

O-561-21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3335042
BY GENIUS BRANDS INTERNATIONAL, INC IN RESPECT OF THE FOLLOWING
TRADE MARK**

RAINBOW RANGERS

IN CLASSES 3, 9, 12, 14, 16, 18, 21, 24, 25, 26, 27, 28, 30, 35 AND 41

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 415053 BY THE
GUIDE ASSOCIATION**

Background and pleadings

1. Genius Brands International, Inc (“the applicant”) applied to register the trade mark no. 3335042, in respect of the mark RAINBOW RANGERS, in the UK on 30 August 2018. It was accepted and published in the Trade Marks Journal on 12 October 2018 in respect of a list of goods and services in classes 3, 9, 12, 14, 16, 18, 21, 24, 25, 26, 27, 28, 30, 35 and 41. For the purposes of these proceedings, only the following of these goods and services are relevant:

Class 3: ...

Class 9: *Sound recordings, video recordings, downloadable sound recordings, downloadable video recordings and DVD's all featuring dance, singing, instrumental music; pre-recorded audio tapes, discs and cassettes, video tapes, discs and cassettes, digital audio and audio video tapes and discs, CDs, DVDs, laser discs, and phonograph records featuring music and entertainment; theatrical and musical sound and video recordings; virtual reality game software; downloadable MP3 files featuring music; downloadable video recordings featuring music and entertainment; downloadable ring tones, music, graphics, games, and images for wireless communication devices via the Internet; downloadable MP3 files featuring music; downloadable video recordings featuring music and entertainment, graphics, computer games, and images; computer game software, tapes, cartridges and cassettes; video game software, tapes, cartridges and cassettes; cellular phones, and cellular and wireless phone accessories, namely, cellular and mobile phone covers and fitted plastic films known as skins for covering and protecting cellular and mobile phones, devices for hands-free use of cellular and mobile phones, earphones and headsets for cellular and mobile phones, cellular and mobile phone straps; specialty holsters, cradles and pouches adapted for carrying personal electronic devices in the nature of cellular and mobile phones; and cellular and mobile phone carrying cases; sunglasses; mouse pads; headphones for use with sound transmitting systems; computer application software for mobile phones, namely, software for gaming, use in*

communicating and networking over social media; bicycle helmets; children's swim goggles.

Class 12: ...

Class 14: *Jewelry, Jewelry cases; clocks; watches, charms and charm bracelets; jewelry, namely, dog tags for wear by humans for decoration purposes; key chains.*

Class 16: *Printed materials, namely, books and magazines in the fields of music, entertainment, art and culture; appointment books; calendars; post cards; date books; decals; stickers; posters, souvenir programs with photographs, souvenir programs without photographs, books with photographs, books without photographs, magazines with photographs, magazines without photographs, all featuring information on a dancing and singing group of performers; stationery, post cards, framed photographs, unframed photographs, posters and trading cards; calendars; art prints featuring emojis and emoticons; bookmarks; children's books; audio cassette books, namely, a series of children's fiction books and cassette tapes packaged together; coloring books; a series of fictional children's books; corrugated record storage boxes; calendars printed onto cards; wall and desk calendars; trading cards; greeting cards; holiday cards; modeling clay sets composed primarily of modeling clay and also including sculpting tools and printed instructions; coloring sets comprised primarily of coloring books, and also including crayons, drawing paper and printed numbered instructions; painting sets for children; printed paper signs for use as doorknobs hangers; paper lunch bags; magazines in the field of children's hobbies and play activities; fan magazines in the field of entertainment, film, television, music, dance, comic books; memo pads; novels; paper design patterns for the transferring of graphic designs onto costumes; pencils; decorative pencil top ornaments; pencil drawing sets for children comprised primarily of drawing pencils and also including drawing paper; posters; framed and unframed photographs; cardboard party decorations, namely, cut-out character stands for decoration; stationery writing paper and envelopes; stencils; sticker decal*

sets; sticker albums; stickers; facial tissue; paper gift tags, theme notebooks, erasers, document portfolios.

Class 18: *Leather goods, namely, purses; briefcases; credit card cases; carrying cases; briefcase-type portfolios; wallets; tote bags, coin purses; gym bags, back packs, book bags, clothing for pets*

Class 21: *Sports bottles and water bottles sold empty.*

Class 24: *Textile goods, namely, bed sheets; bedspreads, fitted bed sheets, pillowcases, bed blankets, pillow shams, tablecloths not of paper; beach towels, towels, hand towels, washcloths, draperies.*

Class 25: *Clothing, namely, t-shirts, sweatshirts, sweatsuits, nightshirts, hosiery, tights, leggings, lingerie, bodysuits; underwear; undergarments; jackets; pajamas; pants; shorts; shirts; sweat shirts; sweat pants; sweat jackets; tank tops; tops and clothing accessories, namely, scarves, bandanas, belts, garter belts, hats, caps and headwear; footwear, namely, flip flops, slippers, shoes, boots, sandals, sneakers, hiking shoes, running shoes, walking shoes; cloth aprons, bathing suits, clothing belts, children's sleepwear; boxer shorts, clothing caps; Halloween costumes; children's footwear; gloves; hats; ski hats; headbands; outerwear jackets; jumpsuits; mittens; neck warmers; children's pram suits; children's raincoats; robes; socks; stockings; suspenders; sweaters.*

Class 26: *Hair accessories, namely, plastic styling inserts that create height and volume on the crown of the head; Hair accessories, namely, snap clips; Hair accessories, namely, twistlers; Hair bands; Hair barrettes; Hair bows; Hair buckles; Hair chopsticks; Hair clips; Hair elastics; Hair ornaments not of precious metal; Hair scrunchies; Ponytail holders and hair ribbons.*

Class 27: *Carpets, rugs, mats and matting, linoleum for covering existing floors; floor coverings; other materials for covering existing floors, namely, vinyl floor coverings; non-textile wall hangings; tapestry-style wall hangings,*

not of textiles; wall paper; bath mats; throw rugs; bath textiles, namely, textile bath mats.

Class 28: *Christmas tree ornaments; plush toys; puzzles; and stuffed toy animals, dolls, children's toy bicycles and tricycles, other than for transport; roller skates; balloons; amusement products, namely, plastic inflated balls; inflatable toys in the nature of pounding bags; toy boxes; kites; Halloween costume masks; elbow pads for athletic use; knee pads for athletic use; inflatable swimming rings; inflatable wading pools; ride-on toys; skateboards; snow skis and ski poles; snow sleds for recreational use; snow boards; action type target games; role-playing game toy play sets for children to imitate real life occupations; miniature toy vehicles; bubble making wand and solution activity toy sets; stuffed plush toys; miniature motorized toy vans; toy whistles; decorative wind socks; coin operated pinball games; coin operated arcade type video game machines; yo-yo's, basketball goal game set containing basketball hoop, net, and basketball; role playing toys in the nature of play shaving kits with play shaver, shave cream and brush for children to imitate real life activities; children's fishing kits, consisting of plastic fly box, plastic worms, hooks and lines for fishing; play arts and craft sets comprised primarily of toy synthetic dough, and also including modeling clay moulds, a modeling knife, play mats and printed instructions; paper party hats.*

Class 30: *Sugar and confectionary, namely, bubble gum, fruit-flavored candy, gummy candies, candy excluding chocolate candy, and sucking candy in the nature of lollipops; novelty confectionery, namely, chocolate candy in the shape of eggs; cookies; crackers; fruit ice bars; popped popcorn.*

Class 35: *Online retail store services featuring sound recordings, video recordings, DVD's, cosmetics, fragrances, souvenir programs, printed material, calendars, clothing, clothing accessories, headwear, footwear, tickets for concerts and tours; association services, namely, promoting the interests of musicians, singers, songwriters, musical performers and artists; computerized on-line ordering featuring general merchandise and general consumer goods; computerized on-line ordering services in the field of music;*

computerized online retail store services in the field of music; computerized on-line gift ordering services which matches the gift giver's requirements with the gift recipients wants and needs; on-line retail store services featuring downloadable pre-recorded music and audio-visual content, clothing, and general merchandise; organization of promotions using audio-visual media; promoting the concerts of others; providing information about the goods and services of others via a global computer network; retail store services available through computer communications featuring CD's, cassettes, DVD's, videocassettes and licensed merchandise.

Class 41: *Entertainment services, namely, live stage performances by a dancing and singing group of performers; providing an entertainment website featuring biographical information, photographs, tour and performance information on a dancing and singing group of performers; entertainment services, namely, providing a website featuring photographic, audio, video, and prose multimedia presentations featuring entertainment news, dancing and singing group performances, user videos, games materials, production and publishing of music; providing an online entertainment website featuring non-downloadable sound and video recordings in the field of music and music-based entertainment; entertainment services, namely, providing playback of online non-downloadable prerecorded musical sound and video recordings via a global computer network; audio and sound recording and production; entertainment in the nature of live concerts and performances by musical artists and groups; entertainment services, namely, personal appearances by musical groups, musical artists and celebrities; entertainment services in the nature of presenting live musical performances rendered by musical artists broadcast over television, radio, and online non-downloadable audio and video media; entertainment services, namely, performances by musical artists rendered live and recorded for future distribution; entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, related film clips, photographs, and other multimedia materials in the nature of entertainment news, music, film, photography and dance; entertainment services, namely, providing on-line reviews of music, musical artists and music videos;*

entertainment services, namely, providing prerecorded non-downloadable music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; entertainment services namely, live, televised and movie appearances by a professional entertainer; organizing exhibitions for entertainment purposes featuring music and the arts; and publishing of web magazine; Distributorships in the field of music; Distributorships in the field of musical sound recordings and video recordings.

2. The Guide Association (“the opponent”) partially opposes the application claiming that in respect of all the goods and services listed above, the application offends under section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”). This is on the basis of three earlier UK trade marks, the relevant details of which are shown below:

Mark Number	Mark	Relevant dates
3035367	RAINBOWS RAINBOW Rainbows Rainbow (Series of 4)	Filing date: 17 December 2013 Registration date: 10 October 2014
<p>Classes opposed: All goods and services in classes 9, 14, 16, 18, 21, 24, 25, 26, 27, 28, 30, 35 and 41</p> <p>Class 9: <i>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; recorded media; computer hardware and firmware; computer software; software downloadable from the Internet; downloadable electronic publications; compact discs; tapes; cassettes; video recorders; video cassettes; video discs; DVDs; CD Roms; compact disc cases; films; slides; digital music downloadable from the Internet; broadcasting apparatus and instruments; telecommunications apparatus, equipment and accessories; mouse mats; mobile phone accessories; contact lenses, spectacles and sunglasses; binoculars; clothing for protection</i></p>		

against injury, accident, irradiation or fire; furniture adapted for laboratory use; telephone chargers; calculators; teaching apparatus and instruments; computer software; audio and video recordings; publications in electronic form supplied on-line from a computer database or the Internet; phone cards; fridge magnets; mouse mats; navigation compasses; parts, fittings and accessories for all of the aforesaid goods.

Class 20: *Picture frames; mirrors; pillows and cushions; sleeping bags; bean bags; wind chimes; keyrings; buttons; badges; figurines and ornaments; decorative plaques, not of metal; trinket boxes.*

Class 24: *Textiles and textile goods, not included in other classes; bed and table covers; textile piece goods; textiles for making articles of clothing; textile plaques, textile mats; bath linen; towels, mats and flannels; beach towels; bedding; bed sheets; pillow cases; blankets; valances; duvet covers; curtains of textile or plastic; sleeping bag sheet liners; bean bag covers; fabric for use in the manufacture of bags; fabrics for use in the manufacture of lining of bags; handkerchiefs; tea towels; textile wall hangings; bar towels; flags (not of paper); pennants; banners; bunting; napkins and tablecloths, table place mats of textile or plastics material; table mats.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery; biscuits; ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

Class 35: *Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services in connection with Badges and emblems, all made of common metals, casting moulds for badges, door knockers, signs, key rings and key latches, badges for vehicles, all made of common metal, horse brasses, locks and keys, Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, recorded media, computer hardware and firmware, computer software, software downloadable from the Internet, downloadable electronic publications, compact discs, tapes, cassettes, video recorders, video cassettes, video discs, DVDs, CD Roms, compact disc cases, films, slides, digital music downloadable from the Internet, broadcasting apparatus and instruments, telecommunications*

apparatus, equipment and accessories, computer games equipment adapted for use with an external display screen or monitor, mouse mats, mobile phone accessories, contact lenses, spectacles and sunglasses, binoculars, clothing for protection against injury, accident, irradiation or fire, furniture adapted for laboratory use, telephone chargers, calculators, teaching apparatus and instruments, computer software, audio and video recordings, publications in electronic form supplied on-line from a computer database or the Internet, phone cards, fridge magnets, mouse mats, accessories for telephones and telephone hand sets, navigation compasses, jewellery and imitation jewellery, badges made of precious metal or coated therewith, horological and chronometric instruments, Paper, cardboard, printed matter, book binding materials, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, office requisites, instructional and teaching material (except apparatus), plastic materials for packaging, postcards, advertising materials, books, posters, prints, pens, pencils, greeting cards, transfers, decalcomanias, calendars, diaries, bookmarks, car stickers, posters of paper and cardboard, files and folders, drawing instruments, drawing rulers, erasers, Leather and imitations of leather, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, handbags, rucksacks, purses, wallets, credit card holders, clothing for animals, bags and containers, travel bags, suitcases, empty make-up cases and beauty cases, backpacks, duffel bags, boot bags, holdalls, belts for luggage, shoulder belts, luggage tags, Picture frames, mirrors, pillows and cushions, sleeping bags, bean bags, wind chimes, keyrings, buttons, badges, figurines and ornaments, decorative plaques, not of metal, trinket boxes, Household or kitchen utensils or containers, combs and sponges, brushes, glassware, porcelain and earthenware, insulated mugs, Textiles and textile goods, bed and table covers, textile piece goods, textiles for making articles of clothing, textile plaques, textile mats bath linen, towels, mats and flannels, beach towels, bedding, bed sheets, pillow cases, blankets, valances, duvet covers, curtains of textile or plastic, sleeping bag sheet liners, bean bag covers, fabric for use in the manufacture of bags, fabrics for use in the manufacture of lining of bags, quilt bags, handkerchiefs, tea towels, textile wall hangings, bar towels, flags, pennants, banners, bunting, napkins and tablecloths, table place mats of textile or plastics material, table mats, Clothing, footwear, headgear, aprons, Buttons, hair accessories and ornaments, belt clips, ornaments for clothing, footwear and headgear, badges, emblems, ribbons and braids, embroidery, patrol names, shoulder tape and patrol patches, lanyards, epaulettes, woggles, cockades, cords, Toys, games and playthings, gymnastic and sporting articles, decorations for Christmas trees, teddy bears, balloons, Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, biscuits, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, sandwiches, prepared meals, pizzas, pies and pasta dishes.

Class 38: *Telecommunications services; chat room services; provision of on-line forums and message boards; message sending; electronic mail services; voice-mail and messaging services; providing user access to the Internet; communications services; broadcasting services; broadcasting and transmission of text, messages, information, sound and images via*

communication and computer networks; communications by and/or between computers and computer terminals; communications for access to information, text, sound, images and data via communication and computer networks; portal services for access to a communications or computer network; providing access to databases including online computer databases; providing access to on-line information services; electronic display of information, messages, text, images and data; information and advisory services relating to any of the aforesaid services.

Class 41: *Organisation of group activities in the education, cultural, training and entertainment fields; arranging and conducting educational and recreational conferences; provision of courses of instruction and training in camping, sports, homemaking, wood-craft; providing courses of instruction in self-awareness; organising of competitions, sporting events and displays; provision of club recreation and sporting facilities; Electronic games via the Internet; education and training services in relation to a healthy lifestyle; advisory, consultancy and information services relating to all the aforesaid.*

Class 44: (not relied upon)

2033809	[Series of 4 marks as above]	Filing date: 14 September 1995 Registration date: 13 December 1996
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Classes opposed: All goods covered by the applicant's specifications in classes 16, 18, 21, 25, 26 and 28

Classes 6 and 14: [Not relied upon]

Class 16: ..., cards, ...; printed matter, periodical publications, books, ..., stationery, pens, pencils, ..., office requisites, instructional and teaching materials, ..., book marks, ...; but not including unprinted paper and board and not including greeting cards.

Class 18: Shoulder bags; ...; rucksacks; daysacks; bags ...

Class 21: Household, kitchen or camping utensils and containers; mugs; cups

Class 25: Articles of clothing, all for women and girls; ...

Class 26: ...; ribbons ...

Class 28: Games and playthings; soft toys; dolls; resin miniatures of animals in uniform.

3218832	RANGERS Rangers RANGER Ranger [Series of 4 marks]	Filing date: 15 March 2017 Registration date: 28 July 2017
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Classes opposed: *All goods and services covered by the applicant's specifications in classes 9, 14, 16, 18, 21, 24, 25, 26, 27, 28, 30, 36 and 41*

Class 6: *[Not relied upon]*

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments, other than protective glasses; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; recorded media; computer hardware and firmware; computer software; software downloadable from the Internet; downloadable electronic publications other than publications being instructional material; compact discs; tapes; cassettes; video recorders; video cassettes; video discs; DVDs; CD Roms; compact disc cases; films; slides; digital music downloadable from the Internet; broadcasting apparatus and instruments; telecommunications apparatus, equipment and accessories; mouse mats; mobile phone accessories; contact lenses, spectacles and sunglasses other than protective glasses; binoculars; furniture adapted for laboratory use; telephone chargers; calculators; teaching apparatus and instruments; computer software; audio and video recordings; publications in electronic form supplied on-line from a computer database or the Internet, other than publications being instructional matter; phone cards; fridge magnets; mouse mats; accessories for telephones and telephone hand sets; navigation compasses; parts, fittings and accessories for all of the aforesaid goods; none of the foregoing being for passenger vehicles; all relating to or for the promotion of The Guide Association.*

Class 14: *Jewellery and imitation jewellery; badges made of precious metal or coated therewith; horological and chronometric instruments; parts and fittings for all the aforesaid goods; all relating to or for the promotion of The Guide Association.*

Class 16: *Paper, cardboard; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and*

office requisites (except furniture); instructional and teaching material (except apparatus); packaging materials not included in other classes; printers' type; printing blocks; printed publications; periodical publications; newspapers; books; magazines; photographs; albums; decalcomanias; labels; wrapping and packaging materials; trading cards; stationery; writing and drawing instruments; pens; pencils; rulers; pencil cases; writing paper; stickers; greeting cards; calendars; diaries; address books; document folders and files; all relating to or for the promotion of The Guide Association.

Class 18: *Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; handbags; rucksacks; purses; wallets; credit card holders; clothing for animals; bags and containers; travel bags; suitcases; empty make-up cases and beauty cases; backpacks; duffel bags; boot bags; holdalls; belts for luggage; shoulder belts; luggage tags; all relating to or for the promotion of The Guide Association.*

Class 20: *Picture frames; mirrors; pillows and cushions; sleeping bags; bean bags; wind chimes; keyrings; badges; figurines and ornaments; decorative plaques, not of metal; trinket boxes; all relating to or for the promotion of The Guide Association.*

Class 21: *Household, kitchen or camping utensils and containers; mugs; cups and saucers; plates; crockery; bowls; tableware, not of precious metal; glassware, crystal, porcelain and earthenware; pottery; decanters; candelabra and candlesticks not of precious metal; china ornaments; figurines of porcelain, terra-cotta or glass; coasters, not of paper and other than table linen; powder compacts, not of precious metal; brushes; combs; comb cases; sponges; money boxes, not of metal; napkin rings, not of precious metal; table place mats of plastics material; all relating to or for the promotion of The Guide Association.*

Class 24: *Textiles and textile goods, not included in other classes; bed and table covers; textile piece goods; textiles for making articles of clothing; textile plaques, textile mats; bath linen; towels, mats and flannels; beach towels; bedding; bed sheets; pillow cases; blankets; valances; duvet covers; curtains of textile or plastic; sleeping bags, sleeping bag sheet liners; bean bag covers; fabric for use in the manufacture of bags; fabrics for use in the manufacture of lining of bags; handkerchiefs; tea towels; textile wall hangings; bar towels; flags (not of paper); pennants; banners; bunting; napkins and tablecloths, table place mats of textile; table mats; all relating to or for the promotion of The Guide Association.*

Class 25: *Clothing; footwear; headgear; aprons; all relating to or for the promotion of The Guide Association.*

Class 26: Badges; emblems; buttons; hair accessories and ornaments; belt clips; ornaments for clothing, footwear and headgear; ribbons and braids; embroidery; patrol names, shoulder tape and patrol patches, all being embroidery; lanyards, epaulettes; woggles; cockades; cords; thimbles; all relating to or for the promotion of The Guide Association.

Class 28: Games and playthings; gymnastic and sporting articles; soft toys; dolls; resin miniatures of animals in uniform; Christmas decorations; computer games equipment adapted for use with an external display screen or monitor; none of the foregoing in the form of or relating to vehicles; all relating to or for the promotion of The Guide Association.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery; biscuits; ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes; all relating to or for the promotion of The Guide Association.

Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services in connection with Badges and emblems, all made of common metals, casting moulds for badges, door knockers, signs, key rings and key latches, all made of common metal, horse brasses, locks and keys, Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, recorded media, computer hardware and firmware, computer software, software downloadable from the Internet, downloadable electronic publications other than publications being instructional material, compact discs, tapes, cassettes, video recorders, video cassettes, video discs, DVDs, CD Roms, compact disc cases, films, slides, digital music downloadable from the Internet, broadcasting apparatus and instruments, telecommunications apparatus, equipment and accessories, computer games equipment adapted for use with an external display screen or monitor, mouse mats, mobile phone accessories, contact lenses, spectacles and sunglasses, binoculars, clothing for protection against injury, accident, irradiation or fire, furniture adapted for laboratory use, telephone chargers, calculators, teaching apparatus and instruments, computer software, audio and video recordings, publications in electronic form supplied on-line from a computer database or the Internet, other than publications being instructional material, phone cards, fridge magnets, mouse mats, accessories for telephones and telephone hand sets, navigation compasses, jewellery and imitation jewellery,

badges made of precious metal or coated therewith, horological and chronometric instruments, printed matter other than instructional material, book binding materials, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, office requisites, instructional and teaching material (except apparatus), plastic materials for packaging, postcards, advertising materials, books, posters, prints, pens, pencils, greeting cards, transfers, decalcomanias, calendars, diaries, bookmarks, posters of paper and cardboard, files and folders, drawing instruments, drawing rulers, erasers, Leather and imitations of leather, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, handbags, rucksacks, purses, wallets, credit card holders, clothing for animals, bags and containers, travel bags, suitcases, empty make-up cases and beauty cases, backpacks, duffel bags, boot bags, holdalls, belts for luggage, shoulder belts, luggage tags, Picture frames, mirrors, pillows and cushions, bean bags, wind chimes, keyrings, buttons, badges, figurines and ornaments, decorative plaques, not of metal, trinket boxes, Household or kitchen utensils or containers, combs and sponges, brushes, glassware, porcelain and earthenware, insulated mugs, Textiles, bed and table covers, textile piece goods, textiles for making articles of clothing, textile plaques, textile mats bath linen, towels, mats and flannels, beach towels, bedding, bed sheets, pillow cases, blankets, valances, duvet covers, curtains of textile or plastic, sleeping bag sheet liners, bean bag covers, fabric for use in the manufacture of bags, fabrics for use in the manufacture of lining of bags, quilt bags, handkerchiefs, tea towels, textile wall hangings, bar towels, flags, pennants, banners, bunting, napkins and tablecloths, table place mats of textile or plastics material, table mats, Clothing, footwear, headgear, aprons, Buttons, hair accessories and ornaments, belt clips, ornaments for clothing, footwear and headgear, badges, emblems, ribbons and braids, embroidery, patrol names, shoulder tape and patrol patches, lanyards, epaulettes, woggles, cockades, cords, Toys, games and playthings, gymnastic and sporting articles, decorations for Christmas trees, teddy bears, balloons, Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, biscuits, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, sandwiches, prepared meals, pizzas, pies and pasta dishes; excluding retail services in connection with toy vehicles or in connection with goods for passenger vehicles; all relating to or for the promotion of The Guide Association.

Class 38: *Telecommunications services; chat room services; provision of on-line forums and message boards; message sending; electronic mail services; voice-mail and messaging services; providing user access to the Internet; communications services; broadcasting services; broadcasting and transmission of text, messages, information, sound and images via communication and computer networks; communications by and/or between computers and computer terminals; communications for access to information, text, sound, images and data via communication and computer networks; portal services for access to a communications or computer network; providing access to databases including online computer databases; providing access to on-line information services; electronic display of information, messages, text, images*

and data; information and advisory services relating to any of the aforesaid services; all relating to or for the promotion of The Guide Association.

Class 41: *Education; providing of training; entertainment; online entertainment; sporting and cultural activities; arranging and organisation of competitions and cultural events or entertainment; publishing services; organisation of group activities in the education, cultural, training and entertainment fields; arranging and conducting educational and recreational conferences; provision of courses of instruction and training in camping, sports, homemaking, wood-craft; providing courses of instruction in self-awareness; organising of competitions, sporting events and displays; provision of club recreation and sporting facilities; Electronic games via the Internet; education and training services in relation to a healthy lifestyle; provision of online electronic publications; publication of electronic books and journals online; provision of news online; provision of online directory information services; advisory, consultancy and information services relating to all the aforesaid; all relating to or for the promotion of The Guide Association.*

Class 44: *[Not relied upon]*

3. The opponent claims that the applicant's mark should be refused under section 5(2)(b) of the Act because the respective goods and services are either identical or at least highly similar and that the applicant's mark is highly similar to its first two marks. It asserts that this is because they all contain the identical "RAINBOW" element at the beginning of the marks, to which the average consumer generally pays more attention. It concludes that there is a likelihood of confusion.

4. In the alternative, the opponent also asserts that the applicant's mark is similar to its RANGERS mark pointing out that its mark is wholly contained in the applicant's mark. It also claims that the respective goods and services are identical or at least highly similar.

5. The opponent also relies upon a ground based upon section 5(3) of the Act, claiming that its series of 4 marks under registration no. 3035367 RAINBOW/RAINBOWS registration have a reputation in respect of the following list of services:

Class 41: *Organisation of group activities in the education, cultural, training and entertainment fields; arranging and conducting educational and*

recreational conferences; provision of courses of instruction and training in camping, sports, homemaking, wood-craft; providing courses of instruction in self-awareness; organising of competitions, sporting events and displays; provision of club recreation and sporting facilities; education and training services in relation to a healthy lifestyle

6. The opponent asserts that the similarities between the marks is such that the relevant public will believe that they are used by the same or linked undertaking. It claims that use, without due cause, would:

- (i) Take unfair advantage of the reputation of its mark
- (ii) Be detrimental to the reputation of its mark
- (iii) Be detrimental to the distinctive character of its mark

and leading to a loss of membership subscriptions and donations.

7. The applicant filed a counterstatement denying the claims made. Only the opponent's earlier mark 2033809 has been registered for more than 5 years prior to the filing date of the applicant's mark and the applicant has put it to proof of use in respect of all the goods relied upon. It also asserts that the opponent has failed to particularise which of the specific goods and services are alleged to be identical or highly similar.

8. The parties have both filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

9. A Hearing took place before me on 8 June 2021, with the opponent represented by Mr Jamie Muir Wood of counsel, instructed by Bates Wells & Braithwaite London LLP and the applicant by Ms Victoria Jones of counsel, instructed by Withers & Rogers LLP.

Evidence

10. The opponent's evidence takes the form of the witness statement of Mr Jonathan Whitehead, Director of Operations of the opponent, and Exhibits R1 – R8.

11. The applicant's evidence takes the form of the witness statement of Ms Lauren Elizabeth Bray, Chartered Trade Mark Attorney with the applicant's representative, Withers & Rogers LLP, and Exhibits LEB1 – LEB9. This evidence is directed at the dictionary reference of the word RAINBOW and the usage of RAINBOW and RANGER in the marketplace.

DECISION

Proof of use

12. The opposition was filed on 10 January 2019, four days prior to the Act (including section 6A) being amended. Therefore, Section 6A of the Act as set out below, applied to these proceedings:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is

why this decision continues to make reference to the trade mark case law of EU courts.

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or

services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or

just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

15. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. Proof of use must be shown during the five-year period ending with the date of publication of the contested application, namely, 13 October 2013 to 12 October 2018.

17. The opponent has been put to proof of use of its 2033809 RAINBOW/RAINBOWS registration in respect of the following list of goods:

Class 16: *cards; printed matter, periodical publications, books, stationery, pens, pencils, office requisites, instructional and teaching materials, book marks;*

Class 18: *shoulder bags; rucksacks; daysacks; bags;*

Class 21: *household, kitchen or camping utensils and containers; mugs; cups;*

Class 25: *articles of clothing, all for women and girls;*

Class 26: *ribbons*

Class 28: *games and playthings; soft toys; dolls; resin miniatures of animals in uniform.*

17. The relevant evidence can be summarised as:

- The Rainbows section of the Guide Association was created in 1987 for girls in the 5 – 7-year old age bracket. Between 2013 and 2018 the number of Rainbows units has remained reasonable constant at just over 7000 and with a total of between 90,000 and 95,000 members each year in the same period¹;
- In respect of articles of clothing:
 - Rainbows have a specific uniform and members are able to purchase a selection of uniform pieces that bear the Rainbows name²;
 - This uniform is available to purchase at the opponent’s website and from retail outlets run by the opponent’s branches. The items are also available to purchase from third party retailers including the John Lewis department stores and via Amazon;³

¹ Mr Whitehead’s witness statement (“Whitehead 1”), para 11

² Ditto, para 17

³ Ditto, para 18

- Example printouts taken from the opponent’s online shop are provided⁴. These are undated. The following items are shown identified as being “Rainbows Uniform” and/or bear a logo incorporating a stylised “Rainbows”:

 - Hoodies;
 - Jog pants;
 - Leggings;
 - Polo shirts;
 - Tabards.
 - Cycle shorts;
 - Badge sashes;
 - Baseball caps.

- In the same exhibit, an undated screenshot from the John Lewis website is also provided showing the following:
 - Hoodies;
 - Polo shirts;
 - Jogging trousers;
 - Caps;
 - Shorts;
- The logo shown (“the stylised RAINBOWS mark”) on this clothing is:



- The current uniform was launched in 2004 and the following sales information has been provided⁵:

Year	No. of uniform items sold	Value (in excess of)
2013	75,982	£850,000
2014	79,521	£900,000
2015	88,399	£1,000,000

⁴ See Exhibit R2

⁵ Whitehead 1, para 19

2016	81,892	£950,000
2017	74,992	£950,000
2018	64,275	£840,000
TOTAL	465,061	£5,490,000

- Mr Whitehead groups together his evidence in respect of “giftware, publications and accessories but does provide the following breakdown of sales in respect of “books/publications”⁶:

Year	No. of units sold	Value (in excess of)
2013	118,257	£200,000
2014	129,519	£240,000
2015	118,580	£200,000
2016	113,112	£200,000
2017	101,510	£180,000
2018	90,285	£160,000
TOTAL	671,263	£1,180,000

- Two purchase orders are provided⁷. The first is in respect of 45000 “Rainbow Handbook” dated in April 2018. The address of the purchaser is partially redacted but it is in London. The second, with a partially redacted purchaser address in Brighton, is dated in November 2017 and relates to several goods including 10,000 goods described as “Rainbows notepad & pencil set”;
- In respect of giftware and accessories, Mr Whitehead states⁸ that sales of these include blankets, hair bands/clips, bracelets, bags/backpacks, purses, toys, dolls, teddy bears, water bottles, mugs, cups, pens/pencils/pencil cases, note pads, photo frames and money boxes and have been available to purchase since 1996.
- Mr Whitehead also explains that the opponent produces an “Essentials Catalogue” that is updated each year where branded uniform, badges and

⁶ Ditto, para 23

⁷ At ExhibitR5

⁸ Ditto

accessories are available. Example extracts from these catalogues are provided⁹. These show a variety of goods sold under or bearing the marks “Rainbow”, “Rainbows” or the logo mark including:

- (2013 -14 catalogue) caps, polo shirts, hooded jackets, cycling shorts, jog pants, tabards, backpacks (all under the heading “Rainbow wear” with most items clearly bearing the logo mark), “welcome” bags and printed activity packs (under the heading “Rainbow resources”), books, notepad, pencil, birthday cards, ribbons, stickers, erasers, resin miniature bear, teddy bears, dolls, sling bags, mugs, beakers (all under the heading of “Rainbow gifts”), aprons, woven badges;
- (2014 – 15 catalogue) caps, polo shirts, hooded jackets, cycling shorts, jog pants, tabards, aprons, backpacks, “welcome” bags, woven/embroidered badges, books, cups, pens, pencils, purse, pencil cases, ribbons, stickers, erasers, resin miniature bear, teddy bears, dolls, sling bags, beakers, printed activity packs;
- (2015 – 16 catalogue) caps, polo shirts, hooded jackets, cycling shorts, jog pants, tabards, backpacks, a “welcome” bag, notepad, cups, pens, pencils, purse, pencil cases, birthday cards, stickers, erasers, resin miniature bear, teddy bears, dolls, mugs, beakers, metal and woven/embroidered badges, printed activity packs;
- (2016 – 17 catalogue) caps, polo shirts, hooded jackets, cycling shorts, jog pants, tabards, “welcome” bags, books, notepad, pencil, teddy bears, dolls, sling bags, mugs, beakers, silicone bags, cups, purse, pencil cases, resin miniature bear, teddy bears, dolls;
- (2017 – 18 catalogue) caps, polo shirts, hooded jackets, cycling shorts, jog pants, tabards, backpacks, craft tape, “welcome” bags, silicone bags, notepad, mugs, books, cups, pens, pencils, purse, pencil cases, stickers, resin miniature bear, teddy bears, dolls, sling bags, beakers, printed activity packs;

⁹ At Exhibit R6

- (2018 – 19 catalogue) caps, polo shirts, hooded jackets, cycling shorts, jog pants, tabards, pens, pencils, pencil cases, notepads, birthday cards, sling bags, craft tape, mugs, cups and beakers, purses, teddy bears, dolls, metal and woven badges, handbooks, books, activity cards, “welcome bags”, stickers, sling bags, resin miniature bear, teddy bears, dolls;
- The opponent’s marks are promoted via its website girlguiding.co.uk and Twitter account¹⁰ with the website having dedicated pages for individual groups including that of Rainbows. Screenshots of archived webpages from 2012 and 2018 are provided¹¹ showing use of the stylised RAINBOWS mark and where a member is referred to as a “Rainbow”. Records of Twitter activity, where Rainbows are mentioned, are also provided recording 110 Tweets between April 2013 and the relevant date;
- There have been numerous mentions of Rainbows in third party press articles¹². A spreadsheet is provided¹³ detailing nearly 2000 articles and publications where Rainbows has been mentioned between October 2013 and December 2018.

18. Mr Muir Wood referred to the guidance in *Yellow Bulldog*¹⁴ where the Court stated that *“in the absence of cross-examination [evidence] must be taken for what [it is] and it is not to be presumed that the evidence would have fared better or worse, if there had been cross-examination”*. I note this, but my assessment of the evidence should focus *“upon its sufficiency for the purpose ... with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand”*. Mr Hobbs went on to comment:

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the

¹⁰ WS1, para 26

¹¹ At Exhibit R7

¹² WS1, para 28

¹³ At Exhibit R8

¹⁴ *Yellow Bulldog Ltd v AP and Co Ltd* [2020] EWHC 3558 (Ch), at [40]

evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

19. Ms Jones criticised the quality of the evidence in a number of ways:

- (i) There is only one set of sales figures in respect of the broad category of “giftware and accessories”. It is not broken down by product item and, consequently, there is no way of knowing whether the figures relate to all the goods relied upon;
- (ii) The supporting evidence in respect of “books/publications is “woeful”, consisting of 2 purchase orders, the first in respect of 45,000 copies of the “Rainbows Handbook”, the second in respect of 10,000 “Rainbows notepad & pencil set”. In both cases, the identity of the purchaser has been redacted. Ms Jones submitted that two purchase orders cannot “on any basis amount to proof of genuine use” and that, without knowing the identity of the purchasers and their relationship to the opponent it is not possible to know whether it constitutes genuine use. Further, one of the purchase orders states that it is “subject to artwork approval and product testing” and it is not known whether the sale took place;
- (iii) There is no evidence of what, if any of the marks there was on the products themselves.

20. I accept that the evidence could have been better marshalled but I do not agree with the criticism regarding the unknown nature of the purchaser. Ms Jones contended that, because of the high number of items listed, they were not purchased by the end user but rather provided to Guide groups and it is not known that the goods were made available to the opponent’s Rainbows members. As Ms Jones pointed out at the hearing, the post code on one of the purchase orders is the same as given in the contact details shown elsewhere in the evidence for one of the opponent’s shops. I accept that sales to its retail shops or to its groups are relevant

because such goods will be onward sold to the opponent's members and adult volunteers. I accept these as evidence of relevant sales.

21. In respect of Ms Jones' other criticisms, it is my view that when viewing the evidence as a whole and in conjunction with the copies of the annual catalogues, it is sufficient to illustrate use in respect of the marks "Rainbows" and "Rainbow" and during the relevant five year period, in respect of numerous Class 16 goods, namely *notepads, books, pens, pencils, erasers, pencil cases, stickers, birthday cards, printed activity packs*. When considering a fair specification to reflect this use, I keep in mind the following guidance of Mr Geoffrey Hobbs Q.C. as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

22. In respect of *books, pens, pencils*, these terms appear in the list of goods subject to proof of use and, consequently, these terms remain. In respect of *notepads, pens, pencils, erasers, pencil cases, stickers*, these are all items of *stationery* and this category of goods is retained in the specification. Use is shown in respect of *birthday cards* but the specification includes a broad term *cards*. I consider that *greeting cards* more appropriately describes the category of goods within which *birthday cards* fall. This leaves *printed activity packs* which are covered by the term *instructional and teaching materials* and it is this category of goods which is appropriate under the guidance referred to above. Taking all of this into account, I conclude that the opponent may rely upon the following Class 16 specification:

Greeting cards; books, stationery, pens, pencils, instructional and teaching materials

23. In respect of Class 18, Ms Jones made the same criticism regarding the purchase orders, something I have already commented on. The opponent's evidence demonstrates use in respect of *backpacks*, "*welcome*" *bags*, *sling bags* and *silicone bags*. The evidence includes images of *sling bags* and *silicone bags* with a shoulder strap and, therefore, may also be described as *shoulder bags*. Backpacks may also be called *rucksacks* or *daysacks* and, therefore, use has been in respect of these terms. This just leaves the broad term *bags*. This is a very broad term that includes bags ranging from suitcases to fashion accessory bags and it would not be appropriate to allow the opponent to retain such a broad term when it has only demonstrated use in respect of a small variety of bags. Consequently, I find that a fair Class 18 specification that reflect the evidence of use is:

Shoulder bags; rucksacks; daysacks

24. Turning to Class 21, Ms Jones criticises the evidence for not containing explicit sales figures relating to these goods. This is a shortcoming of the evidence, but not necessarily fatal to its claim of genuine use. Its catalogues illustrate that it has sold mugs, cups and beakers for a number of years under the Rainbow/Rainbows marks. This is reinforced by Mr Whitehead's statement that "members are able to purchase a range of Rainbows branded accessories ...and giftware [that] include ...mugs, cups..."¹⁵. *Mugs* and *cups* are terms listed in the opponent's specification and it can, therefore, retain those terms. Use of beakers is also shown. This term is not included explicitly in the opponent's specification. It is covered by the term *household, kitchen or camping containers* but this is a very broad category that cannot be retained by use in respect of *mugs*, *cups* and *beakers*. Consequently, I consider that the term should be amended to *household, kitchen or camping drinking containers*. The opponent can, therefore, rely upon the following fair specification in Class 21:

Household, kitchen or camping drinking containers; mugs; cups

25. In respect of Class 25, the opponent's evidence illustrates use in respect of leggings, jog pants, caps, polo shirts, hooded jackets, cycling shorts, tabards and

¹⁵ WS1, para 23

aprons. The evidence only illustrates such goods being for girls. Such a limited range of clothing does not permit the opponent to retain the very broad term *articles of clothing all for women and girls*. Rather, it should be limited to casual clothing and the specific terms. With this in mind, the opponent is entitled to rely upon the following Class 25 goods:

Articles of casual clothing, leggings, caps, polo shirts, hooded jackets, cycling shorts, jog pants, tabards, aprons; all the aforesaid being for girls

26. Despite there being no explicit sales figures, several of the opponent's catalogues offer ribbons for sale and, consequently, I accept that this illustrates that the opponent has genuine use in respect of these goods. Therefore, it may rely upon its Class 26 specification, namely:

Ribbons

27. Finally, in respect of Class 28, the opponent's catalogues also show use over a number of years in respect of teddy bears, *dolls* and *resin miniatures of animals in uniform*. Ms Jones criticised this evidence because of the absence of explicit sales figures for these goods and that there is no information regarding how or if they were distributed to the relevant public. As I have already commented, I am prepared to accept that goods and catalogues provided to "rainbow" units is sufficient to demonstrate that they would have then been purchased by Rainbows members. Teddy bears are covered by the category of *soft toys* and the term *dolls* and *resin miniatures of animals in uniform* are explicit terms in the specification. The use shown does not justify the retention of the very broad term *games and playthings*. Therefore, the opponent is entitled to rely upon the following list of Class 28 goods:

Soft toys; dolls; resin miniatures of animals in uniform.

28. Use of the stylised RAINBOWS mark constitutes use an acceptable variant mark of the registered series of four marks when considered in the context of the guidance

of the courts¹⁶. The word “Rainbows” within the logo mark presents as a stylised word mark alongside the device mark consisting of a rainbow. The stylised word “Rainbows” does not differ in its distinctive character to that of the word only RAINBOWS or RAINBOW and, in such circumstances, can constitute genuine use¹⁷. Further, there are numerous uses of the word only RAINBOWS shown in the evidence. Finally, I note that RAINBOW singular is used in the opponent’s catalogues in headings to describe categories of goods such as “Rainbow wear”, “Rainbow resources” and “Rainbow gifts”. Such use supports the claim of proof of use of RAINBOW/Rainbow (singular) and also as an acceptable variant of RAINBOWS/Rainbows (pleural).

Section 5(2)(b)

29. 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”.

Comparison of goods and services

30. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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

¹⁶ Mr Richard Arnold Q.C. (as he then was) sitting as the Appointed Person in *Nirvana Trade Mark*, BL O/262/06, paras 33 & 34 and *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, para 32

¹⁷ *Bernhard Rintisch v Klaus Eder* Case C-553/11

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”.

31. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

32. 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 für 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”.

33. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

34. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. 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. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

35. Mr Muir Wood provided a table identifying what he believed represented the opponent’s best case in respect of the similarity between the parties’ goods and services. However, no detailed analysis was provided and neither has the opponent

provided it earlier in the proceedings. Therefore, in circumstances where it is not obvious to me what similarity exists, I will find that there is no similarity.

The Applicant's Class 9 Goods

Sound recordings, video recordings, downloadable sound recordings, downloadable video recordings and DVD's all featuring dance, singing, instrumental music; pre-recorded audio tapes, discs and cassettes, video tapes, discs and cassettes, digital audio and audio video tapes and discs, CDs, DVDs, laser discs, and phonograph records featuring music and entertainment; theatrical and musical sound and video recordings ... downloadable MP3 files featuring music; downloadable video recordings featuring music and entertainment; downloadable ring tones, music, ..., and images for wireless communication devices via the Internet; downloadable MP3 files featuring music; downloadable video recordings featuring music and entertainment, ..., and images;

36. All of the above can be described as sound or video recordings (available on a range of media). Such goods are included in the broad terms *recorded media, digital music downloadable from the Internet* and *audio and video recordings* included in the Class 9 specification of the opponent's earlier 3035367 RAINBOWS series registration. Therefore, applying the guidance in *Meric*, these goods are identical.

37. Similarly, the applicant's terms are identical to the same goods also contained in the opponent's earlier 3218832 RANGERS series registration. These goods are, therefore, identical.

Virtual reality game software;.. computer game software, tapes, cartridges and cassettes ... video game software, tapes, cartridges and cassettes

38. These terms all describe games software and sometimes identifies the media upon which such software is stored. These terms include goods that are self-evidently identical to the terms *computer software* and/or *software downloadable from the Internet* listed in the opponent's 3035367 (RAINBOWS series) and 3218832 (RANGERS series) registrations.

downloadable ... , graphics, games, ... for wireless communication devices via the Internet; downloadable video recordings featuring ...graphics, computer games, ...

39. These goods are included or overlap with the opponent's *software downloadable from the Internet* listed in its 3035367 (RAINBOWS series) and 3218832 (RANGERS series) registrations. They are, therefore, identical.

Cellular phones, and cellular and wireless phone accessories, namely, cellular and mobile phone covers and fitted plastic films known as skins for covering and protecting cellular and mobile phones, devices for hands-free use of cellular and mobile phones, earphones and headsets for cellular and mobile phones, cellular and mobile phone straps; specialty holsters, cradles and pouches adapted for carrying personal electronic devices in the nature of cellular and mobile phones; and cellular and mobile phone carrying cases;

40. The opponent's RAINBOWS and RANGERS registrations both include the terms *apparatus for ...transmission ...of sound or images, telecommunications apparatus, equipment and accessories, mobile phone accessories, telephone chargers*. With the exception of telephone chargers, these terms are very broad and will include all of the applicant's goods listed above. Applying the principle set out in *Merit* they are identical. The term *telephone chargers* is covered by the term *wireless phone accessories* and is identical to that term in the applicant's specification.

Sunglasses

41. The identical term appears in both the opponent's earlier 3035367 RAINBOWS series and 3218832 RANGERS series registrations

Mouse pads

42. The opponent's earlier 3035367 (RAINBOWS series) and 3218832 (RANGERS series) both contain the term *mouse mats* that is an alternative way of describing *mouse pads* and I find that they cover identical goods.

headphones for use with sound transmitting systems

43. The opponent's earlier 3035367 RAINBOWS series and 3218832 RANGERS series registrations both contain the term *apparatus for... transmission ...of sound...* that includes the applicant's goods. Therefore, these goods are identical.

computer application software for mobile phones, namely, software for gaming, use in communicating and networking over social media

44. The opponent's earlier 3035367 (RAINBOWS series) and 3218832 (RANGERS series) both contain the broad term *computer software* that includes the applicant's goods. Therefore, these goods are identical.

bicycle helmets

45. This term has no equivalent in the opponent's specifications but earlier 3035367 RAINBOWS series and 3218832 RANGERS series registrations both contain the term *clothing for protection against injury*. Whilst I consider bicycle helmets not to be clothing and, therefore, different in nature to clothing, the purpose is the same (to keep the wearer safe), and their method of use is the same (to cover the part of the body being protected), their trade channels may overlap, especially in circumstances where the clothing is for protection of cyclists. I conclude that these goods share a medium level of similarity.

children's swim goggles.

46. There is no equivalent term in the opponent's specifications and nothing that obviously strikes me as being similar. Therefore, in the absence of any specific claims to similarity, I find that these goods share no similarity to the opponent's goods and services.

The Applicant's Class 14 Goods

Jewelry, Jewelry cases; clocks; watches, charms and charm bracelets; jewelry, namely, dog tags for wear by humans for decoration purposes; key chains.

47. In respect of similarity to the goods and services with its 3035367 RAINBOW series registration, the opponent relies upon the terms *keyrings; buttons; badges* in Class 20 and *retail services in connection with Badges and emblems, all made of common metals* in Class 35. *Key chains* and *keyrings* are often sold together and, therefore, share trade channels. Their close relationship and the fact that they are used together results in them also being complementary and they share a similar method of use. I conclude that there is a reasonably high level of similarity. In respect of the remaining of the applicant's goods, there is no obvious similarity. Their nature, purpose and trade channels are all different and they are not in competition, nor are they complementary. In terms of methods of use both badges and items of jewellery may be worn in a similar way but this is insufficient to result in any similarity.

48. In Mr Muir Wood's table, the opponent relies upon *retail services in connection jewellery and imitation jewellery, badges made of precious metal or coated therewith, horological and chronometric instruments* a term listed in the 3035367 registration. Whilst goods and services are fundamentally different in terms of nature, purpose and methods of use, there is an overlap of trade channels and, in this case they are complementary and I find that there is a medium degree of similarity.

49. In respect of the opponent earlier 3218832 (RANGERS series) registrations, Mr Muir Wood identified *jewellery and imitation jewellery; badges made of precious metal or coated therewith; horological and chronometric instruments; parts and fittings for all the aforesaid goods; all relating to or for the promotion of The Guide Association* as being the opponent's best case. With the exception of *jewelry cases* and *key chains*, the applicant's goods are all categorised as either *jewellery, imitation jewellery* or *horological and chronometric instruments* and are, therefore, identical to the goods covered by the opponent's broad terms. In respect of *jewelry cases*, these are complementary to the opponent's jewellery in the sense that they

are important or indispensable, in the sense expressed in *Boston Scientific*, for *jewelry cases*. They are also likely to share trade channels including sales outlets. Therefore, whilst they are different in terms of methods of use and nature they, nevertheless, share a reasonably high level of similarity. There is no obvious similarity between *key chains* and the opponent's goods and, in the absence of specific submissions, I find there is no similarity.

The Applicant's Class 16 Goods

Printed materials, namely, books and magazines in the fields of music, entertainment, art and culture; appointment books; calendars; post cards; date books; decals; stickers; posters, souvenir programs with photographs, souvenir programs without photographs, books with photographs, books without photographs, magazines with photographs, magazines without photographs, all featuring information on a dancing and singing group of performers; stationery, post cards, framed photographs, unframed photographs, posters and trading cards; calendars; art prints featuring emojis and emoticons; bookmarks; children's books; audio cassette books, namely, a series of children's fiction books and cassette tapes packaged together; coloring books; a series of fictional children's books; corrugated record storage boxes; calendars printed onto cards; wall and desk calendars; trading cards; greeting cards; holiday cards; modeling clay sets composed primarily of modeling clay and also including sculpting tools and printed instructions; coloring sets comprised primarily of coloring books, and also including crayons, drawing paper and printed numbered instructions; painting sets for children; printed paper signs for use as doorknobs hangers; paper lunch bags; magazines in the field of children's hobbies and play activities; fan magazines in the field of entertainment, film, television, music, dance, comic books; memo pads; novels; paper design patterns for the transferring of graphic designs onto costumes; pencils; decorative pencil top ornaments; pencil drawing sets for children comprised primarily of drawing pencils and also including drawing paper; posters; framed and unframed photographs; cardboard party decorations, namely, cut-out character stands for decoration; stationery writing paper and envelopes; stencils; sticker decal sets; sticker albums; stickers; facial tissue; paper gift tags, theme notebooks, erasers, document portfolios.

50. I begin by considering the similarity between the applicant's goods and the goods and services of the opponent's two RAINBOWS registrations. In doing so, I keep in mind that, following my proof of use considerations, the opponent is entitled to rely upon the following Class 16 goods of its 2033809 registration:

Greeting cards; books, stationery, pens, pencils, instructional and teaching materials

51. The applicant's *Printed materials, namely, books ... in the fields of music, entertainment, art and culture; appointment books; ... date books; ..., books with photographs, books without photographs, ... all featuring information on a dancing and singing group of performers, children's books, coloring books; a series of fictional children's books and novels* are all self-evidently identical to the opponent's *books*.

52. In respect of *audio cassette books, namely, a series of children's fiction books and cassette tapes packaged together* these are highly similar, if not identical to the opponent's *books* because they partly share the same nature, intended purpose and method of use. They may also share trade channels and be in competition.

53. In respect of *coloring sets comprised primarily of coloring books, and also including crayons, drawing paper and printed numbered instructions*, whilst there is some similarity to *books* that includes colouring books, the similarity is higher when compared to both the opponent's *stationery, pens, pencils and instructional and teaching materials*. The former because of the overlap of purpose, trade channels, methods of use, nature and purpose. Further they may also be in competition. The latter because the applicant's could be covered by the opponent's broad term and in as such, applying the *Meric* guidance they are identical.

54. The term *stationery* appears in both parties' specification and are, therefore, identical. *Stationery* covers all types of writing and office materials and, therefore, the applicant's *corrugated record storage boxes, printed paper signs for use as doorknobs hangers, memo pads, pencils, decorative pencil top ornaments, pencil*

drawing sets for children comprised primarily of drawing pencils and also including drawing paper, stationery writing paper and envelope, theme notebooks, erasers and document portfolios are all covered by the term and are, therefore, identical.

Additionally, the term *pencils* also appear in both parties' specifications.

55. The applicant's *magazines in the fields of music, entertainment, art and culture; magazines with photographs, magazines without photographs, all featuring information on a dancing and singing group of performers; magazines in the field of children's hobbies and play activities; fan magazines in the field of entertainment, film, television, music, dance, comic books* are all magazines of one kind or another and are similar in nature, purpose and method of use to the opponent's *books* with both being printed material intended to be read. There may also be overlap in trade channels where the same printer produces the goods and where they are sold in the same outlets. Taking all of this into account, I conclude that they share a medium degree of similarity.

56. *Greeting cards* are present in both parties' specifications and are, therefore, identical.

57. The applicant's specification contains numerous items of printed matter not already discussed, namely, *calendars; post cards; decals; stickers; posters, souvenir programs with photographs, souvenir programs without photographs, post cards, posters and trading cards; calendars; art prints featuring emojis and emoticons; bookmarks; calendars printed onto cards; wall and desk calendars; trading cards; holiday cards and posters*. These may all share trade channels with the opponent's *greeting cards; books* and *stationery* being available through the same retail outlets. Many are goods that, whilst not be classified as "stationery" may be sold in adjacent areas of a shop and in the same area as stationery or printed matter. They may differ in nature, purpose and methods of use when comparing to such goods. I find that they share a low level of similarity to the applicant's goods.

58. The applicant's *framed photographs, unframed photographs; framed and unframed photographs* have no obvious equivalent in the opponent's list of goods and neither are there any obvious similarities with any of the opponent's goods,

being different in terms of nature, purpose, methods of use. They are not in competition nor are they complementary. I find that these goods are dissimilar to all of the opponent's goods. However, the opponent also relies upon *retails services in connection with ...photographs* of its 3035367 RAINBOWS series registration in its Class 35 specification. Whilst these are obviously different in nature, purpose and methods of use, there is complementarity and overlap of trade channels and I find that there is a medium level of similarity.

59. In respect of the applicant's *paper design patterns for the transferring of graphic designs onto costumes*, there is no obvious similarity to any of the opponent's goods or services and I find that there is no similarity.

60. The applicant's *modeling clay sets composed primarily of modeling clay and also including sculpting tools and printed instructions and painting sets for children* have no equivalent goods in the opponent's goods. The opponent's 3035367 (RAINBOWS series) includes *retails services in connection with ... artists' materials* and similarly to my considerations in paragraph 58, I find that there is a medium level of similarity with the applicant's goods.

61. The applicant's *paper lunch bags; cardboard party decorations, namely, cut-out character stands for decoration; facial tissue* have no obvious equivalent in the opponent's Class 16 specification nor retail services relating to the same in its Class 35 specification and I conclude that there is no similarity to any of the opponent's goods and services.

62. In respect of the applicant's *stencils; sticker decal sets; sticker albums; stickers; paper gift tags*, the opponent has no obviously similar or identical goods. In respect of services, its 3035367 RAINBOWS series registration includes *retails services in connection with ...transfers, decalcomanias, car stickers* and, similarly to my considerations at paragraph 58, above, I find that there is a medium level of similarity with the applicant's goods

63. In respect to the similarity between the applicant's goods and the goods and services of the opponent's RANGERS series of marks, I note that the opponent's Class 16 specification includes the following:

printed matter; photographs; stationery; artists' materials; paint brushes; instructional and teaching material (except apparatus); printed publications; periodical publications; books; magazines; photographs; albums; decalcomanias; trading cards; stationery; writing and drawing instruments; pens; pencils; pencil cases; stickers; greeting cards; calendars; address books; document folders and files; all relating to or for the promotion of The Guide Association.

64. All of the following are, self-evidently covered by the opponent's broad term *printed matter* and are, therefore, identical.

Printed materials, namely, books and magazines in the fields of music, entertainment, art and culture; appointment books; post cards; date books; posters, souvenir programs with photographs, souvenir programs without photographs, books with photographs, books without photographs, magazines with photographs, magazines without photographs, all featuring information on a dancing and singing group of performers; post cards, unframed photographs, posters and trading cards; coloring books; a series of fictional children's books; trading cards; holiday cards; printed paper signs for use as doorknobs hangers; corrugated record storage boxes; magazines in the field of children's hobbies and play activities; fan magazines in the field of entertainment, film, television, music, dance, comic books; novels; paper design patterns for the transferring of graphic designs onto costumes; children's books; paper gift tags, theme notebooks; art prints featuring emojis and emoticons; posters;

65. The opponent's specification includes *calendars* and the following of the applicant's goods are self-evidently identical: *Calendars, calendars; calendars printed onto cards; wall and desk calendars;*

66. Similarly, *greeting cards* appears in both parties' specifications and are identical.

67. The opponent's specification includes *decalcomanias* and *stickers* that are identical to the applicant's *decals; stickers, sticker decal sets; stickers*. In addition, the applicant's *sticker albums* share a high similarity with stickers because of the strong complementary relationship and an overlap in trade channels.

68. In respect of the applicant's *stationery, stencils; stationery writing paper and envelopes; erasers, document portfolios, memo pads; pencils; decorative pencil top ornaments*, these are all covered by the opponent's broad term *stationery* and are identical.

69. *Framed and unframed photographs*, appearing in the applicant's specification, is self-evidently covered by the opponent's broader term *photographs* and are identical.

70. If not identical, the applicant's *audio cassette books, namely, a series of children's fiction books and cassette tapes packaged together* are highly similar to the opponent's *books*. The audio version of a book is in direct competition with printed books, they share the same purpose and will also share trade channels.

71. The applicant's *modeling clay sets composed primarily of modeling clay and also including sculpting tools and printed instructions; coloring sets comprised primarily of coloring books, and also including crayons, drawing paper and printed numbered instructions; painting sets for children; pencil drawing sets for children comprised primarily of drawing pencils and also including drawing paper and paper design patterns for the transferring of graphic designs onto costumes* are all covered by the opponent's term *artists' materials* and are, therefore, identical. Further, some of the applicant's goods can also be described as *paint brushes* and *drawing instruments* that are also present in the opponent's specification.

72. The applicant's *bookmarks* may be in the form of *printed matter* or covered by the term *stationery* and, therefore, the opponent's goods are identical.

73. Finally, in respect of the applicant's *paper lunch bags; cardboard party decorations, namely, cut-out character stands for decoration; facial tissue*, there is no obvious similarity to any of the opponent's goods. I conclude that there is no similarity.

The Applicant's Class 18 Goods

74. In respect of the earlier 2033809 (RAINBOWS series) registration, following the proof of use outcome, the opponent is entitled to rely upon *Shoulder bags; rucksacks; daysacks*.

75. The applicant's *gym bags* include bags in the form of *shoulder bags* or *rucksacks* and are therefore, identical. The applicant's *back packs* can also be described as *rucksacks* or *daysacks* and are also identical.

76. The applicant's *Leather goods, namely, purses; briefcases; credit card cases; carrying cases; briefcase-type portfolios; wallets; tote bags, coin purses* share some similarity to the opponent's goods because they too could be made of leather and a leather goods manufacturer may produce the goods of both parties and there is overlap in trade channels. Further, the applicant's goods are for the purpose of carrying general or specific items and this is the same as for the opponent's goods. This creates a medium level of similarity.

77. In respect of *book bags*, these may be in the form of a *shoulder bag* or *rucksack* and are therefore, either identical or highly similar to the opponent's goods.

78. Finally, in respect of the applicant's *clothing for pets*, there is no obvious similarity to any of the opponent's goods and services and, in the absence of specific submissions to the contrary, I find no similarity.

79. In respect of the earlier 3218832 (RANGERS series) registration, the opponent's Class 18 specification includes *leather and imitations of leather, wallets, credit card holders, bags and clothes for animals*. All of the applicant's goods are either self-

evidently identical to these and/or covered by the first broad term and, applying the *Meric* guidance are identical.

The Applicant's Class 21 Goods

80. The opponent's earlier 2033809 (RAINBOWS series) registration survives the proof of use analysis in respect of *Household, kitchen or camping drinking containers; mugs; cups*. Whilst these goods may not be described as "sports" goods, the drinking containers will include drinking bottles/water bottles and, therefore, they are either identical or, if not, highly similar to the applicant's *Sports bottles and water bottles sold empty*.

81. In respect of the earlier 3218832 (RANGERS series) registration, the opponent's Class 21 specification includes the same goods identified above in respect of its earlier 2033809 (RAINBOWS series) registration. It follows that the respective goods are either identical or, if not, highly similar to the applicant's *Sports bottles and water bottles sold empty*.

The Applicant's Class 24 Goods

82. The opponent's earlier 3035367 (RAINBOWS series) registration includes, in its Class 24 specification, the following goods:

Textiles and textile goods, not included in other classes; bed and table covers; textiles for making articles of clothing; textile plaques; bath linen; towels, beach towels; bedding; bed sheets; pillow cases; blankets; tablecloths.

83. The broad term *Textiles and textile goods, not included in other classes* includes all of the goods listed in the applicant's specification. In addition, many of the individual terms appear in both parties' specifications. I conclude that the respective goods are identical.

84. In respect of the earlier 3218832 (RANGERS series) registration, the opponent's Class 24 specification is identical to that in its 3035367 registration and it follows that

my findings in respect of similarity of goods will be the same as in the previous paragraph. The respective goods are identical.

The Applicant's Class 25 Goods

85. The opponent's earlier 2033809 (RAINBOWS series) registration, following the proof of use analysis, is entitled to rely upon the following goods:

Articles of casual clothing, leggings, caps, polo shirts, hooded jackets, cycling shorts, jog pants, tabards, aprons; all the aforesaid being for girls

86. All of the following of the applicant's goods are casual clothing or terms that can include casual clothing and are, therefore, identical to the broad term *articles of casual clothing* in the opponent's specification:

Clothing, namely, t-shirts, sweatshirts, sweatsuits, leggings, jackets; pants; shorts; shirts; sweat shirts; sweat pants; sweat jackets; tank tops; tops; clothing accessories, namely, scarves, bandanas, belts, hats, caps and headwear; clothing belts, clothing caps; gloves; hats; headbands; outerwear jackets; jumpsuits; mittens; neck warmers; socks; sweaters

87. The applicant's *cloth aprons* are covered by the opponent's *aprons* and are also identical.

88. In respect of the applicant's *Clothing, namely, nightshirts, hosiery, tights, lingerie, bodysuits; underwear; undergarments; pajamas; and clothing accessories, namely, garter belts, bathing suits, children's sleepwear; boxer shorts, Halloween costumes; ski hats; children's pram suits; children's raincoats; robes; stockings; suspenders*, these are not identical to any of the opponent's goods. Nevertheless, they are all clothing of one sort or another and share the same nature, purpose, and methods of use as the opponent's goods. They are also likely to share trade channels. Taking all of this into account, I conclude that they share a high level of similarity to the opponent's goods.

89. Finally, in respect of the applicant's *footwear, namely, flip flops, slippers, shoes, boots, sandals, sneakers; clothing accessories, namely, hiking shoes, running shoes, walking shoes; children's footwear* are all types of footwear and there is no equivalent in the opponent's specification and they are, therefore, not identical. Their nature, purpose and methods of use are similar in that they are intended to be worn and offer protection and/or chosen for their appearance. However, they are not complementary in the sense described in *Boston Scientific*. I conclude they share a low to medium level of similarity.

90. The opponent also relies upon its *retail services in connection with clothing, footwear, headgear, aprons* in Class 35 of its earlier 3035367 (RAINBOWS series) registration. Whilst these are self-evidently different in nature and purpose to the applicant's Class 25 goods, there is overlap in terms of trade channels and it is common place for clothing and footwear brands to also sell through their own retail outlets or online equivalents. I conclude that the applicant's goods share a medium level of similarity to these retail services.

91. In respect of the earlier 3218832 (RANGERS series) registration, the opponent's Class 25 specification includes *clothing, footwear, headwear and aprons*. Consequently, all of the applicant's goods are covered by these terms and are, self-evidently, identical.

The Applicant's Class 26 Goods

92. The opponent relies upon *ribbons* in its earlier 2033809 (RAINBOWS series) registration. This term includes ribbons being hair accessories and, as such, shares close similarity to all of the applicant's Class 26 goods that are also all hair accessories. Whilst the precise nature of the applicant's hair accessories are different to ribbons, they share a common purpose and methods of use. They are also likely to share trade channels and be in competition where the consumer may make a choice between choosing a hair accessory in the form of a ribbon or in some other form. Taking all of this together, I conclude that the parties' goods share a medium to high level of similarity.

93. Further, the opponent's earlier 3035367 (RAINBOWS series) registration includes *retail services in connection with hair accessories and ornaments*. These services are also likely to share trade channels with the applicant's goods and will share a medium level of similarity.

94. In respect of the earlier 3218832 (RANGERS series) registration, the opponent's Class 26 specification includes *hair accessories and ornaments; ribbons* and are self-evidently identical to the applicant's goods.

The Applicant's Class 27 Goods

95. The opponent does not rely upon the goods and services of its earlier 2033809 (RAINBOWS series) registration. In respect of its earlier 3035367 (RAINBOWS series) registration, it relies upon *textile mats; bath linen; towels, mats and flannels* in Class 24 and *retail services in connection with textile mats, bath linen, towels, mats and flannels* in Class 35. These class 35 services are less similar than its class 24 goods and, therefore, I will restrict my analysis to similarity between the applicant's goods and the opponent's Class 24 goods.

96. The applicant goods are floor coverings or wall hangings. The opponent's goods, by being classified in Class 24, are textiles and substitutes for textiles. Such goods for use as floor coverings or wall hangings are classified in Class 27 and, with the exception of *place mats of textile*, the WIPO classification guide¹⁸ does not list any mats in Class 24. It is permissible to treat the Class number as relevant to the interpretation of the scope of a specification¹⁹, therefore, I proceed on the basis that the opponent's *textile mats* and *mats* do not share the same nature, purpose, methods of use or trade channels as the *mats* or any other goods in the applicant's specification. They are not in competition, nor are they complementary. In summary, in the absence of submissions or evidence to the contrary, I conclude these goods are not similar.

¹⁸ [Nice Classification \(wipo.int\)](http://www.wipo.int)

¹⁹ *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA):

97. The opponent also relies upon *bath linen; towels, flannels*. Similar to my considerations above, with the exception of the fact that they may be made of similar materials as the applicant's goods, there is no similarity.

98. In respect of the earlier 3218832 (RANGERS series) registration, the opponent relies upon the same list of goods and services as discussed above. Consequently, I find that the respective goods and services are not similar.

The Applicant's Class 28 Goods

99. The opponent's earlier 2033809 (RAINBOWS series) registration, following the proof of use analysis, is entitled to rely upon the following goods:

Soft toys; dolls; resin miniatures of animals in uniform

100. The applicant's *plush toys and stuffed toy animals, dolls; stuffed plush toys* are identical or, at least, highly similar to the opponent's *Soft toys*.

101. The applicant's *Christmas tree ornaments* may consist of *resin miniatures of animals in uniform* and, because of this overlap, they are identical.

102. In respect of the remaining of the applicant's Class 28 goods, there is little by way of similarity except that both parties' goods include goods that are aimed at children and may result in an overlap of trade channels where both parties goods are sold from a retail toy shop or online equivalent. There may also be a common purpose (ie as a plaything). However, they differ in terms of nature, methods of use, and they are not obviously in competition or complementary. Taking all of this into account, I conclude that they share a low level of similarity.

103. Further, the opponent's earlier 3035367 (RAINBOWS series) registration includes *retail services in connection with toys, games and playthings, gymnastic and sporting articles, decorations for Christmas trees, teddy bears, balloons*. These retail services are in respect of a broadly defined list of goods that includes all of the opponent's goods. Therefore, whilst services and goods are fundamentally different

in nature, purpose and method of use, there is overlap in trade channels and also there is complementarity in the sense that the applicant's goods are important or indispensable for the opponent's services. I conclude that there is a medium level of similarity.

104. Turning to the similarity between the applicant's goods and the goods of the opponent's earlier 3218832 (RANGERS series) registration, I note that it includes *games and playthings, sporting articles, soft toys, dolls and Christmas decorations*. These terms are either reproduced in the applicant's specification or they are broad in nature with the applicant's goods being included within the broad term. I conclude the respective goods are identical.

The Applicant's Class 30 Goods

105. The opponent does not rely upon its earlier 2033809 (RAINBOWS series) registration. In respect of its earlier 3035367 (RAINBOWS series) registration, the Class 30 specification includes *sugar and confectionery*. The first of these terms is included in the applicant's specification and the latter is a broad term covering all of the other of the applicant's goods with the exception of its *crackers*. Therefore, all of the applicant's goods, except *crackers*, are identical to the goods covered by these two terms. The term *crackers* is covered by the opponent's term *biscuits* and the goods are, therefore, also identical.

106. The opponent's earlier 3218832 (RANGERS series) registration contains an identical list of Class 30 goods as its 3035367 registration and it follows that the same two terms are identical to all of the applicant's goods.

The Applicant's Class 35 Services

107. The opponent does not rely upon its earlier 2033809 (RAINBOWS series) registration. In respect of its earlier 3035367 (RAINBOWS series) registration, the opponent's Class 35 specification includes *retail services in connection with:*

- (i) *Audio and video recordings and DVDs*

- (ii) *Printed matter*
- (iii) *Clothing, footwear, headgear*

108. These services are self-evidently identical to the applicant's *Online retail store services featuring sound recordings, video recordings, DVD's, souvenir programs, printed material, calendars, clothing, clothing accessories, headwear, footwear, on-line retail store services featuring downloadable pre-recorded music and audio-visual content, clothing, and general merchandise, computerized online retail store services in the field of music and retail store services available through computer communications featuring CD's, cassettes, DVD's, videocassettes and licensed merchandise.*

109. In respect of the applicant's *Online retail store services featuring cosmetics, fragrances* and *Online retail store services featuring tickets for concerts and tours*, there is no equivalent in the opponent's specification. Mr Muir Wood's table identifies all of the opponent's Class 35 services as being its best case but I have no specific submissions as to which of its retail services are similar and it is not obvious to me that any are. I, therefore, find that there is no similarity with any of the opponent's services.

110. In respect to the applicant's *computerized on-line ordering featuring general merchandise and general consumer goods; computerized on-line ordering services in the field of music; computerized on-line gift ordering services which matches the gift giver's requirements with the gift recipients wants and needs*, such services are akin to online retail services and relate to a list of goods that can include the goods that overlap with the subject of the opponent's retail services, as noted in paragraph 107, above). Consequently, the respective services are identical or at least highly similar.

111. The applicant's *association services, namely, promoting the interests of musicians, singers, songwriters, musical performers and artists* has no equivalent in the opponent's Class 35 specification. Whilst the opponent's specification includes *advertising services*, an ordinary meaning of this is advertising services with the aim of promoting third party goods or services as opposed to promoting the interests of a

particular sector. Consequently, if there is any similarity between the services covered by the parties' terms, it is only very low.

112. The applicant's *organization of promotions using audio-visual media; promoting the concerts of others; providing information about the goods and services of others via a global computer network* describe the type of services provided as part of a package of *advertising services*, a term present in the opponent's specification. Therefore, the respective services are identical.

113. I now turn to the similarity between the applicant's services and the services of the opponent's earlier 3218832 (RANGERS series) registration. In all material ways, the opponent's specification is identical to that of its earlier 2033809 (RAINBOWS series) registration. Consequently, my findings detailed in paragraphs 107 to 112 apply equally here.

The Applicant's Class 41 Services

114. The opponent does not rely upon its earlier 2033809 (RAINBOWS series) registration. In respect of its earlier 3035367 (RAINBOWS series) registration, Mr Muir Wood identified the opponent's best case as being based upon the following Class 41 services:

Organisation of group activities in the ... entertainment fields; arranging and conducting ... recreational conferences; ...; organising of competitions, sporting events and displays; ...; Electronic games via the Internet; ...consultancy and information services relating to all the aforesaid.

115. The applicant's *Entertainment services, namely, live stage performances by a dancing and singing group of performers; entertainment in the nature of live concerts and performances by musical artists and groups; entertainment services, namely, personal appearances by musical groups, musical artists and celebrities; entertainment services in the nature of presenting live musical performances rendered by musical artists broadcast over television, radio, and online non-downloadable audio and video media; entertainment services, namely, performances*

by musical artists rendered live and recorded for future distribution are all entertainment services relating to dance or musical performances. Such performances can include or arise from organisation of group activities. Consequently, the services overlap with the opponent's *organisation of group activities in the ... entertainment fields*. Such an overlap must lead to a finding that the respective services are identical.

116. In respect of the applicant's *providing an entertainment website featuring biographical information, photographs, tour and performance information on a dancing and singing group of performers*, such services do not appear to share any similarity with the opponent's services beyond being, at a very high level, both being described as "entertainment" and the fact that both could be provided through a website. Similarity at such a high level is insufficient for a finding of similarity within the criteria set out in the guidance and in the absence of specific submissions, I conclude that they are not similar or similar to only a very low degree.

117. The applicant's *entertainment services, namely, providing a website featuring photographic, audio, video, and prose multimedia presentations featuring entertainment news, dancing and singing group performances, user videos, games materials, production and publishing of music* are all services of presenting entertainment news of dance/music performances and related services. These are different to the services of the opponent in the same way as described in the previous paragraph and I conclude that the respective services are not similar or only similar to a very low degree.

118. The applicant's *providing an online entertainment website featuring non-downloadable sound and video recordings in the field of music and music-based entertainment; entertainment services, namely, providing playback of online non-downloadable prerecorded musical sound and video recordings via a global computer network; entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, related film clips, photographs, and other multimedia materials in the nature of entertainment news, music, film, photography and dance* all relate to the provision of music or videos and related media and not to the areas of entertainment covered by the opponent's

specification, namely, group activities or courses of instruction, organising competitions and sporting events. Consequently, I find that, for the same reasons described above, the respective services share no, or only a very low level of similarity.

119. In respect of the applicant's *audio and sound recording and production; Distributorships in the field of music; Distributorships in the field of musical sound recordings and video recordings and publishing of web magazine*, these services are related to entertainment but are not entertainment *per se*. Further, they relate to music, videos and publishing rather than entertainment covered by the opponent's specification, namely, group activities or courses of instruction, organising competitions and sporting events. I conclude that there is no, or only a very low level of similarity.

120. The applicant's *entertainment services, namely, providing on-line reviews of music, musical artists and music videos; entertainment services, namely, providing prerecorded non-downloadable music, information in the field of music, and commentary and articles about music, all on-line via a global computer network* relates to entertainment related to music and not the areas covered by the opponent's services and, once again, I find that they share no, or only a very low level of similarity.

121. The same applies in respect of the applicant's *entertainment services namely, live, televised and movie appearances by a professional entertainer* are disassociated from the group activities of the opponent and, therefore, the subject and nature of the entertainment is different.

122. Finally, the applicant's *organizing exhibitions for entertainment purposes featuring music and the arts* is similar to the opponent's *arranging and conducting recreational conferences*. Conferences and exhibitions are often held side by side and there will be an expectation that they are provided by the same or related entity. Therefore, they share trade channels. They are different in terms of nature, purpose and methods of use. Taking all of this into account, I conclude that they share a low to medium level of similarity.

123. I now turn to the similarity between the applicant's services and the services of the opponent's earlier 3218832 (RANGERS series) registration. The opponent's Class 41 specification includes the broad terms *entertainment; online entertainment; cultural activities; publishing services* and these encompass many of the opponent's Class 41 services and are, therefore, identical. The exceptions are the opponent's *Distributorships in the field of music; Distributorships in the field of musical sound recordings and video recordings*. These services are related to entertainment but are not entertainment or a cultural activity *per se*. As in my discussion of the previous paragraph, these services and the entertainment services and cultural activities may be provided by the same entity and this creates a low level of similarity.

Comparison of marks

124. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 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.”

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

126. The respective marks are shown below:

Earlier marks	Contested mark
RAINBOWS RAINBOW Rainbows Rainbow (series of 4 marks) RANGERS RANGER Rangers Ranger (Series of 4 marks)	RAINBOW RANGERS

127. All of the opponent's marks consists of a single word either in the singular or plural. Therefore, this is the dominant and distinctive element of all of its marks. The applicant's mark consists of the two words RAINBOW RANGERS. Ms Jones submitted that neither RAINBOW or RANGERS plays an independent distinctive role changing the mark from nouns to a name. I agree that the first word qualifies the second and consequently the two words form a unit and the distinctive character resides in the combination of the words with no one word dominating.

128. Visually, the fact that the applicant's mark has been applied for in upper case is not significant because it is well established that the rights conferred upon a registration for a word mark in plain text will include both upper and lower case use and where there is a capitalised first letter. With this in mind, the first word of the applicant's mark is identical to the RAINBOW/Rainbow marks and highly similar to the opponent's RAINBOWS/Rainbows marks. The word RANGERS is absent in the opponent's first series of marks. Taking all of this into account, I conclude that the applicant's mark shares a medium level of similarity to all of the opponent's RAINBOW/Rainbow series of marks.

129. In respect of the similarity with the opponent's series of RANGER(S)/Ranger(s) marks, they share similarity because this word appears as the second word of the

applicant's mark. The applicant's mark begins with the word RAINBOW that is absent in the opponent's marks. I conclude that these also share a medium level of similarity.

130. Aurally, the applicant's mark is likely to be expressed as the four syllables RAIN-BOW-RANGE-ERS whereas the opponent's earlier marks variously consist of the following two syllables RAIN-BOW, RAIN-BOWS, RANGE-ER or RANGE-ERS. Consequently, half of the applicant's mark coincides aurally with all of the opponent's marks and I conclude they share a medium level of aural similarity.

131. Conceptually, the word RAINBOW will be readily understood as “[a]n arch of colours visible in the sky, caused by the refraction and dispersion of the sun's light by rain or other water droplets in the atmosphere”²⁰. Consequently, the opponent's RAINBOW/RAINBOWS marks will be understood as having this meaning or its plural. The word RANGER is readily understood as “[a] keeper of a park, forest, or area of countryside” or “A person or thing that wanders over a particular area”²¹ and the opponent's RANGER/RANGERS marks will be understood as referring to one or more “rangers”. The applicant's mark consists of the two words RAINBOW and RANGERS and consequently the word RAINBOW acts as an adverb modifying the meaning of RANGERS so that the mark, as a whole, will be perceived as describing rangers that are in some way associated with rainbows. Taking all of the above into account, I conclude that the applicant's mark shares a medium level of conceptual similarity to both the opponent's RAINBOW/RAINBOWS marks and its RANGER/RANGERS marks.

Average consumer and the purchasing act

132. 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

²⁰ [RAINBOW | Definition of RAINBOW by Oxford Dictionary on Lexico.com also meaning of RAINBOW](#)

²¹ [RANGER | Definition of RANGER by Oxford Dictionary on Lexico.com also meaning of RANGER](#)

is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

133. 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.”

134. The contested application contains a long and varied list of goods and services that will have an equally varied scope of average consumers. Some services will be business to business, such as *organising exhibitions* or *promoting the interests of musicians* etc whilst others, such as the numerous consumer items in classes 9, 25 and 26 where the average consumer is the general public. The average consumer will pay a varying degree of care and attention during the purchasing process with goods such as *stickers* or *memo pads* attracting a lower degree of care and attention whereas goods such as *mobile phones* will generally involve a more considered approach and a higher degree of care and attention. The opponent’s goods and services are even broader with *scientific apparatus* at one end of the scale that may be specialist equipment only purchased with a high level of care and attention, while at the other end of the scale, goods such as *compact disc cases* involving a lower than normal level of care and attention.

135. The purchasing process for many, if not all, of the respective goods and services is likely to be predominantly visual in nature, with goods being selected from shelves or virtual shelves in the case of online purchases. However, the purchase of some of the goods and services may require additional enquiries to ensure that the

purchaser's requirements are met and, therefore, I do not ignore that aural considerations may also be relevant,

Distinctive character of the earlier trade mark

136. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

137. The applicant's evidence is targeted at illustrating that both the word RAINBOW and RANGER are commonly used in the marketplace. In respect of RAINBOW, it consists of an ordinary and readily understood word and therefore, not of the highest level of distinctive character that an invented word may have. The opponent submits that, based upon its evidence, its distinctive character is impacted because the word is used in respect of a wide range of products and especially so in respect of those

targeted at children. Its evidence illustrates some descriptive use where it refers to products that refer to, bear the design of, or relate to, rainbows as well as trade mark use where RAINBOW is used as part of a trade mark. Where the word RAINBOW is used on goods which could display a rainbow as a decorative element (such as t-shirts), I recognise that the distinctiveness of the mark may be lower. Keeping this in mind, I find that the marks RAINBOW or RAINBOWS are endowed with a low to medium level of inherent distinctive character. Similar considerations apply to the opponent's RANGER/RANGERS marks and, again, I conclude these are endowed with a low to medium level of inherent distinctive character.

138. In respect of whether the RAINBOW/RAINBOWS marks benefit from any enhanced levels of distinctive character, I keep in mind that Rainbows was created in 1987 for girls in the 5 – 7 year old age bracket and that between 2013 and 2018 the number of Rainbows units was just over 7000 with between 90,000 and 95,000 members each year. Such a length of use and the self-evident broad geographical spread across the UK leads me to conclude that in respect of the opponent's core services of *organisation of group activities in the education, cultural, training and entertainment fields, all relating to activities for girls*, the opponent's RAINBOW/RAINBOWS marks benefit from a reasonable level of enhanced distinctive character.

139. In respect of whether the opponent's RANGER/RANGERS marks benefit from an enhanced level of distinctive character, the evidence provided is less compelling. Mr Whitehead states that the name was adopted in June/July 2018²² for the opponent's dedicated group for 14 to 18-year olds. This was only six months before the relevant date in these proceedings. Prior to this the groups were known as "The Senior Section" (since 2002). Therefore, even with there being in the region of 2000 groups around the UK and around 12,000 members²³, they were only so named for six months as of the relevant date and I find that length of use, when considered together with the scale of use is insufficient to enhance the distinctive character of the marks.

²² WS1, para 7

²³ See table at para 9 of WS1

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

140. The following principles are obtained 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:

(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.

Likelihood of confusion with the opponent's RAINBOW marks

141. I have found that:

- The similarity between the respective goods and services ranges from identical to there being no similarity;
- The distinctive character of the opponent's marks lies in the single word of which the marks consist. The applicant's mark consists of two words that form a unit with its distinctive character created by the combination of the two words with no one word dominating;
- The respective marks share a medium level of visual, aural and conceptual similarity;

- There is a range of average consumers who pay an average, or sometimes, higher level of care and attention during the purchasing process that is primarily visual in nature;
- The opponent's earlier marks have a low to medium level of inherent distinctive character that has been enhanced by a reasonable level in respect of its core services.

142. Some similarity between the respective goods and services is required for a finding of likelihood of confusion²⁴. It follows that there is no likelihood of confusion in respect of the following list of the applicant's goods and services that have no similarity to the opponent's goods and services:

Class 9: *children's swim goggles.*

Class 16: *paper design patterns for the transferring of graphic designs onto costumes; paper lunch bags; cardboard party decorations, namely, cut-out character stands for decoration, facial tissues.*

Class 18: *clothing for pets*

Class 27: *Carpets, rugs, mats and matting, linoleum for covering existing floors; floor coverings; other materials for covering existing floors, namely, vinyl floor coverings; non-textile wall hangings; tapestry-style wall hangings, not of textiles; wall paper; bath mats; throw rugs; bath textiles, namely, textile bath mats.*

Class 35: *Online retail store services featuring cosmetics, fragrances; online retail store services featuring tickets for concerts and tours*

²⁴ *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU) and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49

143. A number of the opponent's specifications have a limitation, the wording of which varies slightly but effectively states that all the goods/services relate to The Guide Association. Mr Jones submitted that even where I have found goods and services to be identical or similar, there can be no likelihood of confusion given that the applicant's mark will never be used in relation to or for the promotion of The Guide Association. Mr Muir Wood submitted that there is nothing in the applicant's specifications to limit away from goods and services that promote The Girl Guides. I agree with Mr Muir Wood. The issue is not how the applicant intends to use its mark but, rather, if there is commonality of scope of the respective goods and services. This is because the applicant's may be sold in the future to a party with different intentions in how the mark is used or, the applicant itself may change its marketing strategy in the future.

144. Mr Muir Wood submitted that the level of similarity between the respective marks and goods and services is such to result in indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

145. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this

connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

146. The consumer is highly likely to recognise that the applicant's mark is not any of the opponent's marks even where imperfect recollection is a factor, however, it will also be difficult to miss that the first word of the applicant's mark is also the same as the opponent's mark. Upon encountering the applicant's mark being used in respect of any goods or services identical to, or similar to a low degree or higher, it is likely to be perceived as indicating services provided by, or linked to, the opponent's Rainbows and is indicating a "rangers" arm of the Rainbows or goods related to or promoting these services. Therefore, taking account of the common element in the context of the later mark as a whole, the consumer is likely to conclude that it is another brand of the owner of the earlier mark.

147. Additionally, keeping in mind a significant proportion of the public, upon encountering the mark RAINBOWS may perceive it as a shortened version of RAINBOW RANGERS and, in doing so, believe that the goods and services provided under the marks originate from the same or linked undertakings. Consequently, whilst I do not agree with Mr Muir Wood when he submitted that the applicant's mark will be perceived as a linked or subset brand of the opponent, I do find that the average consumer, upon encountering the opponent's mark is likely to perceive it as a linked or subset brand of the applicant. Such "wrong way round confusion" is sufficient, as found by the Court of Appeal²⁵ when considering the issue of infringement. Such a finding can apply equally to the application of section 5(2)(b).

148. In light of these findings, the section 5(2)(b) ground, insofar as it is based upon the opponent's earlier RAINBOWS registration is successful in respect of the following list of the applicant's goods and services:

Class 9: *Sound recordings, video recordings, downloadable sound recordings, downloadable video recordings and DVD's all featuring dance, singing, instrumental music; pre-recorded audio tapes, discs and cassettes,*

²⁵ Comic Enterprises Ltd v Twentieth Century Fox Film Corporation, [2016] EWCA Civ 41

video tapes, discs and cassettes, digital audio and audio video tapes and discs, CDs, DVDs, laser discs, and phonograph records featuring music and entertainment; theatrical and musical sound and video recordings; virtual reality game software; downloadable MP3 files featuring music; downloadable video recordings featuring music and entertainment; downloadable ring tones, music, graphics, games, and images for wireless communication devices via the Internet; downloadable MP3 files featuring music; downloadable video recordings featuring music and entertainment, graphics, computer games, and images; computer game software, tapes, cartridges and cassettes; video game software, tapes, cartridges and cassettes; cellular phones, and cellular and wireless phone accessories, namely, cellular and mobile phone covers and fitted plastic films known as skins for covering and protecting cellular and mobile phones, devices for hands-free use of cellular and mobile phones, earphones and headsets for cellular and mobile phones, cellular and mobile phone straps; specialty holsters, cradles and pouches adapted for carrying personal electronic devices in the nature of cellular and mobile phones; and cellular and mobile phone carrying cases; sunglasses; mouse pads; headphones for use with sound transmitting systems; computer application software for mobile phones, namely, software for gaming, use in communicating and networking over social media; bicycle helmets.

Class 14: *Jewelry, Jewelry cases; clocks; watches, charms and charm bracelets; jewelry, namely, dog tags for wear by humans for decoration purposes; key chains.*

Class 16: *Printed materials, namely, books and magazines in the fields of music, entertainment, art and culture; appointment books; calendars; post cards; date books; decals; stickers; posters, souvenir programs with photographs, souvenir programs without photographs, books with photographs, books without photographs, magazines with photographs, magazines without photographs, all featuring information on a dancing and singing group of performers; stationery, post cards, framed photographs, unframed photographs, posters and trading cards; calendars; art prints*

featuring emojis and emoticons; bookmarks; children's books; audio cassette books, namely, a series of children's fiction books and cassette tapes packaged together; coloring books; a series of fictional children's books; corrugated record storage boxes; calendars printed onto cards; wall and desk calendars; trading cards; greeting cards; holiday cards; modeling clay sets composed primarily of modeling clay and also including sculpting tools and printed instructions; coloring sets comprised primarily of coloring books, and also including crayons, drawing paper and printed numbered instructions; painting sets for children; printed paper signs for use as doorknobs hangers; ... magazines in the field of children's hobbies and play activities; fan magazines in the field of entertainment, film, television, music, dance, comic books; memo pads; novels; ... pencils; decorative pencil top ornaments; pencil drawing sets for children comprised primarily of drawing pencils and also including drawing paper; posters; framed and unframed photographs; ... stationery writing paper and envelopes; stencils; sticker decal sets; sticker albums; stickers; paper gift tags, theme notebooks, erasers, document portfolios.

Class 18: *Leather goods, namely, purses; briefcases; credit card cases; carrying cases; briefcase-type portfolios; wallets; tote bags, coin purses; gym bags, back packs, book bags.*

Class 21: *Sports bottles and water bottles sold empty.*

Class 24: *Textile goods, namely, bed sheets; bedspreads, fitted bed sheets, pillowcases, bed blankets, pillow shams, tablecloths not of paper; beach towels, towels, hand towels, washcloths, draperies.*

Class 25: *Clothing, namely, t-shirts, sweatshirts, sweatsuits, nightshirts, hosiery, tights, leggings, lingerie, bodysuits; underwear; undergarments; jackets; pajamas; pants; shorts; shirts; sweat shirts; sweat pants; sweat jackets; tank tops; tops and clothing accessories, namely, scarves, bandanas, belts, garter belts, hats, caps and headwear; footwear, namely, flip flops, slippers, shoes, boots, sandals, sneakers, hiking shoes, running shoes,*

walking shoes; cloth aprons, bathing suits, clothing belts, children's sleepwear; boxer shorts, clothing caps; Halloween costumes; children's footwear; gloves; hats; ski hats; headbands; outerwear jackets; jumpsuits; mittens; neck warmers; children's pram suits; children's raincoats; robes; socks; stockings; suspenders; sweaters.

Class 26: Hair accessories, namely, plastic styling inserts that create height and volume on the crown of the head; Hair accessories, namely, snap clips; Hair accessories, namely, twistors; Hair bands; Hair barrettes; Hair bows; Hair buckles; Hair chopsticks; Hair clips; Hair elastics; Hair ornaments not of precious metal; Hair scrunchies; Ponytail holders and hair ribbons.

Class 28: Christmas tree ornaments; plush toys; puzzles; and stuffed toy animals, dolls, children's toy bicycles and tricycles, other than for transport; roller skates; balloons; amusement products, namely, plastic inflated balls; inflatable toys in the nature of pounding bags; toy boxes; kites; Halloween costume masks; elbow pads for athletic use; knee pads for athletic use; inflatable swimming rings; inflatable wading pools; ride-on toys; skateboards; snow skis and ski poles; snow sleds for recreational use; snow boards; action type target games; role-playing game toy play sets for children to imitate real life occupations; miniature toy vehicles; bubble making wand and solution activity toy sets; stuffed plush toys; miniature motorized toy vans; toy whistles; decorative wind socks; coin operated pinball games; coin operated arcade type video game machines; yo-yo's, basketball goal game set containing basketball hoop, net, and basketball; role playing toys in the nature of play shaving kits with play shaver, shave cream and brush for children to imitate real life activities; children's fishing kits, consisting of plastic fly box, plastic worms, hooks and lines for fishing; play arts and craft sets comprised primarily of toy synthetic dough, and also including modeling clay moulds, a modeling knife, play mats and printed instructions; paper party hats.

Class 30: Sugar and confectionary, namely, bubble gum, fruit-flavored candy, gummy candies, candy excluding chocolate candy, and sucking candy in the

nature of lollipops; novelty confectionery, namely, chocolate candy in the shape of eggs; cookies; crackers; fruit ice bars; popped popcorn.

Class 35: *Online retail store services featuring sound recordings, video recordings, DVD's, ...souvenir programs, printed material, calendars, clothing, clothing accessories, headwear, footwear ...; computerized on-line ordering featuring general merchandise and general consumer goods; computerized on-line ordering services in the field of music; computerized online retail store services in the field of music; computerized on-line gift ordering services which matches the gift giver's requirements with the gift recipients wants and needs; on-line retail store services featuring downloadable pre-recorded music and audio-visual content, clothing, and general merchandise; organization of promotions using audio-visual media; promoting the concerts of others; providing information about the goods and services of others via a global computer network; retail store services available through computer communications featuring CD's, cassettes, DVD's, videocassettes and licensed merchandise.*

Class 41: *Entertainment services, namely, live stage performances by a dancing and singing group of performers; entertainment in the nature of live concerts and performances by musical artists and groups; entertainment services, namely, personal appearances by musical groups, musical artists and celebrities; entertainment services in the nature of presenting live musical performances rendered by musical artists broadcast over television, radio, and online non-downloadable audio and video media; entertainment services, namely, performances by musical artists rendered live and recorded for future distribution; organizing exhibitions for entertainment purposes featuring music and the arts.*

149. This ground, insofar as it is based on the opponents earlier RAINBOW/RAINBOWS registrations, fails in respect of the goods and services identified in paragraph 142 and the following services which I have found, at best, are similar to the opponent's goods and services to only a very low degree:

Class 35: *association services, namely, promoting the interests of musicians, singers, songwriters, musical performers and artists*

Class 41: *providing an entertainment website featuring biographical information, photographs, tour and performance information on a dancing and singing group of performers; entertainment services, namely, providing a website featuring photographic, audio, video, and prose multimedia presentations featuring entertainment news, dancing and singing group performances, user videos, games materials, production and publishing of music; providing an online entertainment website featuring non-downloadable sound and video recordings in the field of music and music-based entertainment; entertainment services, namely, providing playback of online non-downloadable prerecorded musical sound and video recordings via a global computer network; audio and sound recording and production; ...; entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, related film clips, photographs, and other multimedia materials in the nature of entertainment news, music, film, photography and dance; entertainment services, namely, providing on-line reviews of music, musical artists and music videos; entertainment services, namely, providing prerecorded non-downloadable music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; entertainment services namely, live, televised and movie appearances by a professional entertainer; ... and publishing of web magazine; Distributorships in the field of music; Distributorships in the field of musical sound recordings and video recordings.*

Likelihood of confusion with the opponent's RANGERS marks

150. In respect of the similarity of goods and services, whilst there are slight differences to that found when comparing the goods and services of the opponent's RAINBOW/RAINBOWS registrations, the range of similarity is the same, ranging between no similarity and identity. Further, I reached the same conclusions regarding the distinctive and dominant parts of the respective marks, the respective marks' level of similarity and the average consumer and the nature of the purchasing

process. There is a difference when considering the level of distinctive character of the opponent's earlier mark, namely, that its RANGER/RANGERS marks do not benefit from an enhanced level of distinctive character.

151. There is no likelihood of confusion in respect of the following list of the applicant's goods and services because they share no similarity to any of the opponent's goods and services:

Class 9: *children's swim goggles.*

Class 16: *paper lunch bags; cardboard party decorations, namely, cut-out character stands for decoration, facial tissues.*

Class 27: *Carpets, rugs, mats and matting, linoleum for covering existing floors; floor coverings; other materials for covering existing floors, namely, vinyl floor coverings; non-textile wall hangings; tapestry-style wall hangings, not of textiles; wall paper; bath mats; throw rugs; bath textiles, namely, textile bath mats.*

Class 35: *Online retail store services featuring cosmetics, fragrances, tickets for concerts and tours*

152. Once again, Mr Muir Wood submitted that there exists a likelihood of indirect confusion. Ms Jones relied on her claim that RANGERS does not have an independent distinctive role in the applicant's mark. I was referred to the decision of Philip Johnson, sitting as the Appointed Person in *Be:FIT London Trade Mark*, BL O-385-18²⁶, paragraph 13 that, itself, referred to Mr Purvis' comments reproduced at paragraph 144, above. I accept that the consumer will perceive the respective marks as being different, but it will also be noticed that they both share the same RANGERS element and, further, in such circumstances, the average consumer is likely to perceive RANGERS as a shortened version of RAINBOW RANGERS or

²⁶ Ms Jones identified the case as *Lions Gate Entertainment Inc v Telegraph Media Group* [2019] FESR 16

RAINBOW RANGERS as a sub-group of RANGERS. In either case, it is likely that the consumer will assume that, because of this link, the marks originate from the same or linked undertaking where the respective goods and services share a low or higher degree of similarity. The General Court has previously recognised that a common element at the end of a mark may be sufficient to create a likelihood of confusion²⁷ and I find that there is a likelihood of indirect confusion.

153. In light of these findings, the section 5(2)(b) ground, insofar as it is based upon the opponent's earlier RANGERS registration is successful in respect of the following list of the applicant's goods and services:

Class 9: The same list of goods as shown in paragraph 151, above.

Class 14: *Jewelry, Jewelry cases; clocks; watches, charms and charm bracelets; jewelry, namely, dog tags for wear by humans for decoration purposes; key chains.*

Class 16: *Printed materials, namely, books and magazines in the fields of music, entertainment, art and culture; appointment books; calendars; post cards; date books; decals; stickers; posters, souvenir programs with photographs, souvenir programs without photographs, books with photographs, books without photographs, magazines with photographs, magazines without photographs, all featuring information on a dancing and singing group of performers; stationery, post cards, framed photographs, unframed photographs, posters and trading cards; calendars; art prints featuring emojis and emoticons; bookmarks; children's books; audio cassette books, namely, a series of children's fiction books and cassette tapes packaged together; coloring books; a series of fictional children's books; corrugated record storage boxes; calendars printed onto cards; wall and desk calendars; trading cards; greeting cards; holiday cards; modeling clay sets composed primarily of modeling clay and also including sculpting tools and printed instructions; coloring sets comprised primarily of coloring books, and*

²⁷ *Bristol Global Co Ltd v EUIPO*, T-194/14

also including crayons, drawing paper and printed numbered instructions; painting sets for children; printed paper signs for use as doorknobs hangers; ...; magazines in the field of children's hobbies and play activities; fan magazines in the field of entertainment, film, television, music, dance, comic books; memo pads; novels; paper design patterns for the transferring of graphic designs onto costumes; pencils; decorative pencil top ornaments; pencil drawing sets for children comprised primarily of drawing pencils and also including drawing paper; posters; framed and unframed photographs;...; stationery writing paper and envelopes; stencils; sticker decal sets; sticker albums; stickers; ...; paper gift tags, theme notebooks, erasers, document portfolios.

Class 18: *Leather goods, namely, purses; briefcases; credit card cases; carrying cases; briefcase-type portfolios; wallets; tote bags, coin purses; gym bags, back packs, book bags, clothing for pets*

Classes 21, 24, 25, 26, 28 and 30: The same list of goods as shown in paragraph 151, above.

Class 35: *Online retail store services featuring sound recordings, video recordings, DVD's, ..., souvenir programs, printed material, calendars, clothing, clothing accessories, headwear, footwear, ...; computerized on-line ordering featuring general merchandise and general consumer goods; computerized on-line ordering services in the field of music; computerized online retail store services in the field of music; computerized on-line gift ordering services which matches the gift giver's requirements with the gift recipients wants and needs; on-line retail store services featuring downloadable pre-recorded music and audio-visual content, clothing, and general merchandise; organization of promotions using audio-visual media; promoting the concerts of others; providing information about the goods and services of others via a global computer network; retail store services available through computer communications featuring CD's, cassettes, DVD's, videocassettes and licensed merchandise.*

Class 41: *Entertainment services, namely, live stage performances by a dancing and singing group of performers; providing an entertainment website featuring biographical information, photographs, tour and performance information on a dancing and singing group of performers; entertainment services, namely, providing a website featuring photographic, audio, video, and prose multimedia presentations featuring entertainment news, dancing and singing group performances, user videos, games materials, production and publishing of music; providing an online entertainment website featuring non-downloadable sound and video recordings in the field of music and music-based entertainment; entertainment services, namely, providing playback of online non-downloadable prerecorded musical sound and video recordings via a global computer network; audio and sound recording and production; entertainment in the nature of live concerts and performances by musical artists and groups; entertainment services, namely, personal appearances by musical groups, musical artists and celebrities; entertainment services in the nature of presenting live musical performances rendered by musical artists broadcast over television, radio, and online non-downloadable audio and video media; entertainment services, namely, performances by musical artists rendered live and recorded for future distribution; entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, related film clips, photographs, and other multimedia materials in the nature of entertainment news, music, film, photography and dance; entertainment services, namely, providing on-line reviews of music, musical artists and music videos; entertainment services, namely, providing prerecorded non-downloadable music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; entertainment services namely, live, televised and movie appearances by a professional entertainer; organizing exhibitions for entertainment purposes featuring music and the arts; and publishing of web magazine; Distributorships in the field of music; Distributorships in the field of musical sound recordings and video recordings.*

Summary of section 5(2)(b) outcome

154. Combining the outcomes based upon both the RAINBOWS/RAINBOW and RANGERS/RANGER earlier marks, the section 5(2)(b) grounds succeeds in respect of the majority of the applicant's goods and services.

155. The only goods and services to survive this ground are listed below:

Class 9: *children's swim goggles.*

Class 16: *paper lunch bags; cardboard party decorations, namely, cut-out character stands for decoration, facial tissues.*

Class 27: *Carpets, rugs, mats and matting, linoleum for covering existing floors; floor coverings; other materials for covering existing floors, namely, vinyl floor coverings; non-textile wall hangings; tapestry-style wall hangings, not of textiles; wall paper; bath mats; throw rugs; bath textiles, namely, textile bath mats.*

Class 35: *Online retail store services featuring cosmetics, fragrances; online retail store services featuring tickets for concerts and tours; association services, namely, promoting the interests of musicians, singers, songwriters, musical performers and artists.*

Section 5(3)

156. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international

trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

157. The opponent relies upon a claimed reputation in respect of its series of four RAINBOW/RAINBOWS marks in respect of the following services:

Class 41: *Organisation of group activities in the education, cultural, training and entertainment fields; arranging and conducting educational and recreational conferences; provision of courses of instruction and training in camping, sports, homemaking, wood-craft; providing courses of instruction in self-awareness; organising of competitions, sporting events and displays; provision of club recreation and sporting facilities; education and training services in relation to a healthy lifestyle*

158. I will consider this ground only briefly. Proceeding on the fair assumption that, based on my finding that its marks have a reasonable enhanced distinctive character in respect of the services described by the first term relied upon, the marks have a reputation as claimed. Taking account of my findings under section 5(2)(b) it is also a reasonable assumption that the opponent would be able to demonstrate the requisite link in respect to at least some of the applicant's goods and services and these would lead to this ground being partially successful. However, the size of its reputation and the strength of the link would not be such as to extend the opponent's success to the goods and services that I have found to be dissimilar. Consequently, the opponent's reliance upon section 5(3) will not improve its level of success and there is no need for me to consider it further.

COSTS

159. The opponent has been substantially successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent a contribution towards the cost of the proceedings, calculated as follows:

Preparing statement of grounds and considering counterstatement £300

Official fee	£200
Preparing evidence and considering other sides evidence	£900
Preparing for and attending hearing	£800
TOTAL	£2200

160. I therefore order Genius Brands International, Inc to pay The Guides Association the sum of £2200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of July 2021

**Mark Bryant
For the Registrar**