

o/0307/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATIONS 3687091 AND 3687110

BY

DICE RECORDING MUSIC LIMITED

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 9, 18, 25, 34, 35,
38 & 41

Dice Recordings Music

DICE RECORDINGS MUSIC

(Series of 2)



(Series of 3)

AND THE OPPOSITIONS UNDER NOS. 431221 and 431230

THERE TO

BY DICE FM LTD

Background and pleadings

1. Dice Recording Music Limited (“the applicant”) applied to register the following trade marks on 27 August 2021:

3687091 (series of 2)

Dice Recordings Music

DICE RECORDINGS MUSIC

3687110 (series of 3)



2. The marks were published on 19 November 2021.

3. The goods and services applied for were as follows:

Class 9: Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coinoperated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus.

Class 18: Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals.

Class 25: Clothing, footwear, headwear.

Class 34: Tobacco and tobacco substitutes; cigarettes and cigars; electronic cigarettes and oral vaporizers for smokers; smokers articles; matches.

Class 35: Advertising; business management, organization and administration; office functions.

Class 38: Telecommunications services.

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

4. Dice FM Ltd (“the opponent”) opposes both of the trade mark applications. The oppositions were filed on 21 February 2022. The opponent initially pleaded section 5(3) also but this was subsequently withdrawn. The oppositions are on the basis of section 5(2)(b) of the Trade Marks Act 1994 (the Act) and concern the following goods and services:

Class 9: Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; computers and computer peripheral devices

Class 25: Clothing, footwear, headwear

Class 35: Advertising; business management, organization and administration; office functions

Class 38: Telecommunications services

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

5. The following mark is relied upon for the oppositions:

UK913084331¹



¹ On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UKIPO created comparable UK trademarks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number 13084331 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark now recorded on the UK trade mark register has the same legal status as if it had been applied for and registered under UK law and the original EUTM filing date remains.

Filing date: 15 July 2014

Registration date: 3 December 2016

Priority date: 31 January 2014

Class 9: Computer software, firmware, programs; downloadable software applications; downloadable software applications for mobile phones, smart phones, desktop computers, laptops and tablet computers; media (downloadable or streamable) carrying electronic publications including books, magazines reviews, newsletters; electronic publications (downloadable or streamable); screensavers; recordings of sound or images; high definition recordings; digital recordings; electronic digital music and video; digital material including music and video provided from the internet and internet MP3 sites including by downloading or by streaming; digital recordings provided from or downloadable from the Internet including by downloading or by streaming; podcasts; audio books; video clips; downloadable pre recorded media including viral video, interviews, spoken word recordings; cases, covers and sleeves for electronic devices including laptops and tablet computers, electronic books, CD and DVD players and MP3 players; photographic and cinematographic films; automated printing and reservation machines and apparatus; information, advice and consultancy relating to all of the aforesaid; all the aforesaid relating to the booking, reservation, sale, printing and issuance of tickets, parcels, wristbands, entry cards for entertainment events, sporting events, musical events, theatre, art events, television shows, motion pictures, art exhibitions, public shows, lectures and other entertainment, cultural and education events, and none of the aforesaid in the fields of or related to employment, recruitment, job placement or resume and career services.

Class 35: Advertising; marketing research and studies; auctioneering; online advertising services on a computer network and via the internet and through smartphones and tablet computers; direct mail advertising; dissemination of advertising matter; administrative processing of purchase and sales orders; administrative processing of purchase and sales orders over the Internet and/or computer networks; sales promotion for others; provision of an online marketplaces for the sale and purchase of tickets; accounting; promotion of

venues, musical performers, sporting events, musical concerts and other entertainment events of others; all the aforesaid relating to the booking, reservation, sale, printing and issuance of tickets, passes, wristbands, entry cards for entertainment events, sporting events, musical events, theatre, art events, television shows, motion pictures, art exhibitions, public shows, lectures and other entertainment, cultural and educational events; information, advice and consultancy relating to all of the aforesaid; none of the aforesaid in the fields of or related to employment, recruitment, job placement or resume and career services.

Class 41: Booking agency services; ticket agency services; booking, seating, ticket reservation and sales services; information and ticket purchasing agency services for venues, sporting events, musical concerts and other entertainment events rendered online, via the internet, via smartphones and tablets, through telephone orders and through tickets outlets; provision of on-line electronic publications; publishing of electronic newsletters; online publishing services; all the aforesaid relating to the booking, reservation, sale, printing and issuance of tickets, passes, wristbands, entry cards for entertainment events, sporting events, musical events, theatre, art events, television shows, motion pictures, art exhibitions, public shows, lectures and other entertainment, cultural and educational events; information, advice and consultancy services relating to all the aforesaid services; none of the aforesaid in the fields of or related to employment, recruitment, job placement or resume and career services.

6. The opponent argues that the dominant and distinctive element of the opponent's mark is 'DICE' and the applicant's mark takes that dominant and distinctive element and adds two additional non-distinctive elements and therefore the marks are highly similar. Further, they state that the goods and services are either identical or similar and as a result, there is a likelihood of confusion. The oppositions have been consolidated to be decided together.

7. The applicant filed counterstatements denying the claims. They raised the defence of honest concurrent use however, no evidence was filed and therefore, I will not consider this further.

8. Neither party filed evidence. Neither party requested a hearing nor filed submissions in lieu. I therefore make this decision following careful consideration of the papers.

9. The applicant was initially represented in these proceedings however, they have represented themselves since March 2024. The opponent is represented by Reddie & Grose LLP.

10. 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

11. Section 5(2)(b) is being relied upon and is as follows:

“5(2) A trade mark shall not be registered if because-

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

12. Section 5A of the Act is as follows:

“5A 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.”

13. 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 –

(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;”

14. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 5, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services they have identified.

Case law

15. 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 Office for Harmonisation 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.

Comparison of Goods and Services

16. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

17. 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 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”.

18. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

19. 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.

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that ‘complementary’ means:

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

21. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM) ('Meric')*, Case T-133/05, the 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 für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

22. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

23. As the goods and services are the same for both oppositions, I will consider them together. The Parties' respective specifications are:

Contested goods and services	Opponent's goods and services
Class 9: Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media;	Class 9: Computer software, firmware, programs; downloadable software applications; downloadable software applications for mobile phones, smart phones, desktop computers, laptops and tablet computers; media (downloadable or streamable) carrying electronic

computers and computer peripheral devices	publications including books, magazines reviews, newsletters; electronic publications (downloadable or
Class 25: Clothing, footwear, headwear	streamable); screensavers; recordings of sound or images; high definition
Class 35: Advertising; business management, organization and administration; office functions	recordings; digital recordings; electronic digital music and video; digital material including music and video provided from the internet and internet MP3 sites
Class 38: Telecommunications services	including by downloading or by streaming; digital recordings provided from or downloadable from the Internet
Class 41: Education; providing of training; entertainment; sporting and cultural activities.	including by downloading or by streaming; podcasts; audio books; video clips; downloadable pre recorded media including viral video, interviews, spoken word recordings; cases, covers and sleeves for electronic devices including laptops and tablet computers, electronic books, CD and DVD players and MP3 players; photographic and cinematographic films; automated printing and reservation machines and apparatus; information, advice and consultancy relating to all of the aforesaid; all the aforesaid relating to the booking, reservation, sale, printing and issuance of tickets, parcels, wristbands, entry cards for entertainment events, sporting events, musical events, theatre, art events, television shows, motion pictures, art exhibitions, public shows, lectures and other entertainment,

	<p>cultural and educational events, and none of the aforesaid in the fields of or related to employment, recruitment, job placement or resume and career services.</p> <p>Class 35: Advertising; marketing research and studies; auctioneering; online advertising services on a computer network and via the internet and through smartphones and tablet computers; direct mail advertising; dissemination of advertising matter; administrative processing of purchase and sales orders; administrative processing of purchase and sales orders over the Internet and/or computer networks; sales promotion for others; provision of an online marketplace for the sale and purchase of tickets; accounting; promotion of venues, musical performers, sporting events, musical concerts and other entertainment events of others; all the aforesaid relating to the booking, reservation, sale, printing and issuance of tickets, passes, wristbands, entry cards for entertainment events, sporting events, musical events, theatre, art events, television shows, motion pictures, art exhibitions, public shows, lectures and other entertainment, cultural and educational events;</p>
--	--

	<p>information, advice and consultancy relating to all of the aforesaid; none of the aforesaid in the fields of or related to employment, recruitment, job placement or resume and career services.</p> <p>Class 41: Booking agency services; ticket agency services; booking, seating, ticket reservation and sales services; information and ticket purchasing agency services for venues, sporting events, musical concerts and other entertainment events rendered online, via the internet, via smartphones and tablets, through telephone orders and through tickets outlets; provision of on-line electronic publications; publishing of electronic newsletters; online publishing services; all the aforesaid relating to the booking, reservation, sale, printing and issuance of tickets, passes, wristbands, entry cards for entertainment events, sporting events, musical events, theatre, art events, television shows, motion pictures, art exhibitions, public shows, lectures and other entertainment, cultural and educational events; information, advice and consultancy services relating to all the aforesaid services; none of the aforesaid in the fields of or related to employment, recruitment, job placement or resume and career services.</p>
--	--

24. I have not been provided with any submissions from the parties regarding the best case or levels of similarity between the goods and services. I note what was said by Iain Purvis KC as the Appointed Person in *Abus August Bremicket Sohne KG v Muhammad Ali*, Case BL O/0911/24 at paragraph 9 that:

“9. In a case like this where the marks cover a multitude of different goods, it is obviously necessary for the Opponent to identify with precision, both in its pleaded case and in any submissions made to the Registry, which goods of its own registrations are alleged to be similar to which goods of the Application. If this is not done, it is unfair to the Applicant and it is extremely difficult if not impossible for the Hearing Officer to decide the case.”

I will therefore proceed on the basis that I will only consider similarities where it is obvious to do so; otherwise, the goods and services will be found to be dissimilar.

25. I note that the opponent’s classes are subject to the following limitation: “all the aforesaid relating to the booking, reservation, sale, printing and issuance of tickets, parcels, wristbands, entry cards for entertainment events, sporting events, musical events, theatre, art events, television shows, motion pictures, art exhibitions, public shows, lectures and other entertainment, cultural and educational events, and none of the aforesaid in the fields of or related to employment, recruitment, job placement or résumé and career services” and I have kept this limitation in mind whilst undertaking the comparison.

Class 9

Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data;

26. I find that in relation to the above goods and the opponent’s ‘recordings of sound or images; high definition recordings; digital recordings; electronic digital music and video’ could share users and trade channels but differ in nature and use. They are not in competition, nor are they complementary (I do not believe the average consumer

would reasonable believe them to come from the same undertakings. I therefore find them similar to a low degree.

Recorded and downloadable media

27. I consider that the above term is a wider one that encompasses the opponent's 'downloadable pre recorded media including viral video, interviews, spoken word recordings' and therefore consider them to be identical under the *Meric* principles.

Computer software

28. I consider that the opponent's 'computer software; all the aforesaid relating to the booking, reservation, sale, printing and issuance of tickets, parcels, wristbands, entry cards for entertainment events, sporting events, musical events, theatre, art events, television shows, motion pictures, art exhibitions, public shows, lectures and other entertainment, cultural and educations events, and none of the aforesaid in the fields of or related to employment, recruitment, job placement or résumé and career services' will fall within the wider term of the applicant's, being, 'computer software' and therefore find them to be identical under the *Meric* principles.

Blank digital or analogue recording and storage media;

29. The applicant's above goods are data carriers where sound or images could be recorded. The following goods from the opponent's specification 'recordings of sound or images; high definition recordings; digital recordings; electronic digital music and video' are not limited by the medium on which they are recorded and could therefore be made available on the storage media contained within the applicant's specification. I therefore consider there to be an overlap user of the respective goods. I believe the nature will differ however, they might share trade channels and could also be complementary. I therefore consider them to be similar to a medium degree.

Computers and computer peripheral devices

30. Ordinarily, I might find there to be similarity between the above goods and the opponent's 'Computer software, firmware, programs' due to the intrinsic nature of software when using computers. However, the limitation on the opponent's specification means that they do not have software at large but rather, software related to 'booking, reservation, sale, printing and issuance of tickets, parcels, wristbands, entry cards for entertainment events, sporting events, musical events, theatre, art events, television shows, motion pictures, art exhibitions, public shows, lectures and other entertainment, cultural and educational events' and therefore, I find this takes them further apart. Where I might have considered there to be complementarity for the general term, this no longer applies as software for booking, reservation, sale, printing and issuance of tickets etc is not important or indispensable for computers themselves. I therefore consider these goods to be dissimilar.

Class 25

31. I find that all the Class 25 goods being: *Clothing, footwear, headwear*, do not overlap on the basis of the above authorities save for a very general overlap in user (i.e. the general public will wear clothing items and might also access some software goods); however, this on its own is not enough for a finding of similarity and, therefore, I consider these goods to be dissimilar to the opponent's services.

Class 35

Advertising

32. As the opponent's term 'advertising' is limited as mentioned above, it falls within the wider term from the opponent's specification and I therefore find them to be identical under the *Meric* principles.

Business management, organization and administration

33. I can see no obvious overlap, and on the basis of the above authorities I therefore, consider these services to be dissimilar to the opponent's services.

Office functions

34. I have no submissions from the parties as to what "office functions" would cover. However, I consider that it is a phrase which naturally includes any services which are core to the functions of an office. Therefore, I consider that 'administrative processing of purchase and sales orders; administrative processing of purchase and sales orders over the Internet and/or computer networks' from the opponent's specification could be considered a core function for some offices and therefore find them to be identical under the *Meric* principles. If I am wrong in that finding, I consider there to be an overlap in nature, use, user and trade channels and find them to be similar to a medium degree.

Class 38

Telecommunications services

35. I can see no obvious overlap of these services and the opponent's and therefore, consider these services to be dissimilar.

Class 41:

Education; providing of training

36. I can see no obvious overlap of these services and the opponent's and therefore, consider these services to be dissimilar.

Entertainment; sporting and cultural activities.

37. The nature, intended purpose and method of use of these services differs to the opponent's 'booking agency services; ticket agency services; booking, seating, ticket reservation and sales services'. However, ticketing/booking services for entertainment/sporting/cultural events will be provided in the same establishments as the services and may be provided by the same undertakings. As such, it is my view that the respective services reach the market through shared trade channels. The respective services are also likely to share users. Moreover, the respective services are important to one another in such a way that consumers may believe the responsibility for them lies with the same undertaking. Therefore, they are complementary. The respective services are not interchangeable; there is no competition between them. Taking all of this into account, I find that the respective services are similar to a medium degree.

38. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

39. I have found no similarity for the applicant's class 25 goods, class 38 services and the following goods and services from classes 9, 35 and 41 and therefore the opposition fails in relation to them:

Class 9: Computers and computer peripheral devices

Class 35: Business management, organization and administration

Class 41: Education; providing of training

40. The opposition will continue in respect of the following:

Class 9: Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media;

Class 35: Advertising; office functions

Class 41: Entertainment; sporting and cultural activities

Average consumer and the purchasing act

41. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

42. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

43. I consider that the average consumer of the goods and services at issue could be members of the public or professionals/business (more particularly businesses in

respect of the class 35 and 41 services). The costs of these services are likely to vary between low (for example, recorded and downloadable media, computer software, blank digital or analogue recording and storage media) and high. I would consider that some of the goods might be purchased more frequently, particularly for the class 9 goods whereas the services will be purchased relatively infrequently although there is potential for the services to be part of ongoing contracts. The average consumer will need to take into consideration the cost and suitability of the goods and services in accordance with their needs. I therefore consider that the average consumer would pay between a medium and an above medium (but not the highest) level of attention during the purchasing process.

44. The above services are likely to be selected from various retailers, websites, advertisements and signs on a physical property. I therefore believe that visual considerations will dominate the selection process. However, I do not discount the possibility that there could be aural considerations from word-of-mouth recommendations or advice from a staff member.



Comparison of the marks

45. 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.”

46. 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.

47. The respective trade marks are shown below:

Contested mark	Earlier Mark
<p>The 091 marks</p> <p>Dice Recordings Music</p> <p>DICE RECORDINGS MUSIC</p> <p>(Series of 2)</p>	
<p>The 110 marks</p>  <p>(Series of 3)</p>	

48. The 091 marks both contain three words. The opponent states within their Form TM7 that the dominant and distinctive element of the contested marks is 'DICE' with

'RECORDINGS MUSIC' being non-distinctive elements. I consider that for some of the applied for goods then 'DICE' will indeed be the dominant and distinctive element. 'RECORDINGS MUSIC' will be descriptive or allusive to some of the goods and therefore will play a smaller role (although I would not go so far as to say entirely non-distinctive). However, for the services where 'RECORDINGS MUSIC' is not descriptive/allusive, I find that the overall impression lies in the combination of the three words.

49. In relation to the 110 marks, I agree with the opponent's assertion that word elements are likely to have a stronger impact on the consumer, particularly in this case where the device element looks as though it is supposed to represent a dice and therefore, is acting as an emphasis on that word within the mark. My findings remain the same as above, for some goods 'DICE' will indeed be the dominant and distinctive element. 'RECORDINGS MUSIC' will be descriptive or allusive to some of the goods and services and therefore will play a smaller role. I note there are the further letters 'D' and 'R' which are on the face of the dice and I believe the average consumer will view these as the initials of 'DICE RECORDINGS' as that is placed at the top of the mark. The device element, as it is also a dice, together with the colourways will play small roles in the overall impression of the mark. For those services where 'RECORDINGS MUSIC' is not descriptive/allusive, again I believe that the distinctive and dominant element are the words 'DICE RECORDINGS MUSIC', with the letters 'D' and 'R', the device element and the colourways all playing smaller roles.

50. The earlier mark is the word 'DICE' in a white lightly stylised typeface presented within a black box. I consider the word element to be the dominant and distinctive element and the presentation to play a smaller role.

Visual comparison

51. In comparing the 091 marks with the earlier mark, I note that they both share the word 'DICE' and that this is found at the beginning of the contested marks. The contested marks both have a further two words that have no counterpart in the earlier mark. I therefore find them to be visually similar to no more than a medium degree.

52. Turning to the 110 marks, I consider again that there is the shared element of 'DICE' and that there are square elements featured in both the earlier mark and the contested marks (i.e. the faces of the dice in the contested marks and the black square of the earlier mark). The contested marks all contain extra features that have no replica in the earlier mark, such as the extra words and letters and the circle around the dice. I therefore consider them to be similar to between a low and medium degree.

Aural comparison

53. For the 091 marks, I consider each word within the mark to be given its ordinary everyday pronunciation and even though the words 'RECORDINGS MUSIC' might play a lesser role for some of the goods and services, I believe they will still be articulated.² In respect of the earlier mark, this will be given its everyday pronunciation which is identical to that of the contested marks. Therefore, they will share an identical beginning aurally however, there are two further words which have no counterpart in the earlier mark. I therefore find them aurally similar to no more than a medium degree.

52. The three words in the 110 marks will also be given their ordinary everyday pronunciations. I believe that a significant proportion of consumers is unlikely to articulate the 'D' and 'R' elements and therefore my finding is the same as above, the marks are aurally similar to no more than a medium degree. If, however, the consumer does articulate the letters 'D' and 'R' then I consider them aurally similar to between a low and medium degree.

Conceptual comparison

54. Conceptually, in the 091 marks all words will be given their ordinary dictionary definitions. I do not consider there to be a meaning with the three words altogether save that 'RECORDINGS MUSIC' can likely be put together to mean recordings that are of music. I consider that the earlier mark self evidently has its ordinary dictionary meaning and this is therefore identical however, the contested marks have extra

² On this point, I remind myself that while the descriptive nature of a word does not render it aurally invisible (as per *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22)

conceptual content that is not found in the earlier mark. Therefore, I find them conceptually similar to no more than a medium degree.

55. The 110 marks have the same ordinary dictionary definitions as above with the additional 'D' 'R' letters which I believe the average consumer will see as initials for 'DICE RECORDINGS' and the dice device to reinforce the same meaning. Therefore, there is again the shared concept of a dice with the additional elements having no counterpart in the earlier mark. I find them conceptually similar to no more than a medium degree.

Distinctive Character of the Earlier Mark

56. 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).”

57. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up 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. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier registration and therefore I must rely on its inherent distinctiveness.

58. The earlier registration is comprised of an ordinary dictionary word. The mark is not descriptive or allusive of the services registered by the opponent. However, it is not an invented word which would usually attract the highest degree of distinctive character. I believe the presentation of the mark only minimally enhances the degree of distinctiveness. Therefore, I find the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

59. 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 goods and 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 goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and 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 he has retained in his mind.

60. The following factors must be considered to determine if a likelihood of confusion can be established:

- The applicant's 091 marks consist of the words 'DICE RECORDINGS MUSIC'. For the goods and services that 'RECORDINGS MUSIC' is descriptive or allusive of then 'DICE' will be the dominant and distinctive element. For the remaining services, the overall impression lies in the mark as a whole.
- For the applicant's 110 marks the same distinction applies. Where 'RECORDINGS MUSIC' is descriptive/allusive then 'DICE' will indeed be the dominant and distinctive element. 'RECORDINGS MUSIC' will play a smaller role along with the letters 'D' and 'R', the device and the colourways. For the remaining services, the distinctive and dominant element are the words 'DICE RECORDINGS MUSIC' with the letters 'D' and 'R', the device element and the colourways all playing smaller roles.
- The distinctive and dominant component of the opponent's mark is the word 'DICE' with the stylisation playing a smaller role.
- In relation to the 091 marks, I have found them to be visually, aurally and conceptually similar to no more than a medium degree.
- In relation to the 110 marks, I have found them to be visually and aurally similar to either no more than a medium degree or between a low and medium degree and conceptually similar to no more than a medium degree.
- I have found the earlier mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the goods at issue to be a combination of members of the general public as well as professionals/businesses. The purchasing process is likely to be predominantly visual.
- I have concluded that between a medium and an above medium (but not the highest) level of attention will be paid during the purchasing process.
- I have found the remaining goods and services to range between identical and similar to a medium degree.

61. Taking all of the above factors into account, I consider that there are sufficient differences between the earlier mark and all contested marks (being the extra words

in the 091 marks and the extra words and device elements in the 110 marks) that would not be overlooked by the average consumer even where some of those extra elements are descriptive/allusive of the goods and services provided. These differences would be enough to offset any identity between the goods and services at issue.

62. I will now turn to look at indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

“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”).

63. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“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.”³

64. In relation to the 091 marks, I will firstly consider indirect confusion for the goods where ‘RECORDINGS MUSIC’ is descriptive (I do not consider ‘RECORDINGS MUSIC’ to be descriptive of the applicant’s ‘entertainment’ as this is an extremely wide category of services and I do not believe recordings are the essence of what is meant by that term). I consider that the addition of descriptive terms will likely be viewed as a brand extension by the average consumer. I therefore consider there to be a likelihood of indirect confusion. For the 110 marks, I consider that the same findings apply and for these particular goods that marks could be seen as part of a rebranding or brand extension including the device element to reinforce the ‘DICE’ as the house mark.

65. For the remaining goods and services at issue for both sets of marks, I consider that the common element between the marks – ‘DICE’ is not so strikingly distinctive that no other brand could use it. It is an ordinary dictionary word and, as established above, has a medium degree of inherent distinctiveness which has not been enhanced. Therefore, the first category is not satisfied.

66. Regarding the second category, the addition of ‘RECORDINGS MUSIC’ is not an addition of a non-distinctive element for the remaining goods and services as it is not descriptive or allusive to them. It is also not wording that is frequently used to indicate sub-brands such as ‘LITE’ or ‘EXPRESS’ as per the examples provided by Mr Purvis. Consequently, the second category cannot be satisfied.

67. Lastly, where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. I do not consider that the addition of the words ‘RECORDINGS MUSIC’ is a logical brand extension of the opponent’s mark, or vice versa, when being used on goods and services for which that wording is not descriptive. I can see no other reason why the

³ Paragraph 12

average consumer might believe these undertakings are linked. I therefore do not consider that the third category is satisfied.

68. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant's mark could be indirectly confused with the opponent's. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. Even if the opponent's mark is brought to mind when viewing the applicant's mark, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Consequently, I consider there is no likelihood of indirect confusion.

Conclusion

69. The opposition is successful in relation to the following goods for both series of marks (subject to any appeal):

Class 9: Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media;

70. The opposition fails and registration may continue for the following goods and services for both series of marks (subject to any appeal):

Class 9: computers and computer peripheral devices

Class 25: Clothing, footwear, headwear

Class 35: Advertising; business management, organization and administration; office functions

Class 38: Telecommunications services

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

Costs

71. The applicant has the larger proportion of success in these proceedings and is therefore entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 as these proceedings commenced after 1 February 2023. I award the applicant the sum of **£400**, calculated as follows:

Considering the Notices of opposition and preparing the counterstatements	£400
---	------

Total	£400
--------------	-------------

72. I therefore order DICE FM LTD to pay Dice Recording Music Limited the sum of £400. This 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 31st day of March 2025

L Nicholas
For the Registrar