BLO/629/22

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS NOS. 3468222, 3468227 & 3478317 IN THE NAME OF GENTING INTERNATIONAL MANAGEMENT PTE LTD

IN CLASSES 41 & 43

AND THE OPPOSITIONS THERETO UNDER NOS. 422070, 422071 & 422072 BY SKY LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF CLARE BOUCHER (O/223/22) DATED 15 MARCH 2022.

DECISION

Introduction

1. This is an appeal by Genting International Management Pte Ltd. ("**Appellant**") from decision O/223/22 of Ms C. Boucher ("**Decision**") concerning the opposition by Sky Limited ("**Respondent**") to the following applications ("**Applications**"):

Mark	Number	Filing date
GENTING SKYWORLDS	3468222	19/02/20
GENTING SKYWORLDS 云顶天城世界	3468227	19/02/20
GENTING SKYWORLDS	3478317	31/03/20

In each case the specification applied for was the same:

> Class 41
> *Education; providing of training; entertainment, sporting and cultural activities; amusement park operations and services; theme park operations and services; providing amusement arcade services; booking of seats for shows; bookmobile services; providing casino facilities; [gambling]; casino services; leasing of casino games; cinema presentations; movie theatre presentations; club services [entertainment or education]; arranging and conducting of colloquiums, concerts, conferences, congresses, seminars, symposiums, workshops [training], beauty contests and exhibitions for cultural or educational purposes and fashion shows for entertainment purposes; cultural, educational or entertainment services provided by art galleries; disc jockey services; discotheque services; entertainment services; entertainment information; conducting fitness classes; gambling services; gaming services; game services provided on-line from a computer network; providing golf facilities; conducting guided tours; health club services [health and fitness training]; holding camp services [entertainment]; karaoke services; nightclub services [entertainment]; organization of competitions [education or entertainment]; organization of exhibitions for cultural or education purposes; organization of lotteries; organization of balls; organization of entertainment events;*

party planning [entertainment]; presentation of variety shows; presentation of live performances; providing recreation facilities; sport camp services; ticket agency services [entertainment]; provision of advice, information and consultation in relation to the afore-mentioned services; Providing theme park facilities; Theme park services; Amusement park and theme park services; Amusement arcade services; Amusement center services; Amusement centre services; Amusement park services; Providing amusement arcade services; Providing amusement facilities; Providing amusement park facilities; Amusement park and funfair services; Production of amusement park shows; Entertainment in the nature of an amusement park ride; Entertainment in the nature of an amusement park show; Entertainment services provided by recreation and amusement parks; Rental of amusement machines and apparatus; Entertainment in the nature of a water park and amusement center; Entertainment in the nature of a water park and amusement centre; Entertainment services in the nature of an amusement park show.

Class 43

Services for providing food and drink; temporary accommodation; bar services; boarding house services; café services; cafeteria services; rental of chairs, tables, table linen, glassware; rental of cooking apparatus; rental of water dispensers; food and drink catering; food sculpting; holiday camp services [lodging]; hotel services; resort hotel services; hotel reservations; rental of meeting rooms; motel services; reception services for temporary accommodation [management of arrivals and departures]; restaurant services; self-service restaurant services; snack-bar services; rental of temporary accommodation; temporary accommodation reservations; rental of tents; tourist home services; rental of transportable buildings; provision and rental of space for food and drink services; boarding of animals; reservation services; hotel reservation services; hotel reservation services provided via the internet; providing online information relating to hotel reservations; making hotel reservations for others; agency services for booking of hotel accommodation; provision of advice, information and consultation in relation to the afore-mentioned services.

2. The Respondent relied upon UK Trade Mark No. 3353626 (**SKY**), the filing date for which was 14 November 2018 and the registration date for which was 1 March 2019 ("**Earlier Mark**"). The Respondent relied upon the following services in class 41:

Providing audio, visual and/or audio visual content; production, compilation, presentation and distribution of audio, visual and/or audio visual content; providing audio, visual and/or audio visual news and current affairs content; production, compilation, presentation, distribution, dissemination and syndication of audio, visual and/or audio visual news and current affairs content; news reporting services; providing audio, visual and/or audio visual sports and/or esports (multi player video game competitions) content; production, compilation, presentation, distribution, dissemination and syndication of audio, visual and/or audio visual sports and/or esports (multi player video game competitions) content; sports reporting services; providing audio, visual and/or audio visual content relating to art and culture; production, compilation, presentation and distribution of audio, visual and/or audio visual content relating to art and culture; providing online computer games; providing online bookmaking services; providing online sports, virtual sports and/or esports (multi player video game competitions) betting services; providing online bingo, poker, roulette, card games, scratch card games, fruit machine games, slot machine games and jackpot games; providing education and

training programmes for young people and sports coaches; arranging, organising and/or running of cyclists and/or a cycling team; arranging, organising and/or running of sportsmen and sportswomen in sports and/or a sports team; providing professional cycling services, namely providing support services during cycling events; arranging, organising and running of cycling events; organising assault courses, theatre performance and escape room games; planning, organising and running of festivals; operation of theme parks; operation of cinemas; providing online ticketing services; providing information and education relating to environmental conservation; information, advice and customer support services relating to all the aforesaid services.

3. In the Decision, C. Boucher for the Registrar held that the opposition was partially successful. The applications were refused in respect of services in class 41 relating to *amusement parks* and *theme parks*. In addition, the Hearing Officer carved out *amusement park* and *theme park* related services from broader classes which would otherwise have encompassed them.

4. On 12 April 2022 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

5. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):

    a. The average consumer of the Appellant's services will in most instances be a member of the general public. For *Leasing of casino games*, *Rental of amusement machines and apparatus* and *Provision and rental of space for food and drink services*, the average consumer will be a business. Other services, such as *Hotel services*, will be purchased by both businesses and the general public.

    b. The average consumer will pay a medium to slightly higher than medium degree of attention when choosing a provider of *gambling services*. For the remaining services directed towards the general public, they will pay a medium degree of attention. For the services directed specifically towards businesses, the average consumer will pay a slightly higher than medium degree of attention

    c. Visual considerations will make the greater impression in selecting the services, but the average consumer will also hear the mark used aurally.

    d. The Hearing Officer divided the Appellant's services into categories. She found that certain services, including those relating to *theme parks* and *amusement parks*, are identical to services in the Earlier Mark. Of the remaining services, she found that some are similar to a high, medium or low degree, and some are dissimilar.

    e. The Earlier Mark is inherently distinctive to a medium degree in respect of the services which she found to be identical or similar to the services in the Applications. For a subset of services, listed in paragraph 122 of the Decision, the Earlier Mark has a very strong reputation, and the inherent distinctiveness of the mark has been enhanced to a high degree in respect of such services.

    f. The Hearing Officer assessed that each of the Applications has a low degree of phonetic similarity, and no more than a medium degree of conceptual similarity to the Earlier Mark. As for visual similarity, she assessed the '222 application as being similar to a low degree, the '227 application lower, and the '317 application lower still.

g. There is no likelihood of direct confusion between any of the Applications and the Earlier Mark in respect of any of the services. However, in respect of services relating to *amusement parks* and *theme parks*, there is a likelihood of indirect confusion.

h. The Hearing Officer rejected the s. 5(3) oppositions, on the basis that the average consumer would not make a link between the marks.

Grounds of Appeal

6. The Appellant contended that the Hearing Officer made the following errors of principle and/or assessment:

1. **Errors in the assessment of similarity**: The Hearing Officer erred in her application of the law on composite marks and the assessment of "independent distinctive elements". Specifically:

a. She failed to identify whether at least one element of the composite elements of each of the Applications is either identical, or almost identical, to the Earlier Mark.

b. She failed to carry out a global comparison of the whole of each of the Applications with the Earlier Mark.

c. In the alternative, even if she did carry out a global comparison, she failed to give any, or any sufficient, significance to the GENTING element of the composite marks on the impact of the mark as a whole on the average consumer.

2. **Errors in the assessment of likelihood of indirect confusion**: The Hearing Officer failed to provide any proper basis for concluding that there is a likelihood of indirect confusion in respect of *theme park* and *amusement park* services where she had already held that there is no likelihood of direct confusion.

3. **Inconsistency between s. 5(2)(b) and s. 5(3) findings**: The Hearing Officer's finding that the Applications will cause a bringing to mind that is "no more than fleeting" is inconsistent with her finding of a likelihood of indirect confusion.

7. The Appellant's Counsel, Ms Chantrielle, expanded upon the above in her skeleton argument and orally at the hearing. The Respondent's Counsel, Mr Hall, sought to uphold the Hearing Officer's decision, and also relied upon a Respondent's Notice. Mr Hall also filed a skeleton argument and made further oral submission during the hearing. I set out below further details of the parties' arguments as are necessary to understand my overall conclusions. I am grateful to both Counsel for their clear written and oral submissions, which I found very helpful.

Standard of review

8. The approach to be adopted in an appeal hearing has been laid down a number of times in case law, both in general terms (e.g. by the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671) and specifically in relation to appeals before the Appointed Person (Daniel Alexander Q.C. sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17), approved by Arnold J in *Apple Inc. v Arcadia Trading Limited* [2017] EWHC 440 (Ch)). These cases establish the following principles:

- Appeals to the appointed person are by way of review, not re-hearing;
- It is necessary for the appellant to satisfy the appeal tribunal that there was a distinct and material error of principle in the Hearing Officer's decision, or that the Hearing Officer was wrong;
- In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it;
- In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation;
- Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice;
- The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account.

9. In addition to the above, Mr Iain Purvis QC sitting as the Appointed Person in *ROCHESTER Trade Mark*, BL O/049/17, made the following observations at paragraph 33:

> "… the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:
>
> (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
>
> (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
>
> (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence ….

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case."

10. I shall bear all the above in mind when reviewing the Decision.

Discussion

11. Looking at the various alleged errors in turn, my analysis is as follows.

(1) **Errors in the assessment of similarity**

12. The Hearing Officer's comparison of the marks is set out at paragraphs 67-80. She reminded herself that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. However, 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.

13. The Respondent submitted that the '222 application represented its best case. I shall therefore confine my analysis in this section to the '222 application (set out again below), because if the opposition fails in respect of the '222 application, it will inevitably fail in respect of the other applications too.

GENTING SKYWORLDS

14. For the '222 application, the Hearing Officer held, at paragraphs 71-75, that:

- Both words contribute to the overall impression of the mark;
- The role played by SKYWORLDS may be slightly larger, given the disparity in size between the two, and the stylisation of the word draws the eye;
- However, the role of GENTING is far from negligible;
- Each word has an independent distinctive role in the mark;
- The average consumer will believe GENTING to be an invented word, with no conceptual content;
- The word SKYWORLDS brings to mind locations at high altitudes.

15. The Hearing Officer, at paragraph 94, reminded herself of her earlier findings:

"I agree that the average consumer will perceive GENTING and SKYWORLDS to have distinctive significance independently of the whole, and that the composite mark would not have a different meaning to the meaning of those separate components. I recall that I found that GENTING would be seen to be an invented word".

16. In her skeleton argument and oral submissions, Ms Chantrielle contended that the Hearing Officer failed to explain her finding that SKYWORLDS has distinctive significance independently

of the whole application. Mr Hall complained that such an argument was not set out in the Grounds of Appeal, and the Appellant should therefore not be permitted to run the argument at the hearing. I note that paragraph 4.1 of the Grounds of Appeal does contend that:

> "Had the Hearing Officer not so erred [in failing to explain how SKYWORLDS is similar enough to SKY for it to be considered to be the house mark of the Opponent], she would have found that [SKYWORLDS and SKY] were not identical, or almost identical, and therefore would not have taken the view that the mark SKY has independent distinctive significance on its own".

17. I shall give the benefit of the doubt to the Appellant on this point, and consider it alongside all the others raised in the Grounds of Appeal.

18. The main thrusts of the Appellant's criticisms were threefold. First, that the Hearing Officer misapplied the principle in Case C-120/04 *Medion AG v Thomson Sales Germany & Austria GmbH* and subsequent cases, namely that the average consumer, while perceiving a composite mark as a whole, may also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark. Secondly, she impermissibly focused on the SKYWORLDS element of the mark, rather than considering the mark as a whole. Thirdly, even if she did carry out a global comparison, she failed to give any, or any sufficient, significance to the GENTING element of the composite marks on the impact of the mark as a whole on the average consumer

19. In *Medion* itself, the CJEU was considering whether the use of the registered mark LIFE within the sign THOMSON LIFE constituted an infringement. It confirmed that where an earlier mark is incorporated into a composite sign, the earlier mark may retain an independent distinctive role in the composite sign.

20. In Case C-591/12 *P Bimbo SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*, the General Court considered an opposition to an application to register BIMBO DOUGHNUTS by the proprietor of an earlier registration, DOGHNUTS. The General Court held, at paragraph 97:

> "In this case, the 'doughnuts' element, which is almost identical to the earlier trade mark, has an independent distinctive role in the mark applied for. Indeed, contrary to what is claimed by the applicant, that element is not devoid of distinctive character but on the contrary has average distinctive character for the part of the relevant public which is not familiar with English. Furthermore, since the 'doughnuts' element is wholly meaningless for that consumer, the mark applied for, BIMBO DOUGHNUTS, does not form a unitary whole or a logical unit on its own in which the 'doughnuts' element would be merged. The part of the relevant public which is not familiar with English will not be able to understand the sign at issue as meaning that the goods concerned are doughnuts produced by the undertaking Bimbo or by the proprietor of the trade mark BIMBO."

21. The General Court's decision was subsequently upheld by the CJEU.

22. *Medion* and *Bimbo* have since been considered by the English High Court and by the Appointed Person. In *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch), Arnold J (as he then was) reviewed *Medion* and *Bimbo* and concluded, at paragraph 44:

> "Although the decision in *Medion v Thomson* does not in terms extend to cases in which the composite sign incorporates a sign which is similar to, rather than identical with, the trade mark and some of the Court of Justice's reasoning would not apply to such a case, I consider that the underlying logic is equally applicable."

23. Subsequently, in *Whyte and Mackay Limited v Origin Wine UK Limited* [2015] EWHC 1271 (Ch), Arnold J said at paragraph 18:

> "The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark."

24. In *Brewdog Plc vs UKIPO* O/048/18, Professor Phillip Johnson, sitting as the Appointed Person, said at paragraphs 36-37:

> "The only third party mark included in BREWDOG ELVIS JUICE is ELVIS. While the included earlier mark need not be identical, it must be very similar. The General Court in T-569/10 *Bimbo v OHIM* (2012) ECLI:EU:T:2012:535 considered that an element DOUGHNUT (in BIMBO DOUGHNUT) could have an independent distinctive character because it was "almost identical to" DOGHNUTS (paragraph 97). The General Court decision was upheld by the Court of Justice C-591/12 *Bimbo v OHIM* (2014) ECLI:EU:C:2014:305.
>
> Arnold J concludes that *Bimbo* means that the rule in *Medion* applies to marks which are similar as well as those which are identical: *Whyte and MacKay v Origin Wine* [2015] EWHC 1271 (Ch), paragraph 18. This word "similar" should be read in the context of the General Court's phrase "almost identical" rather than in a more expansive way."

25. The Appellant contends that:

> "The starting point therefore is for the Hearing Officer to identify whether the SKY and SKYWORLDS are identical (or near identical) and then to decide whether the SKYWORLDS element has distinctive significance independently of the whole. By failing to carry out the first step of the assessment, the Hearing Officer fell into error in the same way as in *Brewdog*. Had she carried out the first step, she would have found that the marks were not identical or similar enough to be considered to be a house mark and therefore did not possess distinctive significance independently of the whole."

26. I first need to consider whether the Hearing Officer was right to apply the approach in *Whyte and Mackay* – i.e. that the *Medion* principle is capable of applying where the composite mark contains an element which is similar to the earlier mark – or whether she ought to have applied the more restrictive approach in *Brewdog* – i.e. that the included earlier mark must be very similar/almost identical. I agree with the Appellant that if the *Brewdog* approach is the correct one, SKY and SKYWORLDS cannot be said to be near identical.

27. Under the doctrine of precedent, the *prima facie* position is that the principles set forth in *Aveda* and *Whyte and Mackay*, as judgments of the High Court, are binding on me, whereas the approach in *Brewdog*, being a decision of an Appointed Person, is persuasive but not binding.

If, however, Professor Johnson in *Brewdog* was reciting principles mandated by the General Court/CJEU, those principles would override *Aveda* and *Whyte and Mackay*.

28. In my view, whereas Professor Johnson was right to observe that in *Bimbo* the elements under consideration were almost identical, there is nothing in the reasoning of the General Court that confines the established principle only to marks which are almost identical. Arnold J was accordingly entitled to hold that the same principle can apply to marks which are "merely" similar, and not almost identical. As such, the more expansive approach laid down in *Aveda* and *Whyte and Mackay* is binding on me and the Hearing Officer. In any case, I respectfully agree with Arnold J's approach. The courts, including the English courts, the CJEU and the General Court, have generally been at pains not to be too prescriptive when laying down tests for assessing trade mark similarity and likelihood of confusion. This, no doubt, is because the courts recognise that, given the virtually limitless set of circumstances in which earlier trade marks may be incorporated in whole or in part (including in a modified form) in a later sign, it is important to leave a degree of flexibility to the courts and trade mark offices when assessing similarity and likelihood of confusion.

29. Turning now to the Hearing Officer's decision, she considered, at paragraphs 105-106, the Respondent's submissions and evidence as to the meaning of the element WORLDS in the context of *theme park* and *amusement park services*. She was invited to conclude that WORLDS is entirely descriptive in such a context. Although she did not expressly state that conclusion, it is clear from paragraph 107 that she must have reached such a conclusion. In my view, it is a conclusion that was open to her on the facts. Accordingly, therefore, she was entitled to conclude that SKY retains an independent distinctive significance in the '222 application.

30. I turn now to the second criticism under this head, namely that the Hearing Officer failed to carry out a global comparison of the whole of the applications with the Earlier Mark. There is no doubt that a global comparison is mandatory – see for example paragraph 21 of *Whyte and Mackay*, where Arnold J said:

> "… even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

31. The Hearing Officer reminded herself at three points in the Decision – paragraphs 17, 92 and 93 (where she quoted the above extract from *Whyte & Mackay*) – of the need to carry out a global assessment. At paragraph 94 she said:

> "I shall therefore consider the possibility that the average consumer might be confused by the similarity between SKY and SKYWORLDS, while keeping in mind that SKYWORLDS will be seen in the context of the mark as a whole and that my assessment must take account of all relevant factors". (my underlining)

32. I do not accept, therefore, that the Hearing Officer failed to have regard to the need to carry out a global assessment. On the contrary, I believe it is clear that she did.

33. As for the third criticism under this head, I do not agree that the Hearing Officer failed to give any, or any sufficient, significance to the GENTING element. Again, on the contrary, it is clear that she did. In paragraph 107, she said "I consider that the average consumer would assume that there is an economic connection between the opponent and the applicant providing its own theme park and amusement park services under any of the GENTING SKYWORLDS marks…". As I explain in paragraph 40 below, the reason that the Hearing Officer came to that conclusion is that she found that the average consumer would regard the sign as the result of a co-branding initiative between GENTING and SKY. She could not have reached that conclusion without having given consideration to the GENTING element and the part it plays in the Appellant's mark as a whole.

34. Accordingly, I reject this ground of appeal.

(2) **Errors in the assessment of likelihood of indirect confusion**

35. Before addressing this substantive ground, I first deal with another issue that was objected to by Mr Hall at the hearing. Ms Chantrielle contended, in oral submissions, that the Hearing Officer had failed to deal with each of the Applications separately, and it was not apparent which one(s) she was considering when assessing likelihood of indirect confusion. The Hearing Officer had noted, at paragraph 69, the Respondent's contention that the '222 application represented its best case. Ms Chantrielle submitted that if the Hearing Officer had confined her analysis only to the '222 application, she may improperly have made findings of a likelihood of indirect confusion in respect of the other two applications, without actually considering them.

36. Mr Hall submitted that this issue was not foreshadowed either in the Grounds of Appeal or in Ms Chantrielle's skeleton argument. Ms Chantrielle responded that it was set out in the Grounds of Appeal, paragraph 4.2 of which includes "The Hearing Officer failed to carry out a global comparison of the whole of each of the Applicant's marks with the Opponent's Marks". Although it is not entirely clear to me that the criticism in that sentence is of an alleged failure to consider each of the marks, as opposed to an alleged failure to carry out a global comparison, I shall again give the Appellant the benefit of the doubt and deal with the point raised.

37. I believe it is clear that the Hearing Officer did consider each of the applications. At paragraph 107 the Hearing Officer said:

> "I am required to make an assessment of the likelihood of confusion on a notional basis. The opponent's earlier mark is registered for *Operation of theme parks*. It did not have to prove that it was using the mark for these services. In a scenario in which a theme park may be operated under the SKY mark, I consider that the average consumer would assume that there is an economic connection between the opponent and the applicant providing its own theme park and amusement park services under any of the GENTING SKYWORLDS marks, given the practices in the industry sector". (my underlining)

38. Furthermore, her analysis at paragraph 94 onwards focuses entirely on the words, and makes no reference to any visual elements. In my view, the Hearing Officer was clearly looking at the word mark (the '317 application) in her analysis. That mark was the weakest one from the Respondent's perspective, and a finding of a likelihood of indirect confusion in respect of it would necessarily apply to the other applications too. I therefore do not accept that the Hearing Officer failed to consider each of the applications.

39. Turning now to the main issue under this head, it is certainly the case, following *Sazerac Brands LLC et al v. Liverpool Gin Distillery Ltd et al* [2020] EWHC 2424, that there must be a "a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion". The Hearing Officer concluded at paragraph 99 that there is no likelihood of direct confusion. She then, in the next 7 paragraphs, considered the Respondent's submissions and evidence in support of the contention that there would be a likelihood of indirect confusion. At paragraph 101, the Hearing Officer made the finding that SKY is used on a wide range of services, not just in relation to its core services (the audio-visual services). She further noted that the evidence submitted by the Respondent includes examples of co-branding, including with Netflix and WWF. As I explain at paragraph 29 above, she impliedly concluded that WORLDS is entirely descriptive in the context of *theme park* and *amusement park services*.

40. Drawing all the above together, the Hearing Officer was clearly of the view that the average consumer would see the sign GENTING SKYWORLDS, form the view that in the context of *theme park* and *amusement park* services the WORLDS element is entirely descriptive, and consequently regard the sign as the result of a co-branding initiative between GENTING and SKY. Such a possibility is expressly countenanced by Arnold LJ in *Liverpool Gin*, where he said at paragraph 12:

> "[*LA Sugar*] is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing)."

41. As I see it, it is clear that the Hearing Officer, in paragraphs 100-106, was setting out the evidence and reasoning for her actual decision, in paragraph 107, that there is a likelihood of indirect confusion. If I am wrong in that regard, I accede to the points made in the Respondent's Notice, and hold that the Hearing Officer's conclusion at paragraph 107 is supported by the facts and matters set out in paragraphs 100-106. In either case, the contents of paragraphs 100-106 established a proper basis, as required by *Liverpool Gin*, for her decision.

42. Overall, I observe that the Hearing Officer's analysis of the likelihood of indirect confusion was a sophisticated one. Although she held that numerous of the services in the Applications were identical to those in the Earlier Marks, it was only in relation to one narrow subset of such services – those relating to *amusement parks* and *theme parks* – that there was a likelihood of indirect confusion, because it was only in respect of such services that the element WORLD would be entirely descriptive. I detect no error of principle in her approach, and her decision cannot be said to be wrong. I reject this ground of appeal.

(3) **Inconsistency between s. 5(2)(b) and s. 5(3) findings**

43. I can deal briefly with this ground. At paragraph 133, the Hearing Officer said:

> "Taking all the factors into account, I find that the significant differences between the marks, even for identical services and where the earlier mark is distinctive and has a strong reputation will, at best, cause a bringing to mind that is no more than fleeting."

That finding is said to be entirely inconsistent with her earlier finding of a likelihood of indirect confusion in respect of *amusement parks* and *theme parks*.

44. This would be a powerful submission if her finding of "a bringing to mind that is no more than fleeting" was in relation to *amusement parks* and *theme parks*. However, the Hearing Officer did not find (nor was she asked to find) that the Earlier Mark had a reputation in relation to *operation of theme parks*. Accordingly the Hearing Officer's reference to "even for identical services" cannot have been a reference to *theme parks* and *amusements parks*, and she cannot have been considering *theme parks* and *amusements parks* when reaching her conclusion that the bringing to mind would be no more than fleeting.

45. Furthermore, in respect of the services for which she did make the "bringing to mind that is no more than fleeting" finding, the Hearing Officer had held in paragraph 104 that there would be no likelihood of confusion under s5(2)(b). That conclusion is entirely consistent with the finding that there would be no link under s. 5(3).

46. I therefore reject this ground of appeal.

Conclusion

47. The Hearing Officer made no errors of principle, and her decision was not wrong. The appeal is dismissed.

Costs

48. Clearly, the Respondent has been the successful party in this appeal. I order that the Appellant should pay the Respondent £1,200 by way of costs of this appeal, comprising:

- Consideration of the appeal, preparation of Respondent's Notice: £600
- Attendance at hearing: £600.

Dr. Brian Whitehead

25 July 2022

Representation

Ms Ashton Chantrielle of Counsel for the Applicant / Appellant, instructed by HGF Limited

Mr Christopher Hall of Counsel for the for the Opponent / Respondent, instructed by CMS Cameron McKenna Nabarro Olswang LLP