

O/160/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003423678

BY THABANI SOLOMON TSHUMA

TO REGISTER:



AS A TRADE MARK IN CLASSES 25 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 418669 BY

SPARTAN RACE, INC

BACKGROUND AND PLEADINGS

1. On 24 August 2019, Thabani Solomon Tshuma (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK. The application was published for opposition purposes on 6 September 2019 and registration is sought for the following goods and services:

Class 25: Vest tops; Vests; V-neck sweaters; Tank tops; Tank-tops; Tee-shirts; Tops; Tops [clothing]; Track pants; Track suits; Tracksuit bottoms; Tracksuit tops; Tracksuits; Trunks; Trunks (Bathing -); Trunks being clothing; T-shirts; Tube tops; Short trousers; Shorts; Shorts [clothing]; Short-sleeved T-shirts.

Class 41: Special event planning; Special event planning consultation; Sport camp services; Sport camps; Sporting activities; Sporting and cultural activities; Sporting and recreational activities; Sporting competitions (Arranging of -); Sporting competitions (Organising of -); Sporting education services; Sporting event organization; Sporting results services; Sporting services; Sports activities; Sports and fitness; Sports and fitness services; Sports camp services; Sports club services; Sports coaching; Sports coaching services; Sports competitions (Organising of -); Sports education services; Sports entertainment services; Sports equipment (Rental of -), except vehicles; Sports events (Timing of -); Sports facilities (Hire of -); Sports facilities (Leasing of -); Sports facilities (Provision of -); Sports information services; Sports instruction services; Sports refereeing and officiating; Sports training; Sports tuition; Sports tuition, coaching and instruction; Education; Education and instruction; Education and training; Education and training in the field of music and entertainment; Education and training services; Education, entertainment and sport services; Education, entertainment and sports.

2. On 6 December 2019, the applicant's mark was opposed by Spartan Race, Inc ("the opponent"). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following trade marks:



UK registration no. 3361512

Filing date 17 December 2018, registration date 15 March 2019

("the opponent's first mark")



UK registration no. 3361514

Filing date 17 December 2018; registration date 15 March 2019

("the opponent's second mark"); and



UK registration no. 3381365

Filing date 7 March 2019; registration date 31 May 2019

("the opponent's third mark")

3. The opponent relies on all goods and services for which its marks are registered. The opponent's goods and services are set out in the **Annex** to this decision.
4. In its notice of opposition, the opponent submits that as a result of the similarities between the marks and the identity and/or similarity of the goods and services, there exists a likelihood of confusion on the part of the public in the UK, which includes a likelihood of association. The applicant filed a counterstatement denying the claims made.

5. The applicant is unrepresented and the opponent is represented by Osborne Clarke LLP. Only the opponent filed evidence. No hearing was requested and only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers
6. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

PRELIMINARY ISSUES

7. The applicant has submitted the following:

“[I]n the three years that we have run our Instagram account there has not been a single instance where a user has been confused between our account or the opponent’s. No user has followed our account thinking that we were in any way associated with ‘Spartan Race’, nor has anyone followed them believing that they were associated with us. We have not been mistakenly ‘tagged’ in any of their media content, nor they in ours. Furthermore, we have not been contacted in any capacity by anyone seeking the opponent’s services, nor have they been contacted by anyone seeking ours. Lastly, the physical locations that our brand appears in, such as carnivals and soca events are not even remotely connected to the opponent’s. Since establishing ourselves on Instagram three years ago, our account name and company name have not been hidden or modified, yet no social or business paths have ever been crossed, further providing the uniqueness of our trademark.”

8. It appears that the applicant is arguing the fact that as there has been no confusion between the marks in the marketplace, there can be no likelihood of confusion under section 5(2) of the Act. For the avoidance of doubt, claims as to a lack of confusion in the marketplace will seldom have an effect on the outcome of cases

under section 5(2) of the Act. In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41, Laddie J held:

“22 It is frequently said by trade mark lawyers that when the proprietor’s mark and the defendant’s sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 (“the 1994 Act”), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer’s use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

9. This position was affirmed by Warren J in the case of *Rousselon Frères et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch).¹ While I note the applicant’s submissions, my assessment of likelihood of confusion is a notional one and I am required to take into account all of the ways in which the marks could be used by reference to the goods and/or services for which they are applied for/registered.

10. In respect of the term ‘Spartan’, the applicant has submitted that:

¹ See paragraph 99

“Such a concept is used by hundreds of entities in relation to an array of goods and services. It is a generic concept used by many businesses in the world. It is not concept [sic] that was invented, created or even popularised by our opponent. This is exactly why the opponent has two aspects of their brand ‘Spartan Race’, in order to make their mark unique to their activities.”

11. While not expressly pleaded, the applicant appears to be arguing that as ‘spartan’ is a term used in the trade marks of ‘hundreds of entities’, the distinctiveness of the opponent’s marks have been weakened due to its frequent use in the marketplace. However, for reasons that I will now explain, the applicant’s point regarding the alleged widespread use of the term ‘spartan’ has no bearing on the outcome of this opposition.

12. I note that in the case of *Zero Industry Srl v OHIM, Case T-400/06*, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71). “

13. The fact that there may be a multitude of entities using the concept of ‘spartan’ is not a relevant factor to the distinctiveness of the opponent’s marks. The applicant has filed no evidence regarding any marks on the register or any evidence to demonstrate that any of these marks are actually in use in the marketplace. The

outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors and the state of the register is not relevant to that assessment.

14. I also note that in the applicant's submissions, he refers to the opponent's brand as 'Spartan Race'. While this forms part of the opponent's name, this is not a trade mark upon which the opponent relies. Instead, the opponent relies on those marks shown at paragraph 2 above and it is against those marks that the applicant's mark will be compared, not 'Spartan Race'.

EVIDENCE

15. The opponent has filed evidence in the form of the witness statement of Sian Edmonds dated 23 March 2020. Ms Edmonds is an associate at the opponent's representative and makes her statement in support of the conceptual similarity between the parties' marks.

16. Ms Edmonds states that two of the opponent's marks contain the word 'Spartan' and that the term is incorporated as the distinctive word element of the applicant's mark. On 23 March 2020, Ms Edmonds states that she undertook an internet search into the meaning of the word 'Spartan'. A print out of the Merriam-Webster online dictionary's definition of 'Spartan' shows that the term is defined as a native or inhabitant of ancient Sparta or alternatively, a person of great courage and self-discipline.² While the search was conducted after the relevant date being the date of the application at issue, I consider it relevant to these proceedings as the meaning of 'Spartan' will not have changed between the relevant date and the date this search was undertaken.

DECISION

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

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

² Exhibit SE1

“(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 or association with the earlier trade mark.”

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

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

19. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

20. The opponent’s marks qualify as earlier trade marks under the above provisions. As the opponent’s 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 proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods and services for which its marks are registered.

21. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a

composite mark, without necessarily constituting a dominant element of that mark;

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

Comparison of goods and services

22. The applicant's goods and services are set out in paragraph 1 of this decision. The opponent's goods and services are set out in the **Annex** to this decision.

23. 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:

"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".

24. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

25. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“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 für 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”.

26. The applicant submits that:

“[O]ur activities: Events/Parties, Clothing and Fitness (with a specific focus on the Soca music and Carnival culture) are not identical to the activities of this company, which appears to hold organised endurance race events.”

27. I consider it reasonable to infer that the reference to ‘this company’ in the above submission is a reference to the opponent. While I appreciate the specific focus of the applicant’s brand, this is not apparent from his specification. As I have already explained at paragraph 9, my assessment of the similarity of the goods and services is a notional one and I am required to take into account all of the ways in which the marks could be used by reference to the goods and/or services for which they are applied for/registered.

Class 25 goods

28. “Vests”, “tops”, “tank tops”, “shorts”, “t-shirts” in the applicant’s specification have direct counterparts in the opponent’s first mark’s specification. These goods are identical.

29. “Vest tops”, “tee-shirts”, “tops [clothing]”, “shorts [clothing]” and “tank-tops” in the applicant’s specification have direct counterparts in the opponent’s first mark’s specification. While I note that they are expressed slightly differently, they are identical.

30. “V-neck sweaters”, “tracksuit tops” and “tube tops” in the applicant’s specification fall within the category of “clothing, namely [...] tops” in the opponent’s first mark’s specification. These goods are, therefore, identical under the principle outlined in *Meric*.

31. “Track pants”, “tracksuit bottoms” and “short trousers” in the applicant’s specification all fall within the broader category of “clothing, namely [...] bottoms” in the opponent’s first mark’s specification. These goods are, therefore, identical under the principle outlined in *Meric*.

32. “Short-sleeved T-shirts” in the applicant’s specification falls within the broader category of “clothing, namely [...] t-shirts” in the opponent’s first mark’s specification. These goods are, therefore, identical under the principle outlined in *Meric*.
33. “Trunks (Bathing -)” in the applicant’s specification describes the same goods as “clothing, namely [...] swim trunks” in the opponent’s first mark’s specification. These goods are, therefore, identical.
34. “Trunks” and “trunks being clothing” in the applicant’s specification can be terms used for shorts, a bathing suit, boxer briefs or boxer shorts. It can also fall within the category of swimming trunks. Given that the opponent’s first mark’s specification includes “clothing, namely [...] shorts, [...] bathing suits, [...] boxer briefs, boxer shorts, [and] swim trunks”, the applicant’s term will fall within one of these types of goods. These goods are, therefore, identical under the principle outlined in *Meric*.
35. Track suits, jogging suits, gym suits, sweat suits and warm up suits, in my view, all describe the same type of clothing. “Track suits” and “tracksuits” in the applicant’s specification are, therefore, identical to “clothing, namely [...] warm up suits, [...] gym suits, [...] jogging suits, [and] sweat suits” in the opponent’s first mark’s specification.

Class 41 services

36. I am of the view that the provision of a service (including the provision of an event) also includes the arrangement, organisation and conducting of that service. This finding applies throughout the course of the class 41 services comparison.
37. “Sport camps” in the applicant’s term has a direct counterpart in the opponent’s second and third mark’s specifications and is, therefore, identical. The applicant’s specification also includes the terms “sport camp services” and “sports camp services” that, while expressed slightly differently, are still identical to “sports camps” in the opponent’s second and third marks’ specifications.

38. “Sporting activities” and “sports activities” in the applicant’s specification will fall within the category of “arranging, organizing and conducting [...] sporting events” in the opponent’s second and third mark’s specifications. These services are, therefore, identical under the principle outlined in *Meric*.
39. While I appreciate recreational activities may cover activities that are not considered sports, it is commonly the case that users participate in sporting activities such as running, skiing or football for recreational purposes and not necessarily from a competitive sporting standpoint. Additionally, there are a number of activities that are considered recreational but may also be considered sports such as fishing, hunting or archery. Therefore, I find “sporting and recreational activities” in the applicant’s specification to be identical to “arranging, organizing and conducting [...] sporting events” in the opponent’s second and third specifications under the principle outlined in *Meric*.
40. “Sporting competitions (arranging of -)”, “sporting competitions (organising of -)”, “sporting event organization” and “sports competitions (organising of -)” in the applicant’s specification fall within the category of “arranging, organizing and conducting [...] competitions” in the opponent’s second and third mark’s specifications. These services are, therefore, identical under the principle outlined in *Meric*.
41. “Sports entertainment services” in the applicant’s specification will fall within the category of “entertainment in the nature of [...] sporting events” in the opponent’s second and third specification. These services are, therefore, identical under the principle outlined in *Meric*.
42. In the absence of any submissions or evidence, I am of the view that “sports events (timing of -)” in the applicant’s specification is a service that involves the arranging of timings for sporting events. For example, large athletic events will require specific arrangement regarding the timetables of different events. As a result, the applicant’s term falls within the category “arranging, organizing and conducting [...] sporting events” in the opponent’s second and third mark’s specifications. These services are, therefore, identical under the principle outlined in *Meric*.

43. “Arranging, organizing and conducting [...] sporting events” in the opponent’s second and third mark’s specifications falls within the category of “sporting and cultural activities” in the applicant’s specification. Further, I also note that the opponent’s second and third mark’s specifications contain the term “organizing community festivals featuring primarily [...] art exhibitions [...] musical performances”. I am of the view that the applicant’s term, where the art exhibitions and musical performances are cultural, is broad enough to encompass the opponent’s services. Therefore, I find that these services are identical under the principle outlined in *Meric*.

44. Education services are commonly provided by way of classes, seminars, conferences, workshops and, generally, educational programs. This can be in person or online. I have no evidence or submissions regarding any other form of educational service. As a result, I find that “sporting education services”, “sports education services” in the applicant’s specification describe the same service as “educational [...] services, namely, conducting classes, seminars, conferences, workshops and programs in the fields of [...] sports”, which I note can also cover online services. These services are, therefore, identical under the principle outlined in *Meric*.

45. In the absence of any evidence or submissions to the contrary, I find that “sporting results services” and “sports information services” in the applicant’s specification describes a type of news or information service that provides the user with live scores, results and news in relation to any sport. In my view, this service will be provided via the internet, radio, newspapers or television. As a result, this service describes the same service as “entertainment services, namely, providing information, news and commentary in the fields of athletic competitions and sporting events” “providing information in the fields of fitness, sports and exercise via a website”/“providing information in the fields of fitness, sports and exercise via a website”³ in the opponent’s second and third mark’s specification. These services are, therefore, identical.

³ While the opponent’s second and third specifications cover the same services in class 41, the services relating to websites are expressed slightly differently. Despite the variation in the wording of these terms, they describe the same service but are both included here for completeness.

46. “Conducting fitness classes” in the opponent’s second and third marks’ specifications falls within the broader categories of “sports and fitness” and “sports and fitness services” in the applicant’s specification. These services are, therefore, identical under the principle outlined in *Meric*.
47. The opponent’s second and third mark’s specifications also feature a wide range of services that relate to sport, that include, but are not limited to “arranging, organizing and conducting obstacle courses, endurance events, endurance races, athletic events, sporting events and competitions”, “production of sporting events for television, radio, podcast and video programs and shows”, “providing information in the fields of [...] sporting events via a global computer network”, “arranging and conducting youth sports programs in the fields of obstacle courses, athletic events, sporting events and competitions”, “sport camps”, “operation of [...] sports camps” and “organizing community festivals featuring primarily sporting events”. “Sporting services” in the applicant’s specification is so wide-ranging that all of the opponent’s services listed above will fall within the applicant’s terms and are, therefore, identical under the principle outlined in *Meric*.
48. In the absence of any evidence or submissions to the contrary, I am of the view that “sports club services” in the applicant’s specification describes a membership service such as an athletics club or a football club where users can join and participate in that sport. Given its purpose as a membership service, it will not include the arranging, organising and conducting of a sporting event. However, I am of the view that this service will be similar to “arranging, organizing and conducting [...] endurance events, endurance races, athletic events, sporting events and competitions” in the opponent’s second and third marks’ specification. This is because there will be an overlap in user in that the user of a sports club membership service is also likely to seek the organisation of a sporting event. While the end purposes may differ, I am of the view that the core purposes will overlap in that both services relate to sports. I am also of the view that the trade channels will overlap in that an undertaking who provides sports club membership services will also organise events. Overall, I am of the view that these services are similar to a medium degree.

49. “Sports coaching” and “sports coaching services” in the applicant’s specification cover the provision of coaching in respect of any sport. Sports commonly require a level of physical fitness that will be provided via coaching. As a result, I am of the view that these services are identical to “physical fitness instruction” in the opponent’s second and third specifications. However, if I am wrong in this finding, they will be similar to a high degree. The reasons for this are that the purposes of these services will overlap due to the fact that a high number of sports require physical fitness training, for example, cross country running or athletics, meaning that part of the coaching will be to provide physical fitness instruction. For this same reason, there will also be an overlap in user. Further, there will be an overlap in nature and method of use as a coach will provide instruction, training and guidance to the user, as will a fitness instructor. An undertaking that provides fitness instruction may also provide coaches for sports and vice versa, meaning that they will also overlap in trade channels.

50. For the same reasons set out in paragraph 49 above, I am of the view that “sports training” and “sports instruction services” in the applicant’s specification is identical with “physical fitness instruction” in the opponent’s second and third specifications. However, also for the same reasons as above, if I am wrong in this finding, then they will be similar to a high degree.

51. “Providing fitness and exercise facilities” in the opponent’s second and third mark’s specifications is a service that covers a wide range of fitness and exercise facilities. For example, a user can use fitness facilities such as gyms or yoga studios and this may also overlap into sports facilities for the purpose of fitness and exercise such as tennis courts or even skiing facilities. Given the broad nature of the opponent’s term, it can also cover provision of those facilities for longer terms, such as those covered by hiring and/or leasing. As a result, I am of the view that “sports facilities (provision of -)”, “sports facilities (Hire of -)” and “sports facilities (Leasing of -)” in the applicant’s specification all fall within the opponent’s term. Therefore, I find that these services are identical under the principle outlined in *Meric*.

52. “Sports equipment (rental of -), except vehicles” in the applicant’s specification describes a service that a consumer can use to rent various sport equipment

ranging from tennis racquets to skiing boots and skis to gym machines. I am of the view that there will be an overlap in user between these services as the user of fitness and exercise facilities may also need to rent sporting equipment to participate in the fitness or exercise activity. Trade channels may also overlap in that an undertaking that provides facilities for exercise may also rent out the sporting equipment required for that activity, such as rental of tennis rackets or skis. I do not consider there to be any overlap in nature or method of use. However, I consider that they may have a complementary relationship in that, in some circumstances, the user will think that the rental of equipment and the provision of the facilities are important to each other and that they are provided by the same undertaking.⁴ For example, when a user goes skiing, he or she may consider the rental of ski equipment to be important to the provision of the skiing facilities and consider the provision of these services to be the responsibility of the same undertaking. Although I appreciate this may not always be the case as some users will bring their own equipment. Overall, I consider these services to have a medium degree of similarity.

53. “Sports refereeing and officiating” in the applicant’s specification describes a service that provides referees and officials to attend sporting events. In my view, if an undertaking was arranging a sporting event of any kind, it would be expected that the undertaking organising the event would provide the referees and officials, where necessary. As a result, these services will fall within the broader category of “arranging, organizing and conducting obstacle courses, endurance events, endurance races, athletic events, sporting events and competitions”. These services are, therefore, identical under the principle outlined in *Meric*.

54. Insofar as “sports tuition, coaching and instruction” in the applicant’s specification cover sports coaching and instruction it will be identical or similar to a high degree with “physical fitness instruction” in the opponent’s second and third mark’s specifications for the same reasons set out in paragraph 49 above. However, if I am wrong in my finding of identity due to the fact that the applicant’s term includes sport tuition, I note that the opponent’s second and third marks’ specifications

⁴ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

include “educational services, namely, conducting classes, seminars, conferences, workshops and programs in the fields of [...] sports”. Sports tuition, in my view, is an educational service that provide tutors to teach the users about various sports. In my view, these terms describe the same service and are, therefore, identical. In addition to this term, the applicant’s specification also contains the term “sports tuition” on its own and for the same reasons set out above, this service is also identical to “educational services, namely, conducting classes, seminars, conferences, workshops and programs in the fields of [...] sports” in the opponent’s second and third marks’ specifications.

55. The opponent’s second and third mark’s specifications contain the following services in relation to education:

“Educational and entertainment services, namely, providing motivational and educational speakers”, “educational services, namely, conducting classes, seminars, conferences, workshops and programs in the fields of physical fitness, mental fitness, nutrition, team building, survival training, behavior modification, sports, exercise, health, wellness, and self-improvement”, “educational services, namely, providing training of teachers, educators and schools for certification in the fields of physical fitness, mental fitness, leadership, team building, and obstacle course creation”, “educational services, namely, conducting camps in the fields of physical fitness, mental fitness, team building, and obstacle course creation and distribution of curricula and training material in connection therewith”, “educational services, namely, providing online educational courses, lectures, seminars, workshops, presentations, podcasts, and training, all in the fields of motivation, psychology, core virtues, values, fitness, exercise, strength, conditioning, exercise, improvement, mental toughness, self-awareness, self-mastery, mental strength and control, emotional strength and control, nutrition, grit, mind-body character development, physical fitness, health, wellness, and self-improvement” and “educational services, namely, providing online publications in the nature of non-downloadable articles, online non-downloadable podcasts, online non-downloadable videos and electronic mail messages, in the fields of nutrition, diets, dietary supplements, food, food shopping lists, food selection, food

recommendations, food recipes, food preparation, food cooking, health, wellness, and healthy lifestyles and providing a website featuring information regarding health, wellness and healthy lifestyles”/”educational services, namely, providing online publications in the nature of non-downloadable articles, online non-downloadable podcasts, online non-downloadable videos and electronic mail messages, in the fields of nutrition, diets, dietary supplements, food, food shopping lists, food selection, food recommendations, food recipes, food preparation, food cooking, health, wellness, and healthy lifestyles and providing information regarding health, wellness and healthy lifestyles via a website”⁵.

56. These terms will all fall within the applicant’s terms, being “education”, “education and instruction”, “education and training” and “education and training services”. These services are, therefore, identical under the principle outlined in *Meric*.

57. “Education and training in the field of music and entertainment” in the applicant’s specification shares the same core purpose as those services in the opponent’s second and third mark’s specification as listed at paragraph 55 above in that they are all education services. However, the end purposes will differ due to the specific nature of the parties’ respective terms. The user base for the applicant’s term is specific and is unlikely to overlap into the user base for the opponent’s terms. There will be an overlap in nature in that both describe education services and in method of use in that both services are likely to be provided by way of classes, workshops or seminars. Further, I consider there to be an overlap in trade channels as some undertakings will look to provide all types of educational services. Overall, I find these services to be similar to a medium degree.

58. The terms “education, entertainment and sport services” and “education, entertainment and sports” in the applicant’s specification are very broad terms that cover all types of education, entertainment and sports services. I have dealt with sport services at paragraph 47 and have dealt with education services at paragraph 55 and 56 of this decision. My findings for those services will also apply to this term

⁵ *op. cit.*, p.15.

in the applicant's specification meaning that "sport services" will be identical with the opponent's sports services (as discussed at paragraph 47 above). As for "education services", these will be identical to those services listed at paragraph 55 above.

59. Moving on to "entertainment services" within this term, I note that the opponent's terms cover a wide range of entertainment services, including (amongst others) "television, radio, podcast and video program and show syndication", "creating and developing concepts for television, radio, podcast and video programs and shows", "television, radio, podcast and video recording, taping and filming services", "multimedia publishing of television and video programs and shows and film clips" and "organizing community festivals featuring primarily [...] art exhibitions [and] musical performances". These terms will fall within the applicant's term and are, therefore, identical under the principle outlined in *Meric*.

60. I have no submissions as to what the term "special event planning" in the applicant's specification covers. This is a very broad term that, in my view, ranges from the planning of sporting events to art exhibitions, music concerts and music festivals. The terms "arranging, organizing and conducting [...] sporting events and competitions" and "organizing community festivals featuring primarily [...] art exhibitions [and] musical performances" in the opponent's second and third marks will fall within the broader category of special event planning, meaning that these services will be identical under the principle outlined in *Meric*. When providing the organisation and arrangement of these services, I am of the view that they would also include any consultation required in relation to the event. This is because the undertaking providing these services will be required to provide some form of consultation to the user, for example, consultation regarding the feasibility of the event itself. Therefore, the terms "arranging, organizing and conducting [...] sporting events and competitions" and "organizing community festivals featuring primarily [...] art exhibitions [and] musical performances" in the opponent's second and third marks' specifications will fall within the broader category of "special event planning consultation" in the applicant's specification. These services are, therefore, identical under the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

61. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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. 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.”

62. I return to my comments at paragraphs 26 and 27 regarding the comments made by the applicant in his counterstatement, in that the applicant's “services and products are clearly targeting a market that is not targeted” by the opponent. The particular segment of the market in which the opponent or the applicant have so far chosen to trade does not deprive the opponent's marks of the normal level of protection afforded to every registered trade mark; this means that I must consider notional and fair use of the opponent's marks across all segments of the markets for the goods and services for which they are registered. .

63. I am of the view that the average consumer for the goods at issue are members of the general public. While the services at issue are also, for the most part, aimed at the general public, I find that the average consumer for some of the services may be business users, for example, “special event planning” in the applicant's specification.

64. The goods at issue are likely to be available through a range of retail shops and their online equivalents. Where the goods are selected at a retailer, they will be displayed on shelves and self-selected by a consumer. A similar process will apply to websites where the consumer will select the goods having viewed an image displayed on a website. The selection of the goods will be primarily visual, but I do not discount an aural component playing a part in the form of word of mouth recommendations and advice from sales assistants.
65. Regardless of whether they are selected by a member of the general public or a business user, the services at issue will be selected at specialist providers and their online equivalents. When attending a specialist provider, the consumer is likely to view the services in catalogues/brochures, on a list of services or on placards. When selecting the services via online websites, the services will be selected after viewing an image displayed on a website. The selection of the services will be primarily visual, but I do not discount an aural component playing a part in the form of word of mouth recommendations and advice from sales assistants.
66. The price and frequency of the purchase of the goods at issue will vary. Even where the goods are of low cost and purchased relatively frequently, a number of factors will still be considered by the average consumer, such as current fashion trends, price, quality and suitability.
67. Given the wide-ranging nature of the services at issue, some will be selected fairly regularly, for example, services such as the selection of physical fitness facilities by individuals, and some less frequently, for example, services such as organising sporting events. The factors that the average consumer will consider when selecting the services will also differ greatly. For example, for individuals attending a fitness class, the average consumer will consider the frequency of the training program, any qualifications held by the trainer, the type of training provided and any testimonials from previous users. However, for services such as the organisation of large sporting events, the average consumer is likely to consider factors such as reliability of the organiser, levels of safety provided, the scale at

which the provider is capable of operating and any track record of previous events organised.

68. The level of attention paid by both the member of the general public and the business user will generally be medium. However, I recognise that, for some services selected by the business user, there will be a higher degree of attention, for example, organisation of sporting events, education services for the training of certified educators in various fields and creating and developing concepts for television, radio, podcast and video programs.

Distinctive character of the opponent's mark

69. 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-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

70. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not pleaded that its marks have obtained enhanced levels of distinctiveness. Therefore, I have only the inherent position to consider. The opponent's first and second marks are identical so I will assess the distinctiveness of those marks together.

The opponent's first and second marks

71. The marks consist of a device and a word element. The marks are registered in black and white. The device element sits at the beginning of the mark and is a circular device within which is a type of ancient warrior's helmet and a number of lines and spots. To the right of the device element is the word 'SPARTAN' displayed in a bold but standard typeface.

72. I am of the view that the distinctive character of the marks will be dominated by the word element. The opponent has submitted evidence that the word 'SPARTAN' means a native or inhabitant of ancient Sparta or a person of great courage and self-discipline.⁶ I am of the view that alongside the device element, the average consumer will connect the word 'SPARTAN' to a warrior of ancient Sparta and not just a native or inhabitant. I note that Spartan warriors were revered for their courage and discipline, meaning that it is possible to argue that the word 'SPARTAN' has an allusive quality. However, aside from the definition provided, I have no evidence that the average consumer would make this connection and I am not convinced that this would be known by the average consumer. While the word 'SPARTAN' is not highly original, it is, in my view, distinctive to a medium degree. As for the device element, I consider that it will increase the distinctiveness of the marks slightly. Therefore, I find that the opponent's first and second marks enjoy a higher than medium degree of inherent distinctive character.

⁶ Exhibit SE1 of the witness statement of Sian Edmonds

The opponent's third mark

73. The opponent's third mark consists only of the same device element described above. Without the word 'SPARTAN' to accompany the device (like the opponent's first and second marks), I do not consider that the average consumer would see it as a 'spartan helmet'. Instead, they will see it as a generic ancient warrior helmet. Overall, I find that it enjoys a medium degree of inherent distinctive character.

Comparison of marks

74. It is clear from *Sabel 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 trade marks, bearing in mind their distinctive and dominant components.

75. 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.”

76. 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.

77. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
 <p>(the opponent's first and second marks)</p>  <p>(the opponent's third mark)</p>	

Overall Impression

The applicant's mark

78. The applicant's mark consists of device and word elements. The device element is an orange and red stylised circle that contains a grey and navy-blue depiction of the upper body of an ancient warrior wearing a red helmet surrounded by eight red swords. The word elements are 'SPARTANS', (which is underlined and displayed in a large, orange standard typeface), 'Soca' (displayed in a near imperceptible manner in a smaller, red standard typeface that is placed above and to the left of 'SPARTANS') and 'UK' (displayed in a blue standard typeface and surrounded by a white circle). All elements sit on a navy-blue background that will be overlooked due to its sole purpose as a background.

79. While I note the size, stylisation and placement of the device element, I am of the view that the eye is drawn to the elements of the mark that can be read. Given the size and placement of the word 'Soca' and the fact that 'UK' will have little trade mark significance due to its indication of the geographical location of the undertaking, I am of the view that 'SPARTANS' plays the greater role in the overall impression of the mark with the device element playing a slightly lesser role and

the remaining elements (the use of different colours and the words 'Soca' and 'UK') playing a much lesser role.

The opponent's first and second marks

80. I have found above that the marks will be dominated by the word element, being 'SPARTAN'. Therefore, I find that the word 'SPARTAN' will dominate the overall impression of the marks with the device element playing a slightly lesser role.

The opponent's third mark

81. The only element in the opponent's third mark is the device element. There are no other elements that contribute to the overall impression of the mark.

Visual Comparison

82. In his counterstatement, the applicant states that:

"In terms of any stated similarities between both company's logo/image, please note that our mark's image is a full upper body image of a figure depicting a Spartan warrior, placed above the text. The logo of the opponent is merely a helmet placed adjacent to their text. A figure of a Spartan's upper body is a stark difference to only showing a (very simple) 'stylised' Spartan helmet. Note also that our mark uses a variety of colours."

The opponent's first and second marks and the applicant's mark

83. Visually, both marks contain the word 'SPARTAN'. I do note, however, that the applicant's mark has the letter 'S' at the end of the word 'SPARTAN', indicating that it is a reference to 'SPARTAN' in the plural. The marks also share a circular device element that contain what will be seen as a reference to a spartan warrior. While similar in that they both contain reference to a spartan warrior, these device elements are stylistically very different. The marks differ further in the presence of the words 'Soca' and 'UK' in the applicant's marks that are absent in the opponent's

marks. Further, the applicant's mark also consists of multiple colour combinations and while the opponent's marks are registered in black and white (meaning that the opponent's marks are registered for use in different colours), this does not extend to contrived colour splits, such as that used in the applicant's mark.

84. I have found that the marks are dominated by the words 'SPARTAN'/'SPARTANS', which are very highly similar. However, while I have found that all the elements that differ play lesser roles in the respective marks, they will still constitute visual differences between the marks. Overall, I find that the marks are visually similar to between a low and medium degree.

The opponent's third mark and the applicant's mark

85. These marks are similar only in that they both include a circular device that include a reference to a type of ancient warrior (I have found above that the opponent's third mark in solus will not be seen as a spartan helmet, but a generic ancient warrior helmet). I have set out above that these devices are stylistically very different. All of the other elements in the applicant's mark are not present in the opponent's third mark. Overall, I am of the view that these marks are similar to a very low degree.

Aural Comparison

The opponent's first and second marks and the applicant's mark

86. The opponent's first and second marks consist of two syllables that will be pronounced 'SPAR-TUHN'. Given the fact the word 'Soca' is nearly imperceptible in the applicant's mark, I do not consider that it will be pronounced. Further, I do not consider that the average consumer will pronounce the word 'UK' given its sole purpose as a geographical indicator of the location of the undertaking. Therefore, the applicant's mark consists of two syllables that will be pronounced 'SPAR-TUHNS'. Overall, I find that the marks are aurally similar to a very high degree.

87. However, if I am wrong in my finding that 'Soca' will not be pronounced, the marks will be similar to a higher than medium degree. In the event that I am also wrong that the word 'UK' will not be pronounced, then I am of the view that the marks will be similar to no more than a medium degree.

The opponent's third mark and the applicant's mark

88. The opponent's third mark does not contain an aural element and is, therefore, incapable of being pronounced. As a result, I find these marks to be aurally dissimilar.

Conceptual Comparison

The opponent's first and second marks and the applicant's mark

89. The marks, in my view, are dominated by the conceptual impact of the word 'SPARTAN'/'SPARTANS'. This is further enhanced by the presence of the device elements which will, in conjunction with the words 'SPARTAN' and 'SPARTANS', be seen a depiction of spartan warriors. While I have found 'Soca' and 'UK' to have lesser roles in the applicant's mark, they will still carry a conceptual message and act as points of conceptual difference between the marks.

90. I note that the applicant has submitted that 'soca' is a globally established popular music genre originating from the West Indies. While this may be the case, I am of the view that a significant proportion of average consumers in the UK will see it as a deliberate misspelling of 'soccer' (this is particularly the case on goods and service that relate to sports) while another significant proportion will see it as an invented word with no obvious meaning. Regardless, 'Soca' will either be a point of conceptual difference or neutrality. However, if I am wrong in this finding and 'soca' is seen as a music genre from the West Indies, it will not affect the fact that 'soca' will act as a conceptual difference between the marks. As for the word 'UK', I have found that this will carry little trade mark significance due to its purpose as a geographical indication of the location of the applicant, however, I find that it will still act as a slight point of conceptual difference. Overall, I am of the view that,

given the dominance of the 'spartan' element in the marks, they are conceptually similar to a high degree.

The opponent's third mark and the applicant's mark

91. The conceptual impact of the opponent's third mark lies solely in the fact that the device element will be seen as a depiction of an ancient warrior's helmet. The conceptual impact of the applicant's mark will be the same as paragraphs 89 and 90 above. While I have found that the opponent's third mark will not be seen as a spartan warrior, the fact that a spartan warrior is an ancient warrior means that there will still be a shared concept between them. While the marks have a shared conceptual hook of an ancient warrior, the 'Soca' and 'UK' elements will serve as points of conceptual difference. Overall, I am of the view that these marks are conceptually similar to a medium degree.

Likelihood of confusion

92. 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 the marks and the goods and services 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 mark, the average consumer for the goods 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.

93. In assessing likelihood of confusion, I am going to focus on the opponent's first and second marks on the basis that they represent the opponent's best case. If I find likelihood of confusion between these marks, then it is not necessary to consider the opponent's third mark as it will have no further bearing on the outcome of this decision. Also, it follows that if I do not find likelihood of confusion between the opponent's first and second marks and the applicant's mark, there will be no likelihood of confusion between the opponent's third mark and the applicant's mark. This is because the opponent's third mark shares a lesser degree of similarity with the applicant's mark.

94. I have found all of the applicant's goods to be identical to the opponent's first mark's goods. I have found the applicant's services to range from being identical to similar to a medium degree to the services in the opponent's second mark's specification. I have found the average consumer for the goods to be both members of the public and business users. I have found that the goods and services will be selected through primarily visual means (although I do not discount an aural component). I have concluded that the average consumer for the goods and some of the services will pay a medium degree of attention but for some other services, a higher degree of attention will be paid.

95. I have found the opponent's first and second marks to have a higher than medium degree of inherent distinctive character. I have found applicant's mark to be visually similar to between a low and medium degree, aurally similar to a very high degree (or to a higher than medium degree if 'Soca' in the applicant's mark is pronounced or no more than a medium degree if 'UK' in the applicant's mark is pronounced) and conceptually similar to a high degree with the opponent's first and second marks. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

96. Taking all of the above factors and the principle of imperfect recollection into account, I consider that the visual and aural differences between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. Consequently, I am satisfied that there is no likelihood of direct confusion between the marks, even on goods and services that are identical.

97. It now falls to me to consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.). BL O/375/10 Page 15 of 16

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

98. I have borne in mind that the examples given by Mr Purvis QC are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁷

99. Even if the differences between the marks are noticed, I consider that the reference to ‘SPARTAN’ in the singular (in the opponent’s marks) and the plural (in the applicant’s mark) will be overlooked or misremembered by the average consumer. I have found the word ‘SPARTAN’ (whether in the singular or plural) to be the dominant element of the parties’ marks. As a result, I am of the view that the differences between the marks will be seen by the average consumer as alternative marks from the same or economically linked undertakings. I have found that a significant proportion of average consumers will view ‘Soca’ as a misspelling of soccer. Therefore, for those average consumers, ‘Soca’ and ‘UK’ will be seen as additional, non-distinctive elements, meaning that it is possible that they will be viewed as indications of a sub-brand. For example, ‘Soca’ will indicate a sub-brand that focuses on soccer and ‘UK’ will be seen as a sub-brand that targets the UK market. Even if, as the applicant submits, ‘Soca’ is recognised as a music genre originating from the West Indies by a significant proportion of average consumers, it will still be an indication of a sub-brand that focuses on that genre. But even if the average consumer were to perceive ‘Soca’ as an invented word, it would not introduce any concept and would not create any conceptual gap between the marks that would prevent the average consumer from thinking that the applicant’s mark was a brand extension of the opponent’s mark. Further, the differences in stylisation and presentation of the marks (such as the typeface, colour and device element used) will be seen as an alternative mark being used by the same or economically linked undertakings and consistent with a re-branding. Consequently, I consider there to be a likelihood of indirect confusion between the marks, even on those services that are similar to a medium degree and in respect of those

⁷ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

services where a higher degree of attention may be paid during the selection process.

CONCLUSION

100. The opposition succeeds in its entirety and the application is refused in respect of all goods and services.

COSTS

101. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Whilst I accepted the definition of the term 'Spartan' provided in the opponent's evidence, the evidence as a whole was considerably light. Therefore, I do not consider it appropriate to make a full award of costs in respect of the evidence provided. In the circumstances, I award the opponent the sum of **£400** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and consider the applicant's counter statement:	£200
Preparing evidence:	£100
Official Fees:	£100
Total	£200

102. I therefore order Thabani Solomon Tshuma to pay Spartan Race, Inc the sum of £400. This 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 12th day of March 2021

A COOPER
For the Registrar

ANNEX

Opponent's first mark

Class 25

Clothing items and apparel, namely, athletic bottoms for exercise and obstacle course racing, shirts, shorts, hats, gloves, pants, sweat shirts, sweat pants, jackets, belts, hats, caps, martial arts uniforms, bottoms, tops, coats, dresses, jackets, loungewear, scarves, sleepwear, socks, sweatbands, swimwear, bathing suits, shorts, board shorts, undergarments, underwear, warm up suits, warm up outfits, t-shirts, hooded sweat shirts, tank tops, baselayer tops, bikinis, blouses, boxer briefs, boxer shorts, briefs, clothing for wear in judo and martial arts practices, clothing for wear in wrestling games, arm warmers, fleece pullovers, fleece tops, gym pants, gym shorts, gym suits, hooded pullovers, jerseys, jogging outfits, jogging pants, jogging suits, knit tops, knitted underwear, long-sleeved shirts, muscle tops, polo shirts, rainproof jackets, short-sleeved shirts, sport shirts, stockings, stretch pants; sweat jackets, sweat shorts, sweat suits; swim trunks, tank tops, thermal underwear, trousers, uniforms, wind pants, wind resistant jackets, wind shirts, wind-jackets, yoga pants, yoga shirts, sports bras, bras, halter tops, sleeveless tops, vests; headwear, namely, hats, caps, baseball caps, beanies, knit hats, sun visors, skull caps, sports caps and hats, headbands; footwear, namely, shoes, sandals, beach shoes, running shoes, tennis shoes, athletic training shoes.

Opponent's Second Mark

Class 41

Entertainment in the nature of obstacle courses, endurance events, endurance races, athletic events, sporting events and competitions; arranging, organizing and conducting obstacle courses, endurance events, endurance races, athletic events, sporting events and competitions; conducting fitness classes; physical fitness training of individuals and groups; physical fitness assessment services; physical fitness boot camps; consulting services in the fields of fitness and exercise; physical fitness instruction; providing assistance in the nature of personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning,

and exercise improvement in their daily living; providing a website featuring information in the fields of fitness, sports and exercise; providing a website featuring non-downloadable videos and images in the fields of athletic competitions, fitness and exercise; providing a website featuring blogs and non-downloadable publications in the nature of articles and magazines in the fields of fitness and exercise; entertainment services, namely, providing podcasts in the fields of exercise, personal training, health and self-improvement; entertainment services, namely, providing video podcasts in the fields of exercise, personal training, health and self-improvement; educational and entertainment services, namely, providing motivational and educational speakers; educational services, namely, conducting classes, seminars, conferences, workshops and programs in the fields of physical fitness, mental fitness, nutrition, team building, survival training, behavior modification, sports, exercise, health, wellness, and self-improvement; production and distribution of television programs, series and segments; entertainment services in the nature of ongoing television series; entertainment services, namely, development, creation, production, post-production and distribution of videos in the fields of fitness, sports, exercise, athletic competitions, personal training, health, nutrition, team building, survival training, behavior modification, wellness, and self-improvement; production of pre-recorded optical, electronic, digital, magnetic and downloadable media content in the nature of television and video programs and shows; production of sporting events for television, radio, podcast and video programs and shows; television, radio, podcast and video program and show syndication; creating and developing concepts for television, radio, podcast and video programs and shows; television, radio, podcast and video recording, taping and filming services; production of closed caption television programs and shows; providing scheduling and content information via a website about television, radio, podcast and video programs and shows; providing information in the fields of entertainment and sporting events via a global computer network; entertainment services, namely, providing information, news and commentary in the fields of athletic competitions and sporting events; entertainment services in the nature of development and production of multimedia entertainment content; providing a website featuring non-downloadable videos and images in the field of athletic competitions provided via global computer networks, wireless communication networks and portable device applications; providing obstacle course training facilities; providing fitness and exercise facilities; providing non-downloadable, digital audiovisual content in the field of fitness;

electronic publishing services, namely, publication of text and graphic works of others online featuring entertainment and athletic competitions, photographs, commentary and interviews; multimedia publishing of television and video programs and shows and film clips; providing news in the nature of current event reporting, namely, radio and television coverage of sporting events; educational services, namely, providing training of teachers, educators and schools for certification in the fields of physical fitness, mental fitness, leadership, team building, and obstacle course creation; arranging and conducting youth sports programs in the fields of obstacle courses, athletic events, sporting events and competitions, physical fitness, mental fitness, leadership, team building, and obstacle course creation; summer camps; sport camps; operation of summer camps and sports camps; educational services, namely, conducting camps in the fields of physical fitness, mental fitness, team building, and obstacle course creation and distribution of curricula and training material in connection therewith; organizing community festivals featuring primarily sporting events, art exhibitions, provision of fitness information, health and fitness classes, musical performances, flea markets, provision of health information, fitness vendor information booths; educational services, namely, providing online educational courses, lectures, seminars, workshops, presentations, podcasts, and training, all in the fields of motivation, psychology, core virtues, values, fitness, exercise, strength, conditioning, exercise, improvement, mental toughness, self-awareness, self-mastery, mental strength and control, emotional strength and control, nutrition, grit, mind-body character development, physical fitness, health, wellness, and self-improvement; providing online non-downloadable videos, non-downloadable electronic publications in the nature of magazines and articles, and non-downloadable e-books, all featuring discussions and coaching in the fields of motivation, psychology, core virtues, values, fitness, exercise, strength, conditioning, exercise improvement, mental toughness, self-awareness, self-mastery, mental strength and control, emotional strength and control, nutrition, grit, mind-body character development, physical fitness, health, wellness, and self-improvement; educational services, namely, providing online publications in the nature of non-downloadable articles, online non-downloadable podcasts, online non-downloadable videos and electronic mail messages, in the fields of nutrition, diets, dietary supplements, food, food shopping lists, food selection, food recommendations, food recipes, food preparation, food cooking, health, wellness, and

healthy lifestyles and providing a website featuring information regarding health, wellness and healthy lifestyles.

Opponent's third mark

Class 41

Entertainment in the nature of obstacle courses, endurance events, endurance races, athletic events, sporting events and competitions; arranging, organizing and conducting obstacle courses, endurance events, endurance races, athletic events, sporting events and competitions; conducting fitness classes; physical fitness training of individuals and groups; physical fitness assessment services; physical fitness boot camps; consulting services in the fields of fitness and exercise; physical fitness instruction; providing assistance in the nature of personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living; providing information in the fields of fitness, sports and exercise via a website; providing non-downloadable videos and images in the fields of athletic competitions via a website, fitness and exercise; providing non-downloadable publications in the nature of articles and magazines in the fields of fitness and exercise via a website; entertainment services, namely, providing podcasts in the fields of exercise, personal training, health and self-improvement; entertainment services, namely, providing video podcasts in the fields of exercise, personal training, health and self-improvement; educational and entertainment services, namely, providing motivational and educational speakers; educational services, namely, conducting classes, seminars, conferences, workshops and programs in the fields of physical fitness, mental fitness, nutrition, team building, survival training, behavior modification, sports, exercise, health, wellness, and self-improvement; production and distribution of television programs, series and segments; entertainment services in the nature of ongoing television series; entertainment services, namely, development, creation, production, post-production and distribution of videos in the fields of fitness, sports, exercise, athletic competitions, personal training, health, nutrition, team building, survival training, behavior modification, wellness, and self-improvement; production of pre-recorded optical, electronic, digital, magnetic and downloadable media content in the nature of television and video programs and shows; production of sporting events for television, radio, podcast and

video programs and shows; television, radio, podcast and video program and show syndication; creating and developing concepts for television, radio, podcast and video programs and shows; television, radio, podcast and video recording, taping and filming services; production of closed caption television programs and shows; providing scheduling and content information via a website about television, radio, podcast and video programs and shows; providing information in the fields of entertainment and sporting events via a global computer network; entertainment services, namely, providing information, news and commentary in the fields of athletic competitions and sporting events; entertainment services in the nature of development and production of multimedia entertainment content; providing obstacle course training facilities; providing fitness and exercise facilities; providing non-downloadable, digital audiovisual content in the field of fitness; electronic publishing services, namely, publication of text and graphic works of others online featuring entertainment and athletic competitions, photographs, commentary and interviews; multimedia publishing of television and video programs and shows and film clips; providing news in the nature of current event reporting, namely, radio and television coverage of sporting events; educational services, namely, providing training of teachers, educators and schools for certification in the fields of physical fitness, mental fitness, leadership, team building, and obstacle course creation; arranging and conducting youth sports programs in the fields of obstacle courses, athletic events, sporting events and competitions, physical fitness, mental fitness, leadership, team building, and obstacle course creation; summer camps; sport camps; operation of summer camps and sports camps; educational services, namely, conducting camps in the fields of physical fitness, mental fitness, team building, and obstacle course creation and distribution of curricula and training material in connection therewith; organizing community festivals featuring primarily sporting events, art exhibitions, provision of fitness information, health and fitness classes, musical performances, flea markets, provision of health information, fitness vendor information booths; educational services, namely, providing online educational courses, lectures, seminars, workshops, presentations, podcasts, and training, all in the fields of motivation, psychology, core virtues, values, fitness, exercise, strength, conditioning, exercise, improvement, mental toughness, self-awareness, self-mastery, mental strength and control, emotional strength and control, nutrition, grit, mind-body character development, physical fitness, health, wellness, and self-improvement; providing online non-downloadable videos, non-

downloadable electronic publications in the nature of magazines and articles, and non-downloadable e-books, all featuring discussions and coaching in the fields of motivation, psychology, core virtues, values, fitness, exercise, strength, conditioning, exercise improvement, mental toughness, self-awareness, self-mastery, mental strength and control, emotional strength and control, nutrition, grit, mind-body character development, physical fitness, health, wellness, and self-improvement; educational services, namely, providing online publications in the nature of non-downloadable articles, online non-downloadable podcasts, online non-downloadable videos and electronic mail messages, in the fields of nutrition, diets, dietary supplements, food, food shopping lists, food selection, food recommendations, food recipes, food preparation, food cooking, health, wellness, and healthy lifestyles and providing information regarding health, wellness and healthy lifestyles via a website.