O/0182/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003743705
BY G1 RECORDS LTD
TO REGISTER THE FOLLOWING SERIES OF MARKS:

Dennis G

DENNIS G

Dennis g

IN CLASSES 9, 16 AND 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 433172
BY D.C. THOMSON & CO. LIMITED

Background and pleadings

1. On 16 January 2022 G1 Records LTD ("the applicant") applied to register the series of three trade marks shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 04 February 2022 and registration is sought for the goods shown below:

> **Class 9:** *Electric, photographic, cinematographic and optical apparatus all for recording, transmission or reproduction of sound or images; recorded vinyl, cassette tapes, DATs (digital audio tapes), CDs, CD ROMs, mini discs, MP3s (downloadable music from the Internet) and similar downloadable music formats, magnetic data carriers, recording discs; data processing equipment and computers; computer apparatus, computer software; electronic publications; telecommunication apparatus; computer programs.*
>
> **Class 16:** *Books, periodicals, newspapers, paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); publications, photographs and albums.*
>
> **Class 25:** *Clothing, footwear, headgear*.

2. On 04 May 2022, the application was opposed by D.C. Thomson & Co. Limited ("the opponent") based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act").[1] The opponent relies upon the following three trade marks:[2]

[1] The opponent initially relied upon Section 5(3) however, as it did not file any evidence the Section 5(3) ground was removed from the proceedings.
[2] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having three EUTMs being protected as at the end of the Implementation Period, three comparable UK trade marks were automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law and retain their original filing dates.

UK00910359255

DENNIS (“the first earlier mark”)

Filing date: 21 October 2011; Registration date: 10 February 2018

Relying on all the goods for which the mark is registered, namely:

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; magnets; pocket calculators; magnetic data media; media for recording sound or images; video and sound recordings; cinematographic film and photographic transparencies; animated cartoons; computers; computer peripheral devices; computer software; computer video games software; computer programs; computer games; electronic games consoles; magnetic, non-magnetic and optical data recording materials; game and amusement apparatus, all adapted for use with television or video receivers or video display units; electronic, video and computer games apparatus; MP3 and MP4 players; audio tapes, audio cassettes, audio discs; audio-video tapes, audio-video cassettes, audio-video discs; video tapes, video cassettes, video discs; CDs, DVDs; downloadable electronic publications; glasses, spectacle glasses, sunglasses, protective glasses and cases therefor; protective clothing; protective helmets; bicycle helmets; cases for mobile phones; cases adapted for electronic equipment; cases for MP3 players; parts and fittings for all the aforesaid goods.*

Class 16: *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other*

classes); printers' type; printing blocks; printed publications; periodical publications; books, brochures; newspapers; magazines; journals; comics; stationery; labels; stickers; decalcomanias; posters; ring binders; calendars; address books; diaries; annuals; notebooks; autograph albums; photo albums; cards; greeting cards; catalogues; programmes; writing paper; envelopes; pads; notepads; photographs; stamps and stamp pads; writing implements; letter paper; drawing materials; napkins of paper; rubber erasers; pens; pencils; erasers; rulers; pencil sharpeners; staplers; paper hole punches; highlighter pens; felt-tip pens; glue sticks stationery purposes; mats [coasters] of card; tablecloths of paper; wrapping paper; paper napkins; bags of paper or plastic materials; pins; parts and fittings for all the aforesaid goods.

UK00910361401

DENNIS AND GNASHER ("the second earlier mark")

Filing date: 21 October 2011: Registration date: 04 May 2012

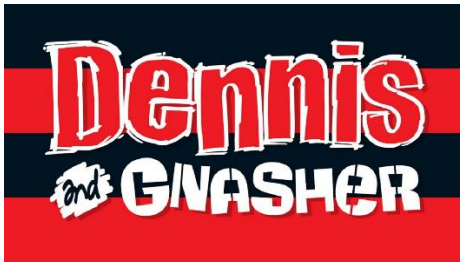
Relying on some of the goods for which the mark is registered, namely:

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; magnets; pocket calculators; magnetic data media; media for recording sound or images; video and sound recordings; cinematographic film and photographic transparencies; animated cartoons; computers; computer peripheral devices; computer software; computer video games software; computer programs; computer games; electronic games consoles; magnetic, non-magnetic and optical data recording materials; game and amusement apparatus, all adapted for use with television or video receivers or video display units; electronic, video and computer games apparatus; MP3 and MP4 players; audio tapes, audio cassettes, audio discs; audio-video tapes, audio-video cassettes, audio-video discs; video tapes, video cassettes, video discs; CDs, DVDs;*

downloadable electronic publications; glasses, spectacle glasses, sunglasses, protective glasses and cases therefor; protective clothing; protective helmets; bicycle helmets; cases for mobile phones; cases adapted for electronic equipment; cases for MP3 players; sound recording and sound reproducing apparatus and instruments; video recording and video reproducing apparatus and instruments; video and sound records, all in the form of films, discs, tapes or of filaments; cinematographic films and photographic transparencies all prepared for exhibition; automatic amusement apparatus; parts and fittings for all the aforesaid goods.

Class 16: *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed publications; periodical publications; books, brochures; newspapers; magazines; journals; comics; stationery; labels; stickers; decalcomanias; posters; ring binders; calendars; address books; diaries; annuals; notebooks; autograph albums; photo albums; cards; greeting cards; catalogues; programmes; writing paper; envelopes; pads; notepads; photographs; stamps and stamp pads; writing implements; letter paper; drawing materials; napkins of paper; rubber erasers; pens; pencils; erasers; rulers; pencil sharpeners; staplers; paper hole punches; highlighter pens; felt-tip pens; glue sticks stationery purposes; mats [coasters] of card; tablecloths of paper; wrapping paper; paper straws and napkins; bags of paper or plastic materials; pins; paper articles, cardboard articles and wrapping and packaging materials; paintings; parts and fittings for all the aforesaid goods.*

Class 25: *Clothing, footwear, headgear; shirts; T-Shirts; sweatshirts; skirts; jogging suits; trousers; jeans; pants; shorts; rainwear; cloth bibs; blouses; sweaters; jackets; coats; jumpers; gloves; socks; vests; leggings; neckties; scarves; night clothes; bathing clothes; sports clothes; bath robes; costumes; dress-up costumes; jodhpurs; boys underwear; girls underwear; men's underwear; women's underwear; casual sportswear; sweatshirts; hosiery; socks; tights; hats; caps; sun visors; boots;*

slippers; bibs; sneakers; sandals; shoes; parts and fittings for all the aforesaid goods.
UK00910501781 (“the third earlier mark”)    Mark Description/Limitation Colour Claimed: Black, red, white. Filing date: 16 December 2011; Registration date: 15 May 2012 Relying on some of the goods for which the mark is registered which are identical to those relied upon under trade mark no. UK00910361401.

3. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to Section 6 of the Act. Normally, trade marks which have completed their registration process more than five years before the date of the opposed application would be subject to proof of use pursuant to Section 6A of the Act. In this case, although the second and the third earlier mark are old enough to be subject to proof of use, the applicant elected not to require proof of use, hence the opponent can rely on all the goods it has identified without having to establish genuine use.

4. The opponent claims that the marks are highly similar and that the goods are identical, meaning that there is a likelihood of confusion. In particular, the opponent states that the letter G within the applicant’s marks is a singular letter which has little or no significance as an indicator of trade source and that the dominant and distinctive element of the applicant’s marks is the word DENNIS, which is identical to one of the opponent's earlier marks relied upon in its entirety. Further, the opponent claims that the letter G within the applicant’s marks could be seen by the average consumer to relate to the name 'Gnasher', which is the second word element of the opponent's mark DENNIS AND GNASHER.

5. The applicant filed a counterstatement in which it denied the claims. In particular, the applicant submitted that:

- The opponent's earlier mark UK00910359255 had a disclaimer stating the opponent does not claim exclusive rights to the name Dennis;

- Dennis G is a well-known and recognizable music artist and will not be confused with the opponent's trade marks which have been used in relation to a comic book character.

6. The applicant attempted to file some evidential material throughout proceedings, with the Form TM8 and, again, after the deadline to file evidence had expired. The statements that were considered to have evidential content concern the origin of the applicant's trade mark which is said to derive from the name of the applicant's director, Dennis GORDON, and his use of the applicant's mark in relation to his music career. The applicant also filed material aimed at establishing that "Beano" – I understand Beano to be the name of the comic magazine where the stories of the characters Dennis the Menace and Dennis and Gnasher originally appear - promotes junk food brands among children. On both occasions the evidential material that had been filed was deemed inadmissible[3] and I will disregard it; however, to the extent that the documents filed also contain legal submissions I will bear them in mind.

7. The opponent is represented by Taylor Wessing LLP. The applicant is without legal representation.

8. Neither party filed evidence. Neither party requested a hearing, but the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

[3] The applicant was also given an opportunity to file a Form TM9R with amended evidence, but nothing was received.

EU Law

9. 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.

DECISION

Section 5(2)(b)

10. Section 5(2)(b) of the Act is as follows:

> "A trade mark shall not be registered if because-
> […]
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

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

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

13. 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.

14. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court ("GC") 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."

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

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

16. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between the goods/services is to assess whether the relevant public are liable to believe that the responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13*:*

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

17. Whilst on the other hand:

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

18. The goods to be compared are as follows:

Class 9

Electric, photographic, cinematographic and optical apparatus all for recording, transmission or reproduction of sound or images; recorded vinyl, cassette tapes, DATs (digital audio tapes), CDs, CD ROMs, mini discs, MP3s (downloadable music from the Internet) and similar downloadable music formats, magnetic data carriers, recording discs; data processing equipment and computers; computer apparatus, computer software; electronic publications; telecommunication apparatus; computer programs.

19. The opponent states that the applicant's *Electric, photographic, cinematographic and optical apparatus all for recording, transmission or reproduction of sound or images* are identical to its *apparatus for recording, transmission or reproduction of sound or images* (as covered by all of the three earlier marks). I agree. The opponent's goods are not limited in any way and include any type of apparatus all for recording, transmission or reproduction of sound or images including electric, photographic, cinematographic, and are sufficiently broad to encompass the applicant's goods, so these goods are identical on the principle outlined in *Meric.*

20. The opponent states that the applicant's *recorded vinyl, cassette tapes, DATs (digital audio tapes), CDs, CD ROMs, mini discs, MP3s (downloadable music from the*

Internet) and similar downloadable music formats, magnetic data carriers, recording discs are identical to its *apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; media for recording sound or images; MP3 and MP4 players; audio tapes, audio cassettes, audio discs; audio-video tapes, audio-video cassettes, audio-video discs; video tapes, video cassettes, video discs; CDs, DVDs* (as covered by all of the three earlier marks). I agree. These goods are either self-evidently identical or identical on the principle outlined in *Meric*.

21. The applicant's *data processing equipment and computers* are self-evidently identical to the opponent's *data processing equipment and computers* (as covered by all of the three earlier marks).

22. The applicant's *computer apparatus, computer software, computer programs* are identical to the opponent's *computers; computer peripheral devices; computer software, computer programs* (as covered by all of the three earlier marks).

23. The applicant's *electronic publications* are identical to the opponent's *downloadable electronic publications* (as covered by all of the three earlier marks).

24. The applicant's *telecommunication apparatus* includes any communications equipment that is used for the purposes of telecommunications and would include audio devices and radio receivers, for example. As such, the applicant's goods either encompass or are encompassed by the opponent's *apparatus for recording, transmission or reproduction of sound or images* (as covered by all of the three earlier marks). These goods are identical on the principle outlined in *Meric.*

Class 16

Books, periodicals, newspapers, paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); publications, photographs and albums.

25. The opponent states that the applicant's *Books, periodicals, newspapers, paper, cardboard and goods made from these materials, not included in other classes;* are identical to its *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; periodical publications; books, brochures; newspapers.* I agree. The applicant's *books, periodicals, newspapers* are self-evidently identical to the opponent's *periodical publications; books, newspapers,* whereas the applicant's *paper, cardboard and goods made from these materials, not included in other classes* are self-evidently identical to the opponent's *Paper, cardboard and goods made from these materials, not included in other classes* (as covered by all of the three earlier marks). These goods are identical.

26. The terms *printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); photographs,* are identically contained in both parties' specifications (as covered by all of the three earlier marks). These goods are identical.

27. Finally, the applicant's *publications* encompass the opponent's *printed publications; periodical publications* (as covered by all of the three earlier marks) and the applicant's *albums* encompass the opponent's *autograph albums*; *photo albums* (as covered by all of the three earlier marks). These goods are identical on the principle outlined in *Meric.*

Class 25

28. The applicant's terms *Clothing, footwear, headgear* are self-evidently identical to the opponent's terms *Clothing, footwear, headgear* (as covered by the second and third earlier marks). These goods are identical. However, I cannot see that there is any similarity between the applicant's goods in class 25 and the opponent's goods in class 9 and 16 (as covered by the DENNIS mark).

Average consumer

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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."

30. The average consumer of the goods at issue is the general public. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalent. Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount aural considerations entirely as it is possible that the purchasing of these goods would involve oral discussions with sales representatives or word of mouth recommendations. Although consumers who purchase the goods might be particularly attentive to factors such as size and colours (for the goods in class 25) or function and compatibility (for the goods in class 9) or subject matter (for some of the goods in class 16), the degree of attention is likely to be no more than medium, possibly above medium for some computer-related goods in class 9.

Comparison of marks

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

created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

32. 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. The respective marks are shown below:

The applicant's marks	**The opponent's marks**
Dennis G **DENNIS G** **Dennis g**	DENNIS **DENNIS AND GNASHER** 

33. Although the opponent applied for three marks in a series, they are all word marks consisting of the words Dennis followed by the letter G, presented in different cases. As word marks notionally cover the presentation of the word(s) in different cases and typefaces, the fact that the words are presented in upper cases or title cases, or lower cases, or a mix of them, does not make any difference. However, since the opponent's best cases are represented by the two word-only-marks DENNIS and DENNIS AND

GNASHER – the stylisation of the words DENNIS AND GNASHER in the figurative marks only adding further differences with the earlier word mark DENNIS AND GNASHER – I will limit my consideration to those earlier marks. Accordingly, as the opponent's earlier word-only-marks are presented in capital letters, the closer mark in the applicant's series is the mark presented in capital letters; that is the mark which I will use for my comparison.

Overall impression

The applicant's mark

34. The applicant's mark consists of the word DENNIS followed by the letter G. The word DENNIS is likely to be understood as a masculine first name. The letter G is likely to be perceived as a second identifier of a person called DENNIS, possibly as the first letter of their surname. Taking into account that:

i. there is no evidence that the first name DENNIS is very common in the UK - this means that it must be attributed at least an average degree of distinctiveness;

ii. the beginnings of words tend to have more visual and aural impact than their ends and the word DENNIS is placed at the beginning of the applicant's mark and

iii. the second element of the applicant's mark is represented by a single letter which, in light of the fact that the number of letters in the alphabet is limited and in light of the frequent use of single letters in trade marks across all market sectors, is inherently distinctive to a low degree

35. I conclude that the element DENNIS occupies a dominant position in the applicant's mark and the letter G, whilst not negligible, is secondary in the overall impression created by the mark.

The opponent's marks

36. The opponent's trade mark DENNIS consists of the single word DENNIS, in which the overall impression resides. I have checked the UKIPO records and there is no indication of any disclaimers, hence, I disregard the applicant's comment on the point. In any event, Tribunal Practice Notice (1/2020): Disclaimers/Limitations of marks clearly states that *"the element(s) of a trade mark that is (are) subject to a disclaimer will be taken into account in the assessment of a likelihood of confusion with a later mark, even where the disclaimed element is the only point of similarity with the later mark",* so even if the applicant was correct, the existence of a disclaimer would not rule out the likelihood of confusion.

37. The opponent's trade mark DENNIS AND GNASHER consists of the three words 'DENNIS', 'AND', 'GNASHER'. I consider that the overall impression lies in the combination of these elements, with the words 'DENNIS' and 'GNASHER' sharing a roughly equal weight in the level of distinctiveness in the marks (though, as I will explain below, the word GNASHER might be slightly more distinctive than the word DENNIS because it is less common). Although the coordinating conjunction 'AND' does nothing but to connect the words DENNIS and GNASHER, it also contributes to the overall impression (but to a lesser degree) insofar as the average consumer is likely to perceive the mark as a phrase.

Visual similarity

The opponent's DENNIS mark and the applicant's DENNIS G mark

38. Visually, the marks coincide in the presence of the word DENNIS. The point of visual difference is the addition of the letter G in the applicant's mark, which has no counterpart in the opponent's DENNIS mark. Taking all of this into account, I consider the marks to be visually similar to a high degree.

The opponent's DENNIS AND GNASHER mark and the applicant's DENNIS G mark

39. The same comparison applies as identified above. However, there is an additional difference created by the presence of the words 'AND GNASHER' at the end of the opponent's DENNIS AND GNASHER mark which makes the mark look much longer. Consequently, I consider the marks to be visually similar to a medium degree.

Aural similarity

The opponent's DENNIS mark and the applicant's DENNIS G mark

40. Aurally, the word DENNIS in both marks will be pronounced identically. However, the additional letter G in the applicant's mark will act as a point of aural difference. Taking this into account, I consider the marks to be aurally similar to a high degree.

The opponent's DENNIS AND GNASHER mark and the applicant's DENNIS G mark

41. The same comparison applies as identified above. However, the addition of the words 'AND GNASHER' at the end of the opponent's mark will be a further point of aural difference. Taking this into account, I consider the marks to be aurally similar to between a medium degree.

Conceptual similarity

The opponent's DENNIS mark and the applicant's DENNIS G mark

42. The applicant submitted that the applicant's mark DENNIS G relates to a well-known music artist and cannot be mistaken for the comic book character in relation to which the opponent uses its earlier trade mark. There is no evidence that DENNIS G is the name of a music artist that is well-known in the UK. Likewise, there is no evidence that DENNIS and DENNIS AND GNASHER are the names of comic characters who are well-known in the UK. In BL O/0064/24, Dr Brian Whitehead, sitting as the Appointed Person, made the following remarks about taking judicial notice of facts not proven by evidence:

> “The Respondent also sought to contend, in the hearing, that the use of bunny imagery is widespread enough for the Hearing Officer to have taken judicial notice of it. I reviewed the law on the taking of judicial notice in O/0709/23 SMASH PATTIES. The requirement is that a fact must be “notorious”, or extremely well-known by the general public, in order for judicial notice to be taken of it. As I see it, the prevalence of bunny imagery in relation to sexual matters may well be “notorious” enough for judicial notice to be taken. However, having reviewed the Respondent’s written arguments filed before the Hearing Officer, it is clear that the Hearing Officer was not invited to take judicial notice - rather the Respondent sought to rely on its evidence to make good its contention (which was rejected by the Hearing Officer). The contention that the Hearing Officer should have taken judicial notice is therefore a new argument in this appeal. There is no Respondent’s Notice, and no application for permission, and accordingly I decline to take this new argument into account.”

43. The identity of the music artist DENNIS G (who I have never heard of) does not seem to me to be a sufficiently notorious or extremely well-known fact that judicial notice might be taken of it. Further the applicant did not invite me to take judicial notice. Hence, I reject the submission.

44. Turning to the opponent’s mark, the opponent stated:

> “The common word 'DENNIS' has a conceptual meaning in all of the signs, namely a masculine first name. The word GNASHER (in the singular) in the Earlier Marks has no specific meaning but is associated with a colloquial word ("gnashers") meaning teeth. It is the name of the well-known cartoon dog character, "Gnasher", who is the companion of the well-known cartoon schoolboy character, called "Dennis the Menace." Both characters have featured in the long-running children's comic, "The Beano", for more than 70 years, and more recently on television. They are so much a part of British cultural life that they both featured on a series of UK postage stamps in 2021 when celebrating their 70th anniversary. Judicial notice of these facts can be taken.”

45. There are a number of issues with the opponent's arguments.

46. First, I am not persuaded that the average consumer of the opponent's goods, who is an adult, is familiar with the cartoon characters "Dennis the Menace" and/or "Dennis and Gnasher". Although the opponent claims that both characters *"have featured in the long-running children's comic, "The Beano", for more than 70 years, and more recently on television"*, I have no idea about what proportion of the opponent's average consumers were readers of the "Dennis the Menace" and/or "Dennis and Gnasher" strips during their childhood. Further, whilst the "recent" broadcast of "Dennis the Menace" and/or "Dennis and Gnasher" episodes on television might have boosted the notoriety of those characters amongst children, I am not sure it had the same effect on the average consumer of the goods concerned.

47. More significantly, as it will be recalled, the opponent's trade mark DENNIS is likely to be perceived as a masculine name that is neither particularly common nor uncommon. It is certainly not so strikingly unusual that it will be associated exclusively with the cartoon character "Dennis the Menace" in the absence of any other clue within the mark (including, for example, the words "the Menace" or a figurative representation of the character).

48. Finally, the scenario I must consider is that of the trade mark DENNIS affixed to the earlier goods without the appearance of the cartoon character; in those circumstances, even if the average consumer were to know the character "Dennis the Menace", it is unlikely that it would conceptually link the trade mark to that character, the reasons being that (i) DENNIS is a masculine first name and can refer to any individual called DENNIS and (ii) cartoon characters are normally used in merchandising not to indicate trade origin.

49. Accordingly, I find that the word DENNIS will be perceived in both marks in the same manner, namely as a masculine name. The letter G in the applicant's mark is likely to be perceived as the first letter of a surname; whilst this element adds a further identifier, it is only one letter long. Hence, I conclude that the marks are conceptually similar to a high degree to the extent that they incorporate the same masculine name DENNIS.

The opponent's DENNIS AND GNASHER mark and the applicant's DENNIS G mark

50. The opponent's main argument in relation to the DENNIS AND GNASHER mark is that given the presence of the word DENNIS in both marks and the recognition of the name DENNIS (as in "Dennis the Menace") and the association with his dog GNASHER, the average consumer may believe that the G in DENNIS G stands for GNASHER. I am not persuaded by this argument. First, the applicant's mark DENNIS G has the structure, and conveys the impression, of a first name followed by the first letter of a surname and it is unlikely to be taken as an abbreviation for DENNIS AND GNASHER. Second, a logic abbreviation for DENNIS AND GNASHER would be D AND G or DENNIS AND G, not DENNIS G.

51. The opponent claims that the word GNASHER derives from teeth. The Collins English dictionary defines gnasher as a tooth or someone who gnashes, however, there is no evidence as to whether the word is commonly used and/or understood in the UK by the average consumer.

52. Accordingly, I find that the comparing marks share the concept of the same masculine name DENNIS but differ in that the opponent's mark conveys the additional concept of GNASHER which will be understood as a first name, surname or nickname identifying another individual (whether the average consumer will understand the meaning of GNASHER or not). The marks are conceptually similar to a medium degree.

Distinctive character of earlier mark

53. 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 *WindsurfingChiemsee* 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)."

54. Registered trade marks possess various 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 a mark can be enhanced by virtue of the use made of it.

55. The opponent's earlier mark DENNIS consists of a first masculine name that does not appear to be neither particularly common nor uncommon. As such, it has an average degree of distinctiveness.

56. The opponent's earlier mark DENNIS AND GNASHER contains the additional element AND GNASHER which will be perceived as a first name, surname or nickname and, as such, it is more unusual than the element DENNIS, increasing the distinctiveness of the mark to medium to high. However, this increased distinctiveness does not assist the opponent's case, as it is the distinctiveness of the common element that is the key.[4]

[4] *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

57. The opponent did not file any evidence during the proceedings. Nevertheless, it asked me to take judicial notice of the fact that the earlier marks are renowned in the UK and are "*an established part of British childhood culture"* and *"have an enhanced level of distinctiveness in relation to at least some of the earlier goods, in particular those relating to printed matter (namely magazines) and children's television shows and directly related merchandising".*

58. Whilst the applicant has made some comments about the fact that the opponent's marks have been used in relation to a cartoon character, these comments cannot be treated as an admission that the opponent's mark has acquired enhanced distinctiveness through use. Further, I have already addressed the issue of taking judicial notice at [45] [48]. For similar reasons, I reject the opponent's request to take judicial notice of the earlier marks' reputation.

Likelihood of confusion

59. 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

60. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. (as he then was) 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)."

In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"12. This 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)".

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17. This is mere association not indirect confusion.

61. Earlier in this decision I found that:

- The parties' goods in classes 9 and 16 are identical (the point being valid for all of the three earlier marks). However, only the earlier DENNIS AND GNASHER mark covers identical goods in class 25, whereas the goods covered by earlier DENNIS mark (in classes 9 and 16) are dissimilar to the applicant's goods in class 25;

- The average consumer would be a member of the general public who would pay at least a medium degree of attention during the purchasing process. The purchasing process would be predominantly visual, although aural considerations cannot be excluded entirely;

- The applicant's mark and the opponent's DENNIS mark, are visually, aurally and conceptually similar to a high degree;

- The applicant's mark and the opponent's DENNIS AND GNASHER mark are visually, aurally and conceptually similar to a medium degree;

- The earlier DENNIS mark has a medium degree of inherent distinctive character, and the earlier DENNIS AND GNASHER mark has a medium to high degree of distinctiveness, although the increased distinctiveness might not necessarily assist the opponent.

62. The opponent's best case is represented by the DENNIS mark. I will therefore consider the likelihood of confusion based on this mark first.

63. Bearing in mind the identity of the goods, the high degree of similarity of the marks, the average degree of distinctiveness of the earlier mark and the average degree of attention that will be exercised by the average consumer of the goods at issue, my conclusion is that when the principle of imperfect recollection is factored in, there is a significant chance that the average consumer would mistake DENNIS for DENNIS G or least think them connected in an origin-signifying manner.

64. Consumers rarely have a chance to compare two marks side by side and, in this regard, first, it should be observed that the first part of the applicant's mark, i.e. the word DENNIS, is identical to the entirety of the earlier mark, whereas the only difference between the marks consist of only one letter, 'G' which is placed at the end of the applicant's mark. Thus, it is reasonable to presume that the identity of the common element DENNIS will hold the consumers' attention and the presence of the letter G will be overlooked. Second, even if consumers paying an above average degree of attention were to notice the additional letter G at the end of the applicant's mark, they might well believe that the identical goods come from the same or economically linked undertakings as they might well assume that DENNIS G is related to DENNIS. There is a likelihood of direct confusion in relation to all of the applicant's goods in class 9 and 16 (which are identical to the goods covered by the opponent's DENNIS mark).

65. Turning to the applicant's goods in class 25, as it will be recalled, they are dissimilar to the goods covered by the opponent's DENNIS mark. As some similarity of goods is essential,[5] there cannot be any likelihood of confusion between the applicant's mark and the opponent's DENNIS mark in relation to the contested goods in class 25. I will therefore consider whether there is any likelihood of confusion with the opponent's DENNIS AND GNASHER mark.

66. Considering that the average consumer of the parties' goods in class 25 will pay only a medium degree of attention, it is my view that although the marks are unlikely to be directly confused, it is still likely that the letter G in the applicant's mark will be overlooked. In those circumstances, even if the average consumer were to notice the absence of the element AND GNASHER in the applicant's mark, the average degree of distinctiveness of the common element DENNIS is sufficient to give raise to a likelihood of confusion. For example, the earlier mark DENNIS AND GNASHER may be seen as the names of two fashion designers, or the consumer might believe that the goods have been co-branded; hence, when encountering the later mark on identical goods, the consumer might link the element DENNIS to DENNIS AND GNASHER and believe that it indicates an new line of clothes originating from the same or economically linked undertaking. There is a likelihood of indirect confusion.

CONCLUSIONS

67. The opposition has been successful, and the applicant's marks will be refused.

COSTS

68. The opponent has been successful, and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £600, calculated as follows:

Preparing the Notice of opposition and considering the counterstatement: £250
Preparing submissions in lieu: £250

[5] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Official fees: £100
Total £600

69. I therefore order G1 Records LTD to pay D.C. Thomson & Co. Limited the sum of £600. This sum is to 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 5th day of March 2024

Teresa Perks
For the Registrar