

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3441070



(A SERIES OF TWO TRADE MARKS)

IN THE NAME OF BING LIN

AND

AN APPLICATION FOR INVALIDATION

UNDER NO. 503150

BY CUONO ROMANO

Background and pleadings

1. Bing Lin (“the proprietor”) owns the registration as shown on the cover page for a series of two trade marks. The trade marks are registered for the following services:

Class 41 Arranging, organising and conducting of dance events, contests, competitions, displays, performances and exhibitions; judging and officiating services for dance contests and competitions; arranging, organising and conducting of award ceremonies relating to dancing; dance training and testing; provision of dance facilities; educational services relating to dancing; dance instruction; provision of information relating to dancing; booking and ticketing services for dance events, contests, competitions, displays, performances and exhibitions; production of video recordings and sound recordings featuring dancing and dance-related events and activities; issuing of publications relating to dance; providing electronic publications relating to dance; information, advisory and consultancy services relating to all of the aforesaid.

The application to register the marks was filed on 1 November 2019, and the marks entered in the register on 27 March 2020.

2. On 27 May 2020, Cuono Romano (“the applicant”) applied for a declaration of invalidity against all the services in the registration by filing a form TM26(l) based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The applicant relies upon the following European Union (“EU”) trade mark:

Mark:



Registration No. 018060660

Filing date: 6 May 2019

Registration date: 31 August 2019

Services:

Class 41 Publishing and reporting; Education, entertainment and sport services; Translation and interpretation; Education, entertainment and sports.

3. The applicant argues that there is a likelihood of confusion, including a likelihood of association because the competing marks are similar, and the services are identical or highly similar.
4. Given its date of filing, the trade mark upon which the applicant relies qualifies as an earlier trade mark under section 6 of the Act.
5. The proprietor filed a counterstatement denying the grounds of invalidation.
6. The proprietor is represented by Wilson Gunn and the applicant is represented by Tennant IP. Only the applicant filed submissions. No hearing was requested. I make this decision after a careful reading of all the papers filed by the parties.

Surrender of the contested trade marks

7. On 3 March 2021, the proprietor filed a form TM22 giving notice of surrender of the contested trade marks for all the services in Class 41. The Registry actioned the form, and the surrender took effect on 17 March 2021. The surrender of the proprietor's trade mark does not render the pending cancellation proceedings invalid because the surrender does not have a retrospective effect.¹ On 17 March 2021, the Registry notified the parties that the cancellation proceedings would continue unless the applicant withdraws the application. In the absence of a response from the applicant on the withdrawal of the application, I must decide the matter on its merits. As the cancellation application is directed

¹ See O-170-07 (*Rapier* Appeal Decision)

against all the services in Class 41, if successful, proceedings will result in removing the contested registration from the Register as if it had never been registered.

Section 5(2)(b)

8. Section 5(2)(b) of the Act is 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”.

Case law

9. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *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 the mark as a whole and does not proceed to analyse its various details;

(d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) Nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

10. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer.

11. 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”.

12. The applicant's services, broadly speaking, cover education, entertainment, publication and sports. While the publication services are most likely to be provided to those in business, the average consumer of the remainder of the services are likely to be the general public. The applicant's education, entertainment and sports services are extremely broad and would encompass services ranging from, for example, providing training in relation to dancing to staging a concert or sporting event and providing an entertainer for birthday parties. The selection of all the services is likely to be predominantly a visual one, involving, for example, perusal of websites, brochures, advertisements in

print or electronic media. There may also be aural considerations, for example, when the choice is informed by oral recommendations. The average consumer of publishing services comprising of business users are likely to pay a fairly high degree of attention. The average consumer's level of attention for the remainder of the services is likely to vary from medium to fairly high depending on the cost and nature of the service being selected.

13. The proprietor's services are mainly related to dance events and activities, and the average consumer is a member of the general public with, broadly speaking, an interest in dance. The services are most likely to be selected from, for example, websites or from promotional materials. However, I do not discount the possibility of aural considerations where selection is made further to word-of-mouth recommendations. Although the costs of the services are not likely to be very high, the average consumer is likely to ensure to select events that suits his/her particular taste. I would expect the average consumer to pay a medium degree of attention to the selection process.

Comparison of services

14. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

"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. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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 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. In *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, however, Jacob J stated:

“In my view, specifications for services should be scrutinised carefully 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.”

17. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

“[...] 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 those goods lies with the same undertaking”.

18. It is an established case law that services can be considered as identical when the services designated by the earlier mark are included in a more general category, designated by the trade mark application - and vice versa.²

19. The competing services are as follows:

Applicant’s services	Proprietor’s services
<p><u>Class 41</u> Publishing and reporting; Education, entertainment and sport services; Translation and interpretation; Education, entertainment and sports.</p>	<p><u>Class 41</u> Arranging, organising and conducting of dance events, contests, competitions, displays, performances and exhibitions; judging and officiating services for dance contests and competitions; arranging, organising and conducting of award ceremonies relating to dancing; dance training and testing; provision of dance facilities; educational services relating to dancing; dance instruction; provision of information relating to dancing; booking and ticketing services for dance events, contests, competitions, displays, performances and exhibitions; production of video recordings and sound recordings featuring dancing and dance-related events and activities; issuing of publications relating to dance; providing electronic</p>

² *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, case T-133/05

	publications relating to dance; information, advisory and consultancy services relating to all of the aforesaid.
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Arranging, organising and conducting of dance events, contests, competitions, displays, performances; arranging, organising and conducting of award ceremonies relating to dancing

20. The term entertainment services in the cancellation applicant's specification *per se* is a broad term and is likely to include all services offered to entertain audience. As arranging, organising and conducting of dance events, contests, competitions, displays, performances and award ceremonies relating to dancing in the proprietor's specification encompass those services intended to provide entertainment, I find that the competing services are identical under the *Meric* principle.

Arranging, organising and conducting of exhibitions

21. The proprietor argues that the above-mentioned services in its specification are neither identical nor highly similar to the applicant's services. I disagree. As exhibitions are organised to attract and entertain audiences, the proprietor's specification falls within the applicant's entertainment services. The competing services are identical under the *Meric* principle.

Judging and officiating services for dance contests and competitions

22. These services under the contested registration differ in their nature and purpose with the applicant's entertainment services. The proprietor's services concern judging and officiating contests while the applicant's services are aimed at entertaining audiences. The proprietor's judging and officiating services may be offered in relation to entertainment services in the form of dance contests and competitions. Judging and officiating services, in those circumstances, are important for dance contests and competitions. The average consumer is also likely to think that the undertakings that arrange

dance competitions as a part of their entertainment service may also be responsible for identifying judges to judge and officiate such contests or competitions. On that basis, I find that the competing services are complementary in the sense described by the case law. Their trade channels are likely to overlap and so are the users. The services do not compete. Considering these factors, I find that the competing services are similar to a medium degree.

Educational services relating to dancing; dance training and testing; dance instruction

23. Educational services in the applicant's specification is broad enough to include educational services relating to dancing, dance training and testing and dance instructions in the proprietor's specification. The competing services are identical under the *Meric* principle.

Provision of dance facilities

24. The proprietor's above-mentioned services are likely to cover services of providing facilities for dancers to learn or rehearse. The nature and purpose of the proprietor's services are different from the opponent's entertainment services. The proprietor's services are likely to be important for entertainment services in the form of dance events and the average consumer is likely to think that the same undertaking responsible for providing facilities such as dance studios may also be responsible for conducting dance events. The competing services are, therefore, complementary in the sense described by the case law. The channels of trade and users are likely to coincide. The services do not compete. Considering these factors, I find that the competing services are similar to a medium degree.

Provision of information relating to dancing

25. These services covered by the proprietor's registration are closely associated with educational services covered by the applicant's specification. The

providers of educational services in the field of dance is likely to provide information about it. The competing services are, therefore, complementary in the sense described by the case law. The channels of trade are shared, as are the users. The nature and purpose of the competing services differ. The services do not compete. Considering these factors, I find that the services are similar to a medium degree.

Booking and ticketing services for dance events, contests, competitions, displays, performances and exhibitions

26. The above-mentioned services are provided to customers wishing to purchase tickets to book seats for dance related events. The nature, purpose and method of use of the proprietor's services varies from entertainment services of the earlier mark. Although these services may include a third-party arranging booking as a standalone service on behalf of undertakings offering entertainment services related to dance, the same service may, for example, be offered directly by those undertakings themselves. There is a degree of complementarity because the booking and ticketing services may be important for entertainment services as a means to sell tickets, and the average consumer is likely to think that the services originate from the same undertaking. The channels of trade will coincide, and the users will be the same (the audience). The competing services are similar to a medium degree.

Production of video recordings and sound recordings featuring dancing and dance-related events and activities

27. I have already concluded that the entertainment services covered by the earlier mark is wide enough to include all services offered to entertain audiences. The nature of these services, however, differ from the proprietor's production of video and sound recordings. Broadly speaking, the competing services may share similar purpose as video or sound recordings featuring dance related activities are likely to be produced for entertaining audiences. The proprietor's services may be important for the applicant's entertainment services in the form of television programmes on dance events in that a television programme must

be produced before it can serve its function to entertain. The average consumer is also likely to think that both services originate from the same undertaking. On that basis, I find that the competing services are complementary in the sense described by the case law. The users and channels of trade are likely to overlap. They do not compete. Taking all of this together, I find that the competing services are similar to a medium degree.

Issuing of publications relating to dance; providing electronic publications relating to dance

28. The aforementioned services are identical to publishing services covered by the applicant's specification under the *Meric* principle.

Information, advisory and consultancy services in relation to all of the aforesaid

29. The contested information, advisory and consultancy services in Class 41 relate to services which I have found to be identical or similar to the opponent's entertainment, educational and publishing services. The proprietor's above-mentioned services are, therefore, similar to the applicant's services (already assessed) to a medium degree due to complementarity, and shared channels of trade and users.

Distinctiveness of the earlier mark

30. The distinctive character of the earlier mark must be considered. 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).”

31. Invented words usually have the highest degree of distinctive character, while words which are allusive of the services have the lowest. Distinctiveness can also be enhanced through the use of the mark. As the opponent filed no evidence, I have only the inherent position to consider.

32. The applicant’s mark consists of the letters “WDO”. Clearly, this is an acronym for the words “World Dance Organizers” written underneath those letters in the mark. A device that appears as a lotus in a shade of blue forms the background for the verbal elements. In relation to services related to dance, World Dance Organizers are allusive that the applicant is an organizer of dance related events or activities. The mark as a whole, in my view, possesses only a fairly low degree of inherent distinctive character.

Comparison of marks

33. 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

34. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

35. The trade marks to be compared are as follows:

Applicant's trade mark	Proprietor's trade mark
	 <p data-bbox="1023 1552 1233 1585">(Series of two)</p>

36. The applicant's mark is comprised of the letters “WDO” in capital letters. Underneath the letters, in a much smaller font appears the words “World Dance Organizers”. A lotus in blue forms the background for the verbal elements. I have already concluded that the letters “WDO” is likely to be viewed as an acronym for “World Dance Organizers”. Given their size and position, the letters “WDO” dominate the overall impression of the mark; a lesser role is played by

the words “World Dance Organizers”. The background is likely to play only a weaker role in the overall impression of the mark

37. The proprietor’s mark is a series of two trade marks. Other than the fact that the marks forming the series are presented in different colours, there are no material difference between the two marks. Therefore, I will consider the marks together for the purpose of comparison. The marks are comprised of the letters “WDO” and the words “World Dance Organizers”. According to the proprietor, the spherical shape presented at the top of the letters “WDO” is suggestive of a globe shape.³ I think this view will accord with how a potentially significant portion of the average consumers is likely to recognise the device element. A globe shape is only likely to reinforce the “global” nature of the services that are clearly emphasised by the word “world” in the mark. Therefore, I do not consider that the device has an equal or greater prominence to the letters “WDO” as argued by the proprietor. I consider that the overall impression of the marks is dominated by the letters WDO; a lesser role is played by the globe element and the words “World Dance Organizers”. The colours in the respective marks play only a weaker role in the overall impression of the marks.

38. Concerning the visual comparison, the applicant argues that the competing marks are highly similar.⁴ Visually, both marks coincide in the letters “WDO” and the words “World Dance Organizers” which are the only verbal elements in the respective marks. The device element in the applicant’s mark does not have a counterpart in the proprietor’s mark, neither does the lotus background in the proprietor’s mark. There are also differences in terms of presentation of the marks in different colours. Weighing up the similarities and differences, and my assessment of the overall impression of the marks, I find that the marks are visually similar to a high degree.

39. In an aural comparison, it is well-established that when a trade mark consists of a combination of words and figurative components, the trade mark is most

³ See counterstatement.

⁴ See the applicant’s submissions dated 9 November 2020, para 27.

likely to be referred to by the words. The only verbal elements in the respective marks are the letters “WDO” and “World Dance Organizers” which will be given identical pronunciations. On that basis, the competing marks are aurally identical.

40. As regards the conceptual comparison, the conceptual message from the respective marks are likely to be derived from the words “World Dance Organizers”. I agree with the applicant that the words “World Dance Organizers” is likely to convey the meaning of an organizer engaged in the arrangement of events related to dance around the world.⁵ The additional globe element in the applicant’s mark is only likely to reinforce the concept of “global” nature of the service and, therefore, unlikely to introduce any second concept in the mark. The average consumer is likely to see the lotus in the proprietor’s mark as a mere decorative background and is unlikely to ascribe any conceptual significance. On that basis, I find that the marks are conceptually identical.

Likelihood of confusion

41. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective services may be offset by a greater degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent’s trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

42. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks

⁵ Ibid para 28.

and the goods/services down to the responsible undertaking being the same or related).

43. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he 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”.

44. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

45. I have found the respective marks to be visually similar to a high degree and aurally and conceptually identical. The services will be selected primarily by visual means, with a medium to high degree of attention by the general public and a high degree of attention by the business users. The services are either identical or similar to varying degrees.

46. With those conclusions in mind, I find that the presence of the device element in the proprietor's mark is prominent enough to avoid a likelihood of direct confusion. Turning to indirect confusion, I am satisfied that the degree of similarity between the marks as wholes, that results from the presence of the common verbal elements - which play a more dominant and distinctive role in the respective marks – will result in a likelihood of indirect confusion. The visual differences between the marks arise from devices that possess a limited distinctive character and play only a weaker role in the respective marks. Accordingly, the average consumer who pays a medium degree of attention to the selection of identical or similar services are likely to think that the marks are variant marks used by the same undertaking or economically related undertakings. The confusion is still likely even where the average consumer pays a higher degree of attention. The visual impact of the verbal elements coupled with the aural and conceptual identity of the marks will counteract any visual differences. There is a likelihood of indirect confusion for both groups of average consumers.

Conclusion

47. The application for invalidation has succeeded and the contested mark is hereby declared invalid in respect of all the services for which it was registered. Under section 47(6) of the Act, the registration is deemed never to have been made.

Costs

48. The applicant has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I award costs to the applicant on the following basis:

Official fee:	£200
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Preparing statements and considering the proprietor's statement:	£200
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Preparing written submissions: £300

Total: £700

49. I order Bing Lin to pay Cuono Romano the sum of £700. 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 22nd of April 2021

Karol Thomas

For the Registrar

The Comptroller-General