

O-242-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 829549  
BY HACHETTE FILIPACCHI (UK) LTD TO REGISTER  
THE TRADE MARK RED  
IN CLASSES 9, 16, 38 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION No 71442  
BY MAJOR LEAGUE BASEBALL PROPERTIES INC**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF International Registration No 829549  
by HACHETTE FILIPACCHI (UK) LTD to register the trade mark  
RED in Classes 9, 16, 38 and 41**

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**IN THE MATTER OF Opposition No 71442 by  
MAJOR LEAGUE BASEBALL PROPERTIES INC**

1. On 13 May 2004 Hachette Filipacchi (UK) Ltd, on the basis of a French registration with a priority date of 5 December 2003, requested protection in the UK under the terms of the Madrid protocol for the mark RED. The request was made in relation to the following goods and services:

Electronic magazines (downloadable).

Magazines.

Communications via computer terminals; computer-aided communication and transmission of messages and images; television program broadcasting; television programs, cable television; news agencies.

Editing services, publication of magazines, online electronic publishing of magazines; organization of competitions (education and entertainment); photographs, photographic reporting; news reporters services; televised entertainment.

2. These goods and services are in Classes 9, 16, 38 and 41 of the International Classification system.

3. The Registry considered that the request satisfied the requirements for protection and particulars of the international registration were published for opposition purposes.

4. The Journal publication recorded that the international registration had proceeded on the basis of distinctiveness acquired through use and honest concurrent use with a third party's registration. It also recorded that there had been consent from the proprietors of a number of other registrations.

5. On 12 January 2007 Major League Baseball Properties Inc filed notice of opposition to the conferral of protection on this international registration citing a single ground of opposition based on Section 5(2)(b) of the Act. In support of this ground it relies on two registrations, details of which appear below:

No  
2248071

Mark



Class(es)  
41

2248180

CINCINNATI REDS

9,16 and 41 (relevant  
Classes only)

6. I will come to the detail of the goods and services relied on later in the decision.

7. Neither of these registrations had been on the register for five years at the date of publication of the international registration so the opponent was not required to show proof of use.

8. The international registration holder (whom for convenience I will simply refer to as the applicant hereafter) filed a counterstatement denying the above ground. The counterstatement claimed that the applicant had been using the mark RED in the UK in relation to the goods and services claimed since at least 1998 and claimed the benefit of section 7 of the Act (this honest concurrent use claim has not been pursued).

9. Only the opponent has filed evidence. Neither side has asked to be heard. Both sides have filed written submissions. In the case of the opponent these were under cover of a letter dated 28 July 2008 from Page Hargrave and in the case of the applicant under cover of a letter dated 28 May 2008 from Potter Clarkson LLP. It seems that the parties were at one stage engaged in discussions with a view to a negotiated settlement but have been unable to reach a resolution of the matter. Acting on behalf of the Registrar I, therefore, give this decision.

### **The evidence**

10. Keith Francis Gymer, a Registered Trade Mark Attorney, with Page Hargrave, authorised to represent the opponent has filed a witness statement with six exhibits. The evidence is mainly material drawn from the Registry's file showing correspondence from the Examiner (and material used by him) and some of the exhibits filed by the applicant as part of its evidence tendered at the examination stage in support of the request for protection. I do not propose to say anything more about this material at this stage but will refer to it where necessary in my decision below.

## DECISION

### Section 5(2)(b)

11. The relevant part of Section 5(2) of the Act is as follows:

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

(a) –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

12. On 27 April 2006, the European Court of Justice (ECJ) handed down a reasoned Order disposing of the appeal in Case C-235/05P *L’Oreal SA v. OHIM*. The relevant legal principles, drawn principally from the Court’s earlier judgments in *Sabel* [1998] RPC 199, *Lloyd Schuhfabrik Meyer* [2000] FSR 77 and *Canon* [1999] RPC 117 are set out in that Order, the relevant part of which is re-produced below:

“34 It is settled case-law that likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 18; and order of 28 April 2004 in Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657, paragraph 28).

35 That global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Thus, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. Accordingly, it is necessary to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the assessment of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services covered (see *Canon*, paragraph 17, and *Lloyd Schuhfabrik Meyer*, paragraph 19).

36 In that regard, as the more distinctive the earlier mark, the greater the risk of confusion (*SABEL*, paragraph 24), marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (see *Canon*, paragraph 18, and *Lloyd Schuhfabrik Meyer*, paragraph 20).

.....

- 40 In the first place, it is settled case-law that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed (see *Lloyd Schuhfabrik Meyer*, paragraph 27).
- 41 In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (see *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25, and the order in Case C-3/03 P *Matratzen Concord v OHIM*, paragraph 29).”

13. This is a case where the two earlier trade marks relied on by the opponent are quite different in character. They have specifications that overlap in terms of Class 41 services but, in the case of No 2248180, also extend into other Classes. Not surprisingly, this state of affairs gives rise to different issues requiring me to give separate consideration to the opponent’s position based on each of its earlier trade marks.

#### **The opponent’s position based on No. 2248071**

14. The marks in issue are

Applicant’s  
RED



15. In terms of distinctive and dominant components the applied for mark is a single word (most likely to be seen as the name of a colour) and does not call for further comment. The opponent’s mark is described in its written submissions as a stylised wishbone C surrounding the word REDS. It is further submitted that, as there is no recognised English word CREDS, the average consumer will perceive the mark as essentially the mark REDS.

16. Beyond referring to the opponent’s mark as a stylised REDS (counterstatement) or REDS device (written submissions) the applicant has not commented on the distinctive and dominant components of No 2248071.

17. The element REDS is visually contained within and, on that narrow basis, may be said to be subordinate to, the device element of the mark. My own initial impression

was that the so-called wishbone C was not a letter but rather an abstract device. I was influenced in that by the uncharacteristic shape (in terms of a letter C) and pointed extension to the left side of the device. However, I accept that some people may more readily see in the device a stylised letter C. The opponent's submissions indicate that in fact the REDS element is the (abbreviated) name of the Cincinnati Reds professional baseball club. (I tread warily here because the written submissions stray into giving evidence). For those in the know, therefore, the surrounding device is indeed likely to be seen as a C standing for Cincinnati. I am less convinced that the generality of consumers will appreciate this. For that to be so I would have to assume a narrow but well informed consumer base of those with a particular interest in, and knowledge of, US baseball teams.

18. It is not a point on which I need to dwell. Whether the device is seen as an abstract design or a stylised letter C, it cannot be ignored in the context of the mark as a whole. It is not descriptive of the services and it is a lot more than a simple border or background device.

19. I also accept the opponent's submission that the element REDS has independent distinctive character within the composite mark (per *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04) and would represent the easiest reference point in the mark in oral use. The distinctive character of the mark as a whole, therefore, resides in the word REDS, the stylised (C) device and the particular configuration of these elements.

20. Turning to the similarity between the respective marks, the opponent has referred me to a number of decisions where the only effective difference was the presence or absence of a final letter S. These are *IDG Communications Ltd's Trade Mark Application* [2002] R.P.C. 10 (DIGIT/digits), *Origin Natural Resources Inc v Origin Clothing*, [1995] F.S.R. 280 (Origins/Origin) and OHIM Opposition Decision 4242/2004 (MET/METS).

21. Whilst I note the outcome of these cases they cannot be determinative of the similarity of the marks before me bearing in mind the composite nature of the earlier trade mark. I also bear in mind that RED is normally encountered as an adjective signifying a colour. As such it would not normally be pluralised and encountered in isolation as REDS. On the other hand the visual, aural and conceptual similarity between RED and REDS is undeniable and compounded when allowance is made for use of the applied for mark in the possessive or plural form. Notwithstanding the presence of the device and overall visual arrangement of the elements in the earlier trade mark I find that there is reasonable degree of similarity between the respective marks. In coming to this view I have noted the opponent's submission (by reference to certain exhibits in the evidence filed by the applicant after examination stage) that the mark predominantly used by the applicant is the word RED in a particular script form and not the plain block capital form applied for. I have based my above view on notional and fair use of the mark in the form applied for.

22. The services that are the subject of the opponent's mark No. 2248071 are as follows:

Entertainment, education and information services; baseball games, competitions and exhibitions rendered live, through broadcast media including television and radio and via a global computer network or a commercial on-line service; providing information in the field of sports, entertainment and related topics, providing multi-user interactive computer games, and providing for interactive exchange of messages and information, all via a global computer network or a commercial on-line service (not being telecommunications services).

23. The opponent submits that the applicant's Class 38 and Class 41 services are identical or closely similar to the above. Furthermore, it is said that in so far as "information services" and "providing information in the field of sports, entertainment and related topics" including "via a computer network" may typically be conducted via printed or electronic media including magazines, the Class 41 services of No 2248071 are also similar to the applicant's "electronic magazines (downloadable)" (Class 9) and "magazines" (Class 16). Before turning to my own analysis of the similarities in the goods and services I should briefly touch on the opponent's observation in its written submissions that "[A]s noted in the Search Report (KFG3) [to Mr Gymer's witness statement] the Class 41 specifications of UK 2248071 are automatically considered relevant to cross-searched Classes 16 and 38". The document referred to is a report from the examination file resulting from the examiner's search for potentially conflicting marks and is divided between 'citations' and 'precedents'. The document gives Class numbers only.

24. The search system used by examiners is intended as an aid to focus attention on potential areas where goods and services may be considered similar. But it is no more than a guide. It is not an exhaustive list. Examiners will use their discretion in determining the extent of their search. Equally, the mere fact that one Class cross searches to another does not render all goods or services in those Classes similar. The registry also makes available a cross search list that gives an indication of the specific goods or services within the Classes concerned where similarity may be considered to exist. I have not been told in this case what particular goods and services are the subject of the cross search between Classes 41 and 16 and 38. Exhibit KFG3 sheds no light on the matter as it merely refers to Class numbers. In any case, the matter falls to be considered afresh when an issue arises in an *inter partes* action.

25. The leading authorities on how to go about determining similarity between goods and services are accepted to be the *Canon* case (*supra*) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case 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.

26. These criteria are, of course, intended to be of general applicability but not all are equally relevant in all circumstances ((e) above being an obvious example of an inapplicable criterion where services are concerned). I also bear in mind it was held in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 that:

“... definitions of services... are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as “boots and shoes.”

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

27. Starting with the applicant's Class 41 services, it is reasonably clear that the following are identical - 'organisation of competitions (education and entertainment);...televised entertainment' (applicant's) and 'entertainment, education.. services;...competitions.... rendered live' (opponent's). If, because the specifications have been drafted in slightly different terms, they are not identical then they are nevertheless closely similar.

28. The balance of the applicant's Class 41 services covers 'Editing services, publication of magazines, online electronic publishing of magazines; photographs, photographic reporting; news reporters services'. (I might just add in passing that it is not clear why 'photographs' are included in this Class). I find little in the written submissions of the opponent that is helpful in explaining how the application of the *Canon*, *Treat* and *Avnet* criteria would result in these services being found to be similar to those of the opponent. My sense of the opponent's case is that it regards information services as in some way touching on some or all of these other services. In the absence of evidence or submissions as to why that should be the case I am not prepared to accept that there is a real commercial connection between such services. I comment further on information services below.

29. The applicant's Class 38 services are, by the nature of the Class they are in, concerned with the means of communication rather than content. To the extent that 'television programs' appear in the specification it must refer to the diffusion or dissemination of such programmes. A number of the major players (the BBC for instance) are engaged in both broadcasting and the production of programme content. Thus, there would in some cases be a shared and complementary purpose and common end users. Beyond that I do not have evidence bearing on the prevalence of this practice. I think it is right to allow for some similarity between the opponent's 'entertainment services' (which would include broadcast entertainment services) and 'television program broadcasting; television programs, cable television'.

30. The applicant's other services in Class 38 have no obvious similarities with the opponent's Class 41 services. I hesitate only as regards 'news agencies'. Is that similar to an information service? I have not been told what the nature and purpose of an information service is, who its customers are likely to be and what if any its relationship is with news agency services. They do not strike me as interchangeable terms. It may be said that at a very general level a news agency provides information (but so does a recipe card for instance - would that make that item similar to an information service?). There may be some overlap in the customer bases of news agency services and information services and some complementarity but on *Avnet* principles, and without knowing more about the nature of information services I would be unwilling to accept that there was more than a low degree of similarity.

31. I have recorded above the opponent's submission as regards similarity between its information services (including such services provided via a computer network) and the applicant's magazines and electronic equivalent. Information services occur in all the service Classes and are in principle classified according to the main subject matter of those Classes. Thus, business information services are in Class 35, financial information services are in Class 36 and so on. If the opponent is right as regards the commercial connection between its Class 41 information services and magazines, it would follow that information services generally would, or at least could, be similar to magazines at large. That would create an extremely broad penumbra of protection around a term of somewhat indeterminate scope. The reality of the position is that there is no evidence pointing to common uses, users, intended purpose, channels of trade.

32. Nor does there appear to be any natural synergy between these goods and services. There have been a number of judgments of the Court of First Instance dealing with the issue of complementarity, mostly involving goods. Thus, in *Mülhens GmbH & Co KG v OHIM*, Case T-150/04 the Court recognised that goods may be aesthetically complementary but that "this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together." In *Alecansan, SL v OHIM*, Case T-202/03 the CFI noted (without disapproving) the position adopted in the OHIM Opposition guidelines:

“46 As regards the complementary nature of the goods and services, it must be pointed out that, according to the definition given by OHIM in point 2.6.1 of Part 2, Chapter 2, of the Opposition Guidelines of 10 May 2004, goods or services are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or for the provision of those services lies with the same undertaking (see also that effect Case T-85/02 *Diaz v OHIM* [2003] ECR II-4835, paragraph 36).”

33. It is clear from these cases that complementarity is not to be viewed in too broad a sense. There must be some natural functional, technical, aesthetic link between, or other feature of, the goods or services that leads consumers to think the goods or services will be marketed, sold or used together. Furthermore, complementarity may not be enough in itself to establish that goods or services are similar.

34. Against all this, it may be said that part of the purpose of a magazine is to convey information so some slight similarity of purpose and complementary nature cannot be entirely ruled out despite the lack of evidence on the point. Taking the matter in the round and bearing in mind the cautionary guidance in *Avnet*, any similarity seems to me to be slight though I am not prepared to say it is entirely negligible.

35. Likelihood of confusion is a matter of global appreciation taking all relevant factors into consideration. There is a greater likelihood of confusion when the earlier mark has a highly distinctive character either as a result of its inherent qualities or through use. I have held that there is a reasonable degree of similarity between the competing marks. The opponent has not made any claims to an enhanced distinctive character through use.

36. The *Canon* case requires me to bear in mind that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. Sequential as opposed to concurrent contact with the respective marks by consumers must also be allowed for (and hence imperfect recollection). Giving appropriate weight to all relevant factors I find that there is a likelihood of confusion as regards identical or closely similar services but, allowing for the differences as well as the similarities in the marks, there is no such likelihood (direct or indirect) where there is greater distance between the opponent's services and the applicant's goods and services.

37. Accordingly, the opponent succeeds on the basis of its earlier trade mark No. 2248071 in relation to the following of the applicant's services:

“Organisation of competitions (education and entertainment); televised entertainment”.

but fails against the balance of the applied for services in Class 41 and the goods and services in Classes 9, 16 and 38.

## The opponent's position based on No. 2248180

38. The comparison of marks here is:

Applicant's mark

Opponent's mark

RED

CINCINNATI REDS

The opponent's written submissions claim widespread awareness of the CINCINNATI REDS in the UK. Even those with no great interest in, or knowledge of, North American sports are likely to be aware that the professional sports teams have names that are usually composed of the town or city they represent and a second element that is a nickname. It is a practice that pervades major US and Canadian sports (baseball, American football, basketball, ice hockey etc). I have little doubt that CINCINNATI REDS would be understood for what it is intended to be, that is the name of a sporting team from Cincinnati. Those with an interest in such things are likely to know it is a baseball team. Others, myself included, would have understood the nature of the designation but without necessarily knowing to which sport it related (I distinguish this mark from the 'REDS' mark of No. 2248071 as it is only knowledgeable fans who are likely to recognise the nickname when it is divorced from its geographical link). The distinctive character of the mark, therefore, resides in the combination.

39. It also follows that I regard CINCINNATI REDS to be conceptually dissimilar to the mark RED.

40. The European Courts have held that conceptual differences between trade marks can be of importance. Thus in Case C-361/04P (*Picaro/Picasso*) the ECJ noted the following paragraph in the CFI's judgment:

"Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately [Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel* (BASS) [2003] ECR II-4335, paragraph 54]."

and approved the point in paragraph 20 of its own judgment.

41. Nevertheless, the opponent's written submissions say:

"By analogy with the THOMSON LIFE decision, therefore, and having regard to consideration of "all relevant factors" (after *Sabel BV v Puma AG*), including that the CINCINNATI REDS will be recognised by relevant consumers as "REDS" and known to have REDS marks (ie the REDS logo), it is justifiable to conclude that there can be a likelihood of confusion between the Hachette RED mark and the mark CINCINNATI REDS. Consumers will simply consider that the geographic location has been dropped, with the RED/REDS performing "an independent distinctive role".

42. That is not, in my view, an appropriate way to approach the comparison of marks. For any consumers who do not appreciate the sporting team significance of the words CINCINNATI REDS (a small number in my view), there is no reason to suppose they would choose to drop or ignore the geographical indication. They would simply regard it as an unusual collocation of words. For those with some awareness of the way in which North American sporting teams are wont to style themselves, it will be appreciated that the second element is a nickname. To the extent that that gives REDS independent distinctive character it comes in the full knowledge of what the full name is and the fact that the team name is not abbreviated to RED (the opponent's submission that an individual player may be known as a RED does not alter that view of the matter).

43. Either way there is a very low level of visual and aural similarity between the marks and, I would hold, no conceptual similarity.

44. Turning to a comparison of the goods and services, the position in relation to the parties' services is substantially the same as for No 2248071. The position in relation to goods is rather different. The opponent's Class 16 specification contains identical goods to the applicant's magazines. Furthermore, 'electronic magazines (downloadable)' in Class 9 of the applied for specification are closely similar to magazines in the opponent's Class 16 specification. One is merely the electronically downloadable equivalent of the other.

45. In summary, the distinctive character of CINCINNATI REDS resides in its totality. That is particularly so for those (the majority) who will recognise that it is the name of a sports team. For those who do not (to the extent that it is necessary to make allowance for this possibility), it will be seen as a somewhat unusual juxtaposition of words (but without either being dominant). The combination enjoys a reasonably high degree of distinctiveness on either account. As with the REDS and device mark there is no evidence of use in the UK such as might further improve the position. Whilst it must be acknowledged that there are identical goods and services, the differences between the marks are so pronounced that there is no likelihood of confusion. The opposition fails in so far as it is based on No 2248180.

## **Conclusion**

46. The opposition has succeeded against the following:

“Organisation of competitions (education and entertainment); televised entertainment.” (Class 41)

but failed in respect of the other goods and services.

## **Costs**

47. Although the opponent has achieved a small measure of success, the applicant has succeeded in relation to a large part of the specification put forward for protection. Reflecting that state of affairs I order the opponent to pay the applicant £750 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 22 day of August 2008**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**