O/0094/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004001371
BY RYAN ARNOLD TO REGISTER:

AS A TRADE MARK IN CLASSES 9, 35 & 41

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 447083 BY
PARAISO SCHOOL OF SAMBA

BACKGROUND AND PLEADINGS

1. On 12 January 2024, Ryan Arnold ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK ("the applicant's mark"). The applicant's mark was published on 26 January 2024 and registration is sought for the following goods and services:

Class 9: Music recordings; Downloadable music sound recordings; Downloadable music files; Musical recordings; Sound recordings; Musical sound recordings; Records [sound recordings]; Downloadable sound recordings.

Class 35: Promotion services; Promotion [advertising] of concerts; Marketing, advertising and promotion services; Advertising, marketing and promotion services; Promotion of special events; Event marketing; Promotion of musical concerts; Product merchandising; Online retail store services relating to clothing; Online retail store services in relation to clothing; Retail services connected with the sale of clothing and clothing accessories.

Class 41: Organisation of musical events; Presentation of live entertainment events; Musical events (Arranging of -); Arranging of musical events; Disc jockeys for parties and special events; Disc jockey services for parties and special events; Record mastering; Record masters (Production of -); Production of record masters; Record master production; Music recording; Music concerts; Music festival services; Publication of music; Live musical concerts; Music publishing and music recording services; Recording of music; Music publishing; Publishing of music; Production of sound and music recordings.

2. On 23 April 2024, the applicant's mark was partially opposed by Paraiso School of Samba ("the opponent"). The opposition is aimed at only those goods and services underlined above and is based on sections 5(1), 5(2)(a), 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). Under each ground of opposition, the opponent relies on the following trade marks:

PARAISO
UK registration no. 2406412
Filing date 14 November 2005; registration date 23 June 2006
Expiry date: 14 November 2025[1]
Relying on all services, namely:

Class 41: Education; providing of training; entertainment; sporting and cultural activities.

("the opponent's first mark"); and

PARAISO
UK registration no. 905517231[2]
Filing date 1 December 2006; registration date 12 September 2007
Relying on all goods and services, namely:

Class 9: Sound and video recordings; audio tapes and video tapes; records, discs, tapes, cassettes, cartridges, cards and other carriers; video recordings, data, images, graphics, text, programs or information; apparatus for recording, transmission or reproduction of sound or images; compact discs, interactive compact discs, CD-ROMs and DVDs, mini-disks, CD-Is;

[1] Despite being an expired mark, the opponent's first mark remains a valid mark for the purpose of these proceedings as the expiry date is after the relevant date, being the filing date of the applicant's mark.
[2] The opponent's second mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

publications in electronic form, supplied on-line from databases or from facilities on the Internet; digital music provided from the Internet; computer software; educational software.

Class 15: Musical instruments.

Class 41: Education; providing of training; entertainment; sporting and cultural activities.

("the opponent's second mark").

3. The opponent relies on its first mark to oppose only those services in class 41 and its second mark to oppose all of the goods and services underlined above. In filing its opposition, the opponent gave a statement of use in respect of the goods and services relied upon.

4. By virtue of relying on section 5(1) of the Act the opponent is claiming that the marks and goods and services at issue are identical, meaning that the mark should be refused registration. As for its section 5(2)(a) ground, the opponent maintains its position that the marks are identical but that the goods and services at issue are similar. It is claimed that this would result in a likelihood of confusion. Under section 5(2)(b), the opponent's position is that the marks at issue are similar and that the goods and services at issue are identical and/or similar, which results in a likelihood of confusion.

5. Turning to the section 5(3) ground, the opponent claims that its marks have acquired a reputation for all the goods and services relied on. It is claimed that the similarity between the marks together with the reputation vested in the opponent's marks would cause the relevant public to think that they originate from the same or economically connected undertakings. As a result, the opponent's position is that use of the applicant's mark would take unfair advantage of the opponent's marks. In addition, the opponent claims that the use of the applicant's mark is likely

to be detrimental to the reputation and/or distinctive character of the opponent's marks.

6. The applicant filed a counterstatement wherein he denied the claims against him as well as requesting that the opponent prove that it has genuinely used its marks.

7. The applicant is represented by Sonder & Clay whereas the opponent is unrepresented. Only the opponent filed evidence. No hearing was requested and only the applicant filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

9. The opponent's evidence came in the form of the witness statement of Mr Richard Galbraith dated 29 September 2024. Mr Galbraith is an advisor to the Board of Trustees of the opponent, a position he has held since April 2023. Prior to this, he states that he was involved with the opponent since 2001 and was a Trustee from January 2006 to March 2019 and, from September 2019 to April 2023, he was Company Secretary. His statement is accompanied by 14 exhibits, being RG01 to RG14, and was adduced in order to prove that the opponent has genuinely used its marks and that they benefit from a reputation in the UK.

10. I do not intend to summarise the opponent's evidence in full here (or the applicant's submissions, for that matter). However, I confirm that I have taken all filed

documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> (aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;
>
> (ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.
>
> […]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

12. Section 6A is also relevant. It reads:

"(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), (aa) 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 relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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. Section 100 of the Act is also relevant. It reads:

"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."

14. As the opponent's second mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union".

15. Given their earlier filing dates, the opponent's marks qualify as earlier trade marks under the above provisions. The opponent's marks completed their registration processes more than five years prior to the filing date of the applicant's mark. As above, the applicant requested proof of use for the opponent's marks for all the goods and services relied upon meaning that they are subject to the use provisions.

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Bundervsvereinigung 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], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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]; *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]."

17. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant's mark, being 12 January 2024. The relevant period is, therefore, 13 January 2019 to 12 January 2024 ("the relevant period"). For completeness, I confirm that for the opponent's second mark only, the relevant territory for genuine use prior to 31 December 2020 ("IP Completion Day") is the EU at large but, thereafter, it is the UK only. The relevant territory for the opponent's first mark is the UK only.

18. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[3] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

[3] *Jumpman* BL O/222/16

19. In his written submissions in lieu, the applicant concedes that the opponent has put its marks to genuine use for "education and training, namely dance and drumming workshops" and "entertainment, namely performance and dance". He denies that the opponent has used its mark for any of the remaining goods and services relied upon. While I am still required to consider the evidence filed by the opponent in order to determine whether or not the other goods and services have been genuinely used, I will bear this concession in mind at the conclusion of the present assessment.

Evidence of use

20. In considering the evidence filed, I note it makes reference to activity prior to the relevant period. While not relevant to the present assessment, I will summarise it here as the opponent also relies upon the existence of a reputation under section 5(3). Such a ground is not restrained by a relevant period so this evidence may become relevant later on in my decision.

21. The evidence sets out that the opponent was formally established in 2006, though it claims to have begun using the mark as early as 2002. The opponent confirms that its mission is to advance education for the public benefit through the promotion of the arts with reference to samba culture, music, dance and carnival arts in the tradition of Rio de Janeiro, Brazil.

22. The evidence begins with discussions surrounding grants and funding given to the opponent. An example of this is the grant of £10,000 given in May 2019 by the Garfield Weston Foundation under their Sustaining Excellent programme. A copy of the letter confirming this is provided in evidence.[4] While the talk around funding and grants is noted, this does not actually demonstrate use (or a reputation, for

[4] RG02

that matter) as it does not pertain to the offering of actual goods or services to the public. Further, I see no reason why the wider public in the UK (or Europe, for that matter) would be aware of such events.

23. The evidence refers to the fact that half of the cast of the Flag Handover Ceremony of the London 2012 Olympics were from the opponent. In addition, in 2015, the opponent had 20 drummers participate in the filming of the movie 'PAN', starring Hugh Jackman and that it was credited as 'Paraiso Drumming School' in the end credits. While the opponent appreciates that this evidence is from prior to the relevant period, it claims that the online presence of the videos and use of the PARAISO mark existed during the relevant period via online videos. In support of this point, the opponent has provided screenshots of videos on YouTube as well as images taken from Flickr and Alamy.[5] Firstly, the YouTube screenshot shows a post from 2012 that was posted by the Olympics account.[6] It makes no reference to the opponent and while I appreciate that the opponent may have participated in the event being shown, I fail to see how the relevant public would have been aware of that fact, either at the time or during the relevant period. Further, there is a still image provided that shows the 'Paraiso Drumming School' listed in the end credits for 'PAN'.[7] This is noted and I accept that the public may have been able to watch the film during the relevant period. However, I am not convinced that many would have watched the entirety of the end credits to the point that they would have become aware of this and, even if they did, I am not convinced that they would take any note of it.

24. There are a number of other images provided in the same exhibit which include screenshots from Flickr and YouTube showing the opponent's presence at the 2022 and 2023 Notting Hill Carnival. While noted, there are no engagement figures for such posts so I am unable to determine their reach. That being said, I appreciate

[5] RG04
[6] While this account has over 14 million subscribers, this is not attributable to the opponent in any way.
[7] See page 3 of RG04

that the evidence does go on to state that the Notting Hill Carnival is attended by an audience of over 100,000 people and that during these events, the opponent's performers waved flags of the opponent's marks and wore branded 'PARAISO' t-shirts. Images demonstrating this from not only the Notting Hill Carnival but from various carnivals during the relevant period are provided in evidence.[8] While I have no doubt that the opponent participates in these events and that its marks were shown, it has not provided any further information as to its actual reach during these events. For example, there is no information as to whether the opponent's participation covers the entirety of the event (so as to potentially reach all 100,000 attendees) or just a small part of it. While this evidence may be capable of pointing to attempts to promote its marks at large events, I am not convinced that it demonstrates any level of awareness amongst the relevant public.

25. It is noted that the photographs discussed in the preceding paragraph also show the opponent's marks displayed on drums.[9] While the opponent does rely on musical instruments under its second mark, it has not provided any evidence as to whether it actually offers such products for sale. Even if it does, nothing is provided in order to indicate how many were sold during the relevant period. In my view, the appearance of the marks in these instances is merely an attempt at promoting its brand as opposed to making genuine use of the opponent's mark on drums.

26. The opponent goes on to state that its main activities are providing classes in dance, percussion and song as well as public parades/performances at carnivals and festivals. It also states that the opponent uses its marks in respect of the following:

    a. Education and providing training;
    b. Entertainment;
    c. Cultural activities;

[8] RG11
[9] See page 7 of RG11, for example

d. Video and sound recordings as well as downloadable music;
e. Musical instruments; and
f. T-shirts, caps and dresses.

27. The above is noted but, as above, there is nothing sufficiently solid in evidence to demonstrate the sale of any musical instruments. Further, the present opposition is not reliant upon any clothing goods.

28. In terms of what the opponent does actually sell, I note that it has provided a breakdown of its sales during the relevant period. This includes sales stemming from education and training (being dance and drumming classes), entertainment (public performances and festivals) and branded clothing. It also includes grants and donations obtained during the relevant period. Firstly, as I have explained above, the opponent does not rely on clothing in the present proceedings, therefore, the figures in relation to the same are of no assistance here. Secondly, the grants and donations are not, in my view, sales in the sense that they can be said to be attributed to the offering of goods and services to the relevant public. The figures associated with this are, therefore, irrelevant. This leaves the only relevant evidence as that relating to education and training, and entertainment. These figures, presented in British pounds, are as follows:

	2019	**2020**	**2021**	**2022**	**2023**	**Total**
Education & Training	27,039	8,598	8,655	19,766	19,793	83,851
Entertainment	68,240	2,198	0	16,090	11,865	98,393
Total	95,279	10,796	8,655	35,856	31,658	182,244

29. It is confirmed in the narrative evidence that the above figures run from 12 January until 11 January the following year meaning that, for example, the 2023 figures cover the period of 12 January 2023 to 11 January 2024.

30. In support of the above figures, the opponent has provided a range of example invoices demonstrating the sale of its services under the marks.[10] I see no need to summarise these but note that they do cover the provision of services throughout the relevant period, primarily to customers based in the London area.

31. In respect of the opponent's dance/drumming classes, evidence is provided as to how the classes are booked and paid for. The methods of how the classes are booked or paid for are not relevant to my decision but I do note that the screenshots provided by the opponent in respect of this issue do show attendance figures.[11] On this point, the screenshots show total attendance figures of 3,954 in 2019, 1,311 in 2020, 1,414 in 2021, 2,202 in 2022 and 2,520 in 2023. This equates to an average of 2,280 attendees a year. This evidence is noted but is not clear to me if the figures are meant to be viewed as a reference to individual attendees or whether they include repeat attendees.

32. The evidence discusses the fact that the opponent has commissioned and recorded 18 'Samba Enredo' songs which are confirmed to have been learnt and sung by carnival participants. An example of one of these songs is provided via a screenshot of the opponent's website which shows the 'Samba Enredo 2019'.[12] The page has the lyrics of the song in English and, presumably, Portuguese[13] as well as a link to download it. While the narrative evidence sets out that these are not actually sold, I am of the view that the provision of a downloadable song would constitute use of goods in class 9. However, the opponent has not provided any download figures for this song (or any of its songs) so I am unable to determine any level of use associated with the offering of such goods. Therefore, this evidence is of no assistance.

[10] RG07
[11] RG08
[12] RG12
[13] On the basis that the opponent's focus is on the samba of Brazil, where the primary language is Portuguese

33. Lastly, the opponent has provided a number of advertising materials such as flyers and stickers.[14] While these are noted, there is nothing before me to suggest where these were distributed, how many of them were distributed or to whom.

Assessment of the evidence

34. While the evidence provided does not show use at a high level (a total turnover of approximately £182,000 and an annual average attendance of 2,280 to the opponent's education/training services), I remind myself that use need not be quantitatively significant in order for it to be deemed genuine. In the present case, I am satisfied that the opponent has made a genuine attempt to create or preserve a market share for the services offered under its mark. Therefore, I accept that the opponent has genuinely used its marks. However, I am not convinced that it has proven use in relation to all of the goods and services relied upon. For example, as discussed above, the evidence is silent as to how many downloads were made of the songs available on the opponent's website so my finding of genuine use does not extend to cover such goods (which would fall within some of the class 9 goods relied upon).

35. Instead, it is my view that the only services the opponent has used its marks for cover the provision of entertainment services and educational services relating to Brazilian Samba dancing and drumming. In light of this finding, I would ordinarily limit the opponent's specification to cover these purposes. However, I remind myself that the applicant accepted that there was use for such services but that these should be limited to "education and training, namely dance and drumming workshops" and "entertainment, namely performance and dance". As far as I am aware, the reference to 'performance' is broad and can, therefore, cover not just dance performances but musical performances also. While I do not consider that the evidence necessarily covers musical performances, it is not appropriate for me

[14] RG13

to limit the terms beyond the concession of the applicant. As such, I find that the opposition may proceed in respect of the following services:

Class 41: Education and training, namely dance and drumming workshops; entertainment, namely performance and dance.

Sections 5(1), 5(2)(a) and 5(2)(b): legislation and case law

36. Section 5(1) of the Act reads as follows:

> "(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

37. Section 5(2) of the Act reads as follows:

> "(2) A trade mark shall not be registered if because-
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
>
> (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 or association with the earlier trade mark."

38. Section 5A of the Act states as follows:

"Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

39. The following principles, whilst relevant to section 5(2) only, are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*. Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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.

Identity of the marks

40. It is a prerequisite of sections 5(1) and 5(2)(a) of the Act that the marks at issue be identical. In considering whether marks are identical, I refer to the case of *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA,* Case C-291/00, wherein the Court of Justice of the European Union ("CJEU") held that:

> "54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

41. In the present case, I appreciate that the marks share the word 'PARAISO' and that the opponent's marks are word only marks meaning that they may be used in any standard typeface and in any colour. However, I do not consider that the device element in the applicant's mark would go unnoticed by the consumer. Therefore, it acts as a point of visual difference between the marks. As a result, I find that the marks are not identical. The consequence of this is that both the section 5(1) and 5(2)(a) grounds fall at the first hurdle. However, the section 5(2)(b) ground may proceed and I will now consider this in the ordinary way.

Comparison of goods and services

42. The competing goods and services are as follows:

The opponent's services	The applicant's goods and services
Class 41 Education and training, namely dance and drumming workshops;	Class 9 Music recordings; downloadable music sound recordings; downloadable music files; musical recordings; sound

entertainment, namely performance and dance.	recordings; musical sound recordings; records [sound recordings]; downloadable sound recordings. <u>Class 41</u> Organisation of musical events; presentation of live entertainment events; musical events (arranging of -); arranging of musical events; disc jockeys for parties and special events; disc jockey services for parties and special events; record mastering; record masters (production of -); production of record masters; music recording; music concerts; music festival services; live musical concerts; publishing of music.

43. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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".

44. 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.

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

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

46. I have submissions from the applicant in respect of the goods and services at issue. These submissions were made on the basis of the proposed limitation to the opponent's specification. As I have proceeded with the decision in line with the proposed limitation, the applicant's submissions on the goods and services

comparison remain relevant here. I confirm that while I do not intend to discuss these submissions further here, I have given them due consideration.

47. As for the opponent, the only comment I have from it is that the applicant's mark covers the field of entertainment and music and the organisation and presentation of musical and entertainment events, for which it claims to be well known. While noted, simply operating in the same fields is not sufficient by itself to render goods and services similar to a material degree. Instead, I am required to look at the wording of the actual terms before me and conduct a fair and notional assessment in respect of the same.[15]

Class 9

Music recordings; downloadable music sound recordings; downloadable music files; musical recordings; sound recordings; musical sound recordings; records [sound recordings]; downloadable sound recordings.

48. The nature and method of use of the above goods plainly differ from the services of the opponent. In terms of purpose, I appreciate that their core purposes differ but note that there is some overlap in end purpose. I say this because the ultimate aim of the applicant's goods and the opponent's entertainment service is to entertain the end user. Both the goods and the services will be sought by members of the general public at large. While this gives rise to an overlap in user, I consider it to be somewhat fleeting given the sheer size of the consumer base for both the above goods and the opponent's entertainment service. As for trade channels, the above goods are likely to be provided by recording companies whereas the opponent's service will be provided by the performance/dance troupe directly. On this point, I do accept that there may be some entertainment providers that offer the goods of the applicant as, for example, an undertaking that provides

[15] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

entertainment performances as a service may also sell (or offer for download) the audio of those performances. However, I have nothing before me to suggest that such a practice is common in the trade to warrant a finding that the trade channels overlap to a material degree. Lastly, the services are not in competition and neither are they complementary.

49. Whilst I appreciate that there may be some overlaps between these goods and services, I am reminded of the case of *Unicorn Studio Inc v Veronese* [2024] EWHC 1098 (Ch) wherein Mr Iain Purvis K.C., sitting as deputy High Court judge, set out at paragraph 24 of his judgment that:

> "[A]ny finding of similarity in the end requires the exercise of common sense and requires the hearing officer to stand back and consider the overall question. It strikes me that here the hearing officer was engaging essentially in a box-ticking exercise, asking how many of the factors identified in *TREAT* or in *Canon* could be said to have been satisfied. Had the hearing officer stood back and considered the overall question of similarity, I believe she would have considered and certainly ought to have considered that the idea that figurines and works of art were similar to electric lamps, chandeliers or mirrors was nonsensical and it hardly needed a careful consideration of the *Canon* or *TREAT* factors to come to that conclusion. I therefore agree with the appellant that this category of goods should have been found dissimilar, and certainly it could not have reasonably been found similar to more than 'a very low degree'."

50. While the above case involved a comparison of entirely different goods than those that are at issue here, I am of the view that the same principle applies. As I have set out above, there can be said to be an overlap in purpose and user (and even trade channels, for that matter). However, I consider that those overlaps are not overly pronounced on the basis that (1) the end purpose of both goods is very general (to entertain), (2) the user base for the goods and services is so large and (3) any overlap in trade channels is likely to reside in the limited example I gave

above. If I were to simply apply a simple *tick-box* exercise, it could be argued that these overlaps were enough to give rise to a finding of similarity between these goods and services. However, I am of the view that upon taking a step back and considering the actual terms before me, a finding of similarity between them is non-sensical. On this point, I am of the view that to find similarity here would offer far too broad a level of protection to the goods and services at issue. As a result, I find that the above goods of the applicant are dissimilar to the opponent's services.

Class 41

Presentation of live entertainment events.

51. The applicant has conceded that there is some similarity between the above service and his own entertainment service. This is on the basis that the above is broad enough to encompass dance performances. In my view, this is not a concession as to similarity but identity under the principle outlined in *Meric*. I, therefore, find that these services are identical.

Music concerts; music festival services; live musical concerts.

52. The above services are entertainment services for the provision of concerts and festivals. While the opponent's entertainment service has been limited to 'performances', I am of the view that this can cover 'musical performances' and, therefore, covers musical concerts and festivals. As a result, I find that the applicant's services are encompassed by the opponent's entertainment service rendering them identical under the principle outlined in *Meric*.

Disc jockeys for parties and special events; disc jockey services for parties and special events.

53. Disc jockey services can be said to be types of musical performances. Therefore, I find that the opponent's service can sufficiently cover the provision of entertainment via disc jockeys. Therefore, I consider that the above services of the applicant fall within the opponent's entertainment service meaning that these services are identical under the principle outlined in *Meric*.

Organisation of musical events; musical events (arranging of -); arranging of musical events.

54. The above are organisational or arrangement services. While the ultimate event being organised or arranged under the above services will be a musical one, it is not the provision of entertainment in the same way as that described by the opponent's entertainment service. As a result, I do not consider that the above services are identical to the opponent's services. In terms of similarity, the nature and method of use differ. The core purposes also differ as the above are to organise/arrange whereas the opponent's service is to entertain. In terms of trade channels, I am not convinced that an undertaking that provides its own musical performances as entertainment would also offer to organise said event. If it were, then I consider that such a practice would not be common in the trade and I have nothing to suggest otherwise. I also consider that the user will differ on the basis that the above services will be sought by business users looking to put on an event whereas the opponent's service will be sought by the end user looking to be entertained. In terms of complementarity, I appreciate that a musical performance event covered by the opponent's service will require some organisation thereby hinting at a degree of importance between them. However, I do not consider that the relationship between the services is such that it would lead to consumers

believing that only one undertaking would be responsible for both.[16] As a result, I find that these services are dissimilar.

Record mastering; record masters (production of -); production of record masters; music recording; publishing of music.

55. The above services relate to the production of music. They are clearly different in nature and method of use when compared to the opponent's services. In terms of purpose, while relating to music, the aim of the above terms is to produce or publish music, not perform it to entertain end users. As such, the purpose differs. In terms of trade channels, the above will be offered by production or publishing companies and not the entertainment provider directly. Even where entertainment providers look to publish or produce music in house, this is not common in the trade. In any event, in-house production/publication is not the same as providing the service to third parties under the cover of a trade mark. The user of the above will be those looking to produce and release music whereas the user of the opponent's service will be members of the general public at large. Therefore, I find that the user does not overlap. Lastly, the services are not in competition and neither are they complementary. Taking all of this into account, I find that these services are dissimilar.

Conclusion of the goods and services comparison.

56. Under the present ground, a likelihood of confusion can only exist where there is at least some similarity between goods and services.[17] This means that as a result of my findings above, the present ground fails against those dissimilar goods and services. However, it may proceed against those services that I have found to be identical. For ease of reference, those are as follows:

[16] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06
[17] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

Class 41: Presentation of live entertainment events; music concerts; music festival services; live musical concerts; disc jockeys for parties and special events; disc jockey services for parties and special events.

The average consumer and the nature of the purchasing act

57. The case law, as set out earlier, requires that I determine who the average consumer is for the parties' respective services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) 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."

58. The services at issue are all entertainment services and, as such, I find that the average consumer base will be made up of members of the general public at large. The consumer is likely to select the services after seeing them on lists on the provider's website, email or social media advertising, physical pamphlets, signage on the high street or billboards. The selection process will, therefore, be primarily visual. That being said, I do not discount the aural component playing a role by way of word of mouth recommendations or advice from sales assistants.

59. The services will be sought on a relatively frequent basis for some consumers who, for example, attend concerts regularly, but far less frequently for those that do not. In terms of the price, this will vary. I say this because some entertainment performances may be offered for free at exhibitions but others may be relatively expensive concerts, especially when factoring into account the price for premium or popular events. In terms of the level of attention paid, consumers will give consideration to factors such as the type of event, the venue, transport options and the performer(s) who will be participating. These are relatively ordinary factors that will, in my view, attract a medium degree of attention, regardless of whether the service relates to a free exhibition or a relatively expensive concert.

Comparison of the marks

60. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

61. 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."

62. 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.

63. The opponent's marks are identical and I will, therefore, consider them together for the purposes of the following comparison and my assessment of distinctive character. For ease of reference, I will refer to them in the singular, namely 'the opponent's mark'.

64. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
PARAISO	

65. The applicant has filed submissions and I will address these where necessary below. As for the opponent, it did not file submissions but, in its notice of opposition, it simply mentioned the identity of the text contained within the marks.

Overall impression

66. The opponent's mark is a word only mark consisting solely of the word 'PARAISO'. There are no other elements that contribute to the overall impression of the mark which lies in the word itself. The applicant's mark is a figurative mark which includes

a word element and a device element. The word element is the word ‘PARAISO’, presented in a fairly standard white typeface. This sits roughly in the centre of a grey and white circular device element. Within this shape sit a number of other shapes, namely a number of waves that sit above the word and a number of horizontal white bars underneath it. As consumers tend to be drawn to the parts of marks that can be read, I find that the overall impression of the applicant’s mark will be dominated by the word. As for the device element, I find that due to its size and the number of shapes within it, it remains somewhat prominent, albeit to a lesser degree than the word element.

Visual comparison

67. In respect of the visual comparison, the applicant submits that while he accepts that the marks share the word ‘PARAISO’, his own mark contains highly distinctive visual elements which have a significant impact of the visual impression created on the consumer. While I have found that the device element will play a role, I do not consider that it is highly distinctive. It is clearly a point of visual difference but given the common use of ‘PARAISO’, being the sole element of the opponent’s mark and the dominant (and sole verbal) element of the applicant’s mark, I do not consider that it is as impactful on the consumer as the applicant suggests. Overall, I consider the identical use of this word results in the marks being visually similar to between a medium and high degree.

Aural comparison

68. In his submissions, the applicant accepts that the marks are aurally identical. Clearly, this is the case and I will proceed on this basis.

Conceptual comparison

69. Despite the presence of the device element in the applicant's mark, its concept is likely to lie solely in the word 'PARAISO'. The applicant submits that the word 'PARAISO' is Portuguese for 'PARADISE'. However, he submits that consumers are unlikely to recognise the term as having any particular meaning and, consequently, a conceptual comparison is not relevant. While I have no evidence suggesting that this is what 'PARAISO' means, I have no reason to disbelieve these submissions. In any event, I agree with the applicant in that this will not be known to consumers. Even if some consumers in the UK who speak Portuguese are aware of what it means, I do not consider that they form a significant proportion. As neither mark has any obvious meaning, I find that they are conceptually neutral.

Distinctive character of the opponent's mark

70. 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)."

71. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has filed evidence of use. I will, therefore, consider whether the opponent's evidence is sufficient to give rise to a finding that the distinctiveness of the opponent's mark has been enhanced through use. Before doing so, I will consider the inherent position.

72. The opponent's mark is a word only mark consisting solely of the word 'PARAISO'. The applicant submits that it enjoys a medium degree of distinctive character. While this is noted, I disagree. As above, 'PARAISO' is not a word that will be known to a significant proportion of consumers in the UK. Instead, it will either be viewed as a made-up or foreign language word with no obvious meaning. Clearly, it will have no distinctive or allusive qualities and neither is it an ordinary dictionary word that would be considered unremarkable from a trade mark perspective. Therefore, I find that it enjoys a high degree of inherent distinctive character.

73. I turn now to consider whether the opponent's mark benefits from an enhanced degree of distinctive character in the eyes of consumers in the UK. I have summarised the evidence of the opponent at paragraphs 20 to 33 above. I do not intend to reproduce that summary here. While it was sufficient to warrant a finding of genuine use, I remind myself that the requirement for a finding of an enhanced

distinctive character is considerably more onerous than that of genuine use. I say this on the basis that use need not be quantitatively significant in order for it to be genuine, whereas distinctive character is a measure of how strongly the mark identifies the goods/services of a single undertaking. It follows that a finding of an enhanced degree of distinctive character requires use at such a level as to be capable of demonstrating that a proportion of consumers would identify the goods and services as originating from a particular undertaking. Put simply, that has not been demonstrated here. The opponent's evidence covers a total turnover of approximately £182,000 in the UK over a five-year period. While I have no evidence as to the size of the relevant market, I suspect it is a relatively large one and, as such, I consider that this is a very low level of turnover. In addition, I appreciate that the opponent has sought to file evidence from 2012 (the Olympic ceremony evidence) and 2015 (being featured in the film 'PAN'). However, this evidence is far from compelling as it fails to demonstrate how this equates to consumers in the UK being aware of the opponent's mark. Even where the opponent attended various carnivals and festivals, I am not satisfied that it would have garnered a level of exposure that would result in an enhancing of its mark's distinctive character.

74. As a result, I find that the evidence filed falls far short of demonstrating that the UK consumer, as at the relevant date, possessed any level of knowledge of the opponent's mark to the point that it could be said that it benefits from an enhanced degree of distinctive character. Therefore, I find that the inherent position applies.

Likelihood of confusion

75. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining

whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

76. I have found the services at issue to be identical. The average consumer base is formed of members of the general public who will select the services via primarily visual means (though not discounting an aural component) whilst paying a medium degree of attention. In respect of the similarity of the marks, I have found the applicant's mark is visually similar to between a medium and high degree, aurally identical and conceptually neutral with the opponent's marks. Lastly, I found the opponent's mark to be inherently distinctive to a high degree.

77. Taking all of the above factors into account together with the principle of imperfect recollection, I am of the view that the parties' marks will be misremembered or inaccurately called for one another. I say this because the common element between them, being 'PARAISO', is the sole element of the opponent's marks and the sole verbal element of the applicant's mark. As such, it is this word that consumers will pin their recollection upon, leading to them forgetting which mark was accompanied by a figurative device element or which was not. In addition, whilst the marks are conceptually neutral to one another, the high level of distinctive character together with the higher level of visual similarity and aural identity will offset this. Consequently, I find that there exists a likelihood of direct confusion between the marks at issue.

78. For the sake of completeness, I will proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein 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'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

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

79. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

80. I consider that the present case represents a paradigm example of indirect confusion. I say this because the only point in either parties' marks that the consumer will associate as being the indicator of origin is the word 'PARAISO'. This is not a known word so I see no reason to conclude that consumers would believe its shared use was coincidental. Further, its high degree of distinctive character is such that consumers would believe that only one undertaking would use it, thereby leading to a conclusion that the marks originate from the same undertaking. In addition, even if I was wrong to find direct confusion and the consumer was able to recall which mark had the device element and which did not, they would assume that they were alternative marks used by the same undertaking. For example, the word only marks would be viewed as those that were used in promotional articles or in write ups on websites whereas the figurative mark was one used on flyers or pamphlets. Consequently, I find that there exists a likelihood of indirect confusion between the marks.

81. For the avoidance of doubt, I consider that, even if the applicant was correct in that the opponent's marks only enjoyed a medium degree of inherent distinctive character, this would not alter the conclusions reached above because, put simply, the shared use of 'PARAISO' would lead consumers to being confused between the marks, regardless of the presence of the applicant's device element.

82. The present ground succeeds in part and I will now proceed to consider the section 5(3) ground.

Section 5(3)

83. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> 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 repute of the earlier trade mark."

84. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure,* Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and Intel, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs

particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

85. I can deal with this ground briefly. I have assessed the opponent's evidence of use at paragraphs 20 to 33 above. I do not intend to repeat this evidence in full here but remind myself that it was insufficient for a finding that the opponent's marks enjoyed an enhanced degree of distinctive character. This is relevant here because while I appreciate that the test for reputation differs from that for enhanced distinctiveness, it is common in proceedings before the Tribunal that, when all factors are equal, the outcomes of these assessments mirror one another. In the present case, the relevant date is the same, so are the marks and the goods and services at issue. While use in the EU for the opponent's second mark may be relevant to the question of a reputation, the opponent's evidence has a significant focus on UK activities only.[18] As such, any difference in the relevant territory between these two tests is of no consequence. Therefore, following the same

[18] The evidence does make brief mention of performances in France and performances in the UK by French and Danish performers. However, aside from a brief number of printouts from the Facebook accounts of these French and Danish organisation (RG05) there is nothing actually pointing to the level of use of the marks by the opponent anywhere other than the UK.

reasons given at paragraphs 73 and 74 above, I find that the opponent has failed to demonstrate that its marks enjoyed a reputation in the relevant territory as at the relevant date. As a result, I find that the present ground falls at the first hurdle.

CONCLUSION

86. The opposition succeeds in respect of some of the services against which it was aimed. Therefore, subject to any successful appeal of my decision, the applicant's mark is refused registration for the following services:

Class 41: Presentation of live entertainment events; music concerts; music festival services; live musical concerts; disc jockeys for parties and special events; disc jockey services for parties and special events.

87. However, the opposition failed in part so the applicant's mark may, subject to any successful appeal of my decision, proceed to registration for those goods and services. Further, I remind myself that the opposition was only partial in nature meaning that those unopposed services will proceed to registration regardless of the outcome of any appeal. Therefore, the applicant's mark may proceed to registration for the following goods and services:

Class 9: Music recordings; downloadable music sound recordings; downloadable music files; musical recordings; sound recordings; musical sound recordings; records [sound recordings]; downloadable sound recordings.

Class 35: Promotion services; promotion [advertising] of concerts; marketing, advertising and promotion services; advertising, marketing and promotion services; promotion of special events; event marketing; promotion of musical concerts; product

merchandising; online retail store services relating to clothing; online retail store services in relation to clothing; retail services connected with the sale of clothing and clothing accessories.

Class 41: Organisation of musical events; musical events (arranging of -); arranging of musical events; record mastering; record masters (production of -); production of record masters; record master production; music recording; publication of music; music publishing and music recording services; recording of music; music publishing; publishing of music; production of sound and music recordings.

COSTS

88. While the opponent has successfully opposed some of the terms under the applicant's mark, I am of the view that, on balance, the applicant enjoyed the greater degree of success. As a result, I find that the applicant is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023, albeit to a reduced degree to reflect the partial success of the opponent. In respect of the costs award, I appreciate that the applicant did not file its own evidence. However, I consider the award of some costs to be appropriate for this task so as to reflect the fact that the applicant was required to review and consider the opponent's evidence.

89. In the circumstances, I award the applicant the sum of £800 as a contribution towards its costs. The sum is calculated as follows:

Considering a notice of opposition and preparing a counterstatement:	£250

Considering the opponent's evidence:	£600
Filing submissions in lieu:	£350
Sub-total	£1,200
Reduction:	*-£400*
Total:	**£800**

90. I hereby order Paraiso School of Samba to pay Ryan Arnold the sum of £800. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of February 2026

A COOPER
For the Registrar