

O-504-12

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF TRADE MARK APPLICATIONS 2521514 & 2492278
BY ADELPHOI LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 5, 30, 32, 16,
25, 38 & 41:**

BATSMAN

AND

**OPPOSITION THERETO (NOs 99812 & 99914) BY DC COMICS (A GENERAL
PARTNERSHIP)**

The background and the pleadings

1) Both applications the subject of these proceedings are in respect of the trade mark: **BATSMAN**. Both were filed by Adelphoi Limited (“Adelphoi”). The dates of filing/publication and the goods/services for which registration is sought are as follows:

Application 2521514

Filed on 21 July 2009 and published in the Trade Marks Journal on 21 August 2009. Registration of the mark is sought for:

Class 05: Dietary supplements; nutritional supplements; vitamin, mineral and protein preparations and substances; dietetic foods and beverages; medicated beverages.

Class 30: Snack foods and snack bars; nutritional, energy, protein and weight gain confectionery bars; cereal bars, biscuits, cakes, pastry and confectionery.

Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; energy drinks; protein based fruit drinks; syrups for making beverages

Application 2492278

Filed on 9 July 2008 and published in the Trade Marks Journal on 25 September 2009. Registration of the mark is sought for:

Class 16: Printed matter, stationery, books, newspapers, magazines, newsletters, periodicals, posters, stickers, transfers, decals, pens, pencils, pencil sharpeners, erasers, pen and pencil cases, note books, papers, envelopes, diaries, address books, art prints, cards, postcards, gift cards, greeting cards, calendars, paintings, photographs, writing paper, writing implements; **all the foregoing goods relating to the sport of cricket.**

Class 25: Clothing, footwear, headgear; **all the foregoing goods relating to the sport of cricket.**

Class 38: Telecommunications; communications; broadcasting; broadcasting and transmission of radio and television programmes; interactive broadcasting and communications services; data transmission and data broadcasting; cellular telephone communication services; cable, satellite and terrestrial broadcasting services; broadcasting via the world wide web; electronic mail services; interactive video text services; news information and news agency services; message sending;

communications by and/or between computers and computer terminals and computer networks; telecommunication access services for access to a communications or computer network; retrieval, provision and display of information from a computer stored database; electronic display of information, text, images, messages and data; on-line communication services; providing on-line chat room for transmission of messages among computer users concerning topics of entertainment and sports; providing on-line electronic bulletin boards for transmission of messages among computer users concerning topics of entertainment and sports; **all the foregoing services relating to the sport of cricket.**

Class 41: Sporting activities; sporting services by or relating to television or radio; organisation, production and presentation of events for sporting purposes; organisation, production and presentation of sporting events and sporting tournaments; organisation, production and conducting of exhibitions and training courses; information relating to sporting events provided on-line from a computer database or the Internet; reservation and booking services for sporting events; information and advisory services relating to all of the aforesaid services; but none of the aforementioned services relating to cricket; education; entertainment; cultural activities; education, entertainment and cultural services by or relating to television or radio; organisation, production and presentation of events for educational, entertainment and cultural purposes; organisation, production and presentation of games, competitions, contests, exhibitions, quizzes, concerts, road shows, staged events, live performances; organisation, production and conducting of conferences, seminars, workshops, symposiums, congresses and colloquiums; publishing services; publication of books, training manuals, periodical publications, magazines, newspapers and newsletters; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; production and presentation of interactive entertainment, CDs, CD-ROMs and computer games; information relating to education, entertainment and cultural events provided on-line from a computer database or the Internet; reservation and booking services for educational, entertainment and cultural-events; **all relating to the sport of cricket.**

In the above list of goods and services I have emboldened a limitation that Adelphoi added to its specification on 8 July 2011.

2) DC Comics (A General Partnership) (“DC”) opposes the registration of Adelphoi’s marks. Its oppositions were filed on 23 November 2009 and 21 December 2009 respectively. The grounds of opposition are the same in each, namely, under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In each opposition the mark/sign relied upon by DC consists of the word: **BATMAN**. DC relies on its Community Trade Mark (“CTM”) registration 2974673 under sections 5(2)(b) and 5(3). The CTM was filed on 13 December 2002 and it completed its registration procedure on 12 April 2005. Given these

dates, DC's mark constitutes an earlier mark as defined by section 6 of the Act and, furthermore, it is not subject to the proof of use provisions as set out in section 6A of the Act; there is no dispute about this. Under section 5(4)(a), DC relies on its claimed goodwill stemming from the use of the sign BATMAN in relation to comics, films, television programmes and "a wide variety of merchandise".

3) Adelphoi filed counterstatements denying the grounds of opposition. The cases were consolidated. Both sides filed evidence. The matter then came to be heard before me on 26 November 2012. Adelphoi was represented by Mr Simon Malynicz, of counsel, instructed by The Trademark Café Limited; DC was represented by Mr John Baldwin QC, also of counsel, instructed by Edwards Wildman Palmer UK LLP.

DC's evidence

4) This consists of a witness statement from Mr Jay Kogan, DC's Vice President and Deputy General Counsel. Mr Kogan gives a detailed and lengthy explanation about DC's activities, focusing in particular on one of the comic book characters it created, BATMAN. As a matter of judicial notice, I am prepared to accept that BATMAN is a very well known comic book character. The evidence establishes that the character was created in 1939. The following provides a brief summary of the evidence, broken down to particular sub-topics:

BATMAN comics & books

5) Mr Kogan states that BATMAN has appeared in thousands of comic books. Exhibits JK5 to JK7 contain extracts from various comics featuring BATMAN, many of which include the word BATMAN on the cover. Mr Kogan acknowledges that they carry prices is US\$ (his comment is made in relation to JK7) but he states that they were available in the UK. Reference is also made to a movie novelization of the Batman Forever film; an extract from Amazon.co.uk is provided in Exhibit JK8 showing this book.

6) Exhibit JK9 contains worldwide revenue figures for sales of BATMAN books and periodicals. Mr Kogan states that a significant proportion of such sales were made in the UK. The sales figures range from around \$6 million to \$12 million per annum between 2001 and 2007; this figure is for US dollars, as are the rest of the figures mentioned in this evidence summary. A DC Comics Encyclopedia has been produced (first published in 2004) which features BATMAN; Exhibit JK12 features a print from Amazon.co.uk showing this publication together with BATMAN related extracts from the book.

BATMAN films and movie tie-ins

7) Between 1989 and 1997 four BATMAN films were produced (BATMAN, BATMAN RETURNS, BATMAN FOREVER & BATMAN & ROBIN). A further film franchise began in 2005 with the release of BATMAN BEGINS. This grossed over £30 million in the UK. A sequel was subsequently released entitled THE DARK KNIGHT. This appears to have been even more popular. However, I note that this film was released on 18 July 2008, so after the material date for application 2492278 but one year before the material date for application 2521514. A further sequel (THE DARK KNIGHT RISES) has also been released but this was after the material date of both applications.

8) Evidence is given about a plethora of movie tie-ins which have generated a significant amount of revenue, of which a significant proportion is said to relate to the UK market. The Dark Knight was released on Blu-ray and DVD and by December 2008 had sold over 2.5 million copies in the UK. Mr Kogan acknowledges that the word BATMAN is not in the title of this film but he says that it is inextricably linked to the BATMAN name and will be recognized as such. Some of the films (Batman Returns, Batman Forever, Batman Begins & The Dark Knight) have been nominated for/won industry awards.

BATMAN on television

9) A BATMAN television series was aired between 1966 and 1968, a series which has been re-broadcast in the 70s, 80s, 90s and 2000s. Animated television programmes have been aired in more recent times including “Batman: The Animated Series” (1992), “The Batman” (2004) and “Batman: The Brave and the Bold” (2008); these are said to have been extensively broadcast in the UK. Exhibit JK14 contains a table highlighting the extent to which the various BATMAN television programmes and movies have been broadcast in the UK between 1992 & 2011. Most have been aired multiple times (and before the material date) on a number of UK television channels.

BATMAN video games

10) A large number of BATMAN video games have also been released, often being tied to the various films or television programmes referred to. Some of the games specifically referred to by Mr Kogan were released after the material dates or it is not clear whether they were released before one or both of the material dates.

BATMAN merchandising

11) To illustrate the range of products that have been merchandised, Mr Kogan provides in Exhibit JK1 extracts from a 1995 book that was published about DC and its comic book characters. The extracts include the origins and history of

BATMAN and I note various items of associated merchandise which have been produced including: toys, lunchboxes, bread, plates, records, magazines, breakfast cereal, arcade games, backpacks, figurines, mugs, boxer shorts, booties. It is stated that DC's UK licensees sell a broad range of goods and that 900 individual agreements are in existence. In terms of licensing, the agreements may be exclusive or non-exclusive and DC's licensing department in New York has to approve samples of the goods. It is stated that an express term appears in every licence, that DC's characters must be attributed to DC. Exhibit JK3 contains examples of DC's style guides issued to its licensees; these instruct on how BATMAN is to be reproduced etc on the licensed goods. Highlighted in one of them, in relation to "Batman: The Animated Series" is the text: "in order to maintain a coordinated presentation as well as trademark control, only logo provided by DC Comics may be used in the Batman merchandising program". Activities in the UK between 1998 and 2011 equate to an average of \$1.5 million per year. Some specific categories of goods are referred to with revenue for the whole of the period 1998-2011 being provided (some of the figures relate to different periods which I will identify), some examples of which are:

- Accessories (including watches, cameras, clocks, wallets, hats, torches) - \$700,000;
- Clothing items - \$5 million;
- Domestic and linens - \$290,000;
- Food items - \$600,000;
- Fine art and collectibles - \$70,000;
- Footwear - \$95,000;
- Gifts and novelties - \$600,000;
- Home merchandise - \$35,000;
- House wear - \$290,000;
- Personal care and health - \$400,000;
- Pet products - \$3000 (for the period 2006-2010);
- General promotions - \$780,000;
- Publishing, audio and music - \$80,000;
- Stationary and paper goods - \$760,000;

- Toys, games and audio equipment - \$9.5 million;
- Video and computer items - \$350,000 (for the period 1998-2010).
- Sporting goods (including sports bags, boxing gloves, skateboards, bicycles, roller skates, ice skates, scooters, protective clothing, basketball accessories, golf clubs, dart boards, snorkeling equipment, paddle bats, Frisbees) - \$430,000 (for the period 2004-2011).

12) A large number of voluminous exhibits are provided in support of the above activities. Most of the goods sold feature either a picture of the BATMAN character, the word BATMAN (sometimes with other words), other signage associated with BATMAN (such as the bat logo), or combinations thereof.

Other BATMAN activities

13) Evidence is given about a BATMAN LIVE stage adaption of the BATMAN story, but this appears to have taken place after the material dates. DC has a number of websites, the primary one appears to be dccomics.com which was created in 1996 and received over 3.5 million visitors in the US in 2011. Various other domains are owned. Some domains feature the word BATMAN but it is not clear if these are used or not; Mr Kogan states that a number of domain names were created to prevent misappropriation by third parties.

Adelphoi's evidence

14) This comes from Ms Laurel McBray, a trade mark attorney at Trademark Café Limited. Much of Ms McBray's evidence relates to the word BATSMAN and its meaning in the world of cricket. Such a meaning is well documented in the various dictionaries she refers to (Collins English Dictionary, Cambridge Dictionaries Online, Wiktionary, Oxford Dictionary and Dictionary.com). It is a word used, unsurprisingly, to refer to a person whose turn it is to bat or who specialises in batting. Ms McBray also conducted other searches (on Google, Twitter, in print and other media) which, again, show that BATSMAN is a known cricketing term.

15) In relation to the goods and services, Ms McBray makes a number of submissions, supported in some cases by factual evidence. In relation to magazines, she provides evidence that sports magazines (which include specialist cricket magazines) are in a separate area to comics etc, and that the same delineation occurs online; Exhibits LM13-14 refer, respectively. Also provided are searches for the term BATSMAN conducted on the websites of some book retailers; these bring back results for cricket related publications.

16) Exhibit LEM19 contains extracts from the website of a company which specialises in decals for cricket bats etc. Evidence (Exhibit LM20) is also given as

to the availability of cricket themed posters, photographs etc. In relation to clothing, evidence is given that a number of retailers sell specialist cricket clothing. Evidence is given of telecommunications and related services with a cricketing theme (e.g. websites that provide cricketing information and websites that provide information on sport in general). Evidence is given of undertakings who offer specific training services in relation to cricket.

17) In relation to Mr Kogan's evidence, Ms McBray notes that much of the evidence contains figurative representations of the BATMAN character. She provides a Google print for the term BATMAN MERCHANDISE, from which she notes that not one of the products contain the word BATMAN alone, instead they additionally contain images of the character and/or the BATMAN symbol; some do not feature the word at all.

DC's reply evidence

2nd witness statement of Mr Kogan

18) Mr Kogan provides evidence demonstrating that the word BATSMAN has a number of meanings. He refers to the meaning of "a landing safety officer on board an aircraft carrier". He also refers to Exhibit JK4 which is a Google results page which has a reference to a comic book character called "Batsman" which is apparently the disembodied consciousness of a future Batman. The reference is from a website called comicvine.com.

19) Exhibit JK3 is a screenshot showing a term being entered into the Google search engine, the term being BATSMAN.COM – Mr Kogan highlights that a dropdown list is provided by Google below the input field in which there are further entries which can be clicked upon, including BATMAN COMICS. Exhibit JK5 contains prints from websites about BATMAN graphic novels which Mr Kogan states are more adult orientated. Exhibit JK6 is print from a web site called punkcricket.com which shows a t-shirt with the words BATSMAN set against the image of the traditional BATMAN logo.

Witness statements of Rudy Osorio & Corinna Drysdale

20) These two witness statements are introduced via a witness statement of Mr John Olsen, although I am not sure why Mr Olsen thought it necessary to provide a witness statement himself. Mr Osorio is Head of Visual for HMV UK Limited, a company engaged, amongst other things, in selling music, films, games and books across all genres and platforms. He is regularly exposed to branded merchandise. He is making his statement as a routine purchaser of household and consumer items. He says that BATMAN and BATSMAN look so similar that he initially mistook one for the other. Ms Drysdale is Director of Global Licensing but does not say for whom; but they are, apparently, in the business of manufacturing and selling licensed apparel. She is also making her statement in

her own capacity as a consumer. She is familiar with the BATMAN brand. She thinks the words are similar and that they could both be read as BATMAN, especially because BATMAN is a very well-known fictional character.

21) I take no cognisance of the evidence referred to in the preceding paragraph. The witnesses say that are giving evidence as consumers, but their job titles indicate that they are far from average consumers in terms of branding issues. Furthermore, the manner in which they have compared the marks is given no marketplace context. Even if the marks were seen in context, and even if they were more average than I have given them credit, they are the opinions of just two people, a statistically irrelevant indication.

Section 5(2)(b)

22) Section 5(2)(b) of the Act reads:

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

(a)

(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.”

23) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

24) The average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The

degree of care and attention the average consumer uses when selecting goods/services can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

25) The conflict involves a wide variety of goods and services. The degree of care and consideration may vary accordingly. However, Mr Malynicz did not argue that any of the goods and services at issue would be subject to a highly considered purchasing process. The degree of care and consideration will therefore be no higher than the norm (in some instances the degree of care and consideration may be lower than the norm). In terms of the goods and services in question, it seems that the primary means of selection and perusal will be via visual stimuli, however aural considerations will still be borne in mind. To the extent that it becomes necessary, I will comment further upon these issues when I determine whether there exists a likelihood of confusion.

Comparison of goods and services

26) On behalf of Adelphoi, Mr Malynicz accepted that the goods and services it sought to register were either identical or similar to the goods and services covered by DC’s earlier mark. In his skeleton argument Mr Malynicz stated:

“16.1 As regards the 2521514 mark, there is identity between all of the goods listed in class 5, similarity between the goods in class 30, and identity for all the goods listed in class 32 save for beers, in respect of which there is similarity;

16.2 As regards 2492278, there is identity between all the goods and services listed and those of the earlier BATMAN mark based on the principle of “inclusion identity” in the case law outlined earlier”

27) Identity is therefore accepted for everything other than for the goods in class 30 and beers in class 32. I will comment briefly on this because, despite what Mr Malynicz stated, I consider some of the goods to be identical for the following reasons.

- Adelphoi’s “snack foods and snack bars; nutritional, energy, protein and weight gain confectionery bars; cereal bars” are encompassed by “preparations made from cereals” which are covered by the earlier mark and are, thus, identical¹.

¹ If a term falls within the ambit of a term in the competing specification then identical goods must be considered to be in play - see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-133/05).

- Adelphoi's "biscuits" are identical to "biscuits" and "cookies" covered by the earlier mark.
- Adelphoi's "confectionery" is identical to "frozen confections", "peanut butter confectionery" and "sugar confectionery" covered by the earlier mark.

28) I agree that the other goods in class 30, and beer in class 32, are not identical to the goods of the earlier mark but they are, nevertheless (and as conceded) similar to the goods of the earlier mark.

Comparison of the marks

29) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

BATMAN v BATSMAN

30) Neither mark breaks down into dominant and distinctive components beyond its constituent parts. The words BATMAN/BATSMAN are the dominant and distinctive components respectively.

31) From a visual perspective, the marks have six letters in common, those letters are presented in the same order. The only difference is that one mark has an additional letter S in the middle of the word. I would not call the marks short (where the additional letter may stand out more), but neither are they long (where it could be lost). Had the additional letter been at the beginning then it may have been more noticeable. Overall, I consider there to be a high degree of visual similarity.

32) From an aural perspective, I agree with Mr Malynicz that there is less aural similarity than visual similarity. BATMAN will be pronounced as BAT-MAN (the syllables being pronounced in the customary way for those words) whereas BATSMAN will most likely be pronounced as BATS-MUN. Mr Malynicz argued that the differences resulted in any similarity being low. Whilst the differences the respective pronunciations create are borne in mind, I consider the similarities to still result in a reasonably high degree of aural similarity.

33) In terms of concept, Mr Malynicz stressed the very different concepts that underpin the respective marks. Mr Baldwin argued that in the context of trade mark use, the concept underpinning BATSMAN may not be appreciated. I will come back to Mr Baldwin's comments later when assessing whether there exists a likelihood of confusion. For the time being, the assessment from the conceptual

basis must be that there is, as a matter of fact, conceptual dissonance between the words BATMAN (the name of a well-known comic book character) and BATSMAN (a type of cricketer or an aircraft safety officer). I should add that the evidence relating to the comic book character BATSMAN has no significance - there is nothing to suggest that such a character is known in the UK, be it now or before the material dates.

The distinctiveness of the earlier mark

34) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In terms of inherent characteristics, the mark is highly distinctive. It is a word with no allusion to anything other than a combination of a bat and a man.

35) That then leads to the use provided by DC. Whilst Mr Malynicz accepted that the earlier mark had a reputation for films, printed matter (such as comic books), and television programmes, he did not accept that BATMAN had a reputation as a trade mark for anything else. Mr Baldwin argued that the extensive use that had been put forward by Mr Kogan proved the contrary. I am more in line with Mr Malynicz than Mr Baldwin. Whilst a lot of evidence has been provided about DC's merchandising activities, this does not of itself equate to the trade mark BATMAN having a specific reputation for the goods merchandised. The revenue figures provided vary considerably between the categories of goods and, furthermore, those categories are diverse with numerous types of goods falling within. However, bearing in mind the revenue figures, together with the examples of use exhibited, I am prepared to accept that in addition to those items referred to by Mr Malynicz, the mark also has a reputation (and thus an enhanced level of distinctiveness) for toys. For the rest of the goods, the mark still has an inherently high level of distinctiveness, so this finding may not be overly significant anyway.

Likelihood of confusion

36) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

37) I will begin by considering application 2521514 which is sought to be registered for:

Class 05: Dietary supplements; nutritional supplements; vitamin, mineral and protein preparations and substances; dietetic foods and beverages; medicated beverages.

Class 30: Snack foods and snack bars; nutritional, energy, protein and weight gain confectionery bars; cereal bars, biscuits, cakes, pastry and confectionery.

Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; energy drinks; protein based fruit drinks; syrups for making beverages

38) I will come on to the significance (or otherwise) of the cricketing limitation which has been directed at the other application. However, there is no limitation here and, furthermore, even if the limitation is significant in respect of the other application I do not consider that there is potential to apply anything similar here, given that the goods in question are not ones which have particular cricketing subsets. The goods are largely identical. They are purchased with no more than an average level of care and consideration; some of the goods (confectionery, for example) may be purchased with a lower than normal level of consideration. The marks are high in visual similarity and are similar to a reasonably high degree from an aural perspective. The goods are bought more by the eye than by the ear. Most of these factors push more towards confusion than against it. However, there is the conceptual dissonance between the marks to bear in mind.

39) As has been stated many times by the courts, conceptual differences may have a counteractive effect on the other aspects of similarity (see, for example, Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-643). However, conceptual differences do not always succeed in having a counteractive effect (see the GC's judgment in *Nokia Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-460/07*). Thus, there being a difference in concept is not a silver bullet to avoid confusion. The meanings behind the words in question are very different. However, the marks are very close. Mr Malynicz argued that the existence of such different meanings, coupled with the fact that the different meanings provide a clear certainty of recollection, meant that confusion was not likely. Whilst I have borne in mind Mr Malynicz's detailed submissions on the various conceptual counteraction cases, it is my view that the marks in this case, when used on the identical goods at issue, may easily be mistaken for one another. I do not quite agree with Mr Baldwin's assessment that in the context of trade mark use the meaning behind BATSMAN will not be perceived, but, nevertheless, the degree to which the average consumer considers these purchases is not one for which the difference in concept will readily leap out. The marks look (and sound) so close that the difference in concept is likely to go unnoticed. If the difference goes unnoticed then the conceptual difference has no material effect. **There is a likelihood of confusion.** This applies also to the goods which are not identical; the

relationships between the various factors are close enough for there to be a likelihood of confusion. **The opposition against application 2521514 succeeds under section 5(2)(b) of the Act.**

40) Application 2492278 is sought to be registered for:

Class 16: Printed matter, stationery, books, newspapers, magazines, newsletters, periodicals, posters, stickers, transfers, decals, pens, pencils, pencil sharpeners, erasers, pen and pencil cases, note books, papers, envelopes, diaries, address books, art prints, cards, postcards, gift cards, greeting cards, calendars, paintings, photographs, writing paper, writing implements; **all the foregoing goods relating to the sport of cricket.**

Class 25: Clothing, footwear, headgear; **all the foregoing goods relating to the sport of cricket.**

Class 38: Telecommunications; communications; broadcasting; broadcasting and transmission of radio and television programmes; interactive broadcasting and communications services; data transmission and data broadcasting; cellular telephone communication services; cable, satellite and terrestrial broadcasting services; broadcasting via the world wide web; electronic mail services; interactive video text services; news information and news agency services; message sending; communications by and/or between computers and computer terminals and computer networks; telecommunication access services for access to a communications or computer network; retrieval, provision and display of information from a computer stored database; electronic display of information, text, images, messages and data; on-line communication services; providing on-line chat room for transmission of messages among computer users concerning topics of entertainment and sports; providing on-line electronic bulletin boards for transmission of messages among computer users concerning topics of entertainment and sports; **all the foregoing services relating to the sport of cricket.**

Class 41: Sporting activities; sporting services by or relating to television or radio; organisation, production and presentation of events for sporting purposes; organisation, production and presentation of sporting events and sporting tournaments; organisation, production and conducting of exhibitions and training courses; information relating to sporting events provided on-line from a computer database or the Internet; reservation and booking services for sporting events; information and advisory services relating to all of the aforesaid services; but none of the aforementioned services relating to cricket; education; entertainment; cultural activities; education, entertainment and cultural services by or relating to television or radio; organisation, production and presentation of events for educational, entertainment and cultural purposes; organisation,

production and presentation of games, competitions, contests, exhibitions, quizzes, concerts, road shows, staged events, live performances; organisation, production and conducting of conferences, seminars, workshops, symposiums, congresses and colloquiums; publishing services; publication of books, training manuals, periodical publications, magazines, newspapers and newsletters; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; production and presentation of interactive entertainment, CDs, CD-ROMs and computer games; information relating to education, entertainment and cultural events provided on-line from a computer database or the Internet; reservation and booking services for educational, entertainment and cultural-events; **all relating to the sport of cricket.**

41) The goods/services are different from the application already assessed, but the primary added factor here is the cricketing limitation that has been added to the specifications. This may result in the meaning of the word BATSMAN being more readily apparent, i.e. that because the goods/services relate to cricket, the cricketing reference will not be missed. I put to one side the argument as to whether the goods/services in question can have a true cricketing subset, and also whether a better form of wording is available. This is because even if the goods/services do relate to cricket then the closeness of the marks and the likelihood of this causing confusion is not diminished. The goods/services are still identical. Counterintuitive as it may seem, DC's earlier mark will include goods relating to cricket. So even in this context, given the closeness of the marks, the identity of the goods/services, and the no more than average degree of care and attention used by the average consumer when selecting them, there is an equally great propensity for the marks to be mistaken for one another. **There is a likelihood of confusion. The opposition against application 2492478 succeeds under section 5(2)(b) of the Act.**

Section 5(3) & 5(4(a) of the Act

42) I have already upheld the opposition against both applications under section 5(2)(b). I consider this to represent DC's strongest ground of opposition. In such circumstances, I do not consider it necessary to probe the other grounds of opposition.

Costs

43) DC has been successful and would, ordinarily, be entitled to a contribution towards its costs. However, Mr Malynicz argued that costs should not necessarily follow the event due to what he considered to be the unnecessarily voluminous nature of DC's evidence and, also, the bombardment, by those who instructed Mr Baldwin, of authorities on the afternoon before the hearing running to many hundreds of pages, none of which Mr Baldwin relied upon at the hearing. Mr Baldwin argued that the evidence was necessarily voluminous due to the facts

upon which DC were put to proof and, as for the authorities, these were simply for information purposes as they supported DC's written submissions which were filed earlier in the proceedings.

44) Whilst I accept that DC was put to proof on a number of issues, I am of the opinion that DC's representatives could have been more measured in their approach. I am sure that it could have provided less evidence to support its case than the 8 lever arch files it put in. Furthermore, although only a small part of the evidence, they also filed three witness statements that were simply pointless. However, I do not say that DC was completely abusive in their approach. My decision is that despite DC being the winning party, they shall not be favoured with an award of costs. However, their conduct is not so disproportionate to award costs to the other party. I make no award of costs.

Dated this 19th day of December 2012

**Oliver Morris
For the Registrar,
The Comptroller-General**