

O-543-19

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3341059
BY LISA HUTCHISON & NICOLA MARY CLAIRE GOVAN
TO REGISTER A SERIES OF TWO TRADE MARKS:

Kink Central

&

KinkCentral

AND

THE OPPOSITION THERETO UNDER NO 414491 BY
CYBERNET ENTERTAINMENT LLC.

Background and pleadings

1. On 25 September 2018, Lisa Hutchison and Nicola Mary Claire Govan (the applicants) applied to register the above series of two trade marks in class 41 for ‘Entertainment’.¹

2. The application was published on 5 October 2018, following which it was opposed by CyberNet Entertainment LLC (the opponent).

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon the following earlier UK Trade Mark (UKTM):

Mark details and relevant dates	Services relied upon
<p>UKTM: 3250778</p> <p>KINK</p> <p>Filed: 16 August 2017</p> <p>Registered: 17 November 2017</p>	<p>Class 35 Mail-order retail, retail and wholesale services in relation to adult sexual stimulation aids, sexual lubricants, bondage goods, whips, harnesses, sex toys, vibrators, body massagers, massage creams, sexual stimulation creams and gels, condoms, digital recordings, printed magazines and books, mugs, ceramics, watches, jewelry, clothing and headgear.</p> <p>Class 40 Custom manufacture of adult sexual stimulation aids and bondage goods; custom manufacture of sex toys, vibrators, penetrative toys, lotions, lubricants, creams, massage creams, condoms, watches, jewelry, clothing and headgear.</p> <p>Class 41 Entertainment and educational services, namely, providing photographic, audio, video and prose</p>

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

	presentations, educational workshops, seminars and tutorial sessions, and non-downloadable videos, all in the field of adult entertainment, via a website.
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4. The opponent's mark is an earlier mark which is not subject to proof of use. This is because, at the date of publication of the application, it had not been registered for five years.²

5. The applicants filed a counterstatement in which they denied the ground raised by the opponent.

6. Neither party requested to be heard. Only the opponent filed submissions and further submissions in lieu of a hearing. I make this decision based on careful consideration of the papers before me.

7. The applicants are representing themselves. The opponent is represented by Greyhills Rechtsanwälte mbB. Both sides seek an award of costs.

The opposition

8. Section 5(2)(b) of the Act states:

“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,

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

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

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

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

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

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

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

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

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

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

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

Preliminary issues

The series mark

10. The applicants have applied for a series of two marks, Kink Central and KinkCentral. I will refer to their mark as Kink Central for the remainder of this decision, by which I mean to refer to both marks.

Actual use

11. In their counterstatement the applicants have made a number of arguments concerning the use of the earlier right and the use of their own mark. These are arguments which are often put before this Tribunal. However, they have no bearing on

the outcome of this decision. Before I continue with the merits of the opposition, it is necessary to explain why this is so.

12. Until a trade mark has been registered for five years (when the proof of use requirements set out in s.6A of the Act commence), it is entitled to protection in relation to all the services for which it is registered. Consequently, the opponent's earlier UK mark must be protected for the services for which it is registered in classes 35, 40, and 41 without the opponent needing to prove any use of its mark in relation to those services. The opponent's earlier mark is therefore entitled to protection against a likelihood of confusion with the applicants' mark based on the 'notional' use of the earlier mark for all the services listed in the register. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*³ as follows:

"22. ...It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

13. So far as the applicants' claimed and proposed use of their mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*⁴, the Court of Justice of the European Union (CJEU) stated, at paragraph 66 of its judgment, that when

³ [2004] RPC 41

⁴ Case C-533/06

assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

14. Furthermore, in *Devinlec Développement Innovation Leclerc SA v OHIM*,⁵ the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

15. In other words, the way in which the applicants are actually using their trade mark at this point is not a factor which is relevant to the decision. Rather I must consider all normal and fair uses of the applicants’ mark. The same applies to the opponent’s earlier mark.

Comparison of services

16. The opponent relies on all of its services in classes 35, 40 and 41. Given that the application is made in respect of class 41, I will begin by comparing both parties’ class 41 services which are as follows:

The opponent’s services:	The applicants’ services:
Class 41 Entertainment and educational services, namely, providing photographic, audio, video and prose presentations, educational workshops, seminars and tutorial sessions, and non-downloadable	Class 41 Entertainment.

⁵ Case C-171/06P

videos, all in the field of adult entertainment, via a website.	
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17. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁶ the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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”.

18. The opponent submits:⁷

“As can be seen, the services covered by the junior UK mark ‘KINK CENTRAL’ are identically included in the broader general class 41 term ‘entertainment’, for which the senior UK mark ‘KINK’ of the opponent has protection. Therefore, these services must be considered identical.”

19. I note from the opponent’s comments that it is operating under a misapprehension with regard to its specification. The term ‘education services’ is immediately followed by the word, ‘namely’ and a narrower list of services. The term ‘namely’ is not ambiguous or open to interpretation. The Classification Addendum to the Manual of Trade Marks Practice deals with this construction as follows:

“Note that specifications including ‘namely’ should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above ‘dairy products namely cheese and butter’ would only be interpreted as meaning ‘cheese and butter’ and not ‘dairy products’ at large. This is consistent with the definitions provided in Collins English

⁶ Case T- 133/05

⁷ See the opponent’s submissions dated 19 March 2019

Dictionary which states 'namely' to mean 'that is to say' and the Cambridge International Dictionary of English which states 'which is or are'."

20. Clearly, the interpretation guidance above means that the scope of protection afforded the opponent's entertainment specification is limited to, 'providing photographic, audio, video and prose presentations, educational workshops, seminars and tutorial sessions, and non-downloadable videos, all in the field of adult entertainment, via a website.'

21. The opponent's services in class 41 for entertainment services are a list of adult entertainment services which are included within the broader term 'entertainment' in the application. Accordingly, these are identical services in accordance with the decision in *Merix*. In other words, the opponent's terms are included in the applicants' terms rather than the other way around, as claimed by the opponent. I will return to this point later in the decision.

The average consumer and the nature of the purchasing act

22. In accordance with the above cited case law, I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

23. 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*⁸, 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.

⁸ [2014] EWHC 439 (Ch)

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

24. The average consumer for entertainment services at large is a member of the general public. For the opponent’s adult entertainment services the average consumer is an adult member of the general public. Such services may be accessed online through a website, app or broadcast which may be accessed on, inter alia, a television, tablet, mobile phone or gaming console. They will be accessed by members of the general public primarily visually, are frequently accessed and are likely to require no more than a medium degree of attention to be paid.

Comparison of marks

25. The marks to be compared are as follows:

Opponent	Applicants
KINK	Kink Central KinkCentral

26. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁹, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

27. The opponent’s mark is the word KINK presented in upper case and in plain black type with no additional stylisation. The overall impression of the opponent’s mark rests in that word.

⁹ Sabel v Puma AG, para.23

28. The applicants' mark is a series of two marks, the first of which is the word 'Kink' followed by the word 'Central'. Both are presented in the same size, in title case and in plain black type with no additional stylisation. The overall impression of the mark rests in those words. The second mark in the series is the same two words conjoined. The capitalization of the second words and the fact that both words are well known in the English language, means that the lack of a space between those words goes almost unnoticed. The mark will still be seen as the two words 'Kink and 'Central', the overall impression resting in those words.

Visual similarity

29. Visual similarity rests in the fact that both marks include the word KINK. It is the totality of the earlier mark and the first word in the mark applied for. The visual differences are, firstly, that the opponent's mark is presented in upper case and the application in title case, a fact that will go largely unnoticed by the average consumer, and, in any case, a presentation which would be covered by fair and notional use. Secondly, and more significantly, the addition of the word 'Central' in the application. Taking these factors into account, I find these marks to be visually similar to a medium degree.

Aural similarity

30. With regard to aural similarity, both marks are made up of common English words. The opponent's mark and the first word of the application will be pronounced the same, as they are both the word 'KINK'. The second word in the application is 'Central' which will also be understood and pronounced accordingly. The earlier mark is one syllable in length; the application is three. Taking these factors into account, the marks are aurally similar to a medium degree.

Conceptual similarity

31. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹⁰ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.¹¹

32. The applicants define the word 'KINK' as the *“term the community have been using for everything that doesn't fit into the traditional mould of sexuality since the 50s.”*

33. With regard to the second word in the application the opponent submits:¹²

“In its submission, the applicant itself recognises the descriptive character of the term 'CENTRAL', which has simply been added to the pre-existing UK trademark owned by the opponent.”

34. The opponent draws my attention to the following paragraph taken from the applicants' counterstatement:

“In this case 'CENTRAL' is a descriptive mark to denote a central meeting place and somewhere that is inclusive to all kinksters via our events and promoting services'.

35. Both marks refer to the concept of 'Kink' which has a number of meanings. It can mean a bend or flaw or a person's, usually more unusual, sexual preference. In light of the opponent's services the KINK mark is likely to be given the latter meaning in the case of the earlier mark. I also find the same meaning is likely to be attributed to the application as, in combination and in the context of entertainment, the mark Kink Central is likely to be seen as a central point for 'KINK' entertainment. In any case, whatever the meaning attributed to the word KINK by the average consumer, it will be the same for both marks and I find them to be conceptually fairly highly similar.

Distinctive character of the earlier mark

¹⁰ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

¹¹ See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, BL O/048/08, paragraphs 36 and 37.

¹² See the opponent's submissions dated 19 March 2019.

36. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.¹³

37. No evidence has been filed in this case, so I have only the inherent distinctiveness of the earlier mark to consider. The word 'KINK' is an ordinary English word which will be easily understood by the average consumer. It alludes to the opponent's adult entertainment services but is not directly descriptive. I find the earlier mark to be a trade mark of slightly lower than average distinctive character.

Likelihood of confusion

38. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹⁴ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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 vice versa.

39. The applicants' services include the opponent's services, meaning that they are identical. I have found the average consumer to be a member of the general public, with the caveat that the consumer must be over 18 years of age to purchase the opponent's services. The level of attention paid to the purchase will be at least average and the purchase will be primarily a visual one. The respective marks possess a medium degree of visual and aural similarity and are conceptually fairly highly similar. The earlier mark has a slightly lower than average degree of inherent distinctive character.

¹³ Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

¹⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

40. The types of confusion were explained in *L.A. Sugar Limited v By Back Beat Inc*,¹⁵ by Mr Iain Purvis Q.C., sitting as the Appointed Person:

“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 recognised 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.”

41. Furthermore, in *Duebros Limited v Heirler Cenovis GmbH*,¹⁶ Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion.

42. With regard to the ‘common element’, I bear in mind *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which 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

¹⁵ BL O/375/10

¹⁶ BL O/547/17

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.”

43. 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.

44. In this case, the purchase of the services will be made based on primarily visual considerations and the consumer will pay no more than a medium degree of attention to the selection of the services at issue. In terms of direct confusion, the visual differences between the marks are sufficient to avoid the consumer thinking that one mark is the other mark. However, this is a case in which the conceptual similarities outweigh the differences when indirect confusion is considered. I remind myself of the question asked by Mr Purvis above, ‘what is it about the earlier mark that gives it its distinctive character?’. In this case, it is the ‘KINK’ concept. Notwithstanding the fact that the distinctiveness of the common element is slightly lower than average, it is still likely to lead the average consumer to believe that the contested mark is another mark in the ‘KINK’ range. The addition of ‘Central’ to the word ‘KINK’ does not alter or remove the independent distinctiveness of the word KINK – rather, it will be seen as referring to a central place where the services can be accessed. There is a likelihood of indirect confusion, and the opposition succeeds.

Entertainment services

45. The applicants have applied for the broad term 'entertainment services' in their specification which, given that it includes the named entertainment services in the earlier specification, is bound to be identical.¹⁷

46. I do not propose to limit the specification for entertainment services as the term does not lend itself to suitable limitation which would avoid a likelihood of confusion. In accordance with my earlier conclusion, an average consumer familiar with one of the parties' marks, used for entertainment services, would, when encountering the other, on a different entertainment service, consider it to be part of the same 'KINK' stable of entertainment service providers.

47. Such a conclusion is made in accordance with the Registry's practice with regard to the partial refusal of trade marks taken from Tribunal Practice Notice (TPN) 1 of 2012, paragraph 3.2.2(d), which reads:

"d) ...Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal."

CONCLUSION

48. The opposition succeeds prima facie, under section 5(2)(b) of the Act. The opponent has succeeded in full based on its services in class 41, therefore, I will not go on to consider the remainder of its specification, which puts it in no better position.

COSTS

¹⁷ In accordance with the decision in Meric.

49. The opposition having succeeded, CyberNet Entertainment LLC is entitled to a contribution towards its costs which I award on the following basis, bearing in mind that the applicant did not file evidence and the decision was made from the papers:¹⁸

Official fees: £100

Preparing the notice of opposition and considering the counterstatement: £300

Submissions/submissions in lieu of a hearing: £300

TOTAL £700

50. I order Lisa Hutchison and Nicola Mary Claire Govan to pay CyberNet Entertainment LLC the sum of £700. These costs should be paid within 21 days of the date of this decision or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 16th day of September 2019

**Al Skilton
For the Registrar,
The Comptroller-General**

¹⁸ The scale of costs applicable to proceedings before the Comptroller can be found in Tribunal Practice Notice 2/2016.