

O/155/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 234 478: THE BALLER  
NETWORK IN CLASSES 09, 16, 25, 35, 36, 41 AND 44 BY PROSPECT IF LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 410 204 BY HOME  
BOX OFFICE, INC

## Background and pleadings

1. Prospect If Limited (the applicant) applied to register the trade mark No 3 234 478: THE BALLER NETWORK in the UK on 31<sup>st</sup> May 2017. It was accepted and published in the Trade Marks Journal on 9<sup>th</sup> June 2017 in respect of the following goods and services:

Class 09:

*Mobile apps; downloadable mobile coupons; application software; downloadable multimedia files; downloadable publications; downloadable computer graphics; electronic publications.*

Class 16:

*Vouchers; coupons; gift vouchers; trading vouchers; vouchers of value; gift certificates; loyalty cards; postcards; stationery; information leaflets; catalogues; periodicals; magazines; newsletters; brochures; pamphlets; promotional material; stationery; calendars; books; diaries.*

Class 25:

*Clothing, footwear, headgear.*

Class 35:

*Advertising; marketing services; promotional services; organisation, operation and supervision of sales and promotional incentive schemes; management of sales and promotional programmes relating to the awarding of points; reward schemes relating to the redemption of allocated promotional schemes for the benefit of members of the award scheme; arranging online sales campaigns for business and advertising purposes for others; planning and management of marketing, promoting or advertising the goods and services of others;*

*organisation of competitions for advertising and business purposes; providing space on websites for advertising and promotional purposes for others; arranging commercial transactions for others, via online shops; management of computer databases; providing a searchable online advertising guide featuring the goods and services of vendors; promoting the goods and services of others by providing a website featuring coupons, contact details, product reviews and links to the retail websites of others; search engine marketing services; real estate advertising; information and advice in relation to the aforementioned services.*

Class 36:

*Issuing of gift vouchers; issuing of gift certificates; issuing of vouchers in relation to incentive schemes; issuing of points and tokens of value; financial services, namely, enabling transfer of funds and purchase of products and services offered by others, all via electronic communication networks; providing a wide variety of payment and financial services, namely credit card services, issuing credit cards and lines of credit, processing and transmission of bills and payments thereof and payment services; real estate brokerage.*

Class 41:

*Entertainment services; leisure services; arranging of sporting activities; cultural activities; arranging of leisure activities; arranging of cultural activities; arrangement of entertainment events and/or activities; exhibition and conference services; arranging track days and advanced driving instruction for drivers of motor cars; ticket services for entertainment, sporting, and cultural events.*

Class 44<sup>1</sup>:

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<sup>1</sup> Class 44 is not opposed.

*Arranging health spa services for health and wellness of the body and spirit incorporating massage, facial and body treatment services, and cosmetic body care services; arranging the provision of hairdressing services; arranging the provision of beauty services; arranging the provision of personal training, health and fitness services; arranging health care relating to therapeutic massage; arranging make-up consultation and application services.*

2. Home Box Office, Inc (the opponent) partially oppose the trade mark on the basis of Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the Trade Marks Act 1994 (the Act). This former two grounds are on the basis of the following earlier trade marks:

- a) European Union (formerly Community) Trade Mark No 1 271 1065: BALLERS. The following goods and services are relied upon in this opposition:

Class 21:

*Mugs, drinking glasses, glass beverage ware, shot glasses; bar ware, namely, bottle openers, cocktail shakers, decanters, wine buckets, wine openers, coolers for wine, coasters not of paper and other than table linen; and sports bottles sold empty.*

Class 25:

*Clothing, namely, tank tops, t-shirts, hooded pullovers, and hooded sweat shirts; sleepwear; robes; socks; headwear, namely, caps; footwear; Halloween and masquerade costumes.*

Class 41:

*Entertainment services in the nature of an ongoing television series featuring both drama and comedy, excluding children's entertainment; interactive online entertainment in the nature of a website containing photographic, video and prose presentations and related video clips from or related to a television series featuring both drama and comedy, excluding children's entertainment.*

- b) European Union (formerly Community) Trade Mark No 1 283 8868:  
BALLERS. The following goods and services are relied upon in this  
opposition:

Class 09:

*Pre-recorded DVDs and high definition digital discs featuring a television series including both drama and comedy, excluding children's entertainment; pre-recorded video clips, video shorts and promotional spots on CDs, video tapes and DVDs featuring content from or related to a television series including both drama and comedy, excluding children's entertainment; digital materials, namely, downloadable pre-recorded video files and graphics files related to an ongoing television series featuring both drama and comedy, excluding children's entertainment; mouse pads; prerecorded audio soundtracks on CDs featuring content from or relating to a television series, excluding children's entertainment; downloadable virtual goods in the nature of clothing, athletic equipment, weapons, ammunition, vehicles, real estate, food and beverages for use in virtual environments and social networking sites created for entertainment purposes, excluding children's entertainment.*

Class 14:

*Jewelry; clocks and watches; trinkets in the nature of jewelry charms and rings of precious metals, semi-precious metals or imitation precious metals.*

Class 16:

*Printed matter and paper goods, namely, calendars, posters, blank journals, notebooks; pens, pencils; and stationery.*

3. Under Section 5(2)(b), the opponent opposes classes 09, 16, 25, 35, 36<sup>2</sup> and 41 of the trade mark applied for. In this regard, it argues that the respective goods and services are identical or similar and that the marks are similar.
4. Under Section 5(3), the opponent opposes the same classes as under Section 5(2)(b). It argues that its earlier trade marks enjoy a reputation in the UK and that use of the later trade mark would lead the public to believe there is an economic connection between this and the earlier trade marks. Further, that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier marks. The opponent also claims that the later use will be out of its control and that poor quality or offensive goods will cause detriment to its valuable reputation and business. It claims that use of the later mark will dilute the distinctive character and reputation of its marks. Finally, the opponent claims that there is no due cause for adoption of the opposed mark.
5. Under Section 5(4)(a), the claim is made on the basis of its alleged earlier rights in BALLERS. It claims to have been selling the following goods and services under this sign since 08<sup>th</sup> September 2015:

Class 09:

*Pre-recorded DVDs and high definition digital discs featuring a television series including both drama and comedy, excluding children's entertainment; pre-recorded video clips, video shorts and promotional spots on CDs, video tapes and DVDs featuring content from or related to a television series including both drama and comedy, excluding children's entertainment; digital*

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<sup>2</sup> It is noted that this class is not included in the opponent's response to Q4 on the Notice of Opposition. However, it is clearly included in the accompanying statement of grounds.

*materials, namely, downloadable pre-recorded video files and graphics files related to an ongoing television series featuring both drama and comedy, excluding children's entertainment; mouse pads; prerecorded audio soundtracks on CDs featuring content from or relating to a television series, excluding children's entertainment; downloadable virtual goods in the nature of clothing, athletic equipment, weapons, ammunition, vehicles, real estate, food and beverages for use in virtual environments and social networking sites created for entertainment purposes, excluding children's entertainment.*

Class 14:

*Jewelry; clocks and watches; trinkets in the nature of jewelry charms and rings of precious metals, semi-precious metals or imitation precious metals.*

Class 16:

*Printed matter and paper goods, namely, calendars, posters, blank journals, notebooks; pens, pencils; and stationery.*

Class 21:

*Mugs, drinking glasses, glass beverage ware, shot glasses; bar ware, namely, bottle openers, cocktail shakers, decanters, wine buckets, wine openers, coolers for wine, coasters not of paper and other than table linen; and sports bottles sold empty.*

Class 25:

*Clothing, namely, tank tops, t-shirts, hooded pullovers, and hooded sweat shirts; sleepwear; robes; socks; headwear, namely, caps; footwear; Halloween and masquerade costumes.*

Class 41:

*Entertainment services in the nature of an ongoing television series featuring both drama and comedy, excluding children's entertainment; interactive online entertainment in the nature of a website containing photographic, video and*

*prose presentations and related video clips from or related to a television series featuring both drama and comedy, excluding children's entertainment.*

6. The opponent has therefore acquired goodwill under the sign BALLERS. Use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.
7. The applicant filed a counterstatement denying the claims made.
8. Both sides filed evidence. This will be summarised to the extent that it is considered appropriate.
9. A Hearing took place on 23<sup>rd</sup> January 2019, with the opponent represented by Mr Jonathan Moss of Counsel, instructed by Joshi Worldwide IP Limited and the applicant by Professor Phillip Johnson of Counsel.

## **Evidence**

### Opponent's evidence

10. This is a witness statement, dated 5<sup>th</sup> March 2018, from Ms Judy McCool, Senior Vice President, Legal Affairs of the opponent. Ms McCool explains that the opponent operates the world's most successful premium pay television channel and provider of entertainment services. Its programming is licensed in over 150 countries worldwide, including the UK and is also sold in digital and physical formats.
11. Since at least as early as June 2015, the opponent and its licensees have marketed, broadcast and distributed BALLERS, a tv show about a retired American Football superstar trying to reinvent himself as a financial manager for current American football players in Miami. To date three seasons of the Series have been aired (30 episodes in total) with a fourth season to come.



12. In the UK, the series airs on Sky Atlantic. Sky has, according to Ms McCool, marketed each season of the series through its digital and social platforms. It is also available to purchase through DVD, Blu-ray and electronic sell through. Exhibit JM-2 contains representative samples of advertising used in the UK by Sky for the BALLERS tv show as well as screen shots for online purchasing options for BALLERS Series DVDs.

13. Additionally, the opponent uses the internet and social media to promote the series, including on Facebook and Twitter. Exhibit JM-3 are representative samples of these websites and social media pages. Exhibit JM-4 are examples of press coverage of the series. It is noted that these include numerous national newspapers in the UK, such as The Guardian and The Telegraph.

### Applicant's Evidence

14. This is a witness statement of Ms Eileen McKendry-Gray. It is undated. Ms McKendry-Gray is the in-house Group General Counsel of the applicant. She attaches to the witness statement two exhibits. The first, Exhibit 1, is an article from a website [www.cable.co.uk](http://www.cable.co.uk), dated May 2018. It describes the process by which members of the public access Sky Atlantic, the channel which airs the Ballers tv show. This is done via subscription through Sky or Now TV, Sky's streaming company. Exhibit 2 is a print out from an internet page showing the Broadcasters' Audience Research Board report of 8<sup>th</sup> January 2018 which shows that the number of UK households who watch Sky as a whole was 8.83 million in quarter 4 of 2017, whereas 18.65 million UK households watched terrestrial television in the same period.

## Opponent's evidence-in-reply

15. This is a further witness statement, dated 3<sup>rd</sup> July 2018, from Ms Judy McCool. The following relevant information is contained therein:

- a) Exhibit JM-8 provides viewing figures of Seasons 1-3 of the Ballers TV show. It is noted that the cumulative figures for Season 1 was 374,000; Season 2 was 282,000 and Season 3 was 230,000.
- b) Exhibits JM-9 - 11 provides examples of advertising in relation to the Ballers tv show on Sky's websites, including the Now TV website.
- c) Exhibits JM12-13 provide examples of how customers can purchase the tv show via DVDs, Blu-rays and digital downloads via retailers such as Amazon prime and Store-HMV. It is noted that no sales figures are provided.

## Conclusions on the evidence

16. It is clear from the evidence filed that the Ballers tv show has been broadcast in the UK. Mr Johnson on behalf of the applicant accepted that at the Hearing and also accepted that this established goodwill. However, whether the use shown is enough to demonstrate a reputation will be considered further below.

## **DECISION**

### **Section 5(2)(b) – Likelihood of Confusion**

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

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

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

## **Comparison of goods and services**

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. In the judgment of the Court of Justice of the European Union 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”.

20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. The earlier goods and services are:

a) European Union (formerly Community) Trade Mark No 1 271 1065:

Class 21:

*Mugs, drinking glasses, glass beverage ware, shot glasses; bar ware, namely, bottle openers, cocktail shakers, decanters, wine buckets, wine openers, coolers for wine, coasters not of paper and other than table linen; and sports bottles sold empty.*

Class 25:

*Clothing, namely, tank tops, t-shirts, hooded pullovers, and hooded sweat shirts; sleepwear; robes; socks; headwear, namely, caps; footwear; Halloween and masquerade costumes.*

Class 41:

*Entertainment services in the nature of an ongoing television series featuring both drama and comedy, excluding children's entertainment; interactive online entertainment in the nature of a website containing photographic, video and prose presentations and related video clips from or related to a television series featuring both drama and comedy, excluding children's entertainment.*

b) European Union (formerly Community) Trade Mark No 1 283 8868:

Class 09:

*Pre-recorded DVDs and high definition digital discs featuring a television series including both drama and comedy, excluding children's entertainment; pre-recorded video clips, video shorts and promotional spots on CDs, video tapes and DVDs featuring content from or related to a television series including both drama and comedy, excluding children's entertainment; digital materials, namely, downloadable pre-recorded video files and graphics files related to an ongoing television series featuring both drama and comedy, excluding children's entertainment; mouse pads; prerecorded audio soundtracks on CDs featuring content from or relating to a television series, excluding children's entertainment; downloadable virtual goods in the nature of clothing, athletic equipment, weapons, ammunition, vehicles, real estate, food and beverages for use in virtual environments and social networking sites created for entertainment purposes, excluding children's entertainment.*

Class 14:

*Jewelry; clocks and watches; trinkets in the nature of jewelry charms and rings of precious metals, semi-precious metals or imitation precious metals.*

Class 16:

*Printed matter and paper goods, namely, calendars, posters, blank journals, notebooks; pens, pencils; and stationery.*

22. The later goods and services are:

Class 09:

*Mobile apps; downloadable mobile coupons; application software; downloadable multimedia files; downloadable publications; downloadable computer graphics; electronic publications.*

Class 16:

*Vouchers; coupons; gift vouchers; trading vouchers; vouchers of value; gift certificates; loyalty cards; postcards; stationery; information leaflets; catalogues; periodicals; magazines; newsletters; brochures; pamphlets; promotional material; stationery; calendars; books; diaries.*

Class 25:

*Clothing, footwear, headgear.*

Class 35:

*Advertising; marketing services; promotional services; organisation, operation and supervision of sales and promotional incentive schemes; management of sales and promotional programmes relating to the awarding of points; reward schemes relating to the redemption of allocated promotional schemes for the benefit of members of the award scheme; arranging online sales campaigns for business and advertising purposes for others; planning and management of marketing, promoting or advertising the goods and services of others; organisation of competitions for advertising and business purposes; providing space on websites for advertising and promotional purposes for others; arranging commercial transactions for others, via online shops; management of computer databases; providing a searchable online advertising guide featuring the goods and services of vendors; promoting the goods and services of others by providing a website featuring coupons, contact details,*

*product reviews and links to the retail websites of others; search engine marketing services; real estate advertising; information and advice in relation to the aforementioned services.*

Class 36:

*Issuing of gift vouchers; issuing of gift certificates; issuing of vouchers in relation to incentive schemes; issuing of points and tokens of value; financial services, namely, enabling transfer of funds and purchase of products and services offered by others, all via electronic communication networks; providing a wide variety of payment and financial services, namely credit card services, issuing credit cards and lines of credit, processing and transmission of bills and payments thereof and payment services; real estate brokerage.*

Class 41:

*Entertainment services; leisure services; arranging of sporting activities; cultural activities; arranging of leisure activities; arranging of cultural activities; arrangement of entertainment events and/or activities; exhibition and conference services; arranging track days and advanced driving instruction for drivers of motor cars; ticket services for entertainment, sporting, and cultural events.*

Comparison of goods in Class 09:

23. The applicant has conceded that *downloadable multimedia files* is identical to the earlier terms of the opponent.

24. As regards the contested *downloadable computer graphics*, this is similar, at least in purpose to the earlier “*downloadable virtual goods...*” This is because these are both, in effect, graphics and so they are likely to perform a highly similar function in that the user can select goods (graphics) to use in, for example, a computer game. They can be aimed at the same consumers,

namely gamers and also coincide in terms of channels of trade. They are similar to a high degree.

25. The contested term is "*application software*". Whilst it is true that some of the earlier class 09 goods will require software to work, this does not make them intrinsically similar. The opponent is again silent on the point. They are considered to be not similar. The same analysis applies to *mobile apps*. They are not similar.

26. The term *downloadable mobile coupons* are incentives for customers, usually with the purpose of saving the customer money. They have nothing in common with any of the earlier terms and are considered to be not similar.

27. The remaining terms are *downloadable publications* and *electronic publications*. It is difficult to see how these terms are similar to any of those covered by the earlier trade marks. In the absence of any argument on the point, they are not similar.

#### Comparison of goods in Class 16:

28. At the hearing, the applicant accepted that the following later terms are identical: calendars and stationery. It also accepted that postcards and diaries are similar to the earlier terms. In terms of the later *books*, it is considered that this is a broad term and can include the earlier blank journals and notebooks. They are, according to the terms in *Meric*, identical.

29. The remaining contested terms have nothing obvious in common with any of the earlier terms and the opponent has not expanded on the point. They aim to provide information, to promote or to otherwise offer incentives to customers. They are considered to be not similar to any of the earlier terms.



Comparison of goods in Class 25:

30. The later term is *clothing, footwear, headgear*. These clearly encompass the earlier goods and so, according to the terms in *Meric* are identical.

Comparison of services in Class 35:

31. These all relate to advertising and promotional services. It is not clear as to what (if anything) they have in common with any of the earlier terms. It is noted that the opponent may promote its tv show as part of the umbrella of entertainment services, but this is not the same as providing such services for others. The opponent has not advanced any reasons as to why there is any similarity. It is considered therefore that they are not similar to any of the earlier goods and services relied upon.

Comparison of services in Class 36:

32. At the hearing, Mr Johnson indicated that the opponent, in its notice of opposition, had not included Class 36 in the list of goods and services under attack. As such, there is no opposition against these terms. It is noted that Class 36 is not included in the pleadings but is in the accompanying statement of grounds. In any case, it is considered that this has no consequence as the terms in Class 36 have nothing in common with any of the earlier terms and are clearly not similar.

Comparison of services in Class 41:

33. The later trade mark includes entertainment services at large. This clearly includes the earlier services which are also types of entertainment services. According to the terms in *Meric*, they are identical.

34. It is noted that the earlier entertainment services are narrow in scope and relate specifically to a television programme. It is difficult to see how they have anything in common with any of the later contested terms, beyond a

vague coincidence in purpose in that they are all broadly speaking, for the customer's enjoyment. In particular many of the later services are in respect of the arrangement of particular activities, which set them even further apart from any of the earlier terms. The opponent has not submitted any specific arguments on the point (over and above stating they are similar) and in the absence of any persuasive argument, it is considered that they are not similar.

## **Comparison of marks**

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

36. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

37. The respective trade marks are shown below:

|                     |                      |
|---------------------|----------------------|
| BALLERS             | THE BALLER NETWORK   |
| Earlier trade marks | Contested trade mark |

38. The trade marks to be compared are all word only with no additional features. There are no stand out visually dominant features in the contested trade mark. It is considered that BALLER is the naturally most distinctive feature as its meaning is unclear and it is unusual. However, the other elements are not negligible so the correct comparison is between the marks as a whole.

39. Visually, the marks coincide in respect of BALLER and differ in respect of the additional words in the later trade mark and the pluralisation in the earlier trade marks as shown. It is true that the contested trade mark is noticeably longer in length, but the coincidental element is an unusual one. The degree of visual similarity is considered to be medium.

40. Aurally, the matter is much the same: the contested trade mark will include three additional syllables with the highly similar element articulated in the middle. There is still aural similarity though and this is pitched as being medium.

41. Conceptually, it was argued on the part of the applicant at the Hearing that the term "baller" is well known in the UK. This line of argument took several forms including that a "footballer" can be described as a "baller" and that the tv show Ballers will lead to an understanding of the term in the UK (namely a rich sportsperson).

42. There is no evidence in support of these submissions. The sole supportive material provided on the definition of “ballers” is from the Merriam-Webster online dictionary. It is considered that this material is not helpful to the applicant as two of the three entries included are clearly focussed on the United States of America. In respect of the third (and top entry), it would appear that a tool used to shape food into a ball can be called a “baller”. However, there is no other material in support of this and it is, in any case, unclear as to the position in the UK.
43. In terms of a footballer being known as a baller, there is also no evidence in support and it is considered that should a footballer be known in this manner, any evidence would have been reasonably easy to collate. In the absence of any such evidence, I reject the submission.
44. As to whether the TV show Ballers would lead to the term being known descriptively, it is noted that on the one hand the applicant has been emphatic in claiming that the viewing figures fall short of enabling the earlier trade mark to claim it has a reputation. However, on the other hand, the applicant claims that the fact the TV show has been shown in the UK inevitably leads to a widespread understanding of the term Baller as a descriptor. This appears illogical and again, there is no evidence on the point and so this submission also fails to persuade.
45. As the tone of the dictionary entries is clearly US focussed and in the absence of any other corroborative information, it is concluded that this term is not well known in the UK and as such has no clear meaning.
46. The contested trade mark likewise has no clear unified meaning. “The” will easily be understood. “Network” will be known to mean a group or system of interconnected people or things. At a push, the mark may be understood to refer to a group or system of interconnected “baller(s)”, but the meaning of baller itself remains unclear. Neither trade mark therefore has a clear meaning and so the conceptual impact in respect of these proceedings therefore is concluded to be neutral.

## **Average consumer and the purchasing act**

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

48. 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.”

49. The identical and similar goods and services are all aimed at the public at large. The purchasing process may be visual in nature (whether online or in a physical shop) and may also include word of mouth recommendations. Both visual and aural considerations are therefore important. The level of attention expected to be displayed will not be high, but will not be at the lowest either. It is considered that a reasonable degree of care and attention will be displayed.

## **Distinctive character of the earlier trade mark**

50. 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).”

51. The opponent has filed evidence in support of a claim for reputation under Section 5(3) and goodwill under Section 5(4)(a). However, it accepts BALLERS is not a famous mark. The assessment of the evidence as regards reputation and goodwill is detailed later in this decision. However, it is noted that the extent of the use shown and its scope is limited. Bearing this in mind, it is difficult to see how the use made of BALLERS has enhanced its degree of distinctive character. I will therefore assess the mark on a prima facie basis. As already stated, I have found that it is clearly not well known as a descriptive term in the UK. Rather, it is unusual. The degree of distinctiveness is therefore at least average and may indeed be above average.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

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

### *The principles*

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

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

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

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

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

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

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

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

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

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

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

53. The marks have been found to be visually and aurally similar to a medium degree. The earlier trade mark is unusual and so is considered to be distinctive to an average or even above average degree. It is comprised of one element which appears within the later trade mark (albeit as a singular version). That said, there are also additional elements present in the later trade mark which do have an impact, both visually and aurally. The degree of attention expected to be displayed during the purchasing process is also reasonable. This is important as even allowing for imperfect recollection, it is considered that the average consumer, bearing in mind the differences shown above, is unlikely to mistake one trade mark for the other. There is no likelihood of direct confusion.



54. However, this is not the end of the matter and in this regard, the following guidance is taken into account: in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

55. Ballers is an unusual word. Though the additional elements in the later trade mark have an impact, they are fairly banal in nature. The result of this is that it is the element baller that is the stand out element. It is considered that baller is memorable and it is likely to provide a hook in the mind of the average consumer. The likely consequence of this is that the consumer will likely conclude that it is another brand of the earlier trade mark. As such, there is indirect confusion and in respect of the goods and services found to be identical or similar, the opposition succeeds.

56. However, this is not the end of the matter as the opposition based upon Section 5(2)(b) has not succeeded across the board. As such, I will go on to consider the position under Section 5(3) and 5(4)(a).

## Section 5(3) - Reputation

57. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

58. The relevant case law can be found in the following judgments of the CJEU:

*Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora.* The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the

relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of

the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

## REPUTATION – THRESHOLD

56. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

57. I have already considered the opponent's evidence in this regard. It is noted that it has no details regarding market share and turnover. In this regard, I bear in mind the guidance in *Rise Construction Management Limited v Barclays Bank*,<sup>3</sup>

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<sup>3</sup> BL O/635/17

where Professor Philip Johnson as the Appointed Person rejected an appeal against the Hearing Officer's decision that the earlier mark had not been shown to have acquired a reputation for s.5(3) purposes. He said:

"76. Even if the Hearing Officer had considered all the evidence of other successful management projects (Bow Street Magistrates' Court, the UK Pavilion at the Madrid Expo, the Royal Opera House, or Kidzania) and the attendant publicity as well as given some (possibly) very little weight to the awards it would have made no material difference. None of this material addresses the fundamental difficulties faced by the Respondent namely that there was no evidence presented as to market share, no evidence from trade bodies or from people with standing in the industry, and no evidence of the market in which the reputation was claimed.

77. In respect of this final point, at the end of the Hearing, I asked Mr Hollingworth in what market the Respondent claimed reputation. He said the "construction industry" and that his client was known as a project manager in that industry. There was no evidence presented as to the size of the construction industry market (a further problem for Mr Hollingworth identified by the Hearing Officer: see paragraph 56). Nevertheless, I can take notice of the fact that the industry is worth many tens of billions of pounds and employs well over a million people. The Respondent's turnover (which as the Hearing Officer pointed out, does not break down between UK and overseas: paragraph 12) is at most £8million and the number employed nearly 100.

78. While the requirement for a reputation is "not onerous" (see *Enterprise Holdings, Inc v Europcar Group UK Ltd & Anor* [2015] EWHC 17 (Ch) at paragraph 120) and there was possibly more evidence the Hearing Officer should have considered to make her determination, none of the missing evidence could have materially changed her conclusion that "RISE has positive connotations of moving upwards" (paragraph 56) and that the Respondent did not have the necessary reputation in relation to construction management (paragraph 73). Furthermore, once the relevant market was identified by Mr Hollingworth as the behemoth that is the construction

industry, the Hearing Officer's statement might even appear generous. Accordingly, I dismiss the cross-appeal in relation to section 5(3)."

59. It is true that the evidence, which focusses upon the TV show called "Ballers" contains some details of viewing figures and advertising of the Ballers tv show, together with a social media presence. It is clear that the tv show has also been made available to purchase via other formats, namely DVD, Blu-ray and digital download. However, there are no sales figures provided. In addition, though there is some evidence of advertising activity and a social media presence, it is difficult to assess its reach and impact. Finally, the true value of the viewing figures is impossible to determine minus any context. I am not provided with any information regarding the television entertainment industry and its worth, nor how it is stratified. This is a significant flaw as regards proving reputation. That said, on the other hand, there is some press coverage in national newspapers. The content of this ranges from being directly in respect of the TV show to indirectly, in the sense that it focusses upon the actor in the leading role, Dwayne Johnson. On balance it is considered that the evidence is not particularly persuasive as regards proof of reputation.

60. In case I am wrong on that, it is considered that at best the evidence demonstrates a very modest reputation and further, this is limited to comedy/drama TV programmes. Bearing this in mind, I will go on to consider whether or not a link between the earlier marks and the contested trade mark will be established.

61. In doing so, I take into account the following factors identified in *Intel* These are:

*The degree of similarity between the conflicting marks*

*The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the*

*public*

*The strength of the earlier mark's reputation*

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

62. I have already found that the respective trade marks are similar for the reasons already given above. I have also already found that the earlier trade marks are unusual and that they are at least distinctive to an average degree (and may indeed be higher than average). These are both factors in the opponent's favour. However, the strength of the reputation is unremarkable and at best very modest. Further, its scope is limited purely to comedy/drama TV programmes. It is considered that there is also a notable gap between such a service and the relevant goods and services which survived the attack under Section 5(2)(b). As a reminder, these are:

Class 09:

*Mobile apps; downloadable mobile coupons; application software  
downloadable publications; electronic publications.*

Class 16:

*Vouchers; coupons; gift vouchers; trading vouchers; vouchers of value; gift certificates; loyalty cards; information leaflets; catalogues; periodicals; magazines; newsletters; brochures; pamphlets; promotional material.*

Class 35:

*Advertising; marketing services; promotional services; organisation, operation and supervision of sales and promotional incentive schemes; management of sales and promotional programmes relating to the awarding of points; reward schemes relating to the redemption of allocated promotional schemes for the*

*benefit of members of the award scheme; arranging online sales campaigns for business and advertising purposes for others; planning and management of marketing, promoting or advertising the goods and services of others; organisation of competitions for advertising and business purposes; providing space on websites for advertising and promotional purposes for others; arranging commercial transactions for others, via online shops; management of computer databases; providing a searchable online advertising guide featuring the goods and services of vendors; promoting the goods and services of others by providing a website featuring coupons, contact details, product reviews and links to the retail websites of others; search engine marketing services; real estate advertising; information and advice in relation to the aforementioned services.*

Class 41:

*Leisure services; arranging of sporting activities; cultural activities; arranging of leisure activities; arranging of cultural activities; arrangement of entertainment events and/or activities; exhibition and conference services; arranging track days and advanced driving instruction for drivers of motor cars; ticket services for entertainment, sporting, and cultural events.*

63. Taking all of these matters in the round, it is difficult to see how a link will be established. Further, even if it could, it will not be particularly strong. As such, it is even more difficult to see how it could lead to any damage. The opposition based upon Section 5(3) therefore fails.

## **Section 5(4)(a) – Passing off**

### **Legislation**

64. Section 5(4)(a) states:



“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

65. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

66. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

67. It is noted that the applicant accepts that the opponent enjoys a goodwill in its earlier trade mark. I agree with the applicant’s position and conclude that it is clear that the earlier sign has been used in the UK and in respect of a comedy/drama TV programme. In terms of the scope of the goodwill, it does not extend beyond this. Further, the criticisms of the evidence are already provided above in that there is no context provided. So, while on the face of it, the viewing figures are at a level which suggests that while the show has not performed poorly in the UK, it has not enjoyed the highest degree of success either. There is considered to be a reasonable degree of goodwill established. The passing off claim will therefore be assessed bearing this in mind.

68. The goodwill in respect of a tv show (and its affect) will only be considered against the remaining goods and services of the application for which the claim under Section 5(2)(b) has failed. For ease of reference, these are:

Class 09:

*Mobile apps; downloadable mobile coupons; application software  
downloadable publications; electronic publications.*

Class 16:

*Vouchers; coupons; gift vouchers; trading vouchers; vouchers of value; gift certificates; loyalty cards; information leaflets; catalogues; periodicals; magazines; newsletters; brochures; pamphlets; promotional material.*

Class 35:

*Advertising; marketing services; promotional services; organisation, operation and supervision of sales and promotional incentive schemes; management of sales and promotional programmes relating to the awarding of points; reward schemes relating to the redemption of allocated promotional schemes for the benefit of members of the award scheme; arranging online sales campaigns for business and advertising purposes for others; planning and management of marketing, promoting or advertising the goods and services of others; organisation of competitions for advertising and business purposes; providing space on websites for advertising and promotional purposes for others; arranging commercial transactions for others, via online shops; management of computer databases; providing a searchable online advertising guide featuring the goods and services of vendors; promoting the goods and services of others by providing a website featuring coupons, contact details, product reviews and links to the retail websites of others; search engine marketing services; real estate advertising; information and advice in relation to the aforementioned services.*

Class 41:

*Leisure services; arranging of sporting activities; cultural activities; arranging of leisure activities; arranging of cultural activities; arrangement of entertainment events and/or activities; exhibition and conference services; arranging track days and advanced driving instruction for drivers of motor cars; ticket services for entertainment, sporting, and cultural events.*

## **The test for misrepresentation**

69. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

70. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C.

58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

*Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency)* [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to

be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

71. It is considered that the strength of the opponent's goodwill in respect of BALLERS is reasonable only. Further, there is a gap in the respective fields of activity. Though there is no requirement for the areas of activity to coincide, it is nonetheless a relevant consideration. Bearing in mind both this aspect, together with the extent of the opponent's goodwill, it is difficult to see how misrepresentation can result, let alone cause damage. As such, the ground of opposition based upon passing off fails in respect of the goods and services which survived the ground of opposition under Section 5(2)(b).

72. The sum of all this is that the opposition succeeds in respect of the following:

Class 09:

*Downloadable multimedia files; downloadable computer graphics.*

Class 16:

*Postcards; stationery; calendars; books; diaries.*

Class 25:

*Clothing, footwear, headgear.*

Class 41:

*Entertainment services.*

73. The following goods and services can proceed to registration:



Class 09:

*Mobile apps; downloadable mobile coupons; application software; downloadable publications; electronic publications.*

Class 16:

*Vouchers; coupons; gift vouchers; trading vouchers; vouchers of value; gift certificates; loyalty cards; information leaflets; catalogues; periodicals; magazines; newsletters; brochures; pamphlets; promotional material.*

Class 35:

*Advertising; marketing services; promotional services; organisation, operation and supervision of sales and promotional incentive schemes; management of sales and promotional programmes relating to the awarding of points; reward schemes relating to the redemption of allocated promotional schemes for the benefit of members of the award scheme; arranging online sales campaigns for business and advertising purposes for others; planning and management of marketing, promoting or advertising the goods and services of others; organisation of competitions for advertising and business purposes; providing space on websites for advertising and promotional purposes for others; arranging commercial transactions for others, via online shops; management of computer databases; providing a searchable online advertising guide featuring the goods and services of vendors; promoting the goods and services of others by providing a website featuring coupons, contact details, product reviews and links to the retail websites of others; search engine marketing services; real estate advertising; information and advice in relation to the aforementioned services.*

Class 36:

*Issuing of gift vouchers; issuing of gift certificates; issuing of vouchers in relation to incentive schemes; issuing of points and tokens of value; financial*

*services, namely, enabling transfer of funds and purchase of products and services offered by others, all via electronic communication networks; providing a wide variety of payment and financial services, namely credit card services, issuing credit cards and lines of credit, processing and transmission of bills and payments thereof and payment services; real estate brokerage.*

Class 41:

*Leisure services; arranging of sporting activities; cultural activities; arranging of leisure activities; arranging of cultural activities; arrangement of entertainment events and/or activities; exhibition and conference services; arranging track days and advanced driving instruction for drivers of motor cars; ticket services for entertainment, sporting, and cultural events.*

Class 44<sup>4</sup>:

*Arranging health spa services for health and wellness of the body and spirit incorporating massage, facial and body treatment services, and cosmetic body care services; arranging the provision of hairdressing services; arranging the provision of beauty services; arranging the provision of personal training, health and fitness services; arranging health care relating to therapeutic massage; arranging make-up consultation and application services.*

## **COSTS**

74. The trade mark application has survived for the most part and the opponent has been successful only to a narrow extent. As such, it is considered that the applicant is entitled to a contribution towards its costs, with an appropriate reduction in place to reflect the limited success of the opponent. In considering this award, I also take into account the fact that the applicant is unrepresented and appointed Counsel only in respect of the Hearing. As

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<sup>4</sup> Class 44 is not opposed.

regards any other costs incurred, a “costs pro forma” was sent to the applicant and was not completed and returned. I will therefore make an award which reflects a contribution towards costs in respect of the Hearing only. This amounts to £800.

75. I therefore order Home Box Office Inc to pay Prospect If Limited sum of £800.

The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated 25 March 2019**

**Louise White**

**For the Registrar**