

**O-194-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3424310 BY  
FAIR SPARK BOOKS LTD**

**TO REGISTER:**

**THE SPARK**

**AS A TRADE MARK IN CLASSES 9 & 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001281 BY  
CYBER GROUP STUDIO**

## Background & pleadings

1. On 28 August 2019, Fair Spark Books Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods shown in paragraph 13 below. The application was published for opposition purposes on 20 September 2019.

2. On 19 December 2019, the application was opposed in full under the fast track opposition procedure by Cyber Group Studio (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon an International Registration designating the European Union (“IREU”) no. 1384849 for the words **Sadie Sparks**, which has a designation date of 30 June 2017 (claiming an International Convention priority date of 30 December 2016 from an earlier filing in France) and for which protection was granted on 20 June 2018. The opponent relies upon the goods in classes 9 and 16 of its designation (also shown in paragraph 13 below):

3. The opponent states:

“There is an overlap in goods. It is contended that the respective marks, SADIE SPARKS on the one hand and THE SPARK on the other hand are overall similar. Both marks share the word SPARK(S). The opponent is of the opinion that there is a risk of confusion.”

4. The applicant filed a counterstatement in which the basis of the opposition is denied.

5. In these proceedings, the opponent is represented by Naomi Aaronson; the applicant is represented by LawBriefs Ltd.

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. In an official letter dated 30 January 2020, the parties were allowed until 13 February 2020 to seek leave to file evidence or request a hearing and until 27 February 2020 to provide written submissions. In a further official letter dated 9 March 2020, the tribunal stated:

“I write with reference to the Registry’s letter dated 30 January 2020 and the email correspondence received from the parties on 27<sup>th</sup> and 28<sup>th</sup> February 2020.

After considering the content of these e-mails it is the Registry’s view that this matter should proceed to a decision as per the fast track process. It is unclear what the discussions between the parties amounted to, however it is clear that we are now in a position where nothing has been received from either party in terms of submissions as per the direction given in the 30th January letter.”

I note that neither party sought to challenge the approach adopted above.

## **DECISION**

9. The opposition is based upon section 5(2)(b) of the Act, which reads 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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

10. 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) a European Union 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

11. The designation upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been protected for more than five years at the date the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, as a consequence, entitled to rely upon it in relation to all of the goods indicated without having to prove that genuine use has been made of it.

## Section 5(2)(b) – case law

12. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings 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

13. The competing goods are as follows:

<b>The opponent's goods</b>	<b>The applicant's goods</b>
<b>Class 9</b> Photographic, cinematographic and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic recording media; sound recording disks; compact disks (audio-	<b>Class 9</b> Electronic magazines. <b>Class 16</b> Magazines.

video); optical disks; optical compact disks; sound recording disks; interactive CD-ROMs; software (recorded programs); video games (software); DVDs with animated film series for television, the Internet, the movies.

**Class 16**

Photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional or teaching material (except apparatus); printing type; printing blocks; paper; cardboard; boxes of cardboard or paper; posters; albums; cards; books; newspapers; prospectuses; pamphlets; calendars; writing instruments; graphic prints; drawing instruments; handkerchiefs of paper; face towels of paper; table linen of paper; toilet paper; bags and small bags (envelopes, pouches) of paper or plastic for packaging.

14. 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:

“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”.

15. 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.

16. As the applicant notes, other than to state that “there is an overlap in goods”, the opponent has done nothing to explain where it considers that overlap to exist. In its counterstatement, the applicant further states:

“15. The Applicant operates in a niche market and its goods comprise solely of magazines (both in hard copy and electronic format), whereas the Opponent's goods relate to a much wider spectrum of products, none of which are or involve magazines. None of the respective goods can fairly be said to be similar in nature, intended purpose, distribution channels, method of use or consumer market.”

17. Without submissions from the opponent to assist me, I agree with the applicant that none of the terms in the opponent’s specification in class 9 appear to relate to or ought to be regarded as including electronic magazines. Rather, in my view, the opponent’s best prospect of success lies in relation to the following goods in its class 16 specification i.e. “books”, “newspapers”, “prospectuses” and “pamphlets”. If one compares the opponent’s “newspapers” with the applicant’s “magazines” in class 16, the physical nature is the same, as are the users, the intended purpose, the method

of use and the trade channels. The opponent's "newspapers" are, in my view, highly similar to the applicant's "magazines". As it is a notorious fact that both newspapers and magazines are made available in both traditional hard copy and electronic form, by parity of reasoning, the applicant's "electronic magazines" in class 9 are also to be regarded as highly similar to the opponent's "newspapers" in class 16.

### **The average consumer and the nature of the purchasing process**

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which such goods 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."

19. The average consumer of the goods at issue is a member of the general public. As such a consumer will, for the most part, self-select such goods from the shelves of a bricks-and-mortar retail outlet or from the equivalent pages of a website, visual considerations will dominate the selection process. While such goods may also be the subject of, for example, oral requests to sales assistants, aural considerations are likely to be a far less significant feature of the selection process.

20. As to the degree of care the average consumer will display when selecting the goods at issue, the goods are likely to be inexpensive and bought fairly frequently. However, as the average consumer will wish to ensure the publication they are

selecting suits their specific needs and preferences, they can, in my view, be expected to pay a between low and medium degree of attention to their selection.

### Comparison of trade marks

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

“.....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.”

22. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The competing trade marks are as follows:

The opponent's trade mark	The applicant's trade mark
Sadie Sparks	

23. The opponent's trade mark consists of the words "Sadie" and "Sparks" presented in title case. The words form a unit which, I am satisfied, will be understood by the

average consumer as a feminine personal name. It is in that unit the overall impression and distinctiveness lies.

24. The applicant's trade mark consists of a number of components. The first, is the word "THE" presented in a vertical orientation in a bold, slightly stylised, but unremarkable script. Although the word "THE" is relatively small and has no distinctive character, in the applicant's trade mark it performs the function of an intensifier. The second component is the word "SPARK" also presented in a bold, slightly stylised script and in which the letter "A" includes a device of a star presented in white. Even if, despite its size, the star device is noticed by the average consumer, given the propensity of those engaged in all areas of trade to use such devices, any contribution it may make to the overall impression conveyed and distinctiveness is, in my view, at best, low. Rather, given its size within the context of the trade mark as a whole, it is the emboldened and slightly stylised word "SPARK" that will make by far the greatest contribution to both the overall impression the applicant's trade mark conveys and its distinctiveness. I will bear those conclusions in mind in the comparison which follows.

### **Visual comparison**

25. The competing trade marks coincide in the respect they both contains the word "SPARK"/"Spark", albeit in the opponent's trade mark there is an additional letter "s" at the end of the word. They differ to the extent that the opponent's trade mark contains the word "Sadie", whereas the applicant's contains the definite article "THE" and the star device in the letter "A". Although the applicant's trade mark is presented in a bold, slightly stylised font, as notional and fair use of the opponent's trade mark would include presentation in a similar manner, that is not a point that assists the applicant. Weighing the similarities and difference results in what I regard as a fairly low degree of visual similarity between the competing trade marks.

### **Aural similarity**

26. As all of the words in the competing trade marks will be known to the average consumer, how they will be articulated is fairly predictable i.e. the opponent's trade

mark as the three syllable combination “Sa-die Sparks” and, as the star device in the applicant’s trade mark is most unlikely to be verbalised, the applicant’s as the two syllable combination “THE SPARK”. That, in my view, results in a medium degree of aural similarity.

### **Conceptual similarity**

27. As I mentioned earlier, the opponent’s trade mark will be conceptualised as the name of a person. In its counterstatement, the applicant states:

“11. Conceptually, the Applicant's Mark would be perceived as meaning the common term referring to a small glowing particle or ember or a form of electrical discharge...This *is* consistent with the use of the glowing star shape within the letter 'A'...”

28. Whereas the word “Sparks” in the opponent’s trade mark will be conceptualised as surnominal in nature, the presence of the word “THE” before the word “SPARK” in the applicant’s trade mark is, in my view, most likely to result in the word “SPARK” being construed as a verb meaning “the first thing causes the second to start happening” (collinsdictionary.com) as in “What was it that sparked your interest in...” (also Collinsdictionary.com). In my view, the competing trade marks are conceptually dissimilar.

### **Distinctive character of the earlier trade mark**

29. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings -

*Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

30. As the opponent has filed no evidence of any use it may have made of the trade mark upon which it relies, I have only its inherent characteristics to consider. Personal names are one of the oldest forms of trade marks. As both “Sadie” and “Sparks” are, I am satisfied, likely to be regarded by the average consumer as fairly unusual, absent use, the opponent’s trade mark is possessed of an above medium degree of inherent distinctive character.

### **Likelihood of confusion**

31. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related. Earlier in this decision I concluded:

- The competing goods are highly similar;
- The average consumer is a member of the general public who, whilst not forgetting aural considerations, is likely to select the goods by predominantly

visual means whilst paying a between low and medium degree of attention during that process;

- The competing trade marks are visually similar to a fairly low degree, aurally similar to a medium degree and conceptually different;
- The earlier trade mark is possessed of an above medium degree of inherent distinctive character.

33. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

34. In *Nokia Oyj v OHIM*, Case T-460/07, the GC stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

35. The fact that: (i) the competing goods are similar to a high degree, (ii) the opponent’s trade mark possesses an above medium degree of inherent distinctive character and, (iii) the average consumer will pay only a low to medium degree of attention during the selection process (thus making him/her more prone to the effects of imperfect recollection), are all points in the opponent’s favour. However, notwithstanding the medium degree of aural similarity between the competing trade marks, the fairly low degree of visual similarity together with the differing conceptual messages the competing trade marks are likely to convey are, in my view, more than sufficient to avoid a likelihood of either direct or indirect confusion.

## **Conclusion**

**36. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.**

## **Costs**

37. As the applicant has been successful, it is entitled to an award of costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Applying the guidance in that TPN and reminding myself that the applicant incurred no official fees in the defence of its application, I order Cyber Group Studio to pay to Fair Spark Books Ltd the sum of **£200** in respect of its consideration of the Notice of opposition and the filing of a counterstatement. This sum is to be paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 27<sup>th</sup> day of March 2020**

**C J BOWEN**

**For the Registrar**