.

43. I am not satisfied that the opponent's evidence is sufficient to establish that the distinctiveness of the earlier mark has been enhanced through use. This is because, whilst the evidence demonstrates that the opponent has genuinely used the mark, I do not consider the use shown to represent a particularly significant market share for the services in issue. Further, I have no information about overall advertising spend and the geographical spread of the services appears to be limited.

Likelihood of confusion

44. 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 services or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services, and the nature of the purchasing act. 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.

45. I have found as follows:

a) The services are identical or highly similar.

b) The average consumer will be a member of the general public who will pay 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 marks are visually similar to between a medium and high degree, aurally highly similar and conceptually highly similar.

e) The earlier mark is inherently distinctive to between a medium and high degree. However, I bear in mind that it is the distinctiveness of the common element which is key, and the common element is distinctive to a medium degree.[3]

46. Taking all of the above factors into account, I consider that there is potential for the marks to be mistakenly recalled or misremembered as each other. If the average consumer predominantly recalls the word element of the marks, bearing in mind that the word SAMBA is the most distinctive, this may result in direct confusion. This is particularly likely given that the services are identical or highly similar. However, even if the differences between the marks are recalled, they are likely to be viewed as alternative marks being used by the same undertaking due to the common use of the word SAMBA and the identical/highly similar services.

47. In reaching this decision I have borne in mind the applicant's position that there is no evidence of confusion. However, that is hardly surprising. Both parties appear to have been trading on a relatively small and localised basis. The applicant confirms that his business operates in the Midlands. The opponent's business appears to be located in the London area.[4] Consequently, it is unlikely that the customers of one party would have come into contact with the other in the marketplace. However, the parties have applied-for/registered national marks and neither is limited

[3] *Kurt Geiger v A-List Corporate Limited*, BL O-075-13
[4] See, for example, Exhibit ASB3.

geographically. Consequently, I must consider the notional position if both parties were to use their marks nationally. I do not consider the absence of evidence of confusion to be of assistance to the applicant in this case.

48. The opposition based upon section 5(2)(b) of the Act succeeds in its entirety.

Section 5(4)(a)

49. 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".

50. 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."

51. I can deal with this ground relatively swiftly. The applicant has filed evidence that he used the sign SAMBA SOCCER SCHOOL as early as 2010 in relation to football coaching and games. This evidence is unchallenged. Whilst the opponent states that

the sign relied upon was used as early as 2010, there is insufficient evidence before me regarding the extent of that use to establish goodwill prior to the time that the act complained of first commenced (some time in 2010). Indeed, I do not have sufficient evidence before me to establish which of the parties is the senior user.

52. The opposition based upon section 5(4)(a) of the Act is dismissed.

CONCLUSION

53. The opposition succeeds, and the application is refused.

COSTS

54. The opponent has been successful and is entitled to a contribution towards his costs, based on the scale published in Tribunal Practice Notice 2/2016. Whilst the opponent paid an official fee of £200, he only paid the higher fee due to his reliance upon the section 5(4)(a) ground in relation to which he was unsuccessful. Consequently, I have awarded only the lower official fee of £100. In the circumstances, I award the opponent the sum of **£1,600**, calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£300
Preparing evidence and considering the applicant's evidence	£850
Written submissions in lieu	£350
Official fee	£100
Total	**£1,600**

55. I therefore order Anthony Price to pay Anil Singh Bagga the sum of **£1,600**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of December 2023

S WILSON
For the Registrar