

O/1063/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3665751
IN THE NAME OF BIBLIOTHECA LIMITED
TO REGISTER AS A TRADE MARK**

biblio+

**IN CLASSES 9, 38, 41, 42
and 45**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 430625
BY GROUPE CANAL+**

BACKGROUND AND PLEADINGS

1. On 07 July 2021, Bibliotheca Limited (“the applicant”) applied to register trade mark number UK3665751 for the mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 29 October 2021, in respect of the following goods and services:

Class 9: *Sound and video recordings; digital recordings; cinematographic films; records, discs, tapes, pre-recorded video tapes and discs; magnetic and optical data-carriers; apparatus for the recording, storage, transmission or reproduction of sound and/or images; CD-ROMs and cartridges; DVDs; non-printed publications; downloadable computer software; software for mobile telephones; software for tablet computers; software for portable electronic devices; software for scheduling appointments; software for audio and video communication; software for streaming audio and video content; software for recording audio and video data; computer software for controlling the operation of audio and video devices; instant messaging software; electronic publications (downloadable); recorded and downloadable media.*

Class 38: *Video, audio and television streaming services; data streaming services.*

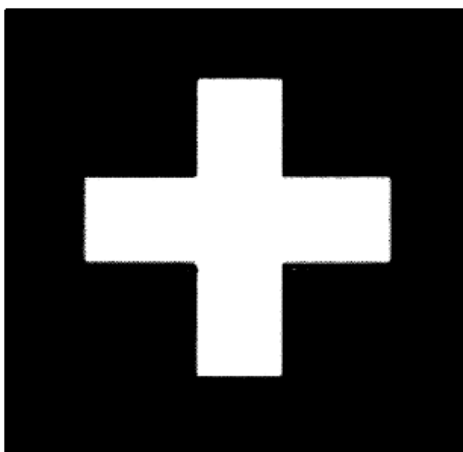
Class 41: *Entertainment services; providing non-downloadable films and television shows via transmission services; rental of audio books and books; rental of video and computer games; rental of digital content; electronic publication services; providing electronic publications; electronic publication lending services.*

Class 42: *Consultancy, advice, assistance, analysis, design, evaluation and programming services relating to computer software, firmware, hardware, and information technology; consultancy and advice relating to the implementation of computer software, firmware, hardware, information technology and of data processing systems; rental of computer programmes and provision of information relating to*

information technology and integrated services digital network systems, including that provided by telecommunications networks, by online delivery and by way of the world wide web; updating and maintenance of software; integration of software, firmware and hardware systems.

Class 45: *Licensing of computer software, firmware and hardware.*

2. The application is opposed by GROUPE CANAL+ (“the opponent”). The opposition was filed on 28 January 2022 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application. The opponent relies upon the following UK comparable mark:



UK trade mark registration number 801025864

Filing date: 15 September 2009

Priority date claimed: 16 March 2009

Registration date: 02 December 2010

Registered in Classes 9, 14, 16, 18, 25, 28, 34, 35, 38, 41 and 42

Relying on goods and services in Classes 9, 38, 41 and 42 only, as shown under paragraph 27 of this decision.

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Trade Mark designating the EU. As a result, the opponent’s mark was converted into a

comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.¹

4. The opponent submits that when considering the marks as a whole, there are clear similarities between them, the verbal element “BIBLIO” in the contested mark being descriptive and therefore does not serve to differentiate the marks sufficiently since the common element “+” will be the focus of consumer attention. It submits that the goods/services in question are identical or similar to those relied upon in the earlier mark, but even where they are found to only similar, (to whatever degree), the proximity of the marks is sufficient for consumers to be confused as to the origin. Accordingly, it submits that the application should be refused under Section 5(2)(b) of the Act.

5. The applicant filed a counterstatement denying the claims, and submits that the element “BIBLIO” is the dominant and distinctive part of the contested mark, which will be the focus of consumer attention and which will serve to differentiate the respective marks. It does not admit that the goods and services are identical or similar because it states that it does not know which of the opponent’s goods and services it is able to rely upon in the opposition.² However, even if sufficient proof of use of the goods and services is demonstrated, the applicant denies that there is a likelihood of confusion on the part of the public because of the lack of similarity of the respective marks. Accordingly, it requests that the opposition be dismissed in full and that an award of costs be made in its favour.

6. Both parties filed written submissions which will not be summarised, but will be referred to as and where appropriate during this decision. Only the opponent elected to file evidence, which will be summarised to the extent considered necessary. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

¹ See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

² See paragraph 21, “My Approach”.

7. In these proceedings, the opponent is represented by D Young & Co LLP and the applicant is represented by Williams Powell.

EVIDENCE

8. The opponent filed evidence by way of three separate witness statements in the names of Richard Burton, Clément Hellich Praquin and Emma Broxholme.

9. I note the official letter from the Tribunal dated 14 June 2022, where it stated that having reviewed the evidence provided by the opponent in support of the opposition, which was in excess of the 300 page limit as given in Tribunal Practice Notice (“TPN”) 1/2015, the preliminary view of the Registry was to allow the volume of evidence filed. The preliminary view was unchallenged by the applicant.

10. The first witness statement is by Richard Burton of D Young & Co LLP, who is the legal representative of the opponent. The witness statement is dated 27 May 2022, to which is attached Annex 1, which comprises the witness statement and supporting exhibits of Clément Hellich Praquin; and Annex 2, comprising the witness statement of translator Emma Broxholme of Priory Translations Ltd, which is dated 22 April 2022.

11. The witness statement of Clément Hellich Praquin, being the Corporate General Counsel of Groupe Canal+, a position which he states he has held since 2016, is dated 10 March 2022. Alongside the witness statement, he adduces nineteen exhibits, labelled **Exhibit CHP1** to **Exhibit CHP19**, accordingly. The main purpose of the evidence is to provide background information about the opponent and its various brands, and to demonstrate genuine use of the trade mark in relation to the goods and services being relied upon in classes 9, 38, 41 and 42, during the relevant period.

12. In her witness statement, Ms Broxholme confirms that she has reviewed the translations in the witness statement of Clément Hellich Praquin and she certifies that the translations presented in Annex 1 are accurate and correctly reflect the information displayed in French to English. I note that Ms Broxholme expressly refers to translations of the following exhibits only: CHP1, CHP2, CHP3, CHP4, CHP6, CHP7, CHP8, CHP9, CHP10, CHP11, CHP13, CHP15, CHP16, CHP17 and CHP18. I further

acknowledge that in the official letter from the Tribunal dated 14 June 2022, it was noted that although it appeared that Exhibit CHP19 contained a translation, this was not included in the list of certified translations by Ms Broxholme. The opponent responded by email on 22 June 2022, stating that in its view, an official translation of this exhibit was not required, and that it was aware that the Hearing Officer would determine what weight to give an exhibit where a non-certified translation is provided. I will take this into account when making my decision.

DECISION

13. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

...”

15. The earlier trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions.

16. The opponent’s mark completed the registration process more than five years before the application date of the contested mark, and, as a result, is subject to the

provisions on use under Section 6A of the Act. The applicant has required the opponent to provide proof of use of the mark for all the goods and services on which it relies, as listed under paragraph 27 of this decision.

Proof of Use

17. Proceedings were started on 28 January 2022, and at that time, the relevant statutory provisions under Section 6A of the Act were as follows³:

(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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 –

³ See Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

(a) within the relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

18. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

19. Section 100 of the Act states that:

“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”.

20. The relevant period during which genuine use must be shown is the five years ending with the date of application of the contested mark, which was 07 July 2021. The relevant period is 08 July 2016 to 07 July 2021.

My approach

21. Having reviewed the evidence, for reasons that will become apparent throughout the course of my decision, I propose to proceed on the basis that the opponent has put the earlier mark to genuine use for all of those goods and services upon which it relies during the relevant period. As a result, I will now move to consider the 5(2)(b) ground of the opposition in full.

Section 5(2)(b)

22. The opposition is based upon Section 5(2)(b) of the Act, which reads as follows:

“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”.

23. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

24. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux*

BV, Case C-425/98, Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”), Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, 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

25. Section 60A of the Act provides:

“(1) For the purposes of this Act goods and services —

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

26. I am therefore mindful of the fact that the appearance of respective goods and services in the same class is not sufficient in itself to find similarity between those goods and services, and that likewise, neither are goods and services to be automatically found to be dissimilar simply because they fall in a different class.

27. The goods and services to be compared are:

Opponent's goods and services	Applicant's goods and services
<p><u>Class 9</u> <i>Scientific (other than medical), nautical, surveying, photographic, cinematographic, optical and electro-optical, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; set-top boxes; electronic information processing apparatus, electric apparatus for measurement and electronic control (inspection); teaching apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing, storing, encrypting, decrypting, transforming and processing sound or images; communication and telecommunication apparatus; audiovisual, telecommunication, telematic, television and remote-controlled appliances and instruments; tape recorders; video recorders, cameras; telephones, mobile telephones; personal organisers (PDAs); electronic agendas; radios, personal stereos; projectors</i></p>	<p><u>Class 9</u> <i>Sound and video recordings; digital recordings; cinematographic films; records, discs, tapes, pre-recorded video tapes and discs; magnetic and optical data-carriers; apparatus for the recording, storage, transmission or reproduction of sound and/or images; CD-ROMs and cartridges; DVDs; non-printed publications; downloadable computer software; software for mobile telephones; software for tablet computers; software for portable electronic devices; software for scheduling appointments; software for audio and video communication; software for streaming audio and video content; software for recording audio and video data; computer software for controlling the operation of audio and video devices; instant messaging software; electronic publications (downloadable); recorded and downloadable media.</i></p>

(projection apparatus); antennae, satellite dishes; loud-speaker cabinets, amplifiers; computers, computer screens, computer keyboards, computer peripheral devices, modems, set-top boxes, encoders; devices for providing access and for controlling access to data processing apparatus; authentication apparatus designed for telecommunication networks; apparatus for scrambling signals and for descrambling signals as well as for retransmission; digital terminals; videos; CD-ROMs, recording discs, digital video discs (DVDs), videodiscs and sound discs, digital discs, videotapes; players for CD-ROMs, digital video discs, digital discs, magnetic discs, video and audio discs, digital discs, recording discs; video game cartridges; video game software; video games adapted for use with a television screen; magnetic recording media; magnetic cards, integrated circuit cards (smart cards), electronic cards; integrated circuits and micro circuits; card readers; electronic components; monitors used for displaying data received from a global computer network; automatic vending machines and mechanisms for coin-operated apparatus; calculating machines and data processing apparatus; satellites for telecommunication and scientific purposes; spectacles, spectacle cases, optical goods; integrated circuit cards (smart cards), simultaneous programming and television channel selection devices; electronic guides for tv and radio

<p><i>programmes; apparatus and instruments for television programme selection and programming; interactive television apparatus and instruments; television screens; software (recorded programs); fibre-optic cables and optical cables; electric cells and batteries.</i></p>	
<p><u>Class 38</u> <i>Telecommunication services; communications via computer terminals or via fibre-optic networks; information on telecommunications; press and information agencies (news); communications via radio, telegraph, telephone or visiophone, by personal stereo, by personal video player, by videophone, by interactive videography via videophone; television broadcasting; information transmission services via data communication networks; sending of messages, telegrams, images, videos, despatches; transmission of data by teletypewriter; teletransmission; television broadcasts, radio broadcasts; programme broadcasting by satellite, cable, via computer networks (especially via the Internet), via radio networks, via wireless networks and by radio relay channels; broadcasting audio, audiovisual, cinematographic and multimedia programmes (texts and/or images (still or moving) and/or sounds musical or not, ringtones) for interactive or other use; electronic display services (telecommunications); rental of telecommunication equipment; rental of</i></p>	<p><u>Class 38</u> <i>Video, audio and television streaming services; data streaming services.</i></p>

remote computing and data communication apparatus namely telephones, facsimile machines, message transmission apparatus, modems, personal stereos; rental of aerials and parabolic aerials; rental of access devices (apparatus) to interactive audiovisual programmes; communications (transmission) over an open global computer network (the Internet) or a closed network (intranets); online downloading services for films and other audio and audiovisual programmes; services transmitting television programmes and selections of channels; provision of access to a computer network; providing connections to telecommunication services, to Internet services and to databases; telecommunications gateway services; services of linking by telecommunications to a global computer network; consulting in telecommunications; services for transmitting and receiving video images via the Internet by means of a computer or a mobile telephone; telephone services; cellular telephone services; cellular telephone communication; radio paging; voicemail, call forwarding, automatic answering machines and electronic mail, electronic message transmission services; video-conferencing services; video messaging services; video-telephone services; services to provide access to the Internet (Internet service providers); electronic correspondence exchange

<p><i>services, electronic mail services, instant electronic messaging services, non-instant electronic message services; information transmission services by means of Internet, extranet and intranet networks; information transmission services by means of secure messaging systems; providing access to electronic conferencing and chat rooms; providing access to Web sites on the Internet containing digital music or any audiovisual work; providing access to telecommunications infrastructures; providing access to search engines on the Internet; rental of access time to telecommunication networks; services for downloading video games and digitized data.</i></p>	
<p><u>Class 41</u> <i>Education; providing of training; entertainment; radio and television entertainment on any media namely television set, computer, personal stereo, portable video player, PDA, mobile telephone, computer networks, the Internet; providing recreation facilities; sporting and cultural activities; animal training; production of shows, films, television films, televised broadcasts, reports, debates, video recordings, sound recordings; rental of videograms, films, sound recordings, video tapes; rental of motion pictures; rental of cinematographic projection apparatus, set-top boxes, encoding devices, radio and television sets, audio and video apparatus, cameras,</i></p>	<p><u>Class 41</u> <i>Entertainment services; providing non-downloadable films and television shows via transmission services; rental of audio books and books; rental of video and computer games; rental of digital content; electronic publication services; providing electronic publications; electronic publication lending services.</i></p>

<p><i>personal stereos, portable video players, theatre scenery and accessories therefor; production of shows, films, audiovisual, radio and multimedia programmes; film studios; organization of competitions, shows, lotteries, and games for education or entertainment; editing of audiovisual, radio and multimedia programmes, texts and/or images, fixed or animated, and/or sounds musical or not, and/or ringtones, for interactive or other use; organization of exhibitions, conferences, seminars for cultural or educational purposes; booking of seats for shows; services provided by news reporters; photographic reporting; videotaping; online game services (from a communication network), gambling services; casino services; editing and publishing of texts (other than advertising texts), multimedia, audio and video media (interactive discs, compact discs, storage discs); electronic publishing of books and periodicals online; publication and loan of books and texts (other than advertising texts); providing electronic publications online; providing cinema facilities; electronic desktop publishing; rental of set-top boxes and all kinds of audiovisual apparatus and instruments.</i></p>	
<p><u>Class 42</u> <i>Research and development of new products; technical research; expert reports of engineers, professional consulting in computers, telephony, video programmes, the Internet; services for operating search engines on the Internet;</i></p>	<p><u>Class 42</u> <i>Consultancy, advice, assistance, analysis, design, evaluation and programming services relating to computer software, firmware, hardware, and information technology; consultancy and advice relating to the implementation of computer</i></p>

<p><i>software design, development, updating and rental; consulting concerning computers and concerning computer rental; photographic services, namely taking photographs, photographic reporting; design and development of design of coding, decoding, access control systems for television and radio programmes, especially mobile users and all information transmission systems; design (development) of interactive programs and apparatus; services of technical establishment of standards (standardisation), services of standardisation, namely development (design) of technical standards for manufactured products and telecommunications services; weather forecasting services; research and development of electronic, computer and audiovisual, scrambling and access control systems in the field of television, computing, telecommunications and the audiovisual sector; electronic message authentication (research of origin) services; information on computing applied to telecommunications; computer formatting of texts and/or images, fixed for interactive or other use.</i></p>	<p><i>software, firmware, hardware, information technology and of data processing systems; rental of computer programmes and provision of information relating to information technology and integrated services digital network systems, including that provided by telecommunications networks, by online delivery and by way of the world wide web; updating and maintenance of software; integration of software, firmware and hardware systems.</i></p>
	<p><u>Class 45</u> <i>Licensing of computer software, firmware and hardware.</i></p>

28. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.⁴

29. In its written submissions in lieu, the opponent has set out in table form⁵ what it describes as “a non-exhaustive comparison showing the identical (or at the very least highly similar) nature of the contested goods and services against those of the earlier mark”. However, the table gives no specific comparison of the goods and services, rather, it lists each of the goods and services under each class, as covered by the respective marks.

30. In its written submissions dated 21 September 2022, the applicant submits that in the opponent’s submissions of the same date, the opponent relies upon its class 9 goods to attack only the applicant’s goods and services in classes 9 and 45. It submits that there is no pleading in the opposition of similarity of goods and services between the opponent’s class 9 goods and the applicant’s services in classes 38, 41 or 42 and it therefore requests that the opposition be decided in accordance with that pleading. I disagree. In the opponent’s aforementioned submissions, on page 4 of 14 under “3. Objection under Section 5(2)(b)”, the opponent confirms that “the opposition is directed against all goods/services applied for in Classes 9, 35⁶, 41, 42 and 45”, and this is further confirmed by way of the comparison table at Annex 1 of the submissions.

31. Given the nature of the broad terms covered by the opponent’s specifications, I do not intend to conduct a full comparison of the respective goods and services, but I proceed on the basis that at least some of the applicant’s goods and services in classes 9, 38, 41 and 42 are self-evidently identical to some of the opponent’s goods

⁴ Paragraph 29

⁵ See Annex 1 of the opponent’s submissions dated 21 September 2022.

⁶ I acknowledge that 35 rather than 38 has been recorded in this instance, but I take this to be a typographical error.

and services, and that there will be an overlap leading to some degree of similarity between the goods and services of the earlier mark and the applicant's services in Class 45.

The average consumer and the nature of the purchasing act

32. 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. (as he was then) described the average consumer in these terms:

“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”.⁷

33. 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*.

34. In its written submissions in lieu, the opponent submits that the average consumer of the goods and services at issue is the general public at large.

35. The respective goods and services are wide ranging and include, inter alia, sound and video recordings, software, and the provision of entertainment services. As submitted by the opponent, such goods and services are commonly purchased by members of the general public, although I acknowledge that some services may be targeted at business customers, e.g. software design and consultancy services.

⁷ Paragraph 60

36. The goods and services are sold through a variety of channels, from high street stores or via the internet, to specialist providers, with the frequency of purchase ranging from infrequent for the more specialised goods and services, to relatively frequently for the likes of CD-ROMs and DVDs and television streaming/transmission services. The selection process would be a combination of visual and aural; some consumers would seek information from written reviews and recommendations, particularly on the internet, whereas others would receive verbal advice from sales representatives, particularly in the case of tele-sales.

37. Accordingly, the level of attention will vary considerably, being low for the purchase of more everyday goods and services, whereas for the more bespoke goods and services, considerations such as technical reviews, price, quality, ease of use, suitability of the product and the reputation of the provider would be taken into account before purchasing those goods or accessing the services, leading to a higher degree of attention being paid by the consumer of those goods and services.

Comparison of marks

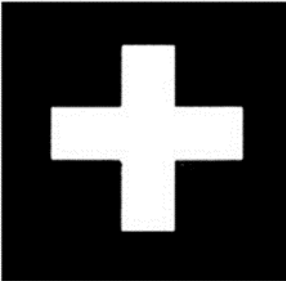
38. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, 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.”⁸

⁸ Paragraph 34

39. 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.

40. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	biblio+

41. The opponent submits that the element “biblio” in the contested mark is descriptive and lacks distinctive character and does not have the ability to distinguish the mark “biblio+” from the earlier mark, and that overall, the comparison of the trade marks shows there is a similarity between the marks on a visual, aural and conceptual basis.

42. In its submissions in lieu, the applicant has responded to the opponent's submissions that the consumer will perceive the contested mark as being formed of two elements, stating that it is an underlying principle that “the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details”. It submits that the word “biblio” will not be perceived as having any significant meaning in relation to the goods and services in question, and that it is an unusual “combining form” rather than a standalone word, which has no meaning when combined with the mathematical symbol “+”. It further submits that when comparing the respective marks, the average consumer will perceive them as being wholly dissimilar, and that the addition of the “+” symbol at the end of the contested mark is not enough in itself to result in a similarity between the marks.

Overall impression

43. The opponent's mark consists of a white, infilled cross/plus sign, presented as relatively thick lines of equal length and breadth, situated on a black square background. I consider that the background has been included as a contrast to the white cross/plus sign, and while that background would not go unnoticed, it is the cross/plus sign itself which plays the greater part in the overall impression.

44. The applicant's mark consists of the word "biblio" in lower case, directly followed by a "+" symbol, the whole being presented in a standard black typeface. There are no other elements to contribute to the overall impression, which therefore lies in the word and symbol combination.

Visual comparison

45. The only element in common between the competing marks is that they both contain a cross or "+" symbol. The symbol in the applicant's mark is preceded by the word biblio, to which it is conjoined. Another point of difference is the respective representations of the "+" symbol, which, due to the thickness of the lines in the opponent's mark, is likely to be perceived as a cross which is contrasted by the black background, as previously described, while in the applicant's mark it looks more like a mathematical 'plus' sign, rather than a cross *per se*. Considered as a whole, I find the contested marks to be visually similar to a very low degree.

Aural comparison

46. The word "biblio" in the applicant's mark would be articulated as three syllables BIB-LEE-OH, and I consider that a significant proportion of the average consumer would verbalise the "+" symbol as the word "PLUS", the whole mark being voiced as BIB-LEE-OH-PLUS. I note the opponent's submissions that if pronounced, the earlier mark would be described as "plus". In *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T- 424/10, the GC stated:

“45 The fact none the less remains that, contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHMI — Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 67).

46 A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.

47 In those circumstances, and given that the contested mark is a figurative mark lacking word elements, it cannot be concluded there is either a phonetic similarity or a phonetic dissimilarity between that mark and the earlier marks.”

47. I acknowledge the above case law, however, I agree with the opponent that in this particular case, the mark could be voiced as the word “PLUS” by the average consumer. To my mind, where the contested mark is pronounced as 4 syllables, BIB-LEE-OH-PLUS, and the earlier mark is articulated as the single syllable “PLUS”, being the only element in common with the applicant’s mark, the marks are aurally similar to a low degree.

Conceptual comparison

48. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]⁹.

49. To the average consumer, the earlier mark is likely to be perceived as either a cross or a plus sign, with no other immediate concept identifiable in relation to the

⁹ Paragraph 56.

goods and services being provided under the sign, although I acknowledge that to some consumers, the sign might bring to mind a flag. Where the sign is seen as either a cross or a flag, I consider that the mark is neither descriptive nor allusive of the goods and services. Where the mark is perceived as representing the word PLUS, I consider that it vaguely alludes to the relevant goods and services providing something in addition to what would usually be expected from such goods and services, although it is unclear what that might encompass.

50. The word “biblio-“ is defined by the Collins English Dictionary as a combining form, “indicating book or books”.¹⁰ The contested mark is likely to be understood by a significant proportion of consumers as being somehow connected to books, particularly in relation to services provided under class 41 of the application, e.g. *rental of audio books and books; electronic publication services; providing electronic publications; electronic publication lending services*. However, while the additional “+” (plus) sign would possibly be seen as alluding to something additional being provided, I do not consider the mark as a whole sends a clear conceptual message that would be immediately obvious to the consumer.

51. Given the above conclusions, I find that where the “+” element is perceived as representing a cross in the earlier mark, then the competing marks are conceptually dissimilar. I further find that where the “+” element in each of the competing marks is perceived as representing the word PLUS, and thus alluding to something extra, considering the indeterminate nature of any perceived additional benefits, the respective marks viewed as a whole are conceptually similar to only a low degree.

Distinctive character of the earlier marks

52. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

¹⁰ Sourced from the Collins English Dictionary online, accessed on 23 November 2022.

53. 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).”

54. Registered trade marks can possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a character of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has claimed that its mark is highly distinctive in view of its reputation and intensive use in the EU, and notably in France.

55. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, in the context of the assessment of distinctiveness for the purposes of registration, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the

relevant public in the territory in which registration is sought.¹¹ The same must apply to the assessment of the distinctive character of trade marks for the purposes of assessing whether there is a likelihood of confusion between them.¹² Therefore the territory relevant to the assessment of enhanced distinctiveness is the United Kingdom.

56. I will first consider the inherent distinctiveness of the earlier mark, before proceeding to assess the evidence of use provided in my considerations on whether the mark enjoys enhanced distinctiveness in relation to the UK market.

57. The mark is a simple geometrical figure consisting of two intersecting lines depicting a white cross or plus sign on a contrasting black background. I consider a cross or plus sign to be a common symbol used in trade by many different undertakings to denote something extra, and which would not be particularly memorable in the mind of many consumers. The mark in question has no embellishments to make it stand out from other, everyday illustrations of crosses or plus signs. As such, I find it to be low in inherent distinctive character.

58. Turning to the assessment of enhanced distinctiveness, I note that in its written submissions dated 12 August 2022, the applicant submits that most of the alleged evidence of use does not relate to the mark in the form as registered, or in a form in which it is accepted meets the test set out in Section 46(2) of the Act in relation to variant forms of use of the mark.¹³

59. In his witness statement, Mr Hellich Praquin states that the earlier mark has been used continuously in the EU since as early as 1984. He further states that Canal+ owns a large number of trade marks where the earlier mark is the key dominant feature appearing in each of the composite marks, with the following examples given to illustrate this:

¹¹ At [24].

¹² See *Matratzen Concord AG v OHIM*, Case T-6/01.

¹³ Section 46(2) of the Act states that "... use of a trade mark includes use in a form ("the variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it is registered...".




60. The majority of the accompanying exhibits reference CANAL, CANAL+ and the CANAL+ Groupe, as well as examples and variations of some of the above composite marks.

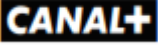
61. In its written submissions in lieu, the opponent refers to the *Rintish* decision issued by the CJEU on 25 October 2012(Case C-553/11):

“As to the purpose of Article 10(2)(a) of Directive 89/104, that provision, which avoids imposing a requirement for strict conformity between the form used in trade and the form in which the trade mark was registered, is intended to allow the proprietor of the mark, in the commercial exploitation of the sign, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned.”

62. Accordingly, it submits that in the present case, the composite marks are not likely



to alter the distinctive character of the element , which is present throughout. I cannot agree. To my mind, the cross/+ element in many of these marks does not play an independent, distinctive role, with the distinctive character of the respective composite marks lying in their overall presentation, with the differing word element in each of the marks playing the greater role to varying degrees, depending on the exact make-up of each of those marks.

63. Even allowing that some of the composite marks could be considered acceptable variant use, the evidence of use provided by way of the witness statement and exhibits is clearly targeted at a French speaking audience, with references to use in other territories, including Poland, Africa, Vietnam, and French Overseas Territories. Where the exhibits are shown in both French and English in the first instance, rather than only in French with an accompanying certified English translation, the majority of this evidence relates to CANAL+/ , rather than the cross/+ device alone, and in my view, the device as presented within these marks does not dominate or play a distinctive role and therefore neither of these marks constitutes acceptable variant use of the mark as registered.

64. There is little to show that the average UK consumer would be familiar with the mark through use in France or other French speaking territories. Furthermore, I consider that use of the mark in partnership with the French online music streaming service Deezer to be incidental to the UK market, rather than being expressly targeted towards the UK consumer. Regardless of whether the distinctive character of the mark has been enhanced through use in other countries, overall, I do not consider that the evidence filed is sufficient to show that the earlier mark has an enhanced level of distinctive character in the UK.

Likelihood of confusion

65. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

66. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

67. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

68. Earlier in this decision, given the nature of the broad terms covered by the opponent’s specifications, I have proceeded on the basis that at least some of the applicant’s goods and services are identical to some of the opponent’s goods and services.

69. I considered the purchasing process of those goods and services would be a combination of visual and aural, where the degree of attention paid by the average consumer, being both the general public and business customers, would range from low for everyday goods such as DVDs to a higher degree for more bespoke goods and services.

70. I found that visually, the competing marks were similar to a very low degree, and that aurally, where the consumer verbalises the earlier mark as the word PLUS and the contested mark as BIB-LEE-OH-PLUS, the marks are aurally similar to a low degree. Conceptually, I found that where the earlier mark is seen as a cross, the competing marks are dissimilar, and where the opponent’s device and the “+” element of the applicant’s mark are both perceived as representing the word PLUS, and thus alluding to the provision of something extra, in view of the indeterminate nature of any perceived additional benefits, the respective marks are similar to only a low degree. I also found the earlier mark to be low in inherent distinctive character, with no evidence to suggest that this has been enhanced through use in the UK.

71. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, the average consumer will notice and recall the differences between the marks. I do not consider there is any likelihood of direct confusion as those differences are too

great for confusion to arise. I find this even where the respective goods/services are considered to be identical, and where the average consumer pays a low degree of attention to the purchasing process, which offsets a lesser degree of similarity between the marks.

72. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

73. Keeping in mind the global assessment of the competing factors in my decision, and in particular the low degree of visual, aural and conceptual similarity between the marks, and the low distinctive character of the common element, being the cross/“+” symbol, it is my view that it is unlikely that the average consumer would assume that there is a connection between the parties. I acknowledge that the categories listed by Mr Iain Purvis Q.C. are not exhaustive, however, I do not see anything which would lead the average consumer into believing that one mark is a brand extension of the other, or assume that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

74. The opposition under section 5(2)(b) fails.

CONCLUSION

75. The opposition has failed. As the outcome is no likelihood of confusion, the question of whether or not the earlier trade mark has been used is irrelevant to the outcome. Subject to any successful appeal, the application may proceed to registration.

COSTS

76. The applicant has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. Applying the guidance in that TPN, I award the applicant the sum of £1300, which is calculated as follows:

Considering the notice of opposition and preparing a counterstatement:	£300
Considering and commenting on the other party’s evidence:	£600
Preparing written submissions:	£400
Total:	£1300

77. I therefore order GROUPE CANAL+ to pay Bibliotheca Limited the sum of £1300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 5th day of December 2022

Suzanne Hitchings
For the Registrar,
the Comptroller-General