

O-561-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3179701 FOR THE TRADE MARK



IN THE NAME OF QL PARTNERSHIP LIMITED

AND

OPPOSITION THERETO UNDER NO 407985
BY NFL PROPERTIES EUROPE GMBH

Background

1. Application No 3179701 has a filing date of 10 August 2016, stands in the name of QL Partnership Limited (“the applicant”) and seeks registration of the trade mark shown on the front page of this decision in respect of services in classes 41 and 43 which I set out later in this decision.

2. Following publication of the application in the *Trade Marks Journal* on 2 September 2016, notice of opposition was filed by NFL Properties Europe GmbH (“the opponent”).

3. The opposition is founded on claims based on grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), the opponent opposes registration of the applicant’s services in class 41 only whereas under section 5(3), it opposes the application in full. In both cases, the opponent relies on its European Union trade mark (“EUTM”) no 1751221 **SUPER BOWL** which has a filing date of 12 July 2000, was entered in the register on 7 November 2001 and is registered for goods and services in classes 16, 25, 28 and 41 which I also set out later in this decision.

4. The applicant filed nothing beyond a counterstatement in which, essentially, it denies the claims made.

5. The opponent filed evidence. I do not summarise that evidence here but will refer to it, and to the written submissions it also filed, as appropriate in this decision. Neither party requested to be heard therefore I give this decision after a careful review of all the written materials before me.

Decision

6. The opponent relies on its EUTM 1751221 which, given the dates set out above, is an earlier mark within the meaning of section 6(1) of the Act. Despite it having been registered more than five years before the date of publication of the application, the applicant has not requested that the opponent provides proof of use of its earlier mark. The opponent is therefore entitled to rely on it for each of the services for which it is registered.

The objection under section 5(2)(b) of the Act

7. I will deal first with the objection under section 5(2)(b) of the Act which states:

“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”.

8. 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.

Comparison of the respective services

9. In its counterstatement, the applicant submits:

“Whilst Superbowl UK may be similar to the opponents use of SUPER BOWL conceptually, we are providing this in the context of Tenpin Bowling in the leisure Industry. Superbowl UK does not provide any facilities that relate or mimic those provided by the opponents’ trademark. Our class 41 list of goods/services, do not conflict with those listed and registered by the opponent...”

10. The applicant did not put the opponent to proof of use of its mark and, as indicated above, the opponent is therefore entitled to rely on it for the services as registered. The comparison I have to make is therefore a notional one taking into account the services as registered (earlier mark) and applied for (application). With this in mind, the services to be compared are as follows:

Services of the earlier mark	Services of the application
Class 41 Education; training; entertainment; sporting and cultural activities.	Class 41 Entertainment services; provision of bowling facilities; Bowling centres (operation of-); provision of ten-pin-bowling facilities; ten-pin-bowling alley services; bowling alleys; provision of lanes for ten-pin bowling; bowling classes; bowling alley services; provision of playrooms and games rooms for entertainment purposes; provision of leisure and recreation facilities; amusement services; organisation of competitions; organisation of parties and provision of facilities for parties; provision of video games and amusement games and machines; provision of snooker and pool facilities.

11. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, 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”.

12. As both specifications include *entertainment/entertainment services*, these are clearly identical services. The applicant's *provision of bowling facilities; Bowling centres (operation of-); provision of ten-pin-bowling facilities; ten-pin-bowling alley services; bowling alleys; provision of lanes for ten-pin bowling; bowling classes; bowling alley services*; are each included within the opponent's *entertainment and sporting activities* and are also identical services. In addition, the applicant's *bowling classes* are included within the opponent's *education* and are also identical services.

13. The applicant's *provision of playrooms and games rooms for entertainment purposes; amusement services; organisation of competitions; organisation of parties and provision of facilities for parties; provision of video games and amusement games and machines; provision of snooker and pool facilities* are each included within the term *entertainment* as is included within the opponent's specification and are identical services. The applicant's *provision of snooker and pool facilities* are also included within the opponent's *sporting activities* and are identical services.

14. Finally, the applicant's *provision of leisure and recreation facilities* are included within the opponent's *entertainment; sporting and cultural activities* and are identical services.

The average consumer and the nature of the purchasing process

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably

well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

16. Each of the respective services is such as will be used by the general public. They are services which are widely available although they are unlikely to be bought on a daily basis with some, such as organisation of parties, likely to be a less common purchase. The purchase of each of the services is primarily a visual one with the average consumer encountering the marks e.g. on the outside of the venue or on the pages of a website or on marketing material though the aural aspects will also have a part to play. An average degree of care will be taken with the purchase.

Comparison of the respective marks

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

18. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore

contribute to the overall impressions they create. The trade marks to be compared are as follows:

The earlier mark	The application
SUPER BOWL	

19. The earlier mark consists of the two words SUPER and BOWL presented in plain block capitals. The word SUPER has a well-known laudatory meaning. The definitions of the word BOWL as set out in the online Collins English Dictionary include the following:

“noun: a wooden ball used in the game of bowls...”

And

“noun: a large heavy ball with holes for gripping with the fingers and thumb, used in ten pin bowling”

The word BOWL is not therefore a distinctive word in relation to services involving bowling but in my view the words SUPER and BOWL form a unit and the distinctiveness of the mark rests in the whole.

20. The applicant’s mark is a composite one made up of a number of elements. By far the largest element is the word which will be seen as SUPERBOWL. The letters of this word appear in red edged with navy though the letter O is replaced by a red ten-pin bowling ball which appears to be rolling down a navy bowling lane and hitting (or about to hit) three white pins which have navy edges and red neck stripes. Alongside this word is the non-distinctive abbreviation “UK” in navy edged with red. In much smaller font, above the word SUPERBOWL and to the left of the pins are the descriptive words “Tenpin Bowling” and to the right are the words “At Its Best” each of these words being presented in navy. These latter words are unlikely to be given any trade mark significance by the average consumer. It is the stylised word SUPERBOWL which forms the dominant and distinctive element of the mark.

21. Each mark contains the words SUPER BOWL/SUPERBOWL which leads to a degree of visual similarity between them. In the application, the letter O is stylised

which leads to some visual differences between them. There are further differences between the marks due to the presence in the applicant's mark of the words and abbreviation "Tenpin Bowling", "At Its Best" and "UK" which have no equivalent in the opponent's mark. When taken as wholes, I find there is a medium degree of visual similarity between the respective marks.

22. The earlier mark will be pronounced entirely predictably. As for the application, the words "Tenpin Bowling" and "At Its Best" are unlikely to be pronounced. Instead, the application is most likely to be referred to as Superbowl or, slightly less likely, Superbowl UK which leads to there being at least a high degree of aural similarity between the respective marks.

23. Both marks contain the word BOWL which, as set out above, is a reference to the ball used in bowling or ten pin bowling. This latter meaning is even more pronounced in the application given the stylisation of the letter O. As indicated above, the applicant appears to accept in its counterstatement that the respective marks are conceptually similar. I find them to be similar to a high degree.

The distinctiveness of the earlier mark

24. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish them from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

25. The opponent has filed evidence in the form of a witness statement by Marcus Leonard Collins, senior associate solicitor employed by its agents on record. Mr Collins states that SUPER BOWL is the name given to the final game of the National Football League's American football championship. The game takes place in the US

and he states it is “a cultural phenomenon in the USA which has crossed the Atlantic to the UK”. He exhibits at MLC1 various screen grabs and articles which he states are articles published in the UK media and which refer to this particular game. The article at pages 1 to 3 is dated after the relevant date. From the remaining articles it is clear that the game takes place in the US but is shown on television in the UK. The game lasts several hours and there is entertainment in the form of a musical performance at half-time. The following extract is from an article exhibited at pages 11-16 and is taken from the BBC Newsbeat page said to date from 1 February 2015:

“Hundreds of thousands of people in the UK are expected to stay up late and watch the Super Bowl on Sunday night.

Many of them will be going along to one of the special parties being held in pubs, bars and clubs across the country.

University and local American football teams, cheerleading squads and hardcore fans are generally the hosts.”

With reference to the “half-time show”, it goes on to state:

“Katy Perry might be getting a lot of attention for her performance at half-time on Sunday night.

But lots of party-goers in the UK will be watching a different show come the break. Cheerleading squads have been preparing for weeks. Beat that, Perry.”

An article from *Mashable* said to date from 9 November 2014 exhibited at pages 17 to 22 states:

““Coverage of the Super Bowl reached 2.5 million/4.2% of the TV population across the night.” Channel 4 spokesperson Peter Heneghan told *Mashable*. “The coverage experienced a peak of 1.2 million/11.7% at 11.30 p.m.””

The figures given appear somewhat at odds with each other. Nevertheless, whilst I have no doubt that the game has a following in the UK and is televised here (with some apparently choosing not to watch the half-time entertainment) by third party broadcasters, the evidence does not show details of any trade by the opponent in the UK under the mark in respect of the goods and services for which it is registered. On this basis, I conclude that I have only the mark's inherent distinctiveness to consider. I find that it is a mark with an average degree of inherent distinctive character.

The likelihood of confusion

26. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. 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 and must instead rely upon the imperfect picture of them he has retained in his mind.

27. Earlier in this decision I concluded that:

- The respective services are identical;
- The purchase of the services is primarily a visual one though the aural aspects have a part to play;
- An average degree of care will be taken with the purchase;
- The respective marks are visually similar to a medium degree, aurally at least highly similar and conceptually similar to a high degree;
- The opponent's earlier mark has not been shown to have been enhanced through use but is a mark with an average degree of inherent distinctiveness.

28. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks/services down to the responsible undertakings being the same or related.

29. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

30. I do not consider the average consumer, on seeing the respective marks, would directly confuse them. I do consider, however, that there is a likelihood of indirect confusion as per sub-paragraph (b) above: the additional words and device element being non-distinctive elements that are likely to lead to the mark being seen as a specific sub-brand having a certain style or as a brand extension. That being the case, the opposition succeeds in respect of all services for which the application was made in class 41.

The opposition under section 5(3) of the Act

31. This ground can be dealt with briefly. As set out above, the opposition under this ground is directed against all services of the application. Given my comments in paragraph 25 above as to the lack of evidence of the opponent’s trade in the UK, the objection under this ground cannot hope to succeed to any greater extent than that already considered under section 5(2)(b) and I decline to deal with it further.

Summary

32. The opposition succeeds in full under section 5(2)(b) of the Act in relation to the applicant’s services in class 41. The opposition fails in respect of the applicant’s services in class 43.

Costs

33. Both parties have had an equal measure of success and each should bear their own costs.

Dated this 8th day of November 2017

**Ann Corbett
For the Registrar
The Comptroller-General**