

O/262/21

TRADE MARKS ACT 1994

**IN THE MATTER OF
REGISTRATION NO. 3261290
IN THE NAME OF THE AUCKLAND CASTLE TRUST
FOR THE TRADE MARK:**



IN CLASSES 9, 16, 25, 29, 30, 31, 32, 33, 35, 36, 41 & 43

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 502589
BY TRINITY BROADCASTING INVESTMENTS NPC**

BACKGROUND AND PLEADINGS

1. The Auckland Castle Trust (“the proprietor”) is the registered proprietor of the trade mark displayed on the cover page of this decision, under registration number 3261290 (“the proprietor’s mark”). The proprietor’s mark was filed on 4 October 2017 and was entered into the register on 12 January 2018 for a range of goods and services in classes 9, 16, 25, 29, 30, 31, 32, 33, 35, 36, 41 & 43.

2. On 7 May 2019, Trinity Broadcasting Investments NPC (“the applicant”) made an application to partly invalidate the proprietor’s mark pursuant to section 47(2) of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act and is directed against the services in class 41 only.

3. For the purposes of its claim, the applicant relies upon the following trade marks:

FAITH UK

UK registration no. 3218566

Filing date: 14 March 2017

Registration date: 22 September 2017

(“the first earlier mark”)

FAITH BROADCASTING NETWORK

UK registration no. 3218562

Filing date: 14 March 2017

Registration date: 14 July 2017

(“the second earlier mark”)

4. The applicant claims that the proprietor’s mark is similar to its earlier marks and is registered in respect of identical or similar services. As a result of these factors, the applicant contends that there is a likelihood of confusion.

5. The proprietor filed a counterstatement denying the ground of invalidation.

6. Thereafter, the proceedings were stayed between 13 September 2019 and 6 April 2020 at the request of the parties to provide them with an opportunity to resolve the matter by negotiating a settlement agreement. Evidently, the parties were unable to reach an agreement as, on 30 July 2020, the applicant filed Form TM9 to request an extension to the deadline by which it was required to file evidence in support of its claim. An additional two months was granted for this purpose, though no evidence was forthcoming. On this basis, the proprietor sought summary dismissal of the application and argued that the applicant's claim had no real prospect of success. On 12 December 2020, the parties were advised by the Tribunal that the circumstances did not support a summary dismissal and that the proceedings would continue.

7. Neither party filed evidence in these proceedings. A hearing took place before me, by video conference, on 5 March 2021. The proprietor was represented by Mr Jonathan Moss of Counsel, instructed by Sintons LLP. The applicant has been represented throughout these proceedings by Taylor Wessing LLP, though elected not to attend the hearing or file written submissions in lieu.

PRELIMINARY ISSUE

8. At the outset of the proceedings, the applicant indicated that it intended to rely upon *'education; providing of training; entertainment; sporting and cultural activities; information, consultancy and advisory services relating to the aforesaid'* in class 41 of the earlier marks. On 3 January 2020, the applicant filed Form TM23 (Notice to partially surrender a registration), the effect of which was to narrow the scope of its class 41 specifications to *'educational and entertainment services in the field of Christianity and religion; providing ongoing television programmes in the fields of Christianity and religion'*.

9. In his skeleton arguments filed in advance of the hearing, Mr Moss submitted on behalf of the proprietor that:

“6. There are two earlier trade marks relied upon. Both marks have been subject to partial surrenders in January 2020. As such, the classes they rely upon in the earlier marks no longer exist as at the date of this hearing. [...] the new

specification cannot be cited against the Proprietor's Mark because it does not appear in the TM26.

[...]

8. The Cancellation Application should be dismissed because it is moot. It serves no purpose because as at the date of the hearing there is no property right in existence and to continue the challenge would be an abuse of process.

9. The date of effect for surrender is the date of the surrender, it is not backdated. See *Re Parasite Eve* citing the *Rapier TM* decision of Geoffrey Hobbs QC sitting as an AP where he stated:

"29...I think that the approach is right in principle. It leads to the conclusion that a duly filed request for surrender of all or part of a registration should be processed in accordance with Section 45 and Rule 26 without prejudice to the continuation of any application for revocation that may have been filed prior to the filing of the trade mark proprietor's TM22 or TM23 as the case may be. The surrender takes effect ex nunc, not ex tunc and does not of itself render the pending revocation application moot or academic."

The same apply to invalidity actions. On that basis, the applicant for invalidity is requested to confirm whether it wishes to continue with the invalidity proceedings [...]"

10. However, the cases to date appear to have all dealt with the issue of the proprietor surrendering their mark. In those cases, as pointed out in the *Rapier* decision above, the action against the proprietor continues.

11. There does not appear to be a case of the cancellation applicant withdrawing their specification and the present case differs. This is because there is no longer any property right that can be cited against the Faith Museum Mark. The definition of 'earlier right' in s6 of the Act refers to a registered trade

mark. The current version of that earlier trade mark contains a different specification to the one that was cited against the Faith Museum.

12. It is important to bear in mind that the relative grounds attacks are intended to mirror the infringement grounds. If an infringement action was brought by the Cancellation Applicant against the Proprietor, they could only cite their new specification. No injunction could be granted on their old specification, as it would serve no purpose.

13. As such, where it is the Cancellation Applicant who has surrendered the right they rely upon, absent an amendment to the TM26, the matter must be rejected as an abuse of process.”

10. Mr Moss’ submissions at the hearing largely reflected those above. However, in addition, he argued that the relevant date should be the date of the hearing and not the date of the application. He also contended that the proceedings should be brought to an end, unless the applicant amends its Form TM26. According to Mr Moss, this is because the case to be answered by the proprietor is that contained in the Form TM26.

11. Section 45 of the Act provides:

“45.—(1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered.

(2) Provision may be made by rules—

(a) as to the manner and effect of a surrender, and

(b) for protecting the interests of other persons having a right in the registered trade mark.”

12. Rule 33 of the Trade Marks Rules 2008 (“the Rules”) stipulates:

“33.—(1) Subject to paragraph (2), the proprietor may surrender a registered trade mark, by sending notice to the registrar—

(a) on Form TM22 in respect of all the goods or services for which it is registered; or

(b) on Form TM23, in respect only of those goods or services specified by the proprietor in the notice.

(2) A notice under paragraph (1) shall be of no effect unless the proprietor in that notice—

(a) gives the name and address of any person having a registered interest in the mark; and

(b) certifies that any such person—

(i) has been sent not less than three months’ notice of the proprietor’s intention to surrender the mark, or

(ii) is not affected or if affected consents to the surrender.

(3) The registrar shall, upon the surrender taking effect, make the appropriate entry in the register and publish the date of surrender on the Office website.”

13. Following receipt of the applicant’s requests, the partial surrenders of the earlier marks were published on the Intellectual Property Office website, in accordance with Rule 33(3) of the Rules. The date of 13 January 2020 is detailed as the recordal of the surrenders. The date on which the partial surrenders took place was, therefore, 13 January 2020. On the same date, letters from the Registry to the applicant’s recorded representatives, Taylor Wessing LLP, confirmed that the requests to partially surrender its marks had been recorded.

14. I cannot accept the position argued by Mr Moss; the partial surrender of the applicant's earlier marks will, as a matter of law, have no bearing on the outcome of these proceedings. Neither is the application considered "moot" or an abuse of process. As Mr Moss has correctly pointed out, surrender takes effect from the date of the surrender. As a result, surrender does not have any effect before such date and cannot be applied retrospectively. In the present case, the applicant partially surrendered its rights in its trade marks, effective from 13 January 2020. However, the partial surrenders are of no consequence to anything before this date and, more specifically, they do not retrospectively narrow the scope of the applicant's specifications. To my mind, whether or not the applicant is able to rely upon its 'new' specifications, i.e. those remaining after the effective date of the partial surrenders, is not relevant. The matter to be determined is whether, at the relevant date, there existed a likelihood of confusion between the proprietor's mark and the applicant's earlier marks. The relevant date in these proceedings is the date of the application for invalidity, namely, 7 May 2019. It is at that point in time that both the standing of any earlier marks and whether there is a likelihood of confusion are to be judged. It does not seem to be, nor could it be, in dispute that trade mark rights were in existence at that relevant date. At that time, the earlier marks were registered in respect of the services listed in the applicant's Form TM26(I) and, as the partial surrenders have no retrospective effect, it is still able to rely upon them for the purposes of these proceedings.

DECISION

15. Section 5 of the Act has application in invalidation proceedings by virtue of the provisions set out in section 47. The relevant legislation is as follows:

"47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

16. Sections 5(2)(b) and 5A of the Act read 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.”

“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.”

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

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

18. The trade marks relied upon by the applicant qualify as earlier trade marks in accordance with the above provisions. The applicant’s marks had not completed their respective registration processes more than five years before the date of the application for invalidity and are not, therefore, subject to the proof of use requirements. Consequently, the applicant is entitled to rely upon the services

identified – i.e. the specified services as they stood at the date of filing the application for invalidity – without having to establish genuine use.

19. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of the EU courts.

20. 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 services

21. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated (at paragraph 23 of its judgement) 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”.

22. 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.

23. In *Separode Trade Mark*, BL O/399/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person confirmed (at paragraph 5) that:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

24. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

25. Moreover, in *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold set out the following summary of the correct approach to interpreting broad and/or vague terms:

“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

26. 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 or services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (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”.

27. Furthermore, the GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

28. The services to be compared are as follows:

The applicant’s services	The proprietor’s services
Class 41: Education; providing of training; entertainment; sporting and cultural activities; information, consultancy and advisory services relating to the aforesaid.	Class 41: Stately home and castle public visiting services; museum, art gallery, gaming and recreation park services; provision of leisure, sports and recreational facilities; organising, arranging and conducting educational, entertainment and sporting shows;

	exhibitions, pageants, demonstrations, conferences, competitions and seminars, staging of sports tournaments; staging of fairs; staging of concerts; information relating to the aforesaid services.
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29. The applicant has claimed that the respective services are identical or similar. At the hearing, Mr Moss disputed that the respective services are identical, though accepted that there is some similarity between them due to the breadth of the applicant’s specification. However, Mr Moss did not indicate what level of similarity the proprietor believes exists between the respective services.

30. To my mind, *‘stately home and castle public visiting services’* in the proprietor’s specification falls squarely within the ambit of *‘cultural activities’* in the applicant’s specifications. Therefore, these services are identical under the principle outlined in *Meric*. Similarly, the proprietor’s related information services would be encompassed by the applicant’s *‘information services relating to cultural activities’*. Consequently, these services are also identical in accordance with *Meric*.

31. The terms *‘organising, arranging and conducting educational, entertainment and sporting shows; exhibitions, pageants, demonstrations, conferences, competitions and seminars, staging of sports tournaments; staging of fairs; staging of concerts; gaming services’* in the proprietor’s specification all refer to various types of entertainment or else of education or sporting and cultural services. As such, they are encompassed by the broader categories of *‘entertainment’*, *‘education’* or *‘sporting and cultural activities’* specified in the applicant’s specifications, rendering the services identical under the principle outlined in *Meric*. Equally, the proprietor’s related information services fall within the scope of the applicant’s *‘information services relating to entertainment’*. As a result, these services are also identical in accordance with *Meric*.

32. In my view, *‘museum and art gallery services’* in the proprietor’s specification refers to the day-to-day running of a museum or art gallery, organising exhibitions therein,

curating artefacts and works of art, and communicating with artists or collectors. These services are accessed by consumers as cultural activities. As such, they fall within the scope of the applicant's '*cultural activities*', rendering the respective services identical under the principle outlined in *Meric*. If I am wrong in my finding that '*cultural activities*' incorporate '*museum and art gallery services*', there will still be instances where the nature of the respective services overlaps, for example, where they both involve showing consumers items of historical or artistic significance. Moreover, I consider that there is an overlap in the intended purpose of the respective services insofar as they both seek to contribute to or enhance the artistic, historical or intellectual development and appreciation of the public. Further, the method of use of the respective services may overlap; typically, consumers of the proprietor's services would attend a museum or art gallery, and it is not uncommon for these establishments to also offer cultural activities such as talks, film screenings and activities for children. In this regard, the respective services may also reach the market through shared channels of trade. Users of the respective services would both include members of the general public with an artistic, historical or intellectual interest. I do not consider there to be any meaningful competition between the respective services. Furthermore, although there is a connection between the applicant's services and establishments such as museums and art galleries, it is not sufficiently pronounced for consumers to assume the respective services are provided by the same undertakings. Accordingly, they are not complementary. In light of the above, if the respective services are not identical, they are similar to a medium degree.

33. To my mind, given that museums and art galleries are accessed by consumers as cultural activities, the applicant's '*information relating to cultural activities*' encompasses the proprietor's '*information relating to museum and art gallery services*'. As a consequence, the respective services are identical under the principle outlined in *Meric*. If I am wrong in this finding, it remains the case that there will be an overlap in nature, intended purpose, method of use and user. Moreover, the respective services may reach the market through shared trade channels. I consider that there may also be an element of competition between the respective services as they are both information services in related fields. In view of the foregoing, if not identical, the respective services are highly similar.

34. The terms *'recreation park services; provision of leisure, sports and recreational facilities'* in the proprietor's specification describe the provision of various facilities for sporting and recreational purposes. I interpret *'sporting activities'* in the applicant's specifications as the organising and conducting of individual or group activities that are pursued for exercise or pleasure. The applicant's services may be conducted at facilities such as those provided by the proprietor. However, when considering the core meanings of the terms, they do not fall within the scope of one another and are not identical. Further, the nature of the respective services is not the same. In my view, there is an overlap in the intended purpose of the respective services insofar as they facilitate the practice or participation in sport and recreation. The method of use of these services, however, is not the same; ordinarily, consumers of the proprietor's services would engage with a provider of such facilities to obtain access and use of them, whereas those of the applicant's services would contact a provider to book their participation in a chosen activity. The respective services may be aimed at the same users. Moreover, it is not uncommon for the providers of sporting activities to also provide sports facilities, and vice versa. In this connection, the respective services sometimes reach the market through shared trade channels. For example, a provider of gym facilities may also offer personal training services. Given that consumers may choose between attending an organised class or simply making use of the facilities on offer, there is an element of competition between the respective services. I am of the view that they are also complementary as there is a close connection between them such that consumers may assume that the responsibility for the respective services lies with the same undertaking. In light of the above, it is considered that there is a medium degree of similarity between the respective services.

35. *'Information relating to recreation park services and provision of leisure, sports and recreational facilities'* in the proprietor's specification and *'information relating to sporting activities'* in the applicant's specifications both refer to information services in related fields. As such, the nature of the respective services is similar. As the subject matter of the information differs, the intended purpose of the respective services is not the same; the proprietor's services provide consumers with information about the provision of facilities, while the applicant's services provide information about a wide variety of sporting activities. The method of use of the respective services is the same, in that consumers of both will receive information from the provider. Users of the

respective services are likely to overlap in that those seeking to engage in a sporting activity may use both. The services are likely to reach the market through shared channels of trade and may be provided by the same undertakings. There is a close connection between them in such a way that consumers are likely to assume that they are provided by the same undertaking. The services are, therefore, complementary. Furthermore, as a consumer may choose between attending an organised class or simply making use of the facilities on offer, there is an element of competition between the respective services. Overall it is considered that there is between a medium and high degree of similarity between the respective services.

The average consumer and the nature of the purchasing act

36. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

37. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

38. I have no submissions from the parties regarding the average consumer of the services at issue in these proceedings.

39. The average consumer will be the general public. The frequency with which the services will be purchased is likely to vary, though, overall, it is considered that they will be purchased relatively frequently. Similarly, the cost of the services may vary.

However, the purchasing act will not require an overly considered thought process as, overall, they are relatively inexpensive purchases. The average consumer will, nevertheless, consider certain factors when purchasing the services. For instance, consumers of sports facilities will consider the range of sports equipment offered; consumers of cultural activities will consider the range and types of activities offered in accordance with their particular interests; consumers of education services will consider the quality of the service provided as well as the performance and outcomes of previous students; and consumers of museum and art gallery services will consider the kinds of artefacts or works of art on display. Taking the above factors into account, I find that the level of attention of the general public would be medium. The services are typically sold at the physical premises of the provider, or after the consumer has viewed information in brochures or on the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as consumers may receive word of mouth recommendations or discuss the services with a sales representative.

Distinctive character of the earlier mark

40. 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).”

41. The distinctive character of a mark may be enhanced as a result of it having been used in the market. However, the applicant has not pleaded that its marks have acquired enhanced distinctive character and has filed no evidence of use. Consequently, I have only the inherent position to consider.

42. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

43. I have no submissions from the parties regarding the level of inherent distinctive character possessed by the earlier marks.

44. The first earlier mark is in word-only format and consists of the words ‘FAITH UK’. The word ‘FAITH’ will be widely understood by consumers as meaning a strongly held belief,¹ while the word ‘UK’ is a common abbreviation for the United Kingdom.² The former cannot be said to be descriptive of any of the services for which the mark is registered, though, in respect of the majority of the services, it will be perceived as alluding to those that are concerned with the topic of religions and belief systems. The abbreviation ‘UK’ will be perceived as descriptive of the geographical location or origin of the services i.e. those that are provided in or emanate from the United Kingdom.

¹ <https://www.lexico.com/definition/faith>

² <https://www.lexico.com/definition/uk>

Overall, I find that the first earlier mark has between a low and medium level of inherent distinctive character in relation to the majority of the services upon which the applicant relies. In respect of '*sporting activities*' and the related information services, the word 'FAITH' has no direct allusive meaning. As a consequence, the first earlier mark is more distinctive for these services, though possesses no more than a medium level of inherent distinctive character.

45. The second earlier mark is in word-only format and comprises the words 'FAITH BROADCASTING NETWORK'. Again, the word 'FAITH' will be widely understood by consumers as meaning a strongly held belief. As I have already found, although it is not descriptive, when used in relation to the majority of the services relied upon it will be perceived as alluding to services that concern the topic of religions and belief systems. The words 'BROADCASTING' and 'NETWORK' will be understood as referring to the transmission of programmes or information by radio or television³ and a group or system of interconnected people or things,⁴ respectively. Together, it is considered that the words 'BROADCASTING NETWORK' will be perceived as referring to the provider of the services, namely, a group of broadcasting stations. Overall, I find that the second earlier mark has between a low and medium level of inherent distinctive character. In respect of '*sporting activities*' and the related information services, the word 'FAITH' has no direct allusive meaning. Therefore, the second earlier mark is more distinctive in relation to these services, though possesses no more than a medium level of inherent distinctive character.

Comparison of trade marks

46. 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

³ <https://www.lexico.com/definition/broadcasting>


⁴ <https://www.lexico.com/definition/network>

CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, 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.”

47. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

48. The competing marks are as follows:

Applicant's marks	Proprietor's mark
FAITH UK FAITH BROADCASTING NETWORK	

49. At the hearing, Mr Moss did not make submissions on the comparison between the second earlier mark and the proprietor's mark. He argued that, if the application could not succeed on the basis of the first earlier mark, it would not succeed on the basis of the second mark. This is because, in his submission, the second earlier mark is “further away” from the proprietor's mark than the first earlier mark. While I appreciate Mr Moss' comments, I do not intend to adopt this approach and will, instead, proceed to conduct comparisons on the basis of both earlier marks.

Overall impression

50. The proprietor has submitted that 'FAITH' is a very well-known English word and, therefore, less weight ought to be placed upon it. I have no submissions from the applicant regarding the overall impressions of the competing marks.

51. The proprietor's mark is a composite, figurative mark comprised of two elements. The mark contains the ordinary dictionary words 'FAITH MUSEUM', presented in a grey, standard typeface. Preceding the words appears a device resembling a lit candle in a curved triangular shape. The device is presented in the same grey colour. Notwithstanding the principle that the eye is naturally drawn to elements in trade marks that can be read,⁵ in my view, the words and the device dominate the overall impression of the mark in roughly equal measure. This is because the device occupies a prominent position within the mark and the words will be seen in combination as a reference to the establishment that is responsible for the services. The use of colour will be seen as decorative and, whilst still providing a contribution, will play a much lesser role in the overall impression of the mark.

52. The first earlier mark is in word-only format and consists of the words 'FAITH UK'. As the word 'UK' is wholly descriptive of the geographical origin or location of the services, it will play a reduced role in the overall impression of the mark. Given that the word 'FAITH' is not descriptive and appears at the beginning of the mark, it will provide a greater contribution to the overall impression of the mark, all the more so for those services for which it has no direct allusive meaning.

53. The second earlier mark is also in word-only format and comprises the words 'FAITH BROADCASTING NETWORK'. The overall impression of the mark lies in the combination of the words, though, as the word 'FAITH' appears at the beginning of the mark, it will have a degree more impact.

⁵ *Wassen International Ltd v OHIM*, Case T-312/03

Visual comparison

The first earlier mark and the proprietor's mark

54. Visually, the competing marks are similar insofar as they both contain the identical word 'FAITH'. There is a clear visual difference between the competing marks in that this word is followed by the word 'UK' in the first earlier mark and the word 'MUSEUM' in the proprietor's mark. As the proprietor has highlighted, another point of significant visual difference between the competing marks is that the proprietor's mark contains a device which has no counterpart in the first earlier mark. Bearing in mind my assessment of the overall impressions, I consider there to be between a low and medium degree of visual similarity between the marks.

The second earlier mark and the proprietor's mark

55. The competing marks are visually similar to the extent that they share the identical word 'FAITH'. The competing marks are visually different as this word in the second earlier mark is followed by the words 'BROADCASTING NETWORK', whereas, in the proprietor's mark, it is followed by the word 'MUSEUM'. The word elements in the second earlier mark are also significantly longer than those in the proprietor's mark. Moreover, there is another clear difference between the competing marks in that the proprietor's mark contains a device; this device occupies a prominent position in the proprietor's mark but is not replicated in the second earlier mark. Taking into account the overall impressions, I consider there to be, at most, a low degree of visual similarity between the marks.

Aural comparison

The first earlier mark and the proprietor's mark

56. The words 'FAITH' and 'MUSEUM' in the proprietor's mark will be given their ordinary English pronunciations. The device will not be articulated by consumers. The word 'UK' in the first earlier mark will be recognised as an abbreviation for the United Kingdom resulting in each letter being articulated, i.e. "YOU-KAY". The word 'FAITH'

in the first earlier mark will also be given its ordinary English pronunciation. The proprietor has, quite properly, accepted that the competing marks aurally coincide in the word 'FAITH'; this element is aurally identical. However, the second word elements of the marks are different. Bearing in mind my assessment of the overall impressions, I consider there to be a medium degree of aural similarity between the marks.

The second earlier mark and the proprietor's mark

57. As I have already found, the words in the proprietor's mark will be given their ordinary English pronunciations, while the device will not be articulated by consumers. The words in the second earlier mark will be given their ordinary English pronunciations. The extent of aural similarity between the competing marks is that their respective first words are aurally identical. Moreover, the pronunciation of the second earlier mark is more elongated than that of the proprietor's mark. Taking into account the overall impressions, I consider there to be a low, or between a low and medium, degree of aural similarity between the marks.

Conceptual comparison

The first earlier mark and the proprietor's mark

58. Conceptually, The word 'FAITH' will be understood by consumers as meaning a strongly held belief, while the word 'MUSEUM' will be understood as a reference to a building in which objects of historical, scientific, artistic, or cultural interest are stored and exhibited.⁶ Together, the words in the mark combine to form a unitary concept and will be understood as referring to a museum with a focus on religions and belief systems, the word 'FAITH' qualifying the word 'MUSEUM'. As I have outlined previously, the device will be perceived by consumers as a lit candle within a curved triangular shape. When used in conjunction with the word 'FAITH', the device is likely to evoke religious connotations as the lighting of candles is not uncommon in certain religious practices. The word 'FAITH' in the first earlier mark will also convey the concept of a strongly held belief. The word 'UK' will be understood as referring to the

⁶ <https://www.lexico.com/definition/museum>

United Kingdom. The word elements do not combine to form a unitary meaning. Rather, the mark will evoke the concept of faith per se, as well as a descriptive reference to the geographical location or origin of the services. I accept that the competing marks coincide in the meaning conveyed by the word 'FAITH' and, to that extent, there is some conceptual overlap between them. However, I agree with the proprietor that there is a perceptible difference in the respective conceptual messages: the proprietor's mark will be understood as a reference to a particular place or establishment, i.e. a museum focused on belief systems, whereas the first earlier mark will conjure more nebulous connotations of belief systems in the abstract. The conceptual identities of both marks have features that are lacking from the other. Bearing in mind my assessment of the overall impressions, I consider there to be, at most, between a low and medium degree of conceptual similarity between the competing marks.

The second earlier mark and the proprietor's mark

59. Conceptually, the words in the second earlier mark combine to form a solitary meaning, namely, a group of broadcasting stations that is concerned with the topic of religion and belief systems. As above, these competing marks also conceptually overlap insofar as they both provide a message related to the word 'FAITH'. Nonetheless, given that the proprietor's mark refers to a particular place or establishment, i.e. a museum focused on belief systems, and the second earlier mark refers to a group of broadcasting stations concerned with faith, there is a perceptible conceptual difference between the marks. Taking into account the overall impressions, I consider there to be a low degree of conceptual similarity between the marks.

Likelihood of confusion

60. 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. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade marks,

the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related.

62. Earlier in this decision, I concluded that:

- Where not identical, the proprietor's services are similar to those of the applicant to at least a medium degree;
- Average consumers of the services at issue are likely to be members of the general public, who would demonstrate a medium level of attention during the purchasing act;
- The purchasing process for the services would be predominantly visual in nature, though I have not discounted aural considerations;
- The earlier marks both possess a low to medium level of inherent distinctive character, rising to no more than a medium level in relation to '*sporting activities*' and connected information services;
- The overall impression of the proprietor's mark is dominated by the words 'FAITH MUSEUM' and the device in roughly equal measure, while the use of colour plays a much lesser role;
- The overall impression of the first earlier mark is dominated by the word 'FAITH', while the word 'UK' plays a reduced role;

- The overall impression of the second earlier mark lies in the combination of the constituent words, though the word 'FAITH' has a degree more impact;
- The proprietor's mark and the first earlier mark are visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to between a low and medium degree (at most);
- The proprietor's mark and the second earlier mark are visually similar to a low degree (at most), aurally similar to a low or between a low and medium degree and conceptually similar to a low degree.

63. I acknowledge that the competing marks share the identical word 'FAITH' and that this word appears at the beginning of the earlier marks, a position which is generally considered to have more impact.⁷ Nevertheless, there are differences between the marks which, to my mind, are not negligible and would not be overlooked by consumers during the purchasing process. Neither of the earlier marks contain the word 'MUSEUM' or the device. Significantly, the latter jointly dominates, and occupies a prominent position within, the proprietor's mark. Moreover, the words 'BROADCASTING NETWORK' in the second earlier mark have no counterpart in the proprietor's mark. Further, whilst the word 'FAITH' creates a limited degree of conceptual overlap, the overall conceptual identities of the competing marks will make different impressions in the minds of consumers: the proprietor's mark will be understood as referring to a museum focused on aspects of faith, whereas the first earlier mark provides a more ambiguous concept of faith and the second earlier mark will be understood as a group of broadcasting stations concerned with faith. In my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to be sufficient to avoid the general public mistaking the proprietor's mark for the earlier marks (or vice versa), even on services which I have found to be identical. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

64. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., again sitting 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.

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).”

65. I have borne in mind that these examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.

66. I also recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.⁸ Applying the principles from the above case law, due to the differences between the marks previously outlined, I do not believe that the average consumer will assume the applicant and the proprietor are economically linked undertakings on the basis of the competing trade marks. I am unconvinced that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the applicant, merely because of the shared word ‘FAITH’. This common element is not strikingly distinctive. To the contrary, I have found this word to be allusive for the majority of the services at issue in these proceedings and, even when considering the services for which it would not be allusive, the word is only averagely distinctive. As such, consumers are unlikely to assume that only the applicant would be using it in a trade mark. Moreover, to my mind, save for the descriptive element ‘UK’ in the first earlier mark, none of the differences between the competing marks are simply adding non-distinctive elements of the kind that consumers are accustomed to denoting sub-brands or brand extensions. I can see no reason why the competing trade marks would be perceived in this manner, even for services that I have found to be identical. Therefore, there is no likelihood of indirect confusion.

⁸ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

CONCLUSION

67. The application for invalidation under section 5(2)(b) of the Act has failed. Subject to any successful appeal against my decision, the proprietor's mark will remain registered in the UK.

COSTS

68. The application has been unsuccessful and, as such, the proprietor is entitled towards a contribution towards its costs. The proprietor has argued that off-scale costs are appropriate. In his skeleton arguments, Mr Moss submitted that:

“23. Finally, the Proprietor seeks their costs off the scale. The Cancellation Applicant has continued with an application based on a mark that no longer exists. The Cancellation Applicant has also not engaged in terms of evidence or submission. Such conduct has forced the Proprietor to defend their mark at cost and that conduct should not be condoned.”

69. Rule 67 of the Rules provides:

“The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid.”

70. Tribunal Practice Notice (“TPN”) 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. The TPN stipulates that costs off the scale are available “to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour”. From the proprietor's submissions, it appears that the matter at issue is two-fold: firstly, whether the continuation of the proceedings notwithstanding the partial surrendering of the applicant's earlier marks should be considered unreasonable behaviour and, secondly, whether the applicant's decision not to file evidence or provide submissions should also be considered unreasonable behaviour.

71. Having considered the conduct of proceedings, I am of the view that off-scale costs are not appropriate in this instance.

72. Firstly, the applicant's continuation of its claim notwithstanding the partial surrender of its earlier marks does not strike me as an abuse of process and, in my view, is not compelling evidence of unreasonable behaviour in and of itself. The applicant does not appear to be concerned with anything other than its own business in deciding to partially surrender its trade marks. Moreover, owners of registered trade marks are open to make legally compliant surrenders of their intellectual property rights as they see fit, but that does not subsequently mean that they are obligated to desist from continuing proceedings involving those marks and neither does it automatically render those proceedings moot. As I have already explained, the effect of surrender is not retrospective and the question of whether there is a likelihood of confusion between two or more competing trade marks is determined as at the relevant date. The property rights relied upon by the applicant were in existence at that date. A party which partially (or fully, for that matter) surrenders its trade marks may still have a commercial interest in the outcome of proceedings that are already underway.

73. I now turn to the applicant's alleged unreasonable behaviour in electing not to file evidence in these proceedings. It is important to note that the earlier marks relied upon for the purposes of the application were not subject to proof of use. As such, whilst the option was still available to the applicant to file evidence in support of its claim, it was not required to do so. The filing of evidence is not compulsory in circumstances such as these, nor was it absolutely necessary to determine the issue before me. Similarly, in respect of the applicant's alleged failure to engage in terms of submission, I would point out that, although it can be of great assistance for parties to actively engage in proceedings, the applicant was not under any obligation to provide written submissions or attend the hearing, which took place at the behest of the proprietor. The applicant's claim was set out in its Form TM26(l) and the information it provided was sufficient, albeit brief. To my mind, none of the foregoing is compelling evidence of an abuse of process or otherwise unreasonable behaviour.

74. The relevant scale is contained in TPN 2/2016. In the circumstances, I award the proprietor the sum of **£700** as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Considering the applicant's statement and preparing a counterstatement	£200
Preparing for and attending a hearing	£500
Total	£700

75. I therefore order Trinity Broadcasting Investments NPC to pay The Auckland Castle Trust the sum of **£700**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 15th day of April 2021

James Hopkins
For the Registrar,
The Comptroller General