

O-041-18

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3101542
BY MY EVENT GENIE LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 35 & 38

AND

**IN THE MATTER OF APPLICATION No. 3176895
BY MY EVENT GENIE LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 9, 35, 38 & 41

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER No. 404724 & 408528 BY
O2 WORLDWIDE LIMITED**

BACKGROUND

1) On 27 March 2015, My Event Genie Ltd (hereinafter the applicant) applied under no. 3101542 to register the trade mark shown above in respect of the following services:

- Class 35: Advertising events via electronic media and specifically the internet; Dissemination of advertising for others via the internet; Providing and rental of advertising space on the internet for client events; Advertising services provided via the internet; Business administration services for processing sales made on the internet; Business information services provided on-line from a computer database or the internet; Business information services provided on-line from the internet; Compilation of directories for publication on the internet; Compilation of event advertisements for use on internet web pages; Compilation of directories for publishing on the internet; Rental of advertising space on the internet; Advertising and commercial information services, via the internet; Dissemination of advertising for others via an on-line communications network on the internet; Information, including such services provided on line or via the internet; Providing a searchable on-line event advertising guide featuring the goods and services of other on-line vendors on the internet; Providing an on-line commercial event information directory on the internet; Advertising services provided over the internet; Advertising space (rental of-) on the internet; Advertisement for others on the Internet; Advertising on the Internet for others.
- Class 38: Arranging access to databases on the internet; Electrical data transmission over the internet; Mail services utilising the internet; Providing access to web sites on the internet; Internet portal services; Broadcasting of video and audio over the Internet.

2) The application was examined and accepted, and subsequently published for opposition purposes on 17 April 2015 in Trade Marks Journal No.2015/016.

3) On 27 July 2016 the applicant applied under no. 3176895 to register the trade mark shown above in respect of the following services:

- Class 9: Computer software; mobile application software; computer databases; downloadable publications; all the aforesaid goods relating to the field of event design, planning, organizing and management, and price comparisons.

- Class 35: Operating online marketplaces and trading services for sellers and buyers of goods and services to post products or services to be offered for sale and purchased via a computer network; provision of information relating to evaluative feedback and ratings of sellers, goods and services; provision of online price comparison services; exhibitions for business purposes; collating of data in computer databases; information, consultancy and advisory services all relating to the aforesaid services; all the aforesaid services in the field of event design, planning, organizing and management.
- Class 38: Online platform communication relating to quotation and invoicing between the host and supplier in the field of event design, planning, organising and management; information, consultancy and advisory services relating to all the aforesaid services.
- Class 41: Entertainment services; special event planning; organization of entertainment events; organization of cultural events; information, consultancy and advisory services relating to all the aforesaid services.

4) The application was examined and accepted, and subsequently published for opposition purposes on 11 November 2016 in Trade Marks Journal No. 2016/046.

5) On 17 July 2015 O2 Holdings Limited filed a notice of opposition to application 3101542. On 10 June 2016 the earlier rights relied upon were assigned to O2 Worldwide Limited (hereinafter the opponent) and a request was made to substitute the opponent company with all necessary undertakings being provided. On 9 March 2017 the opponent filed a notice of opposition to application 3176895. The grounds of opposition in both cases are identical and are that the opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing and registration	Registered for goods and services in classes
GENIE	UK 2587310	11.07.11 02.12.11	9, 35, 36, 37, 38, 39, 41, 42, 43, 44 & 45
GENIE	EU 10113009	11.07.11 17.10.12	9, 35, 36, 37, 38, 39, 41, 42, 43, 44 & 45

a) The opponent contends that its marks and the mark applied for are very similar and that the services applied for are similar to the services for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

6) On 30 September 2015 the parties entered in a cooling off period trying to negotiate a settlement. On 25 October 2016 the applicant filed a counterstatement in respect of application 3101542, and on 22 May 2017 in respect of application 3176895, basically denying that the marks are similar and requesting precise details of the goods and services which the opponent believes are similar to those sought to be registered as no such details were provided by the opponent in its statement of grounds.

7) Only the applicant filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Both sides provided written submissions which I shall refer to as and when necessary in my decision.

APPLICANT’S EVIDENCE

8) The applicant filed a witness statement, dated 30 March 2017, by Sara Jane Leno the applicant’s Trade Mark Attorney. She points out that there are 344 other registered marks which include the word GENIE in the classes for which the opponent’s mark is registered. At exhibit SJL1 she provides a search for the term GENIE upon BING which shows 12 million entries found. At exhibit SJL2 she provides instances of companies using the term GENIE as a trade mark. This search was carried out on 13 March 2017 (after the relevant date). At exhibit SJL3 she provides copies of pages from the applicant’s website showing it using the term GENIE in respect of a SIM card and in respect of advertising services.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

10) The only ground of opposition is under section 5(2)(b) which 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.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

12) The opponent is relying upon its trade marks listed in paragraph 5 above which are clearly earlier trade marks. Given the interplay between the dates that the opponent’s marks were registered (2 December 2011 and 17 October 2012) and the dates that the applicant’s mark were published (17 April 2015 and 11 November 2016), the proof of use requirements do not bite.

13) When considering the issue under section 5(2)(b) I take into account the following principles which 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 will 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 and the nature of the purchasing decision

14) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. 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.”

15) The specifications of the two parties cover a wide variety of goods and services. These will be purchased by members of the general public including businesses. For the most part such goods and services are likely, in my opinion, to be selected mainly by visual means, initially from an on-line search or advertisement, or possibly through a catalogue or brochure. Once selected, even if the transaction is carried out on-line the average consumer is going to take a reasonable degree of care in the selection as in the case of the class 9 goods they will have to be compatible with hardware already owned or, in the case of the services will involve detailing business or personal requirements. Whilst the visual issues are likely to be the most important I also must take into account aural issues as it is possible that word of mouth recommendations may play a part in the selection. The nature of the goods and services are such that the average consumer will pay **a medium degree of attention to their selection.**

Comparison of goods and services

16) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

17) 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

18) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

19) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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

20) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

21) In its written submissions the opponent clarified, to a limited degree, what goods and services it considered to be identical and/or similar to the goods and services applied for. I start with the applicant’s goods in class 9.

Applicant’s goods	Opponent’s goods and services
Class 9: Computer software; mobile application software; computer databases; downloadable publications; all the	Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending

aforesaid goods relating to the field of event design, planning, organizing and management, and price comparisons.	machines and mechanisms for coin operated apparatus; cash registers; data processing equipment; fire-extinguishing apparatus; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; PDAs (Personal Digital Assistants), mobile telephones; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; SD-Cards (secure digital cards); glasses, spectacle glasses, sunglasses, protective glasses and cases therefor; contact lenses; cameras; camera lenses; MP3 players; audio tapes, audio cassettes, audio discs; audio-video tapes, audio-video cassettes, audio-video discs; video tapes, video cassettes, video discs; CDs, DVDs; electronic publications (downloadable); mouse mats; magnets; mobile telephone covers, mobile telephone cases; magnetic cards; encoded cards; parts and fittings for all the aforesaid goods.
--	---

22) In its written submissions the opponent contends:

“In relation to the Applicant’s specification, the Opponent has identical or highly similar goods and services. For example, in relation to the computer software related goods the Opponent submits these are identical, if not very similar to the Opponent’s “data processing equipment” and “apparatus for recording, transmission or reproduction of sound or images;”. This is supported in decision on Opposition No. B2033382 *Robinson Club GmbH v Astrid Van Damme* whereby it is stated:

“By the same token the contested animated cartoons; downloadable image files; downloadable music files, which are also recorded content, are also similar to the opponent’s data-processing equipment and computers.”

This is again supported by the decision on Opposition No. B2050386 *Banco Bilbao v Blu Holdings Limited* whereby the Office stated:

“The contested data processing equipment and computers are considered to be similar to the earlier computer programs relating to banking and downloadable electronic publications of Community trade mark No 9707779. Data processing equipment is apparatus which performs a sequence of operations on data in order to extract information, re-order files etc. Computers are electronic devices that process data according to a set of instructions. A computer program is a set of coded instructions that enables a machine, especially a computer, to perform a desired sequence of operations. In the present case, the opponent's computer program covers the fields of banking and downloadable electronic

publications. These goods can be considered as being complementary to each other in the sense that the contested data processing equipment and computers need programs to operate, and particularly computer programs relating to banking and downloadable electronic publications are necessary to connect devices that can be used for electronic payments. Furthermore, they also share the same end users, distribution channels, sales outlets and commercial origin.”

The opponent further submits:

The Opponent also refers to Decision on Opposition No. B2052879 *Technolas Perfect Vision GmbH v El Corte Inglés* whereby it is stated:

“Apparatus for recording of sound or images in the application are similar to the opponent’s computer software. The goods at issue can coincide in the producer, end user and distribution channels. Furthermore, they are complementary. In relation to the applicant’s apparatus for transmission or reproduction of sound or images and data processing equipment, these goods and the opponent’s computer software can coincide in the end user and in the distribution channels. Furthermore, they are complementary to each other in the sense that the contested goods may need the goods of the opponent to operate. Therefore, these goods are similar. Magnetic data carriers, recording discs; compact discs, dvds and other digital recording media in the application are similar to the opponent’s computer software in Class 9. The goods at issue can coincide in the end user and the distribution channels. ”

And:

Therefore, it is clear that the Applicant's full specification is identical, if not highly similar to a number of goods in the Opponent’s specification, including, “*apparatus for transmission or reproduction of sound or images; data processing equipment; Magnetic data carriers, recording discs; compact discs, dvds*”. It is also clear that the Applicant’s goods in class 9 are highly similar to the Opponent’s “*telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; PDAs (Personal Digital Assistants), mobile telephones, telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus;*”. This is particularly because the software covered in Class 9 could be used on mobile telecommunication devices. This is supported by Decision on Opposition No. B1818726 *SMS GmbH vs Simage Technologies* where it is stated:

“The contested mobile telephones; mobile telephone apparatus; telecommunications apparatus to enable connection to databases and the internet are devices for making telephone calls for either voice or data communication. As such they have points of contact with the earlier right’s computer programs (recorded); computer programs (downloadable); data-processing equipment and computers. This is because current mobile telephones and telecommunications apparatus are often multi-functional electronic devices just like computers. Furthermore they also run software, just like computers. Computers may also be used to replace them, for example a handheld computer with voice over ip software. Consequently these goods are considered to be similar.”

Further, the Applicant’s “computer databases” are also highly similar to the Opponent’s data processing apparatus and equipment. This is because computer databases are a tool to process data and store data and therefore, are highly complementary to the Opponent’s data processing apparatus and equipment.”

23) The opponent’s contentions are flawed in that whilst I accept that in certain cases the circumstances of that particular case may dictate that goods are considered identical and/or similar this does not mean that one simply applies the finding to all future cases irrespective of the circumstances. The applicant’s goods are restricted to various aspects of “events” which to my mind does not equate to “apparatus for recording, transmission or reproduction of sound or images”. I also note that apparatus for recording sound and images does not require computer software (e.g. the box brownie or wax cylinder). From certain of the other cases quoted by the opponent it would appear that they would like any equipment which may have computer software upon it to be regarded as similar to the goods of the applicant; in which case a CNC lathe, an aircraft or submarine might be regarded as similar or complementary to computer software a scenario which is simply absurd. The opponent has singularly failed in its requirement to provide reasons why, in the instant case, the goods and services should be regarded as similar or complementary. All it has done is make assertions that they are similar/complementary etc. I note that in *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case

C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

24) Thus where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar. As shown below certain goods and services in the applicant’s specification are encompassed to the following terms of the opponent’s specification and must be regarded as identical, notwithstanding the restriction included in the applicant’s specification as the opponent’s goods are unrestricted. Other goods are not so encompassed.

Applicant’s goods in Class 9:	Opponent’s goods and services in Class 9:	
computer databases;	data processing equipment;	Identical
mobile application software;	drivers software for telecommunications networks and for telecommunications apparatus;	Identical
downloadable publications	electronic publications (downloadable);	Identical
Computer software;	Whole of the class 9 specification.	Not similar
all the aforesaid goods relating to the field of event design, planning, organizing and management, and price comparisons.		

25) Moving onto the class 35 services of both parties the opponent makes the following submissions:

“In relation to the Applicant’s online market places and trading services, these are all online retail services. Therefore these are identical to the Opponent’s retail services covered by their earlier rights. In relation to the provision of information relating to evaluative feedback etc., exhibitions for business purposes, collating of data into computer databases, these are all a subset of business management and business administration. The provision of information relating to business statistics is an administrative task under the term business administration and therefore these terms are identical. In relation to the advertising terms, these are all a subset of the Opponents advertising services and therefore, are identical. Further, the narrower business

administration and business information services again are a subset of business management, business administration and office functions. Therefore, the entirety of the Applicant's class 35 specification is identical or similar to the Opponent's earlier coverage."

26) There are minor differences between the specifications of the opponent's two marks in this class, with additional wording in mark UK 2587310. However, these additional terms do not make any difference to the comparison test.

27) The term "advertising" in the opponent's specifications encompasses the following terms in the applicant's specification "Advertising events via electronic media and specifically the internet; Dissemination of advertising for others via the internet; Providing and rental of advertising space on the internet for client events; Advertising services provided via the internet; Rental of advertising space on the internet; Advertising and commercial information services, via the internet; Dissemination of advertising for others via an on-line communications network on the internet; Compilation of event advertisements for use on internet web pages; Providing a searchable on-line event advertising guide featuring the goods and services of other on-line vendors on the internet; Advertising services provided over the internet; Advertising space (rental of-) on the internet; Advertisement for others on the Internet; Advertising on the Internet for others" and these services must be regarded as identical.

28) Similarly the term "Business administration" in the opponent's specifications encompasses the following term in the applicant's class 35 services "Business administration services for processing sales made on the internet" and must be regarded as identical.

29) To my mind, the following terms in the applicant's class 35 specification "Business information services provided on-line from a computer database or the internet; Business information services provided on-line from the internet; provision of information relating to evaluative feedback and ratings of sellers, goods and services; provision of online price comparison services; information, consultancy and advisory services all relating to the aforesaid services;" are fully encompassed within the opponent's specification of "information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network;" and must therefore be regarded as identical.

30) The same is true of the applicant's services "Compilation of directories for publication on the internet; Compilation of directories for publishing on the internet; Information, including such services provided on line or via the internet; Providing an on-line commercial event information directory on the internet; collating of data in computer databases;" and the opponent's class 35 services of "information and advisory services relating to the aforesaid services provided over a telecommunications network;" which are again, identical.

31) Similarly, the applicant's terms "Operating online marketplaces and trading services for sellers and buyers of goods and services to post products or services to be offered for sale and purchased via a computer network;" are encompassed by the opponent's "retail services and online retail services connected with scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash registers, **calculating machines**, data processing equipment **and computers**, fire-extinguishing apparatus, apparatus for the transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, **computer hardware, computer software, computer software downloadable from the Internet**, PDAs (Personal Digital Assistants), **pocket PCs**, mobile telephones, **laptop computers**, telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, protective clothing, protective helmets, **computer software recorded onto CD Rom**, SD-Cards (secure digital cards), glasses, spectacle glasses, sunglasses, protective glasses and cases therefor, contact lenses, cameras, camera lenses, MP3 players, audio tapes, audio cassettes, audio discs, audio-video tapes, audio-video cassettes, audio-video discs, video tapes, video cassettes, video discs, CDs, DVDs, electronic publications (downloadable), mouse mats, magnets, mobile telephone covers, mobile telephone cases, magnetic cards, encoded cards; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet".

32) This leaves the term "exhibitions for business purposes" in the applicant's specification which I do not accept is similar to any of the opponent's specification and the opponent has provided no reasons why they should be regarded as similar to any of its specification.

33) I next turn to the class 38 services. The opponent merely states “The entirety of the Applicant’s specification is identical to the Opponent’s telecommunications services”. The opponent’s specifications for its two marks are identical, other than the terms in bold which only appear in UK 2587310. To my mind the following terms of the two parties are identical:

Applicant’s Class 38 services	Opponent’s class 38 services
Arranging access to databases on the internet;	Internet access services;
Electrical data transmission over the internet;	communications services for accessing a database, leasing of access time to a computer database; providing access to computer databases;
Mail services utilising the internet;	email and text messaging services;
Providing access to web sites on the internet;	Internet access services;
Internet portal services;	Internet portal services;
Broadcasting of video and audio over the Internet.	broadcasting services; television broadcasting services; broadcasting services relating to internet protocol TV; provision of access to Internet protocol TV; Internet access services;
Online platform communication relating to quotation and invoicing between the host and supplier in the field of event design, planning, organising and management; information, consultancy and advisory services relating to all the aforesaid services.	Internet access services; email and text messaging services; information services provided by means of telecommunication networks relating to telecommunications;

34) Lastly I turn to the class 41 services of the two parties. The opponent contends “Again, the Opponent has identical coverage to the entirety of the Applicant’s class 41 specification. The Applicant’s specification in class 41 is identical to the entertainment services provided by the Opponent and the information and advisory services provided thereto”. To my mind the following terms of the two parties’ specifications are identical:

Entertainment services;	entertainment;
special event planning	entertainment; sporting and cultural activities;
organization of entertainment events;	entertainment;
organization of cultural events;	cultural activities;

information, consultancy and advisory services relating to all the aforesaid services.	information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.
--	---

35) In conclusion, the specifications of the two marks applied for are identical to the opponent's specifications for its registered marks with the exception of the following goods and services which appear only in the specification of application 3176895:

- In Class 9: Computer software; all the aforesaid goods relating to the field of event design, planning, organizing and management, and price comparisons.
- In Class 35: Exhibitions for business purposes.

Comparison of trade marks

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

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

37) It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. Both parties have two identical marks. Therefore, only one comparison test is required. In carrying out this

comparison test I take into account the comments in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), where Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:


“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

38) The trade marks to be compared are:

Opponents' trade mark	Applicant's trade mark
<p>GENIE</p>	

39) The opponent contends:

“In relation to the goods and services applied for by the Applicant under the mark MYEVENTGENIE “GENIE” is a distinctive mark in relation to these services. The Opponent’s GENIE trade marks are distinctive in relation to high tech goods and services, software, financial services, telecommunications, computer hardware/software etc. Therefore, when viewing the mark MYEVENTGENIE as a whole, the dominant and distinctive element is the element GENIE, and would be instantly recognisable to the average consumer as being the trade mark of O2 Worldwide Limited.”

40) I will deal with the issue of the distinctiveness of the opponent’s mark later in this decision. The opponent contends that the words “MYEVENT” would be seen as descriptive as a number of the services applied for are in relation to entertainment and /or events. Whilst I accept that some of the goods and services relate to entertainment issues not all of the goods and services applied for fall within this category. Even for those that do, I do not accept that the average consumer will immediately view the words as descriptive, and therefore regard the word “GENIE” as the dominant element. The opponent also contends:

“We submit that the average consumer would merely see the lamp element as being a decorative as a stylisation of the letter i. Particularly as the lid is depicted as a star which looks like the top dot of the i. They would not see this element as an indication of origin, simply as a decorative addition.”

41) This is a highly simplistic view. The device of a lamp with the star above it is quite pronounced and would certainly not be overlooked by the average consumer. It is an integral part of the mark and I do not accept that it would be seen as merely a decorative addition.

42) The opponent also contends:

“In relation to the “my” element, this is presented in an italicised font, which is not in bold like the remainder of the mark and looks like a less dominant element. This simply looks to the average consumer that this is a personalised service, and they would not focus too heavily on the “my” element. In relation to the “event” element, this is in the same size and font as GENIE. Whilst it is prior to the GENIE element, “event” is entirely descriptive in relation to entertainment and event services which form the entirety of the Applicant’s class 41 application under Application No.3176895. In relation to the remaining services in classes 9, 35, 38, these types of services cover advertising, computer software, downloadable publications which all cover entertainment as a subject matter – for example the computer software term covers computer software for entertainment purposes, or advertising of entertainment services. Therefore, the average consumer would see the “event” element as totally descriptive. Therefore, the distinctive and dominant element of the Applicant’s mark is the GENIE element. It is also capitalised which makes it stand out further, particularly with the decorative italicised i. Therefore, given that both marks coincide with the element GENIE, it must be found that the marks are highly similar. None of the other elements in the Applicant’s mark are particularly distinctive in relation to the goods and services applied for, as identified above. It would be the GENIE element that they would remember as the Opponent’s GENIE mark is entirely reproduced within the mark and therefore the subject application should be refused.”

43) I have dealt with a number of these contentions already. The mere fact that some of the goods and services, but by no means all, deal with entertainment services does not, in my view, automatically equate in the average consumer’s mind that the words “MY EVENT” should be simply passed over as descriptive. I also note that the word “EVENT” is in capitals and the word GENIE has an italicised letter “I” which has a lamp and star above it.

44) Visually there is a degree of similarity in that both parties’ marks have the word “GENIE” within them, although the mark in suit has the word “my” in italics, the word “EVENT” in capitals and differs in the “GENIE” element as it has the letter “I” in italics and has a lamp and star above the letter “I”. There are substantial visual differences which more than outweigh the similarities.

45) Aurally, it is clear that the last two syllables (out of five) in the mark in suit are identical to the opponent’s mark. Clearly, the device element will not be verbalised. However, there are substantial aural differences which, coming at the start of the mark as they do, to my mind, more than outweigh the similarities.

46) Conceptually, I accept that most consumers in the UK will be aware of the meaning of the word “GENIE” as “a spirit, often appearing in human form, but when summoned by a person carries out the wishes of the summoner”. The words “MY EVENT” in front of the word “GENIE” personalise the mark and provide the notion that the provider will act as your personal “Genie” in respect of the event you are holding/attending/watching. However, the wording used in the marks in suit do not form a unit in such a way as to override the independent distinctive role that the word GENIE has within the mark. The conceptual message is therefore very similar. **Overall the marks are similar to a very low degree.**

Distinctive character of the earlier trade mark

47) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

48) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of

confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

49) The opponent’s marks consist of the word “GENIE”, a standard English word with a well-known meaning, which has no descriptive meaning in relation to the goods and services for which it is registered. **Overall the opponent’s mark is inherently distinctive to a medium degree. The opponent has not shown use of its mark and so it cannot benefit from any enhanced distinctiveness.**

Likelihood of confusion

50) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade marks as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the services is a member of the general public including businesses who will select the goods and services by predominantly visual means, although I do not discount aural considerations, and that they are likely to pay a medium degree of attention to the selection of such goods and services.
- the opponent's mark is inherently distinctive to a medium degree. The opponent has not shown use of its mark and so it cannot benefit from any enhanced distinctiveness.
- the specifications of the two marks applied for are identical to the opponent's specifications for its registered marks with the exception of the following goods and services which appear only in the specification of application 3176895:

In Class 9: Computer software; all the aforesaid goods relating to the field of event design, planning, organizing and management, and price comparisons.

In Class 35: Exhibitions for business purposes.

- Overall the marks are similar to a very low degree.

51) In view of all of the above, and allowing for the concept of imperfect recollection, in respect of both of the opponent's marks there is a likelihood of consumers being confused into believing that the goods and services which I have found to be identical and/or similar as applied for under the marks in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in relation to such goods and services. It fails for those goods and services which I have found to be not similar to the opponent's goods and services.**

CONCLUSION

52) The opposition in relation to the following goods and services has succeeded.

Application 3101542:

- Class 35: Advertising events via electronic media and specifically the internet; Dissemination of advertising for others via the internet; Providing and rental of advertising space on the internet for client events; Advertising services provided via the internet; Business administration services for processing sales made on the internet; Business information services provided on-line from a computer database or the internet; Business information services provided on-line from the internet; Compilation of directories for publication on the internet; Compilation of event advertisements for use on internet web pages; Compilation of directories for publishing on the internet; Rental of advertising space on the internet; Advertising and commercial information services, via the internet; Dissemination of advertising for others via an on-line communications network on the internet; Information, including such services provided on line or via the internet; Providing a searchable on- line event advertising guide featuring the goods and services of other on-line vendors on the internet; Providing an on-line commercial event information directory on the internet; Advertising services provided over the internet; Advertising space (rental of-) on the internet; Advertisement for others on the Internet; Advertising on the Internet for others.
- Class 38: Arranging access to databases on the internet; Electrical data transmission over the internet; Mail services utilising the internet; Providing access to web sites on the internet; Internet portal services; Broadcasting of video and audio over the Internet.

Application 3176895

- Class 9: mobile application software; computer databases; downloadable publications; all the aforesaid goods relating to the field of event design, planning, organizing and management, and price comparisons.
- Class 35: Operating online marketplaces and trading services for sellers and buyers of goods and services to post products or services to be offered for sale and purchased via a computer network; provision of information relating to evaluative feedback and ratings of sellers, goods and services; provision of online price comparison services; collating of data in computer databases; information, consultancy and advisory services all relating to the aforesaid services; all the aforesaid services in the field of event design, planning, organizing and management.

- Class 38: Online platform communication relating to quotation and invoicing between the host and supplier in the field of event design, planning, organising and management; information, consultancy and advisory services relating to all the aforesaid services.
- Class 41: Entertainment services; special event planning; organization of entertainment events; organization of cultural events; information, consultancy and advisory services relating to all the aforesaid services.

53) The mark will be registered for the following goods and services applied for by the applicant.

In Class 9: Computer software; all the aforesaid goods relating to the field of event design, planning, organizing and management, and price comparisons.

In Class 35: Exhibitions for business purposes.

COSTS

54) As the opponent has been largely successful it is entitled to a contribution towards its costs.

Preparing statements and considering the other side's statements	£400
Expenses	£400
Submissions	£200
TOTAL	£1000

55) I order My Event Genie Ltd to pay O2 Worldwide Limited the sum of £1,000. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of February 2018

George W Salthouse
For the Registrar,
the Comptroller-General