

O/029/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003427383

BY SIMON BAKER TO REGISTER THE FOLLOWING TRADE MARK:

Disco Inferno

IN CLASS 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 419564 BY INFERNOS CLAPHAM LIMITED**

Background and Pleadings

1. On 10 September 2019, Mr Simon Baker ('the Applicant') filed an application to register the trade mark shown on the cover page of this Decision, number 3427383. The application was published for opposition purposes in the *Trade Marks Journal* on 22 November 2019. Registration is sought in respect of the following services:

Class 41

Entertainment

2. On 24 February 2020, the application was opposed by Infernos Clapham Limited ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the Applicant's services in class 41. The Opponent relies on the following earlier trade mark registration for its section 5(2)(b) ground:

UK00002490320

INFERNOS

Filing date: 17 June 2008; Date registration completed: 27 March 2009.

Relying on its registered services in class 41:

Entertainment; Nightclub and discotheque services; Provision of live entertainment; Organising and hosting of events; Organisation of parties; Musical entertainment.

3. The Opponent claims that there is a likelihood of confusion under section 5(2)(b) and its opposition is directed against all of the services within the Applicant's mark's specification, i.e. Class 41: Entertainment.

4. The Applicant filed a defence and counterstatement, denying the grounds.
5. Written submissions have been filed by the Opponent only.
6. The Opponent is represented by Keltie LLP; the Applicant represents himself.
7. The only comments from the parties available to me are therefore those within the Opponent's Notice of Opposition and Grounds, the Opponent's written submissions and the Applicant's Defence and Counterstatement.

Preliminary issues

8. Section 6A of the Act provides that where the registration date of the earlier mark is more than 5 years prior to the publication date of the applied-for mark, the opponent may be required to prove use of the earlier mark. In the instant case, although Section 6A is engaged, the Applicant has, in his Defence and Counterstatement, indicated that he does not require the Opponent to provide proof of use. Therefore, the Opponent is entitled to rely upon its mark in respect of all of the services identified in its statement of use; i.e. all the services upon which it relies.

9. The Applicant, in his Counterstatement, makes the following comments:

The opponent has a trade mark listed as "Infernos", a nightclub
My trade mark application is for "Disco Inferno"
This is specifically for the name of a tribute band, formed to play functions and private events.
I can't see anyone would mistake "Infernos", a night club with a unique logo with a function band with a different name and logo - a completely different entity and business.

10. How the Applicant uses its mark, or in respect of which particular entertainment services it intends to use the mark, are not relevant factors in the assessment of whether there is a likelihood of confusion. Even if the Applicant's services can, as a matter of fact, be distinguished from those provided by the Opponent in the way in which the Applicant has described, I must only consider the 'notional' use of the marks.

11. The concept of 'notional use' was addressed in *Compass Publishing BV v Compass Logistics* [2004] R.P.C. 41 per Laddie J.:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market-place but no confusion has been caused, then there cannot exist a likelihood of confusion under Art.9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s.10(2). So, no confusion in the market-place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. 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."

12. The Court of Justice of the European Union has stated the following¹:

"Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered."

¹ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06.

13. In my assessment, I must therefore consider all of the possible circumstances in which the mark applied for *might* be used if it were registered. Even though the Applicant has referred to a particular service that he provides, my assessment must take into account only the specification as it appears on the application for registration i.e. Entertainment. Any actual differences between the parties' services are irrelevant unless they are apparent from the applied-for and registered marks.

14. The following decision has been made after careful consideration of the papers before me.

Decision

Section 5(2)(b) of the Act and related case law

15. 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,

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

16. The following principles are derived from the decisions of the Court of Justice of the European Union (“CJEU”) 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

C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P

The principles:

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

17. The Applicant seeks registration of its mark solely in respect of 'Entertainment' in Class 41. Both the Applicant and the Opponent include the term 'Entertainment' in their respective specifications under Class 41. These services are clearly identical.

Average consumer and the purchasing act

25. 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.

18. In *Hearst Holdings Inc*² Birss J. described the average consumer in the following way:

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

19. The Class 41 term ‘Entertainment’ is a broad category within which a vast array of services will fall. Examples, to name but a few, include: musical events; theatrical performances; the showing of cinematic works; events management services; nightclubs.

20. In my view, the average consumers of services within the term ‘Entertainment’ will comprise the general public. Cinema tickets, for example, will, in most cases, be purchased by the general public.

21. In view of the broad range of entertainment-related services falling under ‘entertainment’, the price range of services will be wide. Admission to a nightclub, for example, may cost a few pounds or be relatively expensive; Tickets to a concert or a West End theatre production will also vary in cost. The level of attentiveness displayed by the average consumer will be low to average, depending on the cost.

22. I recognise that the manner in which services are purchased will also vary depending on the particular service.

² *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).

23. I consider that entry to a nightclub will often be a casual and spontaneous purchase, made after simply happening upon the premises while walking along a street on a night out or because a member of the group of friends has suggested the venue. Membership to more exclusive, members-only clubs, will be purchased after visiting the premises or online. These will be visual purchases.

24. Ticket purchases for theatrical or musical performances will be made from websites or from physical premises such as a box office. Purchases from websites will therefore be visual in nature. Purchases of tickets from a physical premises will also be visual, in many cases made after viewing a poster or billboard, although I acknowledge that some purchases will be made entirely orally by way of requests to staff, in instances where the consumer has not seen any promotional material but has simply heard that a particular performance is running. In my view, the level of attentiveness displayed by the average consumer will be no more than medium.

Comparison of the marks

INFERNOS	Disco Inferno
Opponent's mark	Applicant's mark

26. 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.”

27. 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.

28. The Opponent has submitted the following at page [2] of its written submissions at the penultimate and final paragraphs:

In relation to the visual, aural and conceptual similarity of marks, the global appreciation of the likelihood of confusion must be based upon the overall impression created by the marks, bearing in mind in particular their distinctive and dominant components (ECJ, 3 September 2009, Aceites del Sur-Coosur/OHIM - Koipe Corporacion, C-498/07 P, paragraphs 60-70). In the present case, within the Opposed Mark, having regard to the services for which registration is sought, we submit that the word DISCO will be taken as being descriptive of the activities of the Applicant. It is the word INFERNO that will be taken by consumers to be the dominant distinctive element of the mark.

The global appreciation of likelihood of confusion also implies a degree of interdependence between the relevant factors, and particularly between the similarity between the trade marks and between the goods and services. In this regard, a lesser degree of similarity between services may be offset by a greater degree of similarity between the marks, and vice versa. In the present case, the services at issue are identical. Whilst this may offset a lower degree of similarity between marks, we submit that the marks at issue are at least of average similarity, if not similar to a high degree. Accordingly, the identical nature of the services simply makes confusion inevitable in the present case.

29. The overall impression of the Opponent’s mark resides in its entirety. The mark consists of a single word, ‘INFERNOS’, in a plain font, all letters being upper case; its distinctiveness therefore resides in the single word.

30. The Applicant’s mark comprises two word components, ‘Disco Inferno’, in a plain font, with the first letter of each word in upper case. The overall impression of the mark resides in the two-word mark in its entirety.

31. Visual Comparison

All but the final letter of the Opponent's word mark, i.e. 'INFERNO', are, in that order, incorporated into the second component of the Applicant's mark. The difference in length between the Opponent's single word mark and the Applicant's two-word mark, by virtue of the word 'Disco', will be discerned visually. The presence of the 'S' in the earlier mark, and the absence of the 'S' in the second component of the applied-for mark, also cannot be overlooked.

32. Courts have been willing to find similarity of marks where there is an identical verbal element that is shared by the respective marks, even though the remaining letters are different. The General Court in the case of *Lancome v OHIM*³ considered the word marks 'ACNO FOCUS' and 'FOCUS' and concluded that there was a certain visual similarity between them by virtue of both marks containing the common element 'FOCUS'.

33. In *El Corte Inglés, SA v OHIM*, the General Court observed that the attention of the consumer is *usually* [my emphasis] directed to the beginning of a word mark⁴, but I am mindful that this is not an absolute rule.

34. It has also been held that common elements at the *end* of word marks may suffice to create a likelihood of confusion. In *Bristol Global Co Ltd v EUIPO*, T-194/14, the General Court held that there was a likelihood of confusion between AEROSTONE (slightly stylised) and STONE if both marks were used by different undertakings in relation to identical goods (land vehicles and automobile tyres). This was despite the fact that the beginnings of the marks were different. The common element – STONE – was sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed.⁵

35. Consequently, I find a low-medium level of visual similarity between the marks.

³ Case T-466/08 *Lancôme Parfums et Beauté & Cie v OHIM* EU:T:2011:182, para [63].

⁴ Cases T-183/02 and T-184/02 at para [83].

⁵ The European Intellectual Property Office

36. Aural Comparison

The Opponent's mark will be articulated as 'in-fer-nose' by most average consumers, with the emphasis on the second syllable, i.e. 'in-*fer*-nose'. I also recognise that a very small minority of average consumers would pronounce the mark as '*in*-fer-noss' with the emphasis on the first syllable.

37. The Applicant's mark will be articulated as 'dis-co in-*fer*-no', with the emphasis on the second syllable of 'Inferno'. There is a measure of aural similarity between the respective marks to the extent that the 'inferno' element of the Opponent's mark forms the second word element of the Applicant's mark. But for the presence of the 's' at the end of the Opponent's mark, the 'inferno' element of the Applicant's mark would be aurally identical to the earlier mark. The difference in the lengths of the respective marks, i.e. the earlier mark's 3 syllables as compared to the contested mark's 5 syllables, will be discerned aurally.

38. I therefore find that the degree of aural similarity between the marks is no more than medium.

39. Conceptual Comparison

Dealing with the Opponent's mark first, 'INFERNOS' would be recognised by the average consumer as the plural of the English word 'inferno'. In my view, the average consumer would be familiar with the dictionary definition of 'inferno' as 'a very large uncontrolled fire'⁶, 'a place or situation that is too hot, chaotic or noisy' or as having connotations of 'Hell'⁷. In my view, 'INFERNOS' as a mark for entertainment-related services would, for the average consumer, invoke the idea of excitement, energy and liveliness.

40. I consider that the average consumer would ascribe the same meaning to the 'inferno' element of the Applicant's mark; the same ideas of excitement, energy and liveliness would be conjured in the consumer's mind. The 'Disco' word

⁶ <https://dictionary.cambridge.org/dictionary/english/inferno> accessed 04 January 2021 at 11:27.

⁷ <https://www.lexico.com/definition/inferno> accessed 04 January 2021 at 11:28.

element preceding 'Inferno' would, for the average consumer, be understood as a party at which people dance to recorded music, a nightclub or other establishment at which such events take place⁸ or something involving a genre of dance music particularly popular in the 1970s (disco)⁹. The two word elements together would, to the average consumer, convey the concept of exciting and energetic entertainment featuring disco music and dancing.

41. In the light of the foregoing, given that both marks contain the 'inferno' concept, but that there is the additional concept of 'disco', which is absent from the other mark, I find that the level of conceptual similarity between the marks is medium.

Distinctive character of the earlier mark

42. *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

⁸ <https://www.collinsdictionary.com/dictionary/english/disco> accessed 04 January 2021 at 11:30.

⁹ <https://dictionary.cambridge.org/dictionary/english/disco> accessed 04 January 2021 at 11:31.

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).”

43. I find that earlier mark neither describes nor alludes to the services in respect of which it is registered. I consider that ‘INFERNOS’ is a reasonably unusual choice of word to identify a provider of entertainment-related services. I therefore conclude that the earlier mark is inherently distinctive to at least a medium degree.

Likelihood of confusion

44. Confusion can be direct or indirect. Mr Ian Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹⁰. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹¹ in 1999, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that the later mark is economically linked to the earlier mark by way of being a ‘sub brand’, for instance.

45. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [16].

¹⁰ Case BL O/375/10 at [16].

¹¹ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

46. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods or services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

47. I have found that the respective services are identical.

48. My comparison of the marks has determined that:

- There is a low-medium level of visual similarity between the marks;
- The level of aural similarity between the marks is no more than medium;
- The level of conceptual similarity between the marks is medium.

49. In *New Look Limited v OHIM*¹² the General Court stated that:

“49. ...it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market...”

50. In *Quelle AG v OHIM*¹³, the General Court held that:

“68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs.”

51. Although the above-mentioned GC decision concerns *goods*, I consider the general principle to be apposite to the Applicant’s *services* also. In my view, the services will, for the most part, be self-selected. The way in which the services

¹² Joined cases T-117/03 to T-119/03 and T-171/03.

¹³ Case T-88/05.

are self-selected will vary, as noted above at [22]-[24], but, in each case, the visual aspect of the marks will play a more prominent role in the average consumer's perception of the marks. I consider that the weight to be accorded to the aural similarity of the marks is therefore diminished.

52. I have found that the Opponent's mark is inherently distinctive to at least a medium degree. The CJEU held in *Sabel*¹⁴ that:

"24. The more distinctive the earlier mark, the greater will be the likelihood of confusion."

53. This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited*¹⁵:

"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."

54. I find that a significant proportion of average consumers would confuse the marks. The services are identical and will be purchased with a low-medium level of attentiveness. The earlier mark has at least a medium level of distinctiveness and disco may be seen as describing some entertainment services. In these circumstances, it is my view that when the average consumer tries to remember the Applicant's mark, the non-distinctive element 'Disco' may be forgotten and therefore missing from the image in the 'mind's eye'.

55. I also conclude that, even if the average consumer does recall that the earlier mark is different from the applied-for mark, there will be *indirect* confusion. In

¹⁴ *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

¹⁵ BL O-075-13.

*Whyte and Mackay*¹⁶ it was held that where an average consumer perceives that a composite mark consists of two or more elements, one of which has a distinctive significance independent of the mark as a whole, confusion may occur as a result of the similarity/identity of that element to the earlier mark. In the instant case, 'Inferno' has retained its independent distinctive role. The word 'Inferno' has been placed after the word 'Disco', a descriptive and, therefore, non-distinctive term, leading the average consumer to presume that the Applicant's mark is a sub-brand of 'INFERNOS' (for example another entertainment venue within the same chain featuring disco music.) Consequently, I find that that some average consumers will note the visual differences between the respective marks but conclude that the marks relate to economically-linked undertakings.

Final Remarks

56. The Opposition has succeeded and the application is refused.

COSTS

57. I award the Opponent the sum of **£600** as contribution towards its costs, calculated as follows¹⁷:

Preparation of statement and consideration of the Applicant's statement:	£200
Official fee for 5(2)(b) only:	£100
Written Submissions	£300
Total:	£600

¹⁶ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.

¹⁷ Based upon the scale published in Tribunal Practice Notice 2/2016.

58. I therefore order Mr Simon Baker to pay to Infernos Clapham Limited the sum of £600. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of January 2021

N. R. Morris

**For the Registrar,
the Comptroller-General**