

O/418/17

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3155303

BY VIVA TECHNOLOGIES LIMITED

AND

OPPOSITION No. 407376

BY VIVA MEDIA GMBH

Background and pleadings

1. This is an opposition by Viva Media GmbH (“the opponent”) to an application filed on 17th March 2016 (“the relevant date”) by Viva Technologies Limited (“the applicant”) to register **Viva.com** as a trade mark.

2. The application was published for opposition purposes on 10th June 2016 and covers:

Class 9: Computer hardware; Computer software; Computer peripherals; Electronic data processing equipment; Computer networking and data communications equipment; Computer components and parts; Electronic memory devices; Electronic control apparatus.

Class 38: Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.

Class 41: Teaching, education, training and entertainment services; production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; organization of exhibitions for cultural or educational purposes; publication of electronic books and journals on-line.

3. On 12th September 2016, the opponent filed an opposition to the registration of the trade mark in relation to all the published goods and services.

4. The grounds of opposition are, in summary, that:

- The opponent is the proprietor of EU trade marks 5062039 and 10127141, which consist of the plain word VIVA and the device mark shown below.



- The EU marks were filed in 2006 and 2011, respectively, and registered in 2013. They are therefore earlier trade marks compared to the contested mark.
- The earlier marks are registered in classes 9, 38 and 41 and cover identical or similar goods/services to those covered by the contested mark.
- There is a likelihood of confusion on the part of the public.
- The earlier marks have a reputation in the EU. Use of the contested mark would, without due cause, take unfair advantage and/or be detrimental to, the distinctive character or repute of the earlier marks.
- The earlier marks have been used in the UK since October 2009 in relation to the goods/services for which they are registered. The opponent is therefore a proprietor of an earlier right in those marks.
- Use of the contested mark would constitute passing off.
- On the basis of the points made above, registration would be contrary to s.5(1),(2),(3) and/or s.5(4)(a) of the Act.
- The applicant is not the proprietor of the domain name viva.com and therefore cannot use the trade mark.
- The applicant has no *bona fide* intention to use the mark and is abusing the trade mark registration system.

- Registration should be refused under s.3(6) of the Act on the ground that the application was made in bad faith.

5. The applicant filed a counterstatement denying the grounds of opposition. I note, in particular, that the applicant:

- Denies that the earlier marks are identical or similar to the contested mark.
- Admits that there are some similarities between the respective goods/services, but denies that this is conclusive.
- Pleads that “*the bona fide intention to make use of the subject mark if and when it achieves registration can, according to UK law, only be evaluated in the course of a revocation action due to non-use after 5 years of registration.*” Consequently, the applicant says that the application was made in good faith.
- Makes reference to the opponent’s claim that it does not own the domain name corresponding to the contested mark, but neither denies nor admits the truth of this claim.

6. Both sides seek an award of costs.

7. The earlier marks had not been registered for 5 years as at the date of publication of the contested mark. Therefore, the proof of use provisions in s.6A of the Act do not apply.

The evidence

8. Only the opponent filed evidence.

9. The opponent’s evidence consists of two witness statements by Dr Mark Specht and Ms Katharine Cameron. Dr Specht is the General Manager of the opponent. His evidence goes to the use made of the earlier marks in the UK and other parts of the EU. Ms Cameron’s statement consists mostly of submissions, some of which I will

return to later. However, her statement also provided evidence showing that the applicant was not the owner of the domain name viva.com at the date of the application for registration, or subsequently, and that the sole director of the applicant company is Mr Michael Gleissner.¹ In this connection, Ms Cameron's statement drew attention to my own decision in case BL O-015-17 in which I struck out applications filed by three companies owned by Mr Gleissner to revoke 68 of Apple Inc.'s UK trade marks for non-use on the grounds that the applications for revocation were an abuse of process. In relation to this point, Ms Cameron provided copies of articles from World Trade Mark Review, IPKat and DomainNameWire about Mr Gleissner, which speculate as to the reasons Mr Gleissner has registered thousands of shelf companies and trade marks in the UK, US, EU, Benelux, Portugal and elsewhere. The main theory being that he is a trader in domain names and uses registered trade mark to obtain ownership of them.

10. Returning to Dr Specht's evidence, he says that the opponent is a pan-European music broadcasting company. It was originally founded in Germany in 1993 and was the first German language music TV channel. Since then it has expanded into Switzerland, Hungary, Austria, Poland and, in 2009, the UK and Ireland.²

11. Dr Specht says that the opponent operates the TV channels VIVA and Comedy Central in Germany. In Germany, Hungary and Poland the opponent uses the logo shown under the first bullet in paragraph 4 above. In the UK and Ireland it uses the following logo.



12. The opponent's turnover in 2011 was around €30m. However, this subsequently declined. By 2016 it was down to around €6m. Further, this appears to include turnover from Comedy Central as well as services provided under the VIVA brand or the logo shown at paragraph 4 above.

¹ See exhibits KC2 and KC3

² Exhibit MS1 is a copy of an article from the publication 'on the box' from which it appears that VIVA was launched in the UK in 2009.

13. VIVA UK achieved a 0.04% share of viewing in the UK in 2016. It appears to have been more popular in the past. The UK viewing figures for 2011 are around 9 times higher.

14. The Viva UK Facebook page had over 2m 'likes' as at April 2017.

15. Dr Specht provides copies of advertising and press coverage in Germany, Hungary and the UK for the VIVA television show.³ The examples from Germany and Hungary (and Poland) show use of the logo shown under bullet 1 at paragraph 4 above. There are only two newspaper articles from the UK. They appeared in The Sun and the Daily Star in July 2010. The article in The Sun indicates that VIVA was at that time a digital channel.

16. The opponent has a YouTube channel. A copy of the front page is in evidence.⁴ It appears to date from 2016. It had around 12k subscribers by 2016. It is not clear how long it has existed. The example page in evidence uses the German language. It shows the logo shown at paragraph 4 above, but also the words 'Viva tv'.

17. The opponent organised live music entertainment in the form of "club nights" under the VIVA trade mark in Germany in 2013, which it has carried on under the name VIVA LEGENDS since 2014.

18. The opponent's TV channels in Germany, Poland and Hungary also run an awards ceremony called VIVA Comet, which they broadcast in Germany (1995 – 2011), in Poland (2007 – 2012) and in Hungary ("since 2004"). Dr Specht says that these award ceremonies received wide press coverage.

19. Dr Specht says that VIVA channel won Gold in the Promax BDA Europe *Channel Brand of the Year* awards 2011. This appears to have been an award for the re-brand to the latest version of the logo used by the opponent (see bullet 1 of paragraph 4 above), i.e. literally an award for the brand itself rather than the services provided under it.

³ See exhibit MS8

⁴ See exhibit MS11

Section 3(6) ground – bad faith

20. I find it convenient to start with the s.3(6) ground.

21. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

22. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*.⁵

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which

⁵ [2012] EWHC 1929 (Ch)

must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary

standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

“41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

23. The opponent's case appears to be based on three factors. Firstly, that the applicant cannot intend to use the trade mark because it is not, and has never been, the owner of the domain name viva.com. Secondly, that the sole director of the applicant, Mr Gleissner, owns a very large international network of shelf companies through which he has acquired and holds a wide portfolio of trade marks, which are often used in legal proceedings in order to oppose or cancel third party trade marks and/or to acquire domain names. Thirdly, that the present application is part of an abuse of the trade mark registration system.

24. The applicant has not contested the opponent's evidence that it does not own the domain name corresponding to the contested mark. Nor has the applicant indicated that it intends to acquire that domain name.

25. The mere fact that the applicant does not own the domain name address corresponding to the contested trade mark does not necessarily mean it cannot be used in trade. It simply means that it cannot also be used as a domain name address. Taken by itself the applicant's first point is not therefore sufficient justification for a finding that the application was filed in bad faith. Having said that, the natural way to use a trade mark corresponding to a domain name address would be in connection with a website located at that address. The opponent's point therefore raises a serious question as to whether the applicant really intends to use the mark without using the corresponding domain name address.⁶ The applicant has not answered this point. The applicant merely asserts that its intention to use the mark cannot be challenged until the mark has been registered for 5 years. However, as the opponent's representative points out, that is not the case if it has shown that, contrary to the declaration made on the form of application, the applicant had no *bona fide* intention to use the trade mark at the date of filing the application.

26. The opponent's second point depends largely on information gleaned from press publications about Mr Gleissner, some of which are in evidence, and from facts taken from my published decision in case BL O-015-17. The applicant is Viva

⁶ The use of trade marks corresponding to telephone numbers has been held to be liable to cause confusion where the trade mark applicant has never held the telephone number. See *1-800 Flowers Inc v Phonenames Ltd* [2001] EWCA Civ 721. By analogy, this must also apply to trade marks comprising domain name addresses.

Technologies Limited, not Mr Gleissner. However, As Professor Ruth Annand, as the Appointed Person, held *Joseph Yu v Liaoning Light Industrial Products Import and Export Corporation*:⁷

“22. [A] claim of bad faith is not avoided by making an application in the name of an entity that is owned or otherwise controlled by the person behind the application.”

The applicant does not appear to dispute that Mr Gleissner is the sole Director, and therefore in control, of the applicant. Accordingly, Mr Gleissner’s motives can be attributed to the applicant.

27. The information from the press reports is hearsay evidence. The information and factual findings in my earlier decision are from a final published legal decision. However, I note that not all the evidence in that case has been filed or relied on in this case. If it had been the applicant would have been able to challenge it with further or different evidence. My findings in that case cannot therefore simply be transferred to this case. However, I note that the applicant has not attempted to answer the hearsay evidence filed in this case or provide a specific response to the opponent’s reliance on the published factual findings in the earlier case. These reports/findings indicate that Mr Gleissner has established a large network of shelf companies in the names of which he has acquired a substantial portfolio of trade marks. The applicant has not denied that such marks are often used to oppose or cancel third party trade marks and/or in an attempt to acquire corresponding or similar domain names.

28. In this connection, I note that according to the report in Domain Name Wire of August 2016 that one of Mr Gleissner’s companies – Bigfoot Ventures LLC – has been held to have engaged in attempted ‘reverse domain name high jacking.’ That is using the Uniform Domain Name Dispute Resolution system in an attempt to acquire the domain name slized.com. The report of the case indicates that Bigfoot Ventures LLC claimed, without justification, that the registered mark SLIZED had a reputation.

⁷ BL O-013-05

The adjudication panellist upheld the respondent's complaint that the applicant had misrepresented its use of the trade mark and was trying to hijack the domain name.

29. The opponent's third point is really an accusation, based on the first two points, that the applicant is abusing the trade mark registration system. As the case law indicates, it is important to evaluate the applicant's intentions at the time of the application in assessing the merit of such bad faith claims. This is plainly more difficult where the applicant offers no explanation as to its intentions and rests its case on formal denials. In these circumstances, the applicant's intentions can only be assessed based on the objective factors surrounding the application. Where such factors are sufficient, when considered collectively, to create a *prima facie* case of bad faith, the opposition will succeed in the absence of a satisfactory explanation or rebuttal from the applicant.

30. In *Ferrero SpA's Trade Marks*,⁸ Mr David Kitchen QC (as he then was), as the Appointed Person, upheld a finding that the proprietor had applied to register trade marks in bad faith on the basis of unanswered evidence that it had been 'stockpiling' unused marks. He said:

"I have also come to the conclusion that the hearing officer was entitled to find the allegation established on the basis of the materials before him. By the date of Mr Rickard's declaration the registered proprietors had filed in excess of 60 applications to register trade marks including the word KINDER but had only ever used six. The number of applications had increased to some 68 by the date of Ms Bucks' witness statement. The large number of unused applications and the period of time over which the applications had been made led Mr Rickard to conclude that the registered proprietors were filing applications without any real and effective intention to use them. The evidence of Mr Rickard was never answered by the registered proprietors. No attempt was made to justify or explain the filing policy."

⁸ [2004] RPC 29

31. Although *Ferrero* was decided some time ago, there is no reason to believe that it no longer represents sound law insofar it states that stockpiling trade marks with no intention to use them may justify an allegation that the unused marks have been applied for in bad faith. In this connection, I note that in *EU IPO v Copernicus-Trademarks Ltd*⁹ the General Court held in 2016 that filing an EU trade mark application as part of a blocking strategy, and with no intention of using the trade mark in accordance with its essential function (to distinguish the goods/services of one undertaking from those of others) is an act of bad faith.

32. I note that in this case there is no evidence that the applicant, or any of Mr Gleissner's companies, have used this trade mark in the course of trade, or indeed any of the other trade marks mentioned in the press reports in evidence.

33. I find that the opponent's case is sufficient to create a *prima facie* case that the application was filed in bad faith, i.e. that the applicant had no intention to use the mark in accordance with its essential function. The applicant has not really answered this case. Consequently, the opposition based on s.3(6) succeeds and the application will be refused.

The section 5(2)(b) ground

34. In case I am wrong about the application having been filed in bad faith I will also consider the s.5(2)(b) ground based on the opponent's earlier trade marks.

35. 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”.

⁹ Case T-82/14

36. I find that earlier trade mark 10127141 is not recognisable, either to the eye or the ear, as the word VIVA. Rather the average consumer would regard it as an abstract geometrical device. Consequently, there is no visual, aural or conceptual similarity between this mark and the contested mark. As s.5(2)(b) only applies where there is some similarity between the respective marks it follows that the s.5(2)(b) ground based on earlier mark 10127141 fails.

Comparison of goods and services

37. The respective goods/services covered by the contested mark and earlier trade mark 5062039 are set out below.

Goods/services covered by the contested mark	Goods/services covered by the opponent's mark
<p>Class 9: Computer hardware; Computer software; Computer peripherals; Electronic data processing equipment; Computer networking and data communications equipment; Computer components and parts; Electronic memory devices; Electronic control apparatus.</p>	<p>Class 9: Apparatus for recording, transmission or reproduction of sound or images; amusement apparatus adapted for use with television receivers, in particular for games; electronic amusement apparatus adapted for use with television receivers or with video display units; amusement apparatus for use with or incorporating a television screen or video monitor; computer software; computer game cartridges, discs and cassettes; computer games for use with television, computer game programs; electronic games adapted for use with television receivers; electronic game programs; video game interactive hand held remote controls for playing electronic games; video game cartridges and cassettes; video game discs and programs; video game machines adapted for use with displays; compact-disc-read-only memory games; audio output games; game cartridges for computer video games and video output game machines; computer game tapes; sound and video recordings; phonograph recordings; cinematographic and photographic films; motion picture films and videotapes; MP3 players; digital cameras; mobile telephones and wireless mobile phone equipment and accessories including mobile phone face plates; ring tones being downloadable ring tones, music, MP3s, graphics, games and video images for wireless mobile communication devices; wireless transmission and mobile communication devices allowing voting and receiving of voice and text messages with other wireless mobile communication devices; sunglasses/eyeglasses; magnetic data carriers, in particular containing images and/or sound; laser discs; video discs, compact discs;</p>

<p>Class 38: Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.</p> <p>Class 41: Teaching, education, training and entertainment services; production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; organization of exhibitions for cultural or educational purposes; publication of electronic books and journals on-line.</p>	<p>CD-ROMs; CD-I's; digital versatile discs (DVD's); tapes; videocassettes; cartridges, cards featuring motion picture films, news, sports and television series, documentaries, game shows, variety shows, reality based television shows, animation, concerts and other performance; memory carriers; interactive compact discs and CD ROMS (compact disc read-only-memory); carrying cases for cassettes and compact discs; parts and fittings for all the aforesaid goods; interactive electronic games to use with computers, television/broadcast.</p> <p>Class 38: Broadcasting and transmission of radio and television programmes; broadcasting of cinematographic films and of audiovisual programmes; broadcasting, dissemination and transmission of visual images, audio information, graphics, data and other information, using radio, telecommunications apparatus, electronic media or the internet; cable and satellite broadcasting and transmission services; wireless mobile phone services; providing wireless transmission of uploading and downloading ring tones, voice, music, MP3s, graphics, games, video images, information and news via a global computer network to a wireless mobile communication device; sending and receiving voice and text messages between wireless mobile communications; providing on-line voting system via the internet or a wireless communication device; internet services including communication services, namely transmitting streamed sound and audio-visual recordings via the internet; provision of multi-user access to computer networks for the transfer and dissemination of a wide range of information; providing access to downloadable information for wireless mobile communication devices.</p> <p>Class 41: Education; teaching; entertainment; preparation, production and distribution of radio and television programs; production of films and live entertainment features; production of animated motion pictures and television features; motion picture entertainment, television entertainment and live entertainment performances and shows; production, publication and edition of video cassettes and video tape films, CDS and magnetic data carriers; providing on-line electronic publications [not downloadable]; providing information on television programming services to multiple users via the world wide web or the internet or other on-line databases; production of dance shows, music shows and video award shows, comedy shows, game shows and sports events before live audiences which are broadcast live or taped for later broadcast; live musical concerts; TV news shows; organizing talent contests and</p>
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	<p>music and television award events; organizing and presenting displays of entertainment relating to style and fashion; providing information in the field of entertainment by means of a global computer network; providing digital music [not downloadable] for the internet; providing digital music [not downloadable] from MP3 internet web sites; audio, film, video and television recording services; direction of making radio or television programs; editing of radio and television programmes; film, audio, video and television production; music, film, video and television studio services; providing information about education and entertainment; organization of exhibitions for cultural or educational purposes; providing downloadable ringtones, music, MP3s, graphics, games, video images for wireless mobile communication devices.</p>
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38. In *Gérard Meric v Office for Harmonisation in the Internal Market*,¹⁰ the General Court stated that:

“29.the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM-Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

39. On this basis I find that the broad description *computer hardware* is identical to goods such as image scanning equipment which also falls within the broad term *apparatus for recording, transmission or reproduction of sound or images*. It is also identical to *electronic amusement apparatus adapted for use with television receivers or with video display units*. The latter covers games consoles, which could also be described as *computer hardware* or *electronic data processing equipment*. Both specifications cover *computer software*, so these goods are manifestly identical. *Computer peripherals* covers image scanners, which also fall within the broad description *apparatus for recording, transmission or reproduction of sound or images*. These goods must therefore also be considered identical. *Computer networking and data communications equipment* is wide enough to cover equipment for networking a mobile phone with a tablet computer, which is also covered by

¹⁰ Case T- 133/05

wireless transmission and mobile communication devices allowing voting and receiving of voice and text messages with other wireless mobile communication devices. These goods must therefore also be considered identical. Likewise *electronic memory devices covers computer game cartridges, discs and cassettes* and *electronic control apparatus covers video game interactive hand held remote controls for playing electronic games.* Finally, *computer components and parts covers sound and image cards, which also fall within the broad description apparatus for recording, transmission or reproduction of sound or images.* I therefore find that all of the applicant's goods in class 9 cover more specific descriptions of the opponent's goods in that class, or vice versa.

40. I find that all of the applicant's services in class 38 are covered by the very broad term *broadcasting, dissemination and transmission of visual images, audio information, graphics, data and other information, using radio, telecommunications apparatus, electronic media or the internet* in class 38. Therefore the services in class 38 are also identical.

41. Most of the applicant's services in class 41 are literally identical to, or are covered by, the descriptions *education; teaching; entertainment* in the specification of the earlier mark. For example, *arranging and conducting of workshops (education)* is plainly covered by *education* services. *Publication of electronic books and journals on-line* is covered by *providing on-line electronic publications [not downloadable]*. And both specifications include *organization of exhibitions for cultural or educational purposes.* These services are therefore also identical. The only services in class 41 of the application which may not be covered by the corresponding class of the earlier mark, or vice versa, are *training services* and *arranging and conducting of congresses.*

42. In the judgment of the Court of Justice of the European Union in *Canon*,¹¹ the court stated at paragraph 23 of its judgment that:

¹¹ Case C-39/97

“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”.

43. Training services are manifestly similar in nature to educational services. The purpose of both is to impart knowledge and skills. Further, although training tends to be more vocational than education, the latter can also have a vocational focus. The services are therefore highly similar in purpose. The methods of use also tend to be similar involving lessons and studies. I find that these are highly similar services. I am not entirely sure what *arranging and conducting of congresses* means, but the services appear highly similar to, and possibly overlap with, *organization of exhibitions for cultural or educational purposes*. I find that these services are highly similar. The former are also highly similar to *education* services.

44. I conclude that all of the respective services in classes 9, 38 and 41 are identical or highly similar.

Global comparison

45. The following principles are gleaned from the decisions 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 C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

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

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

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

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

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

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

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

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

Distinctive character of the earlier mark

46. The earlier mark VIVA has no descriptive or allusive characteristics in relation to the goods and services covered by the earlier mark. It is therefore a mark with at least a normal or average degree of inherent distinctive character. The opponent's evidence indicates that the mark has been used in the UK since 2010 in relation to music entertainment services, but it does not appear to have much market share and there is very little evidence of promotion of the mark in the UK. As the likelihood of confusion must be assessed by reference to relevant UK consumers, only the level of distinctiveness of the mark in the UK counts for present purposes. I therefore find that, at most, the inherent distinctiveness of the mark had been enhanced to a small extent by the relevant date as a result of use of the VIVA mark in the UK in relation to music entertainment services. In the context of a mark that has a normal degree of distinctiveness by its very nature, the level of enhanced distinctiveness through use is unlikely to be material.

Average consumer

47. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: CJEU, *Lloyd Schuhfabrik Meyer*.¹²

¹² Case C-342/97

48. The goods and services covered by the application are ordinary consumer goods and services in classes 9, 38 and 41. These are likely to be selected with an average (neither unusually high nor low) degree of attention. The application also covers *teaching, education, training* services, which may be selected with a higher degree of attention. I will allow for this.

49. The applicant's goods and services are likely to be selected primarily by visual means from advertisements on paper and on-line and from catalogues and brochures. However, word of mouth recommendations and orders will also play a part in the selection process, so aural similarity is also material.

Similarity of the marks

50. The applicant submits that the marks are visually different because the earlier mark has only 4 letters whilst the contested mark has 7.

51. Aurally, the difference is greater because the earlier has two syllables VI-VA whilst the contested mark has four: Vi-va-DOT-com.

52. Conceptually, the earlier mark is simply the word VIVA whereas the contested mark is Viva.com. The addition of .com is said to alter the meaning of VIVA by giving it the significance of a badge of trade origin. To illustrate the point, the applicant cites AMAZON v AMAZON.COM. One is a rainforest, the other a brand.

53. The opponent submits that the addition of .com to Viva makes very little difference and the marks are highly similar.

54. The earlier trade mark is registered in capital letters, which by convention means that the mark consists of the word VIVA as such, irrespective of case, font or colour. Therefore the difference between VIVA and Viva is immaterial. However, I accept the applicant's submission that the difference between VIVA and Viva.com as a whole is not so insignificant that it would go unnoticed by a relevant average consumer. Therefore the respective marks are not identical

55. I also accept that the .com suffix makes a difference to the look and sound of the marks. However, there is a rebuttable presumption that the beginnings of marks make more impression on consumers than the endings. That must be all the more likely where, as here, the beginning of the contested mark is quite distinctive and the ending is recognisable as just a generic top level domain name address. Further, the separation of the Viva prefix from the com suffix by a dot makes Viva stand out and adds to the level of recognisable visual and aural overall similarity between the contested mark and VIVA alone. The Viva prefix of the contested mark will therefore make much more of an impression on consumers than the .com suffix. Visually and aurally, I find that the marks are highly similar.

56. I do not accept the applicant's submission that the addition of .com changes the meaning of VIVA. Even assuming that the applicant is correct in saying that AMAZON would be understood by consumers as a reference to the rainforest, the meaning of VIVA is not well-known and immediately obvious to UK consumers. There is therefore nothing to prevent consumers from seeing VIVA as a brand for the goods/services at issue whether or not it is conjoined with .com. In my view, neither of the marks at issue have an immediately graspable meaning. Consequently, there is neither conceptual similarity nor conceptual difference to be taken into account.

57. Overall, I find that the marks are highly similar.

Likelihood of confusion

58. I have found that the contested mark is highly similar to earlier mark 5062039. The respective goods/services are identical or highly similar. Additionally, the earlier trade mark has at least a normal degree of distinctive character. In these circumstances, I have no hesitation in finding that there is a likelihood of confusion on the part of the public, including the likelihood of association.

59. In my view, there is a likelihood of direct confusion resulting from imperfect recollection of one or other of the marks, i.e. average consumers failing to recall whether or not the other mark had a .com suffix. There is an even greater likelihood of indirect confusion, i.e. average consumers who recognise that the marks are

different assuming that the contested mark is a variant of the earlier VIVA mark and used by the same party when trading over the Internet.

60. The s.5(2)(b) ground of opposition therefore succeeds.

Sections 5(1), 5(2)(a), 5(3) and 5(4)(a) grounds

61. In the light of my decisions under s.3(6) and s.5(2)(b) there is no need to consider the further grounds of opposition under s.5(1), s 5(2)(a), s.5(3) or s.5(4)(a).

Outcome

62. The opposition succeeds and the application is refused.

Costs

63. The opponent has been successful and is entitled to a contribution towards its costs. I calculate these as follows:

Filing a notice of opposition (including the official fee) and considering the counterstatement - £600

Filing evidence and submissions in support of the opposition - £1400.

I therefore order Viva Technologies Limited to pay Viva Media GmbH the sum of £2000. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 7th day of September 2017

Allan James
For the Registrar