

O-555-20

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3336951
BY POPCITY LIMITED
TO REGISTER**



(SERIES OF 3)

**AS TRADE MARKS
IN CLASSES 9, 29, 30, 32, 33, 35, 41 & 43
AND OPPOSITION THERETO (UNDER NO. 600001002)
BY
ASSEMBLY FESTIVAL LIMITED**

Background & Pleadings

1. PopCity Limited (“the applicant”) applied for the trade marks set out on the title page as a series of three marks on 7 September 2018. The marks were published in the Trade Marks Journal on 14 September 2018 in classes 9, 29, 30, 32, 33, 35, 41 and 43. The applicant sought to amend its specifications in classes 9, 35, 41 and 43 by means of a Form TM21B dated 10 August 2020 although class 9 does not form part of these opposition proceedings. The contested goods and services will be set out later in this decision.

2. Assembly Festival Limited (“the opponent”) opposed the application on 5 December 2018 using the Fast Track procedure under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on its earlier UK registration no. 2533436 in classes 16, 25, 35, 41 and 43. The earlier registration’s details are outlined below.

| UK TM No. 2533436 | Goods & services |
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| ASSEMBLY assembly (series of 2) Filing date: 2 December 2009 Registration date: 30 September 2011 | Class 16: Printed matter; paper, cardboard and goods made from these materials, not included in other classes; reports; promotional material, publications, albums, almanacs, booklets, books, brochures, diaries, directories, guides, handbooks, journals, leaflets, notebooks, pamphlets, magazines, manuals and periodicals; stationery and printed forms; computer print-outs; database listings; instructional and teaching materials; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; plastic materials for packaging (not included in other classes); document files and holders; folders for papers and stationery; loose leaf binders; photographs; artwork, diagrams and illustrations; charts; graphic prints and posters; graphic reproductions; signboards of paper or |

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| | <p>cardboard; stamps (seals); stencils; wrapping and packing paper; writing pads; writing paper; parts and fittings for all the aforesaid goods.</p> <p>Class 25: clothing; footwear; headgear</p> <p>Class 35: Retail services connected with the sale of printed matter, clothing, headgear and footwear; establishment of business and retail stores; the preparation and distribution of promotional materials; business management services; the bringing together for the benefit of others of a variety of printed matter, clothing, headgear and footwear products enabling customers conveniently to view and purchase those goods in a retail store, from an Internet web site or by means of telecommunications; advertising, marketing, promotional, public relations and publicity services; advertising in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; direct mail advertising, operating, management, advertising and marketing of online websites; public relations; direct marketing services; business management and administration; business advisory services; market surveys, analysis and research; business advisory services in relation to the provision of sponsorship; event marketing; organisation of business shows; database marketing; sales promotion services; preparing and placing of advertisements; consultancy services relating to advertising, publicity and marketing;</p> |
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| | <p>management consultancy services; business advisory services; information, advisory and consultancy services relating to all the aforesaid.</p> <p>Class 41: Entertainment and entertainment services; artistic management of theatre shows; direction of theatre shows; management of theatres; provision of theatre facilities; production of theatre; theatre booking services; theatre ticket agency services; production and publishing of music; hiring out sound recordings; recording studio services; television, film, audio and radio production and distribution; electronic publications (non-downloadable); organisation and provision of corporate events, games and competitions, including via the Internet; organisation, presentation and production and performance of shows and live performances; educational services; DJ services; organisation of dance events and discos; musical performances; management of musical artists and DJs; record production; provision of club services; entertainer services; provision of musical entertainment; provision of live entertainment and information services relating to the foregoing; party planning; performance services; providing facilities for, arranging and conducting parties, dances, nightclubs and discotheques; film events; musical events; cultural and sporting events; live events; arranging of film events, musical events, cultural and sporting events and live events; audio entertainment services; audio-visual display presentation services for</p> |
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| | <p>entertainment purposes; services providing entertainment in the form of live musical performances or recorded music; entertainment services performed by a musical group, by musicians, by singers, by a musical vocal group or by vocalists; live entertainment; live entertainment production services; live entertainment services; management of entertainment services; musical entertainment services; musical group entertainment services; booking of entertainment; entertainment; entertainment by means of concerts; booking agency services; organisation of competitions and award ceremonies; provision of information by electronic means including the Internet; arranging and conducting of conferences, conventions and exhibitions; provision of radio and television entertainment services; information relating to entertainment, music, live performances and events, recordings; information, advisory and consultancy services relating to all the aforesaid services.</p> <p>Class 43: Restaurants; cafés; cafeterias; snack bars; coffee bars; coffee houses; takeaway services; preparation of food and drink; catering services; mobile catering services; carry-out restaurant and catering services; preparation of foods and beverages for consumption off the premises; provision of facilities for the consumption of food and of beverages; banqueting services; administration,</p> |
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| | management, consultation, information and advisory services relating to the aforesaid. |
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3. Following the Notice of Opposition, the parties entered into a cooling off period requested by means of a Form TM9C dated 8 February 2019.

4. The applicant subsequently filed a Form TM8 and a counterstatement on 11 September 2019 denying the grounds of opposition.

5. The opponent's registration has a filing date that is earlier than the filing date of the application and, therefore, it is an earlier mark, in accordance with Section 6 of the Act. As the registration procedure was completed more than 5 years prior to the publication date of the contested application, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of the goods and services it relies on.

6. Rules 20(1)-(3) of the Trade Marks Rules ("TMR") (the provisions which provide for the filing of evidence) do not apply to Fast Track oppositions, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

7. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in Fast Track oppositions. Proof of use evidence was provided by the opponent with the notice of opposition as required. The opponent then sought leave to provide additional evidence in respect of these proceedings in an email dated 8 October 2019. The request was granted by the registrar.

8. Rules 62(5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be

taken. A hearing was not requested nor considered necessary in this case. Both parties provided written submissions. This decision is taken following a careful reading of all the papers.

9. The parties are both represented. The opponent is represented by Harper Macleod LLP and the applicant by Elkington and Fife LLP.

Opponent's evidence

10. The opponent was unrepresented when it filed the notice of opposition. The opponent provided proof of use evidence, as required under the Fast Track procedures, with the notice of opposition. Some criticism that the evidence was unclear and insufficient was made by the applicant in its written submissions. When the opponent appointed a representative, a request was made to file further evidence on the basis that the opponent did not have the benefit of professional assistance at the time of filing the opposition and that further evidence would address the applicant's criticisms. The tribunal allowed the request and the further evidence was filed on 25 November 2019. Given this evidence incorporates the information given at the time of filing the notice of opposition, I will make my summary and assessment from the witness statement and exhibits filed on 25 November 2019, with reference to the material filed with the notice of opposition if necessary.

11. The first issue is to establish whether, or to what extent, the opponent has shown genuine use of the earlier marks within the 'relevant period'. The relevant period is defined as being a period of five years ending with the publication date of the contested application. In this case the relevant period would be 15 September 2013 to 14 September 2018.

12. The witness statement was made in the name of William Burdett-Coutts ("the declarant"), the artistic director of the opponent company. The declarant annexed 40 exhibits. The declarant states that the earlier registration was first used in 1981 for managing live theatrical performances at the Edinburgh Fringe Festival ("the Fringe").

13. In addition the opponent's turnover figures in the relevant period are given as:


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| 2018 | £671,881 |
| 2017 | £799,987 |
| 2016 | £609,809 |
| 2015 | £401,786 |
| 2014 | £45,588 |

14. The declarant states that the opponent promotes its services in classes 35, 41 and 43 primarily via its website with additional use of social media channels. The website advertising expenditure to promote its services during the relevant period are given as:

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|------|------------|
| 2018 | £27,448.97 |
| 2017 | £18,951.77 |
| 2016 | £1,312.53 |
| 2015 | £776.91 |
| 2014 | £917.17 |

15. Exhibit WBC1 is a screenshot from www.edfringe.com explaining what the Fringe festival is and its history.


16. Exhibit WBC2 comprises the opponent's financial statements dated between 2014 and 2018.

17. Exhibit WBC3 comprises screenshots of the opponent's website using the Wayback Machine internet archive service. The screenshots are dated March 2014, December 2014, April 2015 and December 2015. The mark **ASSEMBLY** appears in word form and there is an additional variant, namely .


18. Exhibit WBC4 comprises screenshots of the opponent's Facebook pages. The pages themselves are undated but the customer reviews are dated August 2017. There is use of the words **Assembly Festival**.


19. Exhibit WBC5 comprises a screenshot of the opponent's Twitter feed. The screenshot is undated, but the opponent's pinned tweet is dated November 6 regarding opening the application process for the 2020 Fringe. I presume that places the tweet on 6 November 2019, which is outside the relevant period.


20. Exhibit WBC6 comprises a screenshot of the opponent's Instagram page. The screenshot is undated but there is a reference to the Fringe taking place between 31 July – 26 August 2019. This is outside of the relevant period.

21. Exhibit WBC7 comprises screenshots of the opponent's YouTube channel. The screenshot is undated but there are posts referring to Fringe events dated 2018. The marks **Assembly Festival** and  are apparent.

22. Exhibit WBC8 comprises a list of website transactions dated between 2014 and 2019 mostly in the form of payable invoices. The invoices relate to the design, build, hosting and maintenance of the opponent's websites and other domains. There is also some detail relating to mailing and spam functionality which I take to mean the opponent's electronic mailing list capacity. The word mark is not apparent from the list, only use of the words **Assembly Festival Limited**.


23. Exhibit WBC9 consists of a copy of the opponent's Fringe guide for August 2014. The marks **Assembly, Assembly Festival** and  are apparent throughout.


24. Exhibit WBC10 consists of a venue guide and presentation information for prospective Fringe performers dated 2017. The marks **Assembly, Assembly Festival** and  are apparent throughout.

25. Exhibits WBC11 to WBC18 comprises photos of various Fringe venue frontages and associated signage used by the opponent around Edinburgh. The photos are undated and primarily show use of the  mark.


26. Exhibit WBC19 consists of screenshots of the opponent's website from the Wayback Machine internet archive dated September 2016, October 2016, May 2013, June 2013 and March 2016. The screenshots relate to performer's information around venue booking and their technical staging requirements. There are also references to recruitment for roles in the opponent's press team, technical team, box office, front of house, street team and hospitality team for the duration of the Fringe.

27. Exhibit WBC20 consists of an extract of the opponent's Fringe guide for 2014 with a selection of images from various performances held in the opponent's venues.

28. Exhibit WBC21 comprises screenshots taken from the opponent's Instagram pages showing the frontage of the opponent's box office. The images themselves are undated but the declarant states they were taken in 2013 and 2018. The  mark is prominently displayed.

29. Exhibit WBC22 consists of screenshots of the opponent's website from the Wayback Machine internet archive dated August 2018 and April 2016. The screenshot contains information regarding the opponent's venue known as Assembly Roxy. The information on the screenshot states that Assembly Roxy is a permanent year-round venue suitable for cultural performances, weddings and corporate events. The  mark is prominently displayed on the screenshots.

30. Exhibit WBC23 consists of a screenshot of a website promoting a theatrical production of "Nirbhaya", a play which the declarant states was premiered by the opponent at the Fringe in 2013. The opponent subsequently toured with this production in London, New York and in several cities in India. The declarant points out the producer credit for the opponent on page 2 of the exhibit. The print quality of the exhibit is very poor and word **Assembly** is barely discernible

31. Exhibit WBC24 consists of screenshots of the opponent's website from the Wayback Machine internet archive dated August 2013 which outline the opponent's corporate membership packages. The marks **Assembly** and  are shown.

32. Exhibit WBC25 consists of screenshots of the opponent's website from the Wayback Machine internet archive dated August 2018 showing booking and performance information for musical events taking place in the opponent's venues during the Edinburgh Jazz Festival.

33. Exhibit WBC26 comprises screenshots taken from the opponent's Instagram pages showing posters for musical and burlesque events taking place at the opponent's Edinburgh venues. The images are undated but there is a post from the opponent which references the 2018 Fringe.

34. Exhibit WBC27 consists of screenshots of the opponent's website from the Wayback Machine internet archive dated April 2016 showing booking and performance information for forthcoming Fringe events.

35. Exhibit WBC28 consists of a screenshot of the opponent's website from the Wayback Machine internet archive dated May 2016 containing information about what is termed "the Assembly family". The family is stated to comprise Assembly, Riverside Studios in London and the Brighton Comedy Festival. There is no indication on the screenshot that the mark **Assembly** is used either by Riverside Studios or the Brighton Comedy Festival. This exhibit also contains an Instagram screenshot which refers to a 2012 theatre production being staged at the Riverside Studios.

36. Exhibit WBC29 consists of a screenshot of the opponent's website from the Wayback Machine internet archive dated June 2013, August and September 2018 relating to branding guidance and templates for use by Fringe performers. Exhibit WBC30 also contains branding templates.

37. Exhibit WBC31 consists of screenshots of the opponent's website from the Wayback Machine internet archive dated September 2015 and April 2013 containing guidance for press and promoters during the Fringe.

38. Exhibit WBC32 consists of screenshots of the opponent's website from the Wayback Machine internet archive dated September 2015 showing images of the opponent's bar and catering facilities at its various Edinburgh venues.

39. Exhibit WBC33 comprises screenshots taken from the opponent's Instagram pages showing images of the opponent's printed Fringe guide. The fine detail is hard to discern but I believe the date to be 2018.

40. Exhibit WBC34 consists of screenshots of the opponent's website from the Wayback Machine internet archive dated August 2013 offering sponsorship opportunities for working with the opponent in exchange for Fringe benefits such as complementary tickets.


41. Exhibit WBC35 comprises the opponent's financial accounts for business transacted with sponsors dated between 2014 and 2019.

42. Exhibit WBC36 consists of screenshots of the opponent's website from the Wayback Machine internet archive dated August 2018 containing images of the food provision at the opponent's venues. The images are those of third-party vendors.

43. Exhibit WBC37 comprises screenshots taken from the opponent's Instagram pages showing images of the opponent's own brand wine bottles and a hot beverage cup. The images of the wine bottles appear to date from 2012, whereas the beverage cup image is undated.

44. Exhibit WBC38 consists of screenshots of a website www.edfoodfest.com from the Wayback Machine internet archive dated July 2017 which the declarant states is owned and operated by the opponent. The screenshots are promoting "Assembly's Edinburgh Food Festival" which took place in July 2017 using the opponent's venues. There is a reference to 2017 being the third year of the food festival which suggests this event first took place in 2015.

45. Exhibit WBC39 consists of images of the following Fringe related items, namely staff uniforms, magazines, programmes, access passes, tickets, lanyards, business

cards, floor plans, signage, labels, letterhead and umbrellas. The Fringe magazines and programme images are taken from 2016, 2017 and 2018. The remaining images are undated. All images contain the  mark, except for the magazine front pages which contain the word mark **Assembly**.

46. Exhibit WBC40 contains a balance sheet for the food festival event dated December 2015 to November 2016.

47. That concludes my summary of the evidence.

Proof of use provisions

48. The relevant statutory provisions for proof of use are as follows:

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in

the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

49. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

50. The following case law is also applicable. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and

simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].


(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Form of the mark

51. As noted above, in addition to the registered word mark **Assembly**, the opponent has used variants namely  and **Assembly Festival**. However, section 6A(4)(a) of the Act enables an opponent to rely on use of a mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.


32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its

independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

52. I find that use of the variant marks,  and **Assembly Festival**, is acceptable based on the guidance set out above.

Sufficiency of use

53. The opponent has demonstrated a consistent turnover and advertising expenditure during the relevant period. The evidence has shown that promotional activity has taken place and there is consistent use of the mark on websites backed up by use on several social media channels. The evidence overwhelmingly shows use on goods and services provided in one location, namely Edinburgh. Although the declarant stated that opponent has commercial links with Riverside Studio and the Brighton Comedy Festival, no evidence was given showing that either of those

entities use the mark **Assembly**. However, I take notice that the Edinburgh Fringe Festival is internationally renowned and attracts performers and audiences from all over the world. Therefore, its reach is significantly beyond that of a single location. I find that the opponent has demonstrated genuine use of the registered mark and acceptable variants during the relevant period.

Framing a fair specification

54. The next stage is to decide whether the opponent's use entitles it to rely on all of the goods and services for which the earlier registration is registered. In framing a fair specification for those goods and services, I rely on guidance given in the following judgements. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

55. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the

services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

56. The evidence demonstrates that the opponent has used its mark on a range of goods and services concerned with the management of live entertainment events at the Fringe and other Edinburgh based festivals. There was also evidence of related goods and services such as the provision of promotional services, venue preparation and ticket booking infrastructure.

57. In my view the evidence did not show that the opponent provided catering services for food and drink at large, other than *bar services*, but rather provided facilities to enable third parties to provide such catering. This was especially the case in Exhibits WBC 36 and 38 which showed images of third party food vendors. Nor did I find use in relation to *clothing; footwear; headgear* (and retail of same in class 35). The only reference to clothing was in exhibit WBC39 and that referred to staff uniforms which I do not find to be indicative of *clothing; footwear; headgear* for sale to third parties.

58. Taking all of these factors in to account I find the following goods and services has been demonstrated by evidence. I have listed the goods and services in class order for ease of reference.

Class 16: Guides relating to entertainment events

Class 35: The preparation and distribution of promotional materials; advertising, marketing, promotional, public relations and publicity services; advertising in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; direct mail advertising, operating, management, advertising and marketing of online websites; public relations; direct marketing services; business advisory services in relation to the provision of sponsorship; event marketing; database marketing; sales promotion services; preparing and placing of advertisements.

Class 41: Entertainment and entertainment services; artistic management of theatre shows; direction of theatre shows; management of theatres; provision of theatre facilities; production of theatre; theatre booking services; theatre ticket agency services; electronic publications (non-downloadable); organisation, presentation and production and performance of shows and live performances; musical performances; provision of musical entertainment; provision of live entertainment and information services relating to the foregoing; performance services; musical events; cultural events; live events; arranging of musical events, cultural events and live events; services providing entertainment in the form of live musical performances or recorded music; entertainment services performed by a musical group, by musicians,

by singers, by a musical vocal group or by vocalists; live entertainment; live entertainment production services; live entertainment services; management of entertainment services; musical entertainment services; musical group entertainment services; booking of entertainment; entertainment; entertainment by means of concerts; booking agency services; provision of information by electronic means including the Internet; information relating to entertainment, music, live performances and events, information, advisory and consultancy services relating to all the aforesaid services.

Class 43: Bar services; provision of facilities for the consumption of food and of beverages; administration, management, consultation, information and advisory services relating to the aforesaid.

Decision

59. 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.

60. 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

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

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

62. 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.

63. The following case law is also applicable to these proceedings. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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”.

64. The goods and services to be compared are:

| Opponent’s goods and services | Applicant’s goods and services |
|--|---|
| Class 16: Guides relating to entertainment events | |
| | Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; oils and fats for food; snack foods made from any of the aforesaid goods. |
| | Class 30: Cocoa; rice; tapioca and sago; flour and preparations made from cereals; |

| | |
|--|--|
| | bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice (frozen water); snack foods made from any of the aforesaid goods. |
| | Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages. |
| | Class 33: Alcoholic beverages; spirits; wines; cocktails. |
| Class 35: The preparation and distribution of promotional materials; advertising, marketing, promotional, public relations and publicity services; advertising in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; direct mail advertising, operating, management, advertising and marketing of online websites; public relations; direct marketing services; business advisory services in relation to the provision of sponsorship; event marketing; database marketing; sales promotion services; preparing and placing of advertisements. | Class 35: Retail services in relation to sound recordings, clothing, foodstuffs, non-alcoholic beverages and alcoholic beverages; business mediation for rental and reservations of temporary and permanent accommodations, including exhibit space, storage space, leisure space, restaurant space, retail space, office space, workspace and entertainment venue space; consultative and advisory services in relation to all of the aforesaid; none of the foregoing to be offered at comedy festivals, theatre festivals, music festivals, performing arts festivals, film festivals, food festivals, drinks festivals or festivals relating to food and drink. |
| Class 41: Entertainment and entertainment services; artistic management of theatre shows; direction | Class 41: Arranging and conducting of entertainment events, musical events, cultural events, marketing events, |

of theatre shows; management of theatres; provision of theatre facilities; production of theatre; theatre booking services; theatre ticket agency services; electronic publications (non-downloadable); organisation, presentation and production and performance of shows and live performances; musical performances; provision of musical entertainment; provision of live entertainment and information services relating to the foregoing; performance services; musical events; cultural events; live events; arranging of musical events, cultural events and live events; services providing entertainment in the form of live musical performances or recorded music; entertainment services performed by a musical group, by musicians, by singers, by a musical vocal group or by vocalists; live entertainment; live entertainment production services; live entertainment services; management of entertainment services; musical entertainment services; musical group entertainment services; booking of entertainment; entertainment; entertainment by means of concerts; booking agency services; provision of information by electronic means including the Internet; information relating to entertainment, music, live performances and events, information, advisory and

promotional events, educational events, sporting events and competitions; provision and management of entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; providing facilities for sporting events and competitions; ticket reservation and booking services for entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; provision of information about entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions, including information provided via online networks and the internet; consultative and advisory services in relation to all of the aforesaid; none of the foregoing relating to comedy festivals, theatre festivals, performing arts festivals, film festivals, food festivals, drinks festivals, festivals relating to food and drink or the organisation or arranging of festivals for entertainment purposes.

| | |
|---|--|
| consultancy services relating to all the aforesaid services. | |
| Class 43: Bar services; provision of facilities for the consumption of food and of beverages; administration, management, consultation, information and advisory services relating to the aforesaid. | Class 43: Catering services; provision of food and drink; bar, café and restaurant services; none of the foregoing to be offered at comedy festivals, theatre festivals, music festivals, performing arts festivals, film festivals, food festivals, drinks festivals or festivals relating to food and drink, or festivals for entertainment purposes. |

65. With regard to the applicant's goods in classes 29 and 30, I find there is no similarity between these goods and the opponent's services in class 43 for *bar services* or *the provision of facilities for the consumption of food and of beverages*. The nature and purpose of the goods and services are different and will not share the same producers or trade channels.

66. In relation to class 35, I do not find that the applicant's services are similar to the opponent's class 35 services. I understand the applicant's term *business mediation* to mean negotiation and arranging of rental and reservation services, which does not overlap with the largely advertising, marketing and promotional nature of the opponent's services. Their nature and purpose is different and there is unlikely to be an overlap in users.

67. Furthermore I do not find that the applicant's services namely *Retail services in relation to sound recordings, clothing, foodstuffs* have any similarity to the opponent's class 35 services.

68. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

69. As I do not find any similarity between the goods and services set out above, it follows that the opposition must fail in relation to these goods.

70. The opponent has class 16 in its registration which has no direct equivalent in the application. The opponent has not explained why it believes class 16 is similar to the goods or services in the application. However, I find the opponent’s class 16 goods namely *Guides relating to entertainment events* to be similar to a low degree to the applicant’s services being *provision of information about entertainment events, including information provided via online networks and the internet*. I find they share the same purpose, ie to provide information about entertainment events and may share the same users. There is also an element of competition between them as one is a physical printed guide and the other is an online equivalent.

71. Regarding the applicant’s goods in classes 32 and 33, I find there to be a low degree of similarity between these goods and the opponent’s services in class 43 for *bar services*. I make this finding on the basis that producers of alcoholic and non-alcohol beverages can also have premises under the same brand serving such beverages.

72. With regard to the applicant’s class 35 services *Retail services in relation to non-alcoholic beverages and alcoholic beverages*, I find that these are similar to a low degree to the opponent’s *bar services*. Although the nature of the services is different, they overlap in their purpose as both provide beverages to the consumer. There also an element of competition between them as the consumer has a choice as to whether to buy a beverage and consume it elsewhere or to consume the beverage in a bar.

73. Turning now to class 41, I find that the applicant's services namely *Arranging and conducting of entertainment events, musical events, cultural events*, marketing events, promotional events, educational events, sporting events and competitions; *provision and management of entertainment events, musical events, cultural events*, marketing events, promotional events, educational events, sporting events and competitions; *providing facilities for sporting events and competitions; provision of information about entertainment events, musical events, cultural events, including information provided via online networks and the internet; consultative and advisory services in relation to all of the aforesaid* are encompassed by the following services in the opponent's specification, namely *organisation, presentation and production and performance of shows and live performances; musical performances; provision of musical entertainment; provision of live entertainment and information services relating to the foregoing; arranging of musical events, cultural events and live events; information, advisory and consultancy services relating to all the aforesaid services*. I make this finding because some of the terms in the respective specifications are identical and where they are not literally identical, the applicant's terms fall within the ambit of the opponent's broader terms and are therefore identical on the *Meric* principle.

74. I find the applicant's services namely *ticket reservation and booking services for entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions* to be similar to high degree to the opponent's *theatre booking services; theatre ticket agency services* as both share the same nature and purpose and there is an overlap of users.

75. Lastly, looking at class 43 I find that *bar services* are identical in the respective specifications. I also find that *catering services, provision of food and drink, café and restaurant services* in the applicant's specification are similar to a medium degree to *provision of facilities for the consumption of food and of beverages*. I find there is some similarity in the nature and purpose of the services and there is complementarity in that one is necessary for the delivery of the other.

Average consumer and the purchasing process

76. I next consider the role of the average consumer and how the goods and services are purchased. 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*.

77. 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.”

78. The average consumers for the goods and services at issue here are the general public and businesses especially those in the arts sector. The contested goods are likely to be a visual purchase because consumers would find them in a physical retail environment. The contested goods are an ordinary type of purchase and the cost is likely to be inexpensive so I would categorise the level of attention during the purchasing process as medium.

79. The contested services are also likely to be a visual purchase as the average consumer would have browsed literature, brochures or promotional material either online or from print media whilst researching venues and entertainment events. Consumers would also be attending organised events either online or in person. However, I do not discount an aural element to purchasing the services such as word of mouth recommendations, radio advertising or telephone booking of tickets for example. In my view the cost of the contested services can vary, but the

average consumer would be paying at least a medium degree of attention during the purchasing process.


Comparison of the marks

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

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

81. 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.

82. The marks to be compared are:

| Opponent’s registration | Applicant’s mark |
|---|---|
| <p>ASSEMBLY</p> <p>assembly</p> |  |

83. The opponent's registration is a series of two word marks. The marks differ only in that the first mark in the series is in upper case and the second mark is in lower case. The overall impression is derived solely from the word **ASSEMBLY**. The same comparison will apply to both marks.

84. The applicant has a series of three figurative marks comprising the word **ASSEMBLY** in upper case and a geometric device. The marks differ only by means of colour and background. The first mark is depicted in black on a white background, the second is reversed so it is white on a black background and the third is yellow on a black background. Although the figurative element has a visual significance there is a rule of thumb that words will speak louder than devices and I find this to be the case here. The word **ASSEMBLY** plays the greater role in the overall impression of the marks. The same comparison will apply to all of the marks in the series.

85. In a visual comparison, the marks share the identical word element **ASSEMBLY** which is the entirety of the opponent's registration and the sole word element of the applicant's mark. The applicant has the additional figurative element as a point of difference. However whilst taking this into account, I find there to be a medium degree of visual similarity.

86. In an aural comparison, the figurative element of the applicant's mark will not feature so I have only the words to consider. The word **ASSEMBLY** is common to the respective marks and has the same pronunciation. Therefore, I find there is aural identity.

87. In a conceptual comparison, the message brought to mind by the shared word element **ASSEMBLY** will be identical. The applicant's figurative device is a point of difference but in my view it has no concept other than it is a geometric shape which does not detract from the concept of the word **ASSEMBLY** so it is neutral. Therefore I find the shared word element to be conceptually identical.

Distinctiveness of the earlier registration

88. The degree of distinctiveness of the earlier registration must be assessed. This is because the more distinctive the earlier registration, based either on inherent

qualities or because of the use made of it, the greater the likelihood of confusion. 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).”

89. I have considered the inherent distinctiveness of the earlier registration. Both marks in the registration consist of the ordinary dictionary word **Assembly** which is not descriptive in relation to the goods and services. Taking this into account, I find the opponent’s mark to be inherently distinctive to medium degree.

90. I have previously found that the opponent had demonstrated genuine use of the earlier registered mark. However, it does not automatically follow that the use shown has enhanced the distinctiveness of the registration. Following the criteria given in *Windsurfing* above, the evidence presented is insufficient in several areas. For example, the opponent appears to be one of several providers of venues and live

entertainment events for the Fringe, but no market share indication was provided. Although advertising expenditure figures were provided, these seem relatively modest. Furthermore, there is no indication of how widespread its customer base is despite the volumes of ticket sales figures and as there is only evidence of use in one location, the geographical scope of the use is limited. Taking these factors into account, I do not find that the earlier registration's distinctive character has been enhanced because of the use made of it.

Likelihood of confusion

91. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer and the nature of the purchasing process for the contested goods and services. In doing so, I must be aware that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

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

92. In the course of this decision I have concluded that,

- Many of the contested goods and services are identical and similar to varying degrees. Although I found that some goods and services were dissimilar.
- The average consumers are the general public and businesses who would select the goods and services through visual and aural means and they would be paying at least a medium degree of attention during the purchasing process.

- The competing trademarks are visually similar to a medium degree and aurally identical. The shared word element was conceptually identical and whilst the applicant's figurative element is a point of difference, it does not detract from the identical concept of the word.
- The earlier mark has a medium degree of inherent distinctiveness.

93. The respective marks both contain the identical word **Assembly**. The addition of the applicant's figurative element will be noted. Therefore, there is no likelihood of direct confusion. However, I find there is a likelihood of indirect confusion as this point of difference, namely the figurative element, does not outweigh the identity of the shared word. The additional element will be seen as merely a figurative addition to the brand which consumers would still believe to be connected to the same economic undertaking.

Conclusion

94. The opposition brought under section 5(2)(b) of the Act has succeeded in full against classes 32, 33, 41, 43 and succeeded in part against class 35. The opposition has failed in full against classes 29, 30 and in part against class 35. Subject to any appeal against this decision, the application will be partially refused for the following goods and services.

Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

Class 33: Alcoholic beverages; spirits; wines; cocktails.

Class 35: Retail services in relation to non-alcoholic and alcoholic beverages.

Class 41: Arranging and conducting of entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; provision and management of entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; providing facilities for sporting events and

competitions; ticket reservation and booking services for entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; provision of information about entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions, including information provided via online networks and the internet; consultative and advisory services in relation to all of the aforesaid; none of the foregoing relating to comedy festivals, theatre festivals, performing arts festivals, film festivals, food festivals, drinks festivals, festivals relating to food and drink or the organisation or arranging of festivals for entertainment purposes.

Class 43: Catering services; provision of food and drink; bar, café and restaurant services; none of the foregoing to be offered at comedy festivals, theatre festivals, music festivals, performing arts festivals, film festivals, food festivals, drinks festivals or festivals relating to food and drink, or festivals for entertainment purposes.

95. The application can proceed to registration for classes 9 (which did not form part of these proceedings), 29, 30 and for the following services in class 35.

Retail services in relation to sound recordings, clothing, foodstuffs; business mediation for rental and reservations of temporary and permanent accommodations, including exhibit space, storage space, leisure space, restaurant space, retail space, office space, workspace and entertainment venue space; consultative and advisory services in relation to all of the aforesaid; none of the foregoing to be offered at comedy festivals, theatre festivals, music festivals, performing arts festivals, film festivals, food festivals, drinks festivals or festivals relating to food and drink.

Costs

96. The opponent has been largely successful. As such it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs in Fast Track proceedings are governed by Tribunal Practice Notice (TPN) 2/2015. Bearing in mind the guidance given in TPN 2/2015, I award costs to the opponent as follows:

£100 Official fee

£200 Filing a notice of opposition

£200 Filing written submissions

£500 Total

97. I order PopCity Limited to pay Assembly Festival Limited the sum of £500. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of November 2020

June Ralph

For the Registrar

The Comptroller-General