

O/327/17

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION UNDER NO. 3141757
BY LMS PATENTS (ISLE OF MAN) LIMITED
TO REGISTER THE TRADE MARK:**

“SuperVivo”

IN CLASS 41

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 406856
BY VIVO INTERNATIONAL LIMITED**

BACKGROUND AND PLEADINGS

1. On 21 December 2015, LMS Patents (Isle of Man) Limited (“the Applicant”) applied to register as a trade mark in the UK the word “SuperVivo” for the following services in class 41:

“Operating and conducting lotteries, raffles, sweepstakes, instant prize competitions; organisation of competitions, lotteries, raffles, sweepstakes, instant prize competitions”.

2. The application was published for opposition purposes in the Trade Marks Journal on 29 April 2016. It is opposed by VIVO INTERNATIONAL LIMITED (“the Opponent”), which has a UK trade mark application (No. 3159450) for the word “vivo” and which claims priority in the UK on the basis of a trade mark filed in the Republic of Namibia.
3. Under paragraph 2 of The Trade Marks (Relative Grounds) Order 2007 only the proprietor of an earlier trade mark or other earlier right may bring an opposition proceedings based on section 5 of the Act. The Applicant has challenged whether the Opponent is validly entitled to claim priority, so I deal with that issue first.

Validity of priority of Opponent’s mark

4. The Opponent applied to the UK Intellectual Property Office to register “vivo” on 14 April 2016, a date of application clearly later than that of the Applicant. However, the Opponent’s UK application claims priority on the basis of a trade mark (No. NA/T/2015/2253) filed on 15 October, 2015 at the Namibian Ministry of Industrialisation, Trade and SME Development for the following services in class 41:

“Production and distribution of television shows and movies; production of television programs; provision of non-downloadable films and television programmes via video-on-demand services.”

5. The Opponent included within its Notice of Opposition (Form TM7) a copy of the application for registration of the Namibian 'vivo' mark, which it labelled “**Exhibit 1**”.

That exhibit showed the application date as 15 October 2015 and that the Namibian mark was filed in the name of Namib Brand Investments (PTY) Ltd. The Form TM7 also included (“**Exhibit 2**”) a “Substitution of Applicant” document from the Namibian Registrar of Trade Marks, “signed and sealed” on 20 April 2016. The substitution document certifies that VIVO INTERNATIONAL LIMITED has been entered on the Namibian trade mark register as the proprietor of trade mark application 2015/2253, “with the goodwill, with effect from 14 April 2016.”

6. The Form TM7 was sent by fax and the print quality of the exhibits was not very clear (particularly in the detail of the date stamps and official crests), but the Opponent later provided the following original documents:

- a Filing Notice that confirms the filing details of trade mark application NA/T/2015/2253 (as outlined above) and bears an office date stamp of 19 October 2015 and a ministry crest;
- the application for registration. It is noted that the original differs slightly from the copy provided as Exhibit 1 - in the apparent placement of its office stamp and in that the original includes a handwritten “Official number” (2015/2253), which is absent from the copy;
- the Substitution of Applicant document (exactly as at Exhibit 2 of the Form TM7).

7. The Opponent’s evidence also includes a witness statement dated 11 October 2016 from Michael Gleissner who, since March 2016, has been the sole Director of Vivo International Limited. Mr Gleissner’s witness statement chronicles the relevant dates in this process from application at the Namibian registry, to transfer of ownership of the application to the Opponent. The witness statement also refers to three exhibits, being the application for registration and the substitution of applicant document, plus a third exhibit showing an assignment agreement dated 28 March 2016, transferring the applied for Namibian trade mark (No. NA/T/2015/2253) from Namib Brand Investments (PTY) Ltd to the current proprietor Vivo International Limited. (The latter assignment document shows Michael Gleissner as Director of Namib Brand Investments (PTY) Ltd, as well as of Vivo International Limited.)

8. The Applicant notes in its submissions in lieu of a hearing that the assignment agreement refers to assigning “... *the said Trademark Application together with the whole of the goodwill of the business in the goods with respect for which the said Trademark Application is registered ...*” (the emphasis added by the Applicant). The Applicant points out that the Namibian mark was filed not in relation to goods, but for services only and concludes that “*accordingly, the assignment of goodwill as set out in the assignment document cannot have occurred. Further, at the time of the assignment, the Namibian trade mark was still an application, not a registration.*” The Applicant submits that the “*assignment document is void and therefore the priority claim is not valid.*” I find that the reference to goods appears an inappropriate inclusion, but it does not seem enough to invalidate the assignment of trade mark application that is correctly documented in the agreement in relation to class 41 services. Moreover, the Namibian registry has accepted and registered the substitution of applicant. The subject of the assignment agreement is the trade mark application for the specification that is recorded on the Namibian trade mark register. The reference to the application being “registered” seems therefore neither wrong nor inappropriate, notwithstanding that it has not completed the registration process.
9. The Applicant has contested the priority on the basis that “*there is no indication when this "Substitution of Applicant" was originally filed at Namibian Trade Mark Office*” and that in any event the substitution “*can only transfer a priority from 14 April 2016 at the earliest as this is the alleged date of the transfer of the goodwill.*” The Applicant also provides evidence¹ that the Opponent was incorporated only on 18 March 2016 and therefore contends that the Opponent and “*has no right to oppose the Applicant's trade mark which was used and filed long before the Opponent was incorporated.*” The Applicant also considers it “*surprising and incongruous*” that the Namibian registry only accepted transfer of goodwill with effect from 14 April 2016, rather than the date of the assignment agreement (28 March 2016).
10. Although the circumstances may seem unusual, it is clear in law that a trade mark application is personal property that may be transferred by assignment.² Mr

¹ (Exhibit A to the Applicant's counterstatement)

² See sections 22, 24 and 27 of the Trade Marks Act 1994 on trade marks as objects of property.

Gleissner is therefore entitled to have transferred the application originally in the name of one company to another company. This is the case even if the latter company did not exist at the time of the original application. I find that the Opponent is therefore entitled to rely on the priority date of the Namibian trade mark.³ I make this finding despite the textual incongruities and misalignments in dates identified by the Applicant - goodwill is not a relevant factor in the grounds of this opposition and has no bearing on the Opponent's legal standing to bring its claim.

Parties' substantive pleadings and evidence

11. Since the application date of the Namibian trade mark precedes the date of the Applicant's application for registration, the Opponent is considered to have an "earlier trade mark" under Section 6(1)(a) of the Trade Marks Act 1994 ("the Act").⁴
12. The opposition is based on section 5(2)(b) of the Act and is directed against all of the Applicant's services. The Opponent claims that the application is for a mark similar to the Opponent's earlier mark and is for services that are identical with or similar to those specified in the Opponent's earlier application.
13. Since the earlier trade mark has not yet completed its registration procedure, the earlier mark is not subject to the proof of use provisions under section 6A of the Act. Consequently, the Opponent is able to rely, as it does, on all of the services protected by its earlier mark without having to prove use.
14. The Applicant filed a counterstatement in which it challenges the priority claim outlined above and denies the grounds of opposition, asserting that the claim is frivolous and vexatious. The counterstatement also states that "the Applicant has used its Super Vivo trade mark widely in the United Kingdom since at least 2013 and on its website since 3/02/2015." It also asserts that the trade mark is "*registrable in*

³ Article 4 of the Paris Convention for the Protection of Industrial Property, provides that an applicant for a trade mark from one contracting State shall be able to use its first filing date (in one of the contracting State) as the effective filing date in another contracting State, provided that the applicant, or his successor in title, files a subsequent application within 6 months from the first filing.

⁴ Section 6(2) Trade Marks Act 1994 makes clear that an earlier trade mark includes 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 section 6(1)(a), subject to its being so registered.

the name of Applicant”, “*is distinctive of the Applicant’s services*” and that “*the Applicant is entitled to be registered as proprietor of the Trade Mark.*”

15. Tribunal Practice Notice 4/2009 makes clear that defences to section 5 (2) claims based on the applicant for registration having used the trade mark before an opponent registered its mark are wrong in law. “*Section 5(2) of the Act turns on whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.*”⁵
16. The counterstatement provides an account of the Applicant’s business context, including various applications for and registrations of intellectual property that it considers relevant, together with three exhibits, which evidence I summarise here:
- **Exhibit A** is a printout from the Companies House website, showing the Opponent’s date of incorporation;
 - **Exhibit B** the Applicant describes as a “*brief chronology showing prior use of its SUPERVIVO trade mark*” which includes dates of patent applications by the Applicant, mentioning the Applicant’s mark and the timeline around the Opponent’s trade mark applications; and
 - **Exhibit C** is a printout from the website of the UK Intellectual Property Office showing the results of a search of the UK and EU trade mark registries for trade marks consisting of or containing “vivo” and which lists a dozen or so trade mark applications / registrations in class 41. These registrations are not relevant to the proceedings.⁶

⁵ See the decision of Ms Anna Carboni, sitting as the Appointed Person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09.

⁶ It is a matter for each trade mark owner to decide whether to challenge another mark (whether by opposition or invalidity proceedings) and that decision will be influenced by multiple factors e.g. a registered mark may predate that of a potential Opponent; whether a registered has been used in the market place and so on.

17. The Applicant also filed written submissions in lieu of a hearing. I bear all submissions of the parties in mind in this decision and shall refer to them where necessary. The Applicant also filed evidence, which I summarise here:

- a **witness statement**, dated 17 March 2017, of John Reid, who is CEO of the Applicant company. The witness statement states that the Applicant has used the brand name SUPERVIVO for its online gaming system since the game's inception in New Zealand in 2012. The witness statement gives information on the related intellectual property registrations, and states that the Applicant obtained the domain name www.supervivo.co.uk which went live in 2014 promoting the SUPERVIVO gaming system, in particular its use in virtual horse racing. The witness statement includes various submissions, but also refers to evidence in the form of four exhibits (JR1 – JR4). For the sake of completeness, I summarise those exhibits below, but - as with other parts of the evidence filed - I do not consider them relevant to the substance of the decision before me.
- **Exhibit JR1** comprises copies of four letters of intent (with dates in 2014) from gaming companies expressing interest in hosting the Applicant's Supervivo games.
- **Exhibit JR2** shows a certificate of registration issued in April 2013 the New Zealand Intellectual Property Office for the trade mark "SUPERVIVO" in class 41 relating to gaming services. The registration is in the name of Sole Survivor Holdings Limited, which the Applicant states is its related company and which has since assigned the registration to the Applicant.
- **Exhibit JR3** is said to show mention of the SUPERVIVO trade mark in an international patent application by the Applicant. The exhibit comprises little more than that word on a sheet of A4, although there are also some reference numbers.
- **Exhibit JR4** is a printout of a webpage from the www.supervivo.co.uk website showing the word "supervivo" used prominently in relation to a virtual horse racing game.

18. The Opponent made a number of points as part of its statement of grounds in its Notice of Opposition. It also filed evidence in the form of supporting documentation going to its priority claim as discussed previously in this decision. The Opponent submitted observations in reply to the Applicant's notice of defence and counterstatement and later provided written submissions in lieu of a hearing.
19. The Applicant represents itself in these proceedings and the Opponent relies on its own legal affairs department. I take this decision based on the papers as indicated and taking into account relevant jurisprudence.

DECISION

20. The Opponent's claim is based solely on section 5(2)(b) of the Act, which states:

"... 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."

21. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

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

The principles are that:

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

Comparison of the services

22. The respective services to be compared are:

Applicant's services in class 41	<i>Operating and conducting lotteries, raffles, sweepstakes, instant prize competitions; organisation of competitions, lotteries, raffles, sweepstakes, instant prize competitions.</i>
Opponent's services in class 41	<i>Production and distribution of television shows and movies; production of television programs; provision of non-downloadable films and television programmes via video-on-demand services.</i>

23. In comparing the respective specifications to assess similarity between the services concerned, I must consider all relevant factors, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, where the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment "... Those factors include, inter alia,

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

24. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court described goods as “complementary” where “...*there is a close connection between [the goods], 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*”. The description in *Boston Scientific* was made in relation to goods, but applies equally to services.
25. In *British Sugar Plc v James Robertson & Sons Limited* (“Treat”) [1996] R.P.C. 281 Jacob J. (as he then was) identified that the relevant factors in assessing similarity in the specified good/services also include consideration of their respective users and of the trade channels through which the goods or services reach the market.
26. The same ruling further held that it is relevant to consider “*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.*”
27. The earlier mark is not subject to proof of use, which means my task of comparing the services must be made on the basis of notional and fair use of the services in the parties’ respective specifications.⁷
28. I also bear in mind the guidance of Jacob J. (as he then was) in *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, where he stated his view that “... *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.*”

⁷ See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. at paragraph 78

29. The parties make various submissions as to the similarity of the services at issue. The Opponent variously assesses the services offered as “*highly similar*” or “*at least highly similar*” and elsewhere refers to the “*identity of the services.*” The Opponent contends that the services are “*highly similar in nature as they both produce and distribute entertainment to the public and, therefore, share the same purpose of entertaining and/or informing through a similar method of use, in that they are both observed or viewed or participated in by the public.*”

30. For its part, the Applicant contends that the respective services are “*dissimilar*” and submits as follows:

“The uses of the Applicant’s services are different to those of the Opponent’s ... The Applicant’s services are highly restricted and regulated - requiring a licence, and governed by the UK Gambling Act 2005. The Applicant’s services offer an interactive form of entertainment to the general public, with the opportunity/incentive of receiving financial rewards for partaking in the games of chance offered by the Applicant. In contrast, the services offered by the Opponent relate to the production and distribution of TV shows which are intended to be watched by a consumer, no interactive participation on the part of the Consumer takes place apart from selecting which tv/movie they wish to watch.”

31. The Opponent on the other hand submits that it is “*highly common for private television networks to host game shows, prize competitions, quizzes and other competitions, particularly in late evening and overnight time slots. The revenue stream of these shows, as with the services of the opponent, is money gambled by customers.*”

32. Bearing in mind the caution in *Avnet* against giving services a wide construction covering a vast range of activities, I find that the Opponent’s points of comparison⁸ as to the nature and purpose of the services are too broad to equate to similarity. The purpose of television production, distribution and streaming services is to entertain through television shows or films. I accept that the means of entertainment could involve a televised competition, but there is no evidence that an important purpose of

⁸ Entertainment and / or information of the viewing or participating public.

such services is to organise lotteries or prize competitions so that viewers can gamble or enter competitions. By contrast, the core purpose of organising a lottery or similar competition is plainly to offer the users of the service a chance to enter and win a prize themselves. I find that the nature of producing and distributing television shows involves core activities and considerations (scripting, casting, set design, shooting, direction, post-production, scheduling, audience figures etc), that are absent from the organisation of competitions and lotteries.

33. Another point going to the difference in the natures of the respective services is that production and distribution of television shows are services that are governed by a different regulatory regime from that governing lotteries and instant prize competitions. The Applicant has highlighted the distinctive regulatory framework within which the Applicant's services would operate. The Opponent has provided no evidence or submissions to set out the extent to which there may or may not be any coinciding governance affecting production and distribution of competition-based television shows, including those that entail a degree of interaction, for example, by requiring viewers to contact the programme by telephone or other means.
34. In general therefore, I find no similarity in the nature or purpose of the services. To the extent that a television show may be based on a competition of some sort, the natures of the services – for example as between “*production of television shows*” on the one hand and “*organisation of competitions*” on the other - become more closely aligned, but I find that the purposes of the services remain distinct and achieve a level of similarity not more than low.
35. The nature and regulatory regime of the Applicant's services also means that its users are somewhat different from the services of the Opponent. The Applicant's services could be offered directly to the end user (the gambling public). As Applicant submits, the law imposes a minimum age limit for the end users of the Applicant's services. The users of the Opponent's services are presumably television companies or broadcasters engaging the services to make or distribute a programme. Inasmuch as a registration for television production services implies a product television show, the users or end consumers of the Opponent's services would be the viewing public at large. Despite differences identified in the respective service users, I find that

there is some similarity in the users in that the adult public at large may consume the Applicant's offerings and the Opponent's output.

36. The methods of use differ between the respective services. The Applicant's services entail delivery through licensed gaming companies, with individual end user customers staking money in the hope of winning a prize. This act of gambling may be undertaken by various means, including purchasing a lottery ticket in a licensed shop, entering a sweepstake in a licensed bookmakers, registering to play an online game. By contrast, the Opponent's services would generally be directed at television companies and broadcasters with the product shows being distributed to as large a viewing audience as possible, often as part of a wider viewing package.

37. The Opponent also submits that "*established trade customs must be considered. It would be widely expected by any relevant consumers that a company providing "production and distribution of television shows and movies" could also "operate and conduct lotteries, raffles, sweepstakes."* In fact, it is common practice for television channels and programmes to host their own competitions or to broadcast national lotteries. Therefore, when considering the similarity of goods, these common commercial origins are considered as a strong factor." The Opponent provides no evidence on this point. Since the UK has had a national lottery for over two decades, the majority of the public will likely be aware that the same is broadcast on the television, but I do not think that most people would be under the impression that it is the television channel that organises the lottery. As far as I am aware, the television programme is essentially the presentation or revelation of the draw result. The draw is of course a vital component, but the act is far short of organisation of the national lottery itself, which entails, for example, the distributed infrastructure in newsagents and other outlets around the country and the computational processing of the public's individual selections of number combinations. I therefore do not find convincing the Opponent's submission on common commercial origins by virtue of established trade customs.

38. As to distribution channels, the Opponent submits that "*there is potential for these entertainment and/or information services, to fall under the same distribution channels, for example, via television or online advertisements or programming.*

Therefore the consumer may be more likely to assume that the goods or services are possibly produced, operated, conducted or organized by the same entity and vice versa.” Again, the Opponent has provided no evidence to support this latter broad assertion. I accept that the services both of the Applicant and the Opponent could entail similar distribution channels in as much as they may make use of the internet and television. However, this is true of many disparate services and I do not find that this submission provides an especially compelling basis for similarity of services in this case, especially since I have already found notable differences in the respective users and methods of use.

39. In light of differences such as in purpose and nature, I do not find that the parties’ services are in competition with one another. As to whether the services are complementary, I remind myself that the purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. The Opponent has provided no evidence that such perception would be likely in this instance. I bear in mind the guiding criteria in *Boston Scientific* and find that even if a television programme were one with a format based on a competition or lottery⁹, and therefore one for which it might be said that “*organisation of competitions*” or “*lotteries*” (as per the Applicant’s services) were “indispensable or important” in the language of *Boston Scientific*, there is an absence of complementarity in the other direction. In other words, I do not find that “*production and distribution of television shows ... and provision of non-downloadable films and television programmes via video-on-demand*” are services that are indispensable or important for the Applicant’s services and the public would not therefore think that the same undertaking was responsible for both services.
40. Overall, I find the services to be similar to a low degree.

⁹ I have already distinguished a programme that serves only to present the lottery results.

The average consumer and the purchasing process

41. It is necessary to determine who the average consumer is for the services in question and to consider how the services are likely to be selected and purchased.

42. In *Hearst Holdings*¹⁰, Birss J. described the average consumer:

“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 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...”

43. Submissions from the Applicant stated that *“the relevant members of the public likely to use the services offered by the Opponent would be a particular group of TV or movie studio workers or network executives who are interested in obtaining the rights to movies or TV shows produced by the opponent and not the general public per se. Whereas the Applicant’s services are to the general public who are over 18 years of age due to the rules and regulations in place governing gambling services.”* I agree that the principal and direct user of the Opponent’s services may be professionals working in television or film, who may commission or engage production or distribution services. However, as I have previously observed, such production services strongly imply a television or film product. To the extent that the general public (including those over 18 years of age) consume television, films, and access video-on-demand, these end users may also be considered as an average consumer. The user of the Applicant’s services includes licensed professionals working in the gaming industry operating as intermediaries between the Applicant and the general public, as well as the general public.

44. In respect of both services, I find that to the extent that the average consumer is a member of the general public, the level of attention paid to the purchasing process would be no more than average. Accessing individual television or film content is not

¹⁰ *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)

expensive and nor is entering a lottery or comparable instant prize competition. Where the average consumer of either service is a professional, the financial outlay and risk are considerably greater, and I would there expect the level of attention to the selection of services to be above average and to take into account the providers' track record and / or close examination of the offering.

45. The situation will differ between the services and the particular average consumer, but overall I find that the purchasing act will be mainly visual, but I do not discount that aural considerations may also play a part. For example, professional consumers¹¹ of the Applicant's services may encounter the Applicant's mark online or in correspondence from the Applicant touting its offering; whereas the public encountering the Applicant's mark may see it advertised online or promoted in a location selling lottery tickets or otherwise providing gambling opportunities. Professional consumers of the Opponent's services may likewise encounter the Opponent's mark online or in correspondence touting the Opponent's offering and hear it spoken in any resultant business engagement. It is possible that members of the public may note the name of the providers of television or film production or distribution services within the credits of any associated product.

Comparison of the marks

46. It is clear from *Sabel*¹² 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 CJEU stated in *Bimbo*¹³ 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

¹¹ Intermediary gaming companies

¹² *Sabel BV v Puma AG*, Case C-251/95, particularly paragraph 23

¹³ Case C-591/12P *Bimbo SA v OHIM* at paragraph 34 of the judgment

all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

47. It would therefore be wrong to artificially dissect the trade marks, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible¹⁴ and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

vivo	SuperVivo
Opponent's earlier trade mark	Applicant's contested trade mark

48. The Opponent's mark consists of a single word which comprises the sole aspect of its overall impression. The Applicant's mark is also a single word, but the average consumer would perceive the mark to contain the word "super" and the word "vivo", especially since the Applicant's mark is presented on the trade mark register with capitalisation¹⁵ applied not only to its opening letter "S" but also to its first letter "V". The overall impression lies in the single word SuperVivo as a unit, but since the "vivo" component strikes one as an invented word, I find it more distinctive than the commonplace component of "super." To that extent I find that "vivo" provides the greater impact in the overall impression of the mark, although the "super" component is far from negligible.

Visual similarity

49. The Applicant's mark is notably longer than that of the Opponent, consisting of nine letters as against the Opponent's four-letter mark and the first five letters of the Applicant's mark are entirely different.
50. Both marks are word marks and I note and accept the Opponent's submission that *"the differences in capitalisation between the marks is irrelevant when carrying out a*

¹⁵ I recognise, however, that word marks are not unreasonably constrained in fair use to a particular case presentation.

comparison of word marks. The protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic or stylistic characteristics which that mark might possess.”¹⁶

51. Since both marks share the same “vivo” element, which I have found to be the more distinctive and dominant component in the overall impression of the Applicant’s mark, I consider the marks to be visually similar to a medium degree.

Aural similarity

52. The shared "vivo" element of both marks is aurally identical. The Opponent submits that *“the secondary "super" element of the subject mark is such that even if this element were to be read aloud, it would simply seem like a laudatory addition to the earlier mark.”* I see no reason to suppose that the Applicant’s word mark would not be spoken in full. It therefore has clear aural differences from the Opponent’s mark, for example in its opening sounds and having twice the number of syllables overall. I consider the marks aurally similar to a medium degree.

Conceptual similarity

53. The parties make various submissions as to the conceptual underpinnings of the marks. The Applicant explains in its submissions that the branding of its gaming system *“derives from the English phrase sole survivor”* and submits that its mark means *“to outlive”* or *“to survive”*, reflecting the nature of the lottery system on which the mark is premised. The Applicant submits that, in contrast, the Opponent’s mark means *“life”*.
54. The Opponent makes the following submissions: that *“conceptually, the signs will have highly similar meanings to any English-speaking public Both marks include the common 'VIVO' element, while the subject mark also contains the laudatory term "Super". This element is commonly defined as meaning "excellent" or "brilliant". As such, the earlier mark means "excellent VIVO" or "Brilliant VIVO". It simply implies a higher quality or better version of the same "VIVO" product - in other words the ..*

¹⁶ See judgment of Court of First Instance of May 22, 2008, Case No.: T-254/06 - RadioCom

Super" is a laudatory and non-distinctive element of the subject mark. Such examples can be seen in well known brands such as "Super Nintendo", "Super Sport" and "Super 8". Due to this lesser meaning of the additional "Super" element, the marks are highly conceptually similar."

55. It is clear from case law that a concept is only relevant if it is capable of immediate grasp by the average consumer¹⁷. Invented words can be evocative of an idea,¹⁸ but in this case I consider it unlikely that the average consumer would perceive any clear evocation based on the marks' Latinate roots. Although the component "super" has a conceptual meaning, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details I find that neither mark has a clear concept and that there is no conceptual similarity between the marks.

Distinctive character of earlier trade mark

56. In *Lloyd Schuhfabrik*¹⁹ 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 ...

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 ..."

57. Since the earlier mark neither describes nor alludes to the services or any characteristic of the services, I find it has a high degree of inherent distinctive

¹⁷ See Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

¹⁸ *Usinor SA v OHIM*, Case T-189/05.

¹⁹ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97

character. As the Opponent filed no evidence in these proceedings as to use of the earlier mark, there is no enhancement to the inherent position.

Conclusion as to likelihood of confusion

58. I now turn to reach a conclusion as to the likelihood of confusion²⁰ between the two marks if they were used in relation to the services specified. When assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered;²¹ consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties.²²
59. In making this global assessment of likelihood of confusion I take stock of my findings set out in the foregoing sections of this decision as to: the relevant average consumer and the nature of the purchasing process; the similarity between the specified services; and the similarity between the conflicting marks, taking account of the degree of inherent distinctiveness of the earlier mark. I also take account of the various principles from case law outlined in paragraph 21 of this decision.
60. I have found differences in the professional nature of the average consumer, but some overlap in the end users of the services as members of the public – with the level of attention amongst professionals here being above average, and for members of the public not more than average. I have noted significant differences in the nature of the purchasing process and found that visual factors predominate, but aural considerations also play a part. I have found little compelling similarity between the specified services, which mostly differ in nature, purpose and method of use. There is some commonality in the trade channels through which the services reach the market, but the services do not compete with one another and are not complementary in the sense described in the case law. I have found that the marks

²⁰ I recognise that confusion can be direct, which effectively 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/goods down to the responsible undertakings being the same or related.

²¹ See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, CJEU at paragraph 66

²² See *Oakley v OHIM* (Case T-116/06) at paragraph 76

share a medium degree of visual and aural similarity, but no meaningful conceptual similarity given the opaque and invented nature of the terms.

61. It is a rule of thumb that the attention of average consumers is usually directed to the beginning of marks, and here, consumers paying a normal level of means that it is more than likely that the very different beginnings of the marks will be noted. The Opponent submits that *“the relevant public will focus purely upon the distinctive “VIVO” element, as the “Super” element simply seems like a commendation or review of the service itself.”* I do not fully accept the first part of that assertion since the Applicant’s mark may well be perceived as a single unit. However, the “super” component could be perceived as laudatory and weak in distinctive character and I take account of the inherent distinctiveness of the earlier mark (which is contained too in the Applicant’s mark).
62. However, I find that neither the similarity in the marks, nor the level of distinctiveness of the earlier mark is sufficient to offset the low level of similarity between the services and weighing all factors in the balance I find no likelihood of confusion on the part of the average consumer in this case. The opposition consequently fails.

Costs

63. The Applicant has successfully defended its application and is entitled to a contribution towards its costs. The Applicant has not engaged independent professional representation and as such is a litigant in person. I assess its costs based on the guidance the scale published in Tribunal Practice Notice 2/2016 and based on an £18 hourly rate, which is the minimum level of compensation for litigants in person in The Litigants in Person (Costs and Expenses) Act 1975.
64. The Applicant has submitted a Tribunal Costs Pro Forma in which it set out its time spent in hours dealing with the matter as follows:

“Notice of Defence, including searches - 17 hours and 30 minutes;

Considering forms filed by the other party – 5 hours and 45 minutes;

(Total 23 hours and 15 minutes);

Preparing evidence / written submissions and considering and commenting on the other side's evidence / written submissions – 32 hours and 24 minutes – entailing the following activity:

Research case law; review related TiVo opposition; compare different services and review searches of marks on UK / EP [sic] containing “vivo”, query Namibian assignment; consultation with UK resident Director; prepare submissions.”

65. As will be apparent from the lengthy account under the background and pleadings section of this decision, this opposition has entailed a number of unusual points that will have demanded the attention of the Applicant and involved it in exploring preliminary matters. However, the Opponent has established its right to claim priority and should not be penalised for that. It is also the case that I found that several aspects of the evidence from the Applicant were not especially relevant to the claim at issue and did not assist in my decision.
66. As an unrepresented party, the work properly undertaken is likely to have taken the Applicant some time as it will have entailed researching legal matters and procedures with which the Applicant will presumably have been unfamiliar and formulating suitable responses. It is my assessment that in these proceedings an appropriate contribution towards the Applicant's costs would be £756, calculated as follows:

Considering the Opponent's Notice of Opposition and filing a counterstatement:	£360
Filing written submissions in lieu of a hearing:	£396

67. I therefore order VIVO INTERNATIONAL LIMITED to pay LMS Patents (Isle of Man) Limited the sum of £756 (seven hundred and fifty six pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of July 2017

Matthew Williams

For the Registrar,

the Comptroller-General