

O-180-20

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3324101  
BY THE ART NEWSPAPER SA  
TO REGISTER**

**ART FOCUS**

**AS A TRADE MARK  
IN CLASSES 9, 16, 35, 38, 41, 42  
AND OPPOSITION THERETO (UNDER NO. 414181)  
BY  
INFORMATION BUILDERS INC**

## Background & Pleadings

1. The Art Newspaper SA ('the applicant') applied to register the mark **ART FOCUS** on 12 July 2018. The mark was published in the Trade Marks Journal on 27 July 2018 in classes 9, 16, 35, 38, 41 and 42. The goods and services in classes 9, 16, 41 and 42 affected by the opposition are set out later in this decision. Classes 35 and 38 do not form part of these proceedings.

2. Information Builders, Inc ('the opponent') opposed the applied-for mark on 26 October 2018 under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') based on its earlier EU TM No. 13662531, outlined below. The goods and services are set out later in this decision.

EU TM No. 13662531
<b>FOCUS</b>
Filing date: 22 January 2015
Registration date: 19 February 2017

3. The opponent claims under section 5(2)(b) that the applicant's mark is similar to its earlier mark and is applied for in respect of identical or similar goods to those in the specification of the earlier mark. In consequence, it claims that there exists a likelihood of confusion.

4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act but, as it had not been registered for five years or more at the publication date of the application, it is not subject to the proof of use requirements, as per section 6A of the Act.

5. The applicant filed a counterstatement in which it denied the ground of opposition.

6. During these proceedings both parties have been professionally represented throughout, the opponent by Wilson Gunn and the applicant by Lewis Silkin LLP.

7. Both parties filed evidence, which I refer to below, and written submissions in lieu of a hearing. I make this decision based on the material before me.

### **Preliminary issues regarding evidence**

8. The opponent filed a witness statement and 8 exhibits in the name of Peter Walker, its Vice President and UK country manager. However, in the written submissions dated 3 October 2019, the opponent states the following:

15.c. The opposition can therefore be decided under the section 5(2)(b) Trade Marks Act 1994 without reference to the Witness Statement of Peter Walker, which was simply the evidence already prepared for the response to the cancellation proceedings against EUTM registration 3448362.

16. Following on from the above, the Witness Statement of Steven Jennings, which is in response to the Witness Statement of Peter Walker, does not need to be considered in relation to the opposition. This is because it is only relevant as a response to the cancellation proceedings against EUTM registration 3448362, which is not the basis for the opposition and has no relevance to the opposition.

17. For the sake of completeness and clarity, the Opponent does not intend to rely on the Witness Statement of Peter Walker as evidence of enhanced distinctiveness of the Earlier Trade Mark in the UK.

9. Given that the opponent states its evidence is not relevant to the earlier mark it relies on for this opposition, and the applicant's evidence was given in reference to it, then I do not intend to refer to either party's evidence again in this decision.

### **Section 5(2)(b)**

10. Section 5(2)(b) of the Act states as follows:

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

(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.

11. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

### **The principles**

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

12. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary”.

13. 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.

14. The following case law is also applicable in these proceedings, *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, in which 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 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”.

15. The opponents sought to oppose only some goods and services of the application. The applicant filed a form TM21B dated 29 May 2019 in which amendments were requested to classes 9 and 42. The opponent confirmed on 2 July 2019 that these amendments had not overcome its objections and that the opposition was maintained. For the sake of clarity the amended specifications for classes 9 and 42 in addition to the other goods and services which have been opposed are set out below. The table now indicates the goods and services which are under opposition.

<b>Opponent's goods &amp; services</b>	<b>Applicant's goods &amp; services</b>
9: Computer software; computer programs; downloadable electronic publications and manuals relating to computer software and computer programming.	9: Downloadable digital media; downloadable publications; downloadable application software for smart phones for viewing and reviewing material relating to art, artists and the art world; downloadable electronic reports; electronic applications (downloadable); downloadable electronic newspapers; downloadable electronic newsletters; downloadable electronic brochures; downloadable electronic publications; podcasts; downloadable publications in the nature of magazines.
16: Printed publications and manuals relating to computer software and computer programming.	16: Printed matter; newsletters; printed newsletters; newspapers; printed educational publications; journals
41: Training in the design, development and operation of computer software and computer programs and in computer programming; online publication of electronic publications and manuals (non-downloadable) relating to	41: Publishing services; publishing and reporting; publication of newspapers; online publication of electronic newspapers; publication of newspapers, periodicals, catalogues and brochures; publication of newspapers accessible

<p>computer software and computer programming; information, advisory and consultancy services relating to all the aforesaid services.</p>	<p>via a global computer network; multimedia publishing of newspapers; multimedia publishing of magazines, journals and newspapers; electronic publication; news reporting; providing on line electronic publications not downloadable; publication of printed matter; publication of educational printed matter; publication of electronic newspapers accessible via a global computer network; providing online videos (non-downloadable); providing non- downloadable electronic publications from a global computer network or the Internet; educational and instruction services; educational and instruction services relating to business; publishing of reviews; organisation of educational events; arranging and conducting of educational events; providing electronic publications; providing online electronic publications; conducting workshops and seminars; provision of information, advisory and consultancy services in respect of the aforesaid services.</p>
<p>Class 42: Computer programming services; design, development and operation of computer software and computer programs; software as a service [SaaS]; information, advisory and consultancy services relating to all the aforesaid services.</p>	<p>42: Providing, running, managing and maintaining online or networked platforms for e-commerce; providing, running, managing and maintaining an online or networked business service aggregator website; computerised data storage; secure data storage; providing,</p>

	<p>running, managing and maintaining an online or networked platform for ordering, reserving and booking third party products or third party services; technical writing; platform as a service services; hosting on-line web facilities as websites and mobile sites for others for managing and sharing online content; providing search engines for obtaining data via communications networks; computer services, namely, hosting electronic facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; application service provider (ASP) namely software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic text and media or information all relating to art, artists and art world over communication networks; providing temporary use of non downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; computer services in the nature of customized web pages featuring user-defined or specified information in the nature of personal profiles, audio, video, photographic</p>
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	<p>images, text, graphics and data; creating and maintaining websites, blogs, online communities relating to art, artists and the art world; consumer product and service testing and consultation; research services; product research; storage, analysis and retrieval of digital information and data; design of formats for television, video, internet-based and audio-visual media; set design services; computerised information storage; providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks namely, provision of search engines for the Internet; provision of information, advisory and consultancy services in relation to the aforementioned services.</p>
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### Class 9

16. I find the opponent's term *Computer software* at large is broad enough to cover *downloadable application software for smart phones for viewing and reviewing material relating to art, artists and the art world* in the applicant's specification and is therefore considered identical on the *Merck* principle

17. I find the terms *Downloadable digital media; downloadable publications; downloadable electronic reports; electronic applications (downloadable); downloadable electronic newspapers; downloadable electronic newsletters;*

*downloadable electronic brochures; downloadable electronic publications; downloadable publications in the nature of magazines* in the applicant's specification are covered by *downloadable electronic publications and manuals relating to computer software and computer programming* in the opponent's specification and are therefore considered identical on the *Meric* principle.

18. With regard to the term *podcasts* in the applicant's specification, I do not find these to be similar to the opponent's goods. Podcasts themselves are digital audio files, usually in episodic format and distributed from specialist platforms and whilst they are downloadable, I find that they do not have the same nature, uses or channels of trade as downloadable electronic publications.

#### Class 16

19. I find that the terms *Printed matter; newsletters; printed newsletters; newspapers; printed educational publications; journals* in the applicant's specification will encompass *Printed publications and manuals relating to computer software and computer programming* in the opponent's specification and are therefore considered identical on the *Meric* principle.

#### Class 41

20. I find that the terms *educational and instruction services; organisation of educational events; arranging and conducting of educational events; conducting workshops and seminars; provision of information, advisory and consultancy services in respect of the aforesaid services* in the applicant's specification are *Meric* identical to the earlier *Training in the design, development and operation of computer software and computer programs and in computer programming; information, advisory and consultancy services relating to all the aforesaid services*.

21. I find that *Publishing services; publishing and reporting; publication of newspapers; online publication of electronic newspapers; publication of newspapers, periodicals, catalogues and brochures; publication of newspapers accessible via a global computer network; multimedia publishing of newspapers; multimedia publishing of magazines, journals and newspapers; electronic publication; news reporting; providing on line electronic publications not downloadable; publication of*

*printed matter; publication of educational printed matter; publication of electronic newspapers accessible via a global computer network; providing non-downloadable electronic publications from a global computer network or the Internet; publishing of reviews; providing electronic publications; providing online electronic publications; provision of information, advisory and consultancy services in respect of the aforesaid services in the applicant's specification are Meric identical to the earlier online publication of electronic publications and manuals (non-downloadable) relating to computer software and computer programming; information, advisory and consultancy services relating to all the aforesaid services.*

22. With regard to the applicant's *providing online videos (non-downloadable)*, I find them to be similar to a medium degree to *online publication of electronic publications and manuals (non-downloadable) relating to computer software and computer programming* in the opponent's specification as it is often the case that electronic publications and manuals include an audio visual element to them. The services are similar in their nature, i.e. non-downloadable display material and their method of use, i.e. accessed online. In addition, there will be overlap in the users of such services and they will share the same channels of trade in that the material is shared via an online presence.

23. Turning to the applied for term *educational and instruction services relating to business*, I do not find it to be similar to *Training in the design, development and operation of computer software and computer programs and in computer programming* in the opponents' specification. I note the opponent's contention in its written submission, viz:

“the term *business* is not defined or specified and the training services of the Registration fall within this term in as much as they are necessary for the operation of a business”<sup>1</sup>

24. I disagree with the opponent on this matter. Training for design, development and operation of software and computer programs is a specialist and technical

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<sup>1</sup> Paragraph 29

subject matter and therefore, in my view, does not have the same purpose as educational services relating to business. I also find that the users and uses of the respective services to be different. Whilst at a general level both services may reach the market through the same trade channel such as an educational establishment or on-line distance learning, this is not sufficient, by itself, for a finding of similarity. In terms of complementarity as it is set out in *Canon* I do not find that the services are in competition with each other nor is one necessary or indispensable to the other. I find these are dissimilar services.

#### Class 42

25. In its written submissions<sup>2</sup>, the opponent contends that:

“The class 42 services of the Application are identical or highly similar to the *design, development and operation of computer software and computer programs; software as a service [SaaS]; information advisory and consultancy services relating to all the aforesaid services* of the Registration. The terms of the Registration are unqualified and so cover the provision of software for all the specific natures and purposes as those set out in the Application.

26. I consider that the term *software as a service* in the opponent’s specification can be considered as identical to *application service provider (ASP) namely software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic text and media or information all relating to art, artists and art world over communication networks; providing temporary use of non downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; computer services in the nature of customized web pages featuring user-defined or specified information in the nature of personal profiles, audio, video, photographic images, text, graphics and data; creating and maintaining websites, blogs, online communities relating to art, artists and the art world* on the *Meric* principle.

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<sup>2</sup> Paragraph 30

27. I consider the term *operation of computer software and computer programs* in the opponent's specification can be considered as similar to at least a medium degree to *Providing, running, managing and maintaining online or networked platforms for e-commerce; providing, running, managing and maintaining an online or networked business service aggregator website; providing, running, managing and maintaining an online or networked platform for ordering, reserving and booking third party products or third party services; platform as a service services; hosting on-line web facilities as websites and mobile sites for others for managing and sharing online content; providing search engines for obtaining data via communications networks; computer services, namely, hosting electronic facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks namely, provision of search engines for the Internet; computerised data storage; secure data storage; storage, analysis and retrieval of digital information and data; computerised information storage*. I make this consideration on the basis the applicant's above services are performed under the auspices of computer software and programs so their uses, users and nature overlap to some degree.

28. With regard to the terms *technical writing; consumer product and service testing and consultation; research services; product research; set design services; design of formats for television, video, internet-based and audio-visual media in class 42*; in the applicant's specification, I do not find these are covered by the opponent's services set out in the above paragraphs. These are clearly different services with different users, uses and channels of trade. I find these to be dissimilar to the opponent's services.

29. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that

has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

30. Having found that the applicant’s services, namely *podcasts* in class 9, *educational and instruction services relating to business* in class 41 and *technical writing; consumer product and service testing and consultation; research services; product research; set design services; design of formats for television, video, internet-based and audio-visual media*; in class 42 are not similar to any of the opponent’s earlier goods and services, there can be no likelihood of confusion. Therefore, the opposition to these services fails and is dismissed accordingly.

### **Average consumer and the purchasing process**

31. It is necessary to consider the role of the average consumer and how the goods and services are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

32. 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.”

33. The average consumers for the contested goods and services will be the general public and businesses. Such goods and services are likely to be accessed online for the most part, and through a primarily visual purchasing process, although I do not discount an aural aspect if advice is sought prior to purchase. The prices of the contested goods and services can vary, from an inexpensive journal to the far more expensive provision of a networked platform for e-commerce. The former likely to be purchased by a member of the general public, the latter more likely to be purchased by a business or professional. For those goods which are relatively inexpensive such as a mobile phone app or a journal I find that an average consumer will be paying at least a medium degree of attention during the purchasing process, as they will be browsing the contents to ensure they are relevant before purchase. For more expensive purchases such as a provider to run an e-commerce platform, the consumers level of attention will be higher.

### **Comparison of the marks**

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

35. 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.

36. The respective trade marks to be compared are:

<b>Opponent's mark</b>	<b>Applicant's mark</b>
FOCUS	ART FOCUS

37. Both marks are words with no other aspects to them. The overall impression of the respective marks resides solely in the words. However, given that the applicant's specification positively limits some of its goods and services to "art, artists and the art world", then the word ART plays a more subordinate role as it qualifies the word FOCUS by being a descriptor of the subject matter. For those goods and services not limited in this way, then the words, ART FOCUS, can be considered as a self-contained unit and both words make an equal contribution to the overall impression of the mark

38. Turning first to a visual comparison, the marks clearly share the word FOCUS. It is the entirety of the opponent's mark and the second word element of the applicant's mark. The applicant has the additional word ART as its first word element. Taking this into account, I find there is a medium degree of visual similarity.

39. Regarding any aural similarity, again the marks share the word FOCUS which will pronounced identically. The applicant's mark has an additional first word, not present in the opponent's mark, which also will be pronounced. Factoring this in, I find there is a medium degree of aural similarity.

40. In its written submissions<sup>3</sup>, the opponent contends that the marks are conceptually identical. I agree that the shared word FOCUS will bring to mind the same concept for both marks, i.e. 'the centre of interest'<sup>4</sup>. As previously set out, I find the word ART to be lower in distinctiveness for some of the applicant's goods and

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<sup>3</sup> Paragraph 38

<sup>4</sup> [www.dictionary.com](http://www.dictionary.com)

services (where they have been positively limited) as in conceptual terms it serves as a descriptor to the word FOCUS, by telling the average consumer what subject matter the focus is on. I find there to be a high degree of conceptual similarity. For those goods and services not limited to “art, artists and the art world”, the conceptual similarity for the shared element FOCUS remains and I would pitch the degree of similarity as medium.

### **Distinctiveness of earlier mark**

41. The distinctive character of the earlier mark must be assessed. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

42. As was established earlier in the decision, the opponent stated that it did not intend to rely on evidence of enhanced distinctiveness, so I only have the inherent distinctiveness of the earlier mark to consider. The earlier mark consists of an ordinary dictionary word which does not directly describe to the goods and services for which it is registered. For the majority of goods and services it has a medium degree of inherent distinctive character. For goods and services relating to, in particular, publications, I find that it could allude to a publication which takes an in-depth look at a subject. As such, I find the earlier mark to have a lower than medium degree of distinctiveness for these goods and services.

### **Likelihood of confusion**

43. There is no scientific formula to apply in determining whether there is a likelihood of confusion. 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. It is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer and the nature of the purchasing process for the contested goods. In doing so, I must be aware 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.

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 the marks and the goods and services down to the responsible undertakings being the same or related.

45. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for

which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

46. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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.

47. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, also sitting as the Appointed Person, commented on the passage above, stressing that the examples given by Mr Purvis were just that and should not be taken as akin to a statutory test:

“81.2 ... the reason why the CJEU stressed the importance of the global assessment is, in my view, because it is supposed to emulate what happens in the mind of the average consumer on encountering, for example, the later mark applied for with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.

81.3 ... when a tribunal is considering whether a likelihood of confusion exists, it should recognise that there are four options:

81.3.1 The average consumer mistakes one mark for the other (direct confusion);

81.3.2 The average consumer makes a connection between the marks and assumes that the goods or services in question are

from the same or economically linked undertakings (indirect confusion);

81.3.3 The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);

81.3.4 For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services;

81.3.5 Accordingly, in most cases, it is not necessary to explicitly set out this fourth option, but I would regard it as a good discipline to set out the first three options, particularly in a case where a likelihood of indirect confusion is under consideration.

81.4 ... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: 'Taking account of the common element in the context of the later mark as a whole.' (my emphasis)."

48. So far in this decision I have found that some of the contested goods and services are identical and some services are similar to varying degrees. I also found that the goods and services are primarily purchased visually, though not to discount aural consideration. They may be purchased by the general public who will be paying medium level of attention during the purchasing process and there are some goods and services which may be bought by a business or professional and where a higher degree of attention is likely to be paid. In addition, I have found that the earlier

mark has a lower than medium level of inherent distinctiveness for goods and services relating to publications but has a medium degree of distinctiveness for others. The contested marks are visually and aurally similar to a medium degree. I found that the marks were conceptually similar to a medium degree for those goods and services not limited to “art, artists and the art world” and a high degree for where they are.

49. As matters stand, I do not find there is a likelihood of direct confusion, that is an average consumer is not likely to mistake one mark for the other.

50. However, I do find that there is a likelihood of indirect confusion for those goods and services I found to be identical and similar. Given the nature of the word ART to be a descriptor of the word FOCUS, it is my view that consumers would not regard ART FOCUS as a unit having a different meaning as a whole to the separate meaning of the words. In my view consumers would regard the applied for mark as a sub brand or brand extension of FOCUS, for example as a publication with art as its subject matter. In its submissions dated 3 October 2019 <sup>5</sup> the applicant contends that the conventional form for brands and sub-brands is that the brand precedes the sub brand. I agree this is often the case, but it is also not uncommon for the sub brand or brand extension to precede the brand especially if the sub brand is a descriptor as is the case here. In *Bristol Global Co Ltd v EUIPO*, T-194/14, the General Court held that there was a likelihood of confusion between AEROSTONE (slightly stylised) and STONE if both marks were used by different undertakings in relation to identical goods (land vehicles and automobile tyres). This was despite the fact that the beginnings of the marks were different. The common element – STONE – was sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed.

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<sup>5</sup> Page 3

51. In its submissions<sup>6</sup>, the applicant offered amended specifications for classes 9, 16, 41 and 42 to the extent that the specifications at large would be limited to 'art, artists and the art world'.

52. Where the opponent has broad terms such as in class 9 for *Computer software; computer programs* and for all its services in class 42, I find there is a likelihood of indirect confusion with the goods I identified in paragraph 9 and the services I identified in paragraph 25 as even if the applicant's specifications are limited to *all the aforesaid relating to art, artists and the art world*, those broad terms will still encompass the applicant's limited goods and services.

53. This leaves me to consider the effect of the applicant's proposed limitation to its goods and services in relation to those elements of opponent's goods in class 9 and 16 and services in class 41 which relate to *computer software, computer programs and computer programming*. I remain of the view that the word Art describes the subject matter relating to the goods and services. An average consumer when encountering printed or electronic publications both sharing the word Focus is likely to assume they are from the same stable of publications and relate to niche subject areas. Therefore, even with amended specifications, I still consider there to be a likelihood of indirect confusion.

## **Conclusion**

54. The opposition succeeds for the following goods and services:

*Class 9: Downloadable digital media; downloadable publications; downloadable application software for smart phones for viewing and reviewing material relating to art, artists and the art world; downloadable electronic reports; electronic applications (downloadable); downloadable electronic newspapers; downloadable electronic newsletters; downloadable electronic brochures; downloadable electronic publications; podcasts; downloadable publications in the nature of magazines.*

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<sup>6</sup> Page 3

*Class 16: Printed matter; newsletters; printed newsletters; newspapers; printed educational publications; journals.*

*Class 41: Publishing services; publishing and reporting; publication of newspapers; online publication of electronic newspapers; publication of newspapers, periodicals, catalogues and brochures; publication of newspapers accessible via a global computer network; multimedia publishing of newspapers; multimedia publishing of magazines, journals and newspapers; electronic publication; news reporting; providing on line electronic publications not downloadable; publication of printed matter; publication of educational printed matter; publication of electronic newspapers accessible via a global computer network; providing online videos (non-downloadable); providing non-downloadable electronic publications from a global computer network or the Internet; educational and instruction services; publishing of reviews; organisation of educational events; arranging and conducting of educational events; providing electronic publications; providing online electronic publications; conducting workshops and seminars; provision of information, advisory and consultancy services in respect of the aforesaid services.*

*Class 42: Providing, running, managing and maintaining online or networked platforms for e-commerce; providing, running, managing and maintaining an online or networked business service aggregator website; computerised data storage; secure data storage; providing, running, managing and maintaining an online or networked platform for ordering, reserving and booking third party products or third party services; platform as a service services; hosting on-line web facilities as websites and mobile sites for others for managing and sharing online content; providing search engines for obtaining data via communications networks; computer services, namely, hosting electronic facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; application service provider (ASP) namely software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic text and media or information all relating to art, artists and art world over communication networks; providing temporary use of non downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics*

*and data; computer services in the nature of customized web pages featuring user-defined or specified information in the nature of personal profiles, audio, video, photographic images, text, graphics and data; creating and maintaining websites, blogs, online communities relating to art, artists and the art world; storage, analysis and retrieval of digital information and data computerised information storage; providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks namely, provision of search engines for the Internet; provision of information, advisory and consultancy services in relation to the aforementioned services.*

55. The opposition did not succeed for the following goods and services which can proceed to registration subject to any appeal to this decision. I have included classes 35 and 38 here for the sake of clarity although these classes were not part of the opposition proceedings.

*Class 16: Magazines; periodicals; stationery; writing instruments and implements; drawing instruments and implements; artists' materials, easels, brushes, canvas, pens, pencils, modelling materials.*

*Class 35: Advertising, marketing and promotional services; arranging for the provision of advertising space in newspapers; advertising services relating to newspapers; providing advertising space in periodicals, newspapers and magazines; commercial trading and consumer information services; newspaper subscriptions; business intermediary services; business management and administration services; business introductions; auction house services; talent agency and talent management services; commercial and business exhibitions and trade shows; preparation and compilation of statistics for business; preparation, compilation and writing of business reports; preparation of expert evaluations relating to business matters; provision of information, advisory and consultancy services in respect of the aforesaid services.*

*Class 38: Broadcasting services; video broadcasting; video, audio and television streaming services; streaming of video material on the internet; news agency*

*services; providing on-line electronic bulletin board services and chat rooms; message boards; provision of information, advisory and consultancy services in respect of the aforesaid services.*

*Class 41: Entertainment, educational and cultural services; ghostwriting services; educational and instruction services relating to art, history; organising events for cultural purposes; publication of calendars of events; news reporting; cultural activities; information about entertainment and entertainment events provided via online networks and the internet; arranging and conducting of entertainment and cultural events; educational and instruction services relating to business; booking agency and ticketing agency services; booking of seats and tickets for events; text editing; research for writing (non-publicity, non-advertising); script, song, blog, book, article, screenplay and speech writing and writing of artistic works; custom writing for others (non-publicity, non-advertising); film and audio editing; selection and compilation of audio, video, text and images namely curating content for online publications; arranging and conducting colloquiums, exhibitions, concerts, entertainment events, conferences, congresses, seminars, symposiums, festivals, fairs, shows, workshops; provision of information, advisory and consultancy services in respect of the aforesaid services.*

*Class 42: Consumer product and service testing and consultation; research services; product research; set design services; technical writing; design of formats for television, video, internet-based and audio-visual media; provision of information, advisory and consultancy services in relation to the aforementioned services.*

### **Costs**

56. As the opponent has been largely successful, it is entitled to a contribution towards the costs incurred in these proceedings. I will not consider costs for evidence as it was not used in these proceedings. Awards of costs are guided by Annex A of Tribunal Practice Notice (TPN) 2/2016. Using this guidance, I award the following costs:

£100	Official fee for Opposition
£300	Preparing Notice of Opposition

£400            Preparing written submissions and considering the other side's  
                         submissions

57. I order The Art Newspaper SA to pay Information Builders Inc the sum of £800. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of March 2020**

**June Ralph  
For the Registrar,  
The Comptroller General**