

O/0163/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3459778
BY IDEAS + CARS LTD
TO REGISTER AS A SERIES OF TRADE MARKS:**



R
THE RACE

IN CLASSES 9, 25, 28, 32, 35, 38, 41, AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 420881
BY AF RACING AG**

Background and pleadings

1. On 21 January 2020, **Ideas + Cars Ltd** (“the applicant”) applied to register the series of trade marks displayed on the cover of this decision in the UK, under number **3459778**. As the only difference between the marks in the series is the reverse use of black and white, I will refer to them in the singular (“the contested mark”) unless it becomes necessary to distinguish between them. The contested mark was published in the Trade Marks Journal for opposition purposes on 6 March 2020. Registration is sought for the following goods and services:

Class 9: Virtual reality headsets; headphones; computer keyboards, mouse (mice) and mouse pads; video game software; virtual reality software; headsets.

Class 25: Clothing, headwear and footwear; gloves.

Class 28: Golf gloves; Golf tees; Golf ball markers; Golf divot repair tools.

Class 32: Joysticks, controllers, computer mice and computer keyboards adapted for playing video games; headsets adapted for playing video games; steering wheels and pedals for playing video games; gloves for games; Games, toys and playthings; video game devices, apparatus and machines; apparatus for playing games; gaming consoles; electronic devices for virtual reality gaming; parts and accessories therefor.

Class 35: Energy drinks; non-alcoholic beverages.

Class 38: Broadcasting films and TV documentaries; computer aided transmission of messages and images; video-on-demand transmission; transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet.

Class 41: Organisation of entertainment and entertainment events; organization of competitions; production of films and TV documentaries; videotaping; game services provided on-line from

a computer network; games equipment rental; computer and video game amusement and entertainment services; providing information about tournaments, events, and competitions in the video game field via a website; rental of video game apparatus, video game consoles and video games.

Class 42: Computer software design.

2. On 30 July 2020, **AF Racing AG** (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b)¹ of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods and services of the application.

3. In support of its claim the opponent relies upon the following marks:²



European Union Trade Mark (EUTM) number: **015750078**

Filing date: 15 August 2016

Registration date: 16 March 2017

Priority date: 17 February 2016³

(“the first earlier mark”)

¹ The opponent originally sought to rely upon additional grounds, namely, s.5(3) and s.5(4)(a). However, due to the opponent’s failure to provide evidence these additional grounds were struck out by the registrar. Its claim is now based solely on s.5(2)(b).

² Although the UK has left the EU and the transition period has now expired, EUTMs, such as the earlier marks, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

³ Priority is claimed from Swiss Trademark No. 00060/2016



EUTM number: **015750086**

Filing date: 15 August 2016

Registration date: 3 April 2017

Priority date: 17 February 2016⁴

("the second earlier mark")



EUTM number: **015752538**

Filing date: 15 August 2016

Registration date: 28 February 2017

Priority date: 17 February 2016⁵

("the third earlier mark")

⁴ Priority is claimed from Swiss Trademark No. 00061/2016

⁵ Priority is claimed from Swiss Trademark No. 00063/2016



EUTM number: **017891323**

Filing date: 24 April 2018

Registration date: 27 June 2019

Priority date: 1 November 2017⁶

(“the fourth earlier mark”)

4. For the purposes of the opposition, the opponent relies upon the goods and services in classes 9, 35, 36, 41 and 43 set out in the Annex to this decision.

5. Given the respective filing dates, the opponent’s marks are earlier marks, in accordance with section 6 of the Act. However, as they have not been registered for five years or more at the filing date of the application, they are not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of the goods and services identified without having to establish genuine use.

6. In its notice of opposition, the opponent argues that the respective goods and services are either identical or similar, giving rise to a likelihood of confusion, including the likelihood of association.

7. The applicant filed a counterstatement denying that the goods and services at issue are identical or similar, and denying that the marks are similar. As such, it disputes that there is a likelihood of confusion.

⁶ Priority is claimed from Swiss Trademark No. CH63693/2017

8. The opponent is professionally represented by Urquhart-Dykes & Lord LLP, whereas the applicant is professionally represented by Wynne-Jones IP Limited. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. Neither party elected to file evidence. However, the applicant filed written submissions in lieu of a hearing. Whilst I do not intend to summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

9. Although the UK has left the EU, 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

Decision

Section 5(2)(b)

10. Sections 5(2)(b) and 5A of the Act read 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”.

“5A 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.”

Case law

11. 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 OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

12. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

13. 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.

14. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,⁷ 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 für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or

⁷ Case T-133/05

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

17. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was), sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

18. The goods and services to be compared are those in paragraph 1 and the Annex to this decision.

19. I note that many of the opponent’s terms relied upon include a term followed by the words “in particular”. For example, in the first earlier mark the term, “*Advertising, in particular for promoting motor racing activities and motor racing teams*”. Unlike when the phrase “namely” is used which narrows the term in the specification, “in particular” simply provides an example of the types of goods or services included within the term. As such, under the principle of notional use, the above example will be interpreted as referring to advertising in general, rather than advertising only for promoting motor racing activities and motor racing teams.

Class 9

Computer keyboards, mouse (mice) and mouse pads; Headphones; headsets; Virtual reality headsets

20. The opponent claims the applicant’s above terms are similar to its terms “Entertainment; Sporting and cultural activities, in particular arranging and conducting of motor racing activities, motor racing and motor sport events, arranging and conducting of events” under the first and second earlier marks, and similar to its terms “Entertainment; athletic and cultural activities, in particular organizing and conducting motorsports activities, racing and motorsports events, organization and conducting of events” under the fourth earlier mark. The applicant’s above terms can all be described as computer equipment or computer accessories. They differ in nature, method of use and intended purpose as these goods are used specifically for users to interact with the computer rather than to provide the entertainment itself, whereas entertainment services usually involve an event, performance or activity that people would purchase tickets or a subscription to view, which is designed to amuse or bring enjoyment to the user. The trade channels will be different as computer equipment is hardware that

would be manufactured and sold by a computer or electrical store, whilst entertainment services will be provided by entertainment companies and sold through subscriptions or ticket sales. Users may overlap but only on a generalised level. The goods and services are not in competition with each other as hardware accessories do not themselves provide entertainment. Neither are they complementary in nature as, although headphones may be used to listen to entertainment, they are not important or essential to the provision of entertainment services. Furthermore, consumers would not reasonably believe that they were produced by the same undertaking as this would not be typical of trade. Therefore, I find that the goods and services are dissimilar.

21. The opponent also argues that its term “electronics for vehicles, namely...electronic vehicle navigation systems, electrical and electronic wheel and control devices and vehicle dashboard instruments, wires for electrical signal transmission in vehicles, cable harnesses for vehicles” (relied on by its fourth earlier mark) would also include headsets and headphones in the applicant’s specification as motorcycles would be included in vehicles and it is commonplace for headphones and headsets to form part of a motorcycle electronic navigation system.⁸ The opponent’s terms involve electronics for vehicle navigation, signal transmission, or vehicle control. I acknowledge the Nice classification explanatory notes⁹ state that class 9 covers “apparatus and instruments for controlling and monitoring aircraft, watercraft and unmanned vehicles, for example, navigational instruments, transmitters, compasses for measuring, GPS apparatus, automatic steering apparatus for vehicle”.¹⁰ It follows from this explanation that the opponent’s terms would not apply to an electronic navigational system on a manned motorcycle as suggested by the opponent; instead, the term would cover electrical GPS and electrical transmission for the purposes of locating vehicles or for automated steering. Furthermore, in my opinion, the natural and ordinary meaning of the opponent’s term would not include headsets and headphones. Therefore, there would be no connection between the opponent’s terms and the applicant’s headphones and headsets. These goods are different in nature, method of use and intended purpose as the applicant’s goods are GPS apparatus used to detect vehicle location and automatically navigate vehicles without them

⁸ Form TM7, page 22

⁹ www.wipo.int/classifications/nice/en/

¹⁰ www.wipo.int/classifications/nice/en/class9

having to be manned. Headphones, on the other hand, are worn to allow users to listen to audio. The goods have different trade channels, as headphones and GPS apparatus would be manufactured by different companies and sold through separate outlets. The goods are not complimentary as headphone and headsets are not essential for the use of GPS vehicle navigation systems, nor are they in competition. The users would also differ. Overall, I find that these goods are dissimilar.

Video game software; virtual reality software

22. The opponent claims that its services (under the first and second earlier marks), “entertainment; sporting and cultural activities, in particular arranging and conducting of motor racing activities, motor racing and motor sport events, arranging and conducting of events” encompass and include motor racing esports, virtual reality motor racing and computer game motor racing entertainment, competitions, events and activities. The opponent makes the same argument for its services “entertainment; athletic and cultural activities, in particular organizing and conducting motorsports activities, racing and motorsports events, organization and conducting of events” under its fourth earlier mark. I acknowledge that gaming is a form of entertainment; however, the application is for video game software and virtual reality software as a good, therefore the physical nature differs to that of entertainment services. The method of use differs as the entertainment services require an online platform to arrange virtual activities and events such as competitions for challenging people globally. The goods, however, are for use with a computer or console, and I accept that the intended purpose of the goods and services may overlap insofar as they are both intended for enjoyment and amusement of the user. Entertainment could possibly include a service that streamed games or virtual reality software or allowed users to interact with each other whilst playing with the games/virtual reality software. As a result, there would be a degree of complementary as the software is essential to the entertainment services described and it would be reasonable for consumers to believe that the goods and the entertainment services relating to those goods were provided by the same or connected undertakings. Trade channels would overlap to the extent that they may be produced by the same company, however the goods and services would be sold in different ways. The goods would be sold in video games stores or online, whereas the services would most likely be purchased through an online

subscription. Users would also be the same. Overall, I find that the goods and services are similar to a low degree.

Class 25

Clothing, headwear and footwear, gloves.

23. The opponent states that the applicant's goods in class 25 are similar to the opponent's services "as it is commonplace and expected that organisers and participants in sporting events, especially professional sporting events, produce and sell clothing as part of the merchandise."¹¹ In light of this, I will compare the opponent's services "entertainment; sporting and cultural activities [...]" under the first and second earlier marks and "entertainment; athletic and cultural activities [...]" under the fourth earlier mark. Taking into consideration notional use, I accept that manufacturers of sports clothing, headwear or footgear tend to promote the practicing of sports and may be organisers or sponsors of sporting events.¹² There is an obvious difference in nature, method of use and intended purpose as the applicant's goods are to be worn on the body, head, or feet, to cover the body, whilst the opponent's services are to hold activities and events for users to participate in or view the participation of others in sporting and cultural activities. However, the goods and services may share the same trade channels; the goods sometimes being manufactured by the same company that would organise or sponsor a sporting or cultural activity, whether they are sold at the event or sold at sports clothing stores. The same end users would also be targeted. I do not believe that the goods and services are complementary in nature as the goods are not important or indispensable to holding of sporting and cultural activities. The same applies to gloves in class 25 which includes gloves for driving, motorcycling, cycling and horse riding. Applying the same approach to gloves as to clothing above, it follows that some companies manufacturing and offering these gloves would also look to promote the practice of the related activities by sponsoring and organising related events. Overall, I find that there is a low level of similarity between these goods and services.

¹¹ Form TM7, pages, 16, 19 and 22

¹² Confirmed in the Board of Appeal decision (R 887/2018-2), paragraph 38.

Class 28

Joysticks, controllers, computer mice and computer keyboards adapted for playing video games; headsets adapted for playing video games; steering wheels and pedals for playing video games; Gloves for games; video game devices, apparatus and machines; apparatus for playing games; gaming consoles; electronic devices for virtual reality gaming; parts and accessories therefor.

24. The applicant's above terms can all be described as gaming apparatus or gaming equipment/accessories. The opponent argues its class 41 services (under its first, second and fourth earlier marks) includes virtual motor racing entertainment and events, and motor racing esports entertainment, events and activities,¹³ with which I agree. However, gaming apparatus is used by gamers for the purpose of enabling interaction with gaming software, whilst the opponent's e-sport services encompassed under its terms "entertainment; sporting and cultural activities and events" are entertainment services hosted in the virtual world. Consequently, they have a different nature, method of use and intended purpose. The trade channels will differ as companies manufacturing and selling the gaming apparatus and equipment will not be the same as those offering services for sporting and cultural activities and events, even virtually. Furthermore, the goods and services are not complementary as per the established caselaw; despite the goods being important to allow the gamers to access the opponent's services, consumers are unlikely to believe that the goods and services will originate from the same undertaking as it is not typical in trade. Neither would they have a competitive role as the entertainment and activities services would not satisfy the need for the hardware goods and vice versa. Accordingly, I find that the goods and services are dissimilar.

Games, toys and playthings

25. The applicants applied-for terms would not be covered under the opponent's class 41 services under the first, second, and fourth earlier marks. To do so would construe the earlier services beyond their ordinary, natural, and core meaning. I have not interpreted games to include video games, as these are instead found in class 9, but to encompass physical games in line with toys and playthings. As such, the physical

¹³ Form TM7, pages 16, 19, 23

nature of the goods and services clearly differs. The method of use also differs as the user will directly interact with tangible games and toys, whereas typically entertainment will be enjoyed by watching an event or performance. Nevertheless, the intended purpose of the games/toys and entertainment services overlap to the extent that they are both for the user's enjoyment. The trade channels would differ as companies that manufacture and produce games and toys to sell would not typically provide entertainment or sporting and cultural activity services, although there may be some overlap in limited circumstances such as where a toy is created based on a television show or event. The goods are not complementary as games and toys are not important or indispensable to the use of the opponent's services and vice versa. Neither are the goods and services in direct competition with each other, although users may choose to play with a toy or game rather than watch a television show, there are a number of activities that users could participate in rather than watch television, such as reading a book. Moreover, users would only overlap on a generalised level. Consequently, I find that the goods and services are not similar.

Class 32

Energy drinks; non-alcoholic beverages.

26. The opposition to the applicant's class 32 goods is based on its third earlier mark, namely its class 43 terms "services for providing food and drink, in particular preparation and providing of food and drink (catering); providing food and drink". Although the nature and method of use are clearly not the same, there will be an overlap in the intended purpose insofar that they quench thirst or are for enjoyment. There is an overlap in distribution channels as companies that offer the services may also produce the goods. There is an element of competition between the goods and services in that consumers can buy these goods from a café, restaurant or bar (which all fall under the opponent's broad term), or they can be purchased in supermarkets and consumed at home. There is also a degree of complementarity as the goods are essential to the supply of the opponent's services, and in some circumstances, they may be provided by the same undertaking. Furthermore, the users will be the same. Overall, I find that there is a medium level of similarity between these goods.

Class 35

Marketing, organization of trade fairs for commercial or advertising purposes; promotion of goods and services through sponsorship of sports events.

27. I agree with the opponent's view¹⁴ that marketing is a specific step within advertisement. Advertising uses data and research collected through marketing to promote goods and services for companies. Services for the "promotion of goods and services through sponsorship of sporting events" is also a type of advertising as it is publicising goods or services, as is "organisation of trade fairs for commercial or advertising purposes". The above terms are all therefore particular examples of types of advertisement, as such, they would be encompassed by the opponent's broad term "advertising" relied on under its first and third earlier marks. Accordingly, I find that the goods are *Meric* identical.

Class 38

Broadcasting films and TV documentaries; Video-on-demand transmission; transmission of videos, movies, [...] games, user-generated content, audio content, [...].

28. The nature and intended purpose of the above terms and the opponent's "entertainment" services (relied on under the first, second and fourth earlier marks) differs, as the applicant's services are to broadcast content that has already been produced and the opponent's services are to produce entertainment such as films and television documentaries to be broadcast. However, it is not uncommon within the broadcasting industry for mainstream networks (such as Netflix, Amazon Prime, BBC, ITV, Sky, etc.), to be responsible for producing the entertainment/content they broadcast or transmit as well as the broadcasting or transmission services themselves. As a result, trade channels would overlap. There is also a degree of complementarity between the services as they are dependent on one another to reach viewers. Overall, I consider the services to have a low level of similarity.

¹⁴ Form TM7, page 21, continuation sheet 3

Computer aided transmission of messages and images; transmission of [...] pictures, images, text, photos, [...] and information via the Internet.

29. The applicant's above services are all transmission services absent of any link to entertainment. These are services which allow users to communicate and send information, messages or pictures. These services differ in nature, method of use and intended purpose to the opponent's "entertainment" services, which are to produce entertaining content for users to view. The services would not be complementary, as the transmission services do not include the transmission of entertainment. The trade channels would differ as companies that provide entertainment services would be unlikely to provide transmission services for information and images that is not encompassed under entertainment. There is no reason why the consumer would consider the provider of the transmission services to be responsible for the images and information itself. Users may overlap but only on a generalised level. Consequently, the services are dissimilar.

Class 41

Organisation of entertainment and entertainment events; organization of competitions; production of films and TV documentaries; videotaping; game services provided on-line from a computer network; computer and video game amusement and entertainment services.

30. All of the above applied for services would be encompassed under the opponent's "entertainment" services found within the specifications of the first, second and fourth earlier marks. In relation to videotaping as a service, this is a type of video production that is also include under entertainment services. Therefore, I find these services to be *Meric* identical.

Games equipment rental; rental of video game apparatus, video game consoles and video games.

31. The applicant's services allow customers to rent gaming goods, such as, equipment and video games for a monthly fee. These services differ in nature to the opponent's "entertainment" services which includes providing online gaming services.

The method of use also differs as users engage with the rental services to obtain gaming equipment and software whilst the opponent's entertainment services are to be viewed or in the case of gaming interacted with online. The intended purpose of the rental services is to provide gaming equipment and software to users, whereas the applicant's services are to provide entertainment, in the case of gaming, online. The trade channels are different as companies that offer rental services will not also provide the online gaming entertainment. The services are not competitive in nature as the rental services for gaming equipment and software cannot be satisfied by entertainment services such as online gaming themselves and vice versa. Furthermore, although the services can be used together, they are not indispensable to one another, in any event, there is no reason for consumers to believe that providers of rental services would also provide the online gaming entertainment. Users would overlap to a certain degree, but this is not enough to engage similarity; as such, I find that the services are dissimilar.

Providing information about tournaments, events, and competitions in the video game field via a website

32. These services would be used by gamers who want to find out what gaming events are going to take place. The users will be the same as those for the opponent's "entertainment" services, such as, online gaming services. There will be an overlap in the nature of service as they may both relate to gaming tournaments. Trade channels will also overlap as the information regarding video game tournaments and competitions is likely to be provided by the same company that runs the online gaming services. The services are complementary as information about these events is important to the provision of the events themselves and it is reasonable for consumers to believe that the same company would provide both these services. However, the services method of use and intended purpose clearly differ; information services are read by the user to obtain details about the gaming events, whereas gamers interact directly with the gaming services for the purpose of enjoyment and entertainment. Furthermore, they do not share a competitive role. Overall, I find the services similar to a medium degree.

Class 42

Computer software design

33. The opponent argues, “this [computer software design] is similar to the Class 41 services of the Opponent’s registration as it would include design of motor racing computer games software and the motor racing virtual reality software, which are similar to the Opponent’s Class 41 services insofar as they would coincide in respect of the producer, relevant public and are complementary.” However, although the opponent’s “entertainment” services (in class 41 of the first, second and third earlier mark) may use software in order to provide virtual gaming entertainment, this is an entirely different service to the applicant’s “computer software design” services. The opponent’s services are to supply entertainment, such as, online gaming services, whereas the applicant’s services are to produce software. Consequently, the nature, method of use and purposes of the services are different as users of the opponent’s services will view and interact with these services for the purpose of being entertained, whereas users of the applicant’s services will instruct a company to design software that suits their requirements. The trade channels also differ as providers of computer software design services are unlikely to also provide entertainment services, even for online gaming services. The users of the online gaming entertainment services will be members of the general public who wish to be entertained, whilst the users of the computer software design services are most likely to be businesses who want software produced and supplied for a particular purpose. Despite software being used by entertainment services and being the product of computer software design companies, without evidence to the contrary, there is no reason why consumers would believe that companies designing the software would also provide the entertainment services. Neither are the respective services in competition with each other as one cannot perform the role of the other and vice versa. Taking into account the differences between the services, I find no similarity between them.

34. For the avoidance of doubt, I have also considered the other goods and services relied upon across the specifications of the earlier marks and none puts the opponent in a more favourable position.

35. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against goods of the application that I have found to be dissimilar, namely:¹⁵

Class 9: Computer keyboards, mouse (mice) and mouse pads; Headphones; headsets; Virtual reality headsets

Class 28: Joysticks, controllers, computer mice and computer keyboards adapted for playing video games; headsets adapted for playing video games; steering wheels and pedals for playing video games; gloves for games; Games, toys and playthings; video game devices, apparatus and machines; apparatus for playing games; gaming consoles; electronic devices for virtual reality gaming; parts and accessories therefor.

Class 38: Computer aided transmission of messages and images; transmission of [...] pictures, images, text, photos, [...] and information via the Internet.

Class 41: Games equipment rental; rental of video game apparatus, video game consoles and video games.

Class 42: Computer software design

36. For clarity, the remaining goods and services in the application are either identical or have some degree of similarity with goods or services under each of the earlier marks.

The average consumer and the nature of the purchasing act

37. 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

¹⁵ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

38. 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 then was) 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.”

39. In relation to the goods at issue the average consumer is likely to be the general public who is likely to purchase the goods rather frequently for regular use. The goods are likely to vary in price depending on their nature, from relatively inexpensive for energy drinks or non-alcoholic drinks to moderately expensive for particular articles of clothing or video games. Overall, the purchasing process will not require an overly considered thought process. However, when selecting the products, consumers will consider factors such as, the cost, quality, and specification of the goods. Taking the above factors into account, I find that, overall, the general public will demonstrate an average level of attention in respect of these goods. The goods are typically sold in retail outlets such as gaming stores, clothing stores, or supermarkets, or their online equivalents, where the goods will be self-selected. In these circumstances, visual considerations would dominate, though I do not discount aural considerations entirely, as it is possible that consumers will have conversations with sales assistants or receive word of mouth recommendations. In the case of energy drinks and non-alcoholic beverages, these will also be sold in hospitality environments such as bars, restaurants and cafes. In these environments, there may be an aural component to the selection process, such as requests to serving staff. However, even where the goods are ordered in this way, the selection process would still be in the context of a

visual inspection of the goods or a drinks list, for example, prior to the order being placed. As such, overall, the purchasing process would be primarily visual in nature, though I do not discount that aural considerations will play their part.¹⁶

40. With respect to the services, it is necessary to identify two groups of relevant consumers, namely, members of the general public and business users.

41. In relation to services for the general public, the cost and frequency of purchase will vary depending on whether it is a one-off event for which tickets need to be purchased or a regular subscription for frequent use and enjoyment. I find that the purchasing process is not likely to be merely casual, with consideration given to factors such as the cost, quality, range of content available, suitability, and in some cases the location. Taking everything into account, it is my view that consumers will demonstrate an average level of attention when purchasing these services. The services are likely to be purchased directly from the service provider after viewing information in specialist magazines, brochures or on the internet. The services are likely to be purchased on a one-off basis through ticket providers, mostly online, or via a regular subscription for these services. In these circumstances, visual considerations would dominate, however, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of services would involve radio advertisement, word of mouth recommendations or conversations with representatives over the telephone.

42. In relation to services for business users, in particular, marketing, advertising and promotional services or broadcasting and transmission services, the cost of these services will vary depending on the range of services or the service package required by business users, as will the frequency at which the services are purchased. The purchasing process will be a careful consideration, as for example, marketing, advertisement and promotion for commercial purposes are naturally a very important element of any business, and business users will be alert to the major consequences these services could have on their business. Overall, I consider consumers from the business community will demonstrate an above average level of attention. These services are likely to be purchased directly from the service provider after viewing information online or at trade show events or from sales representatives. I find that

¹⁶ *Simonds Farsons Cisk plc v OHIM*, Case T-3/04

visual considerations would dominate, however, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of services would involve discussions with sales representatives or word of mouth recommendations.

Distinctive character of the earlier marks

43. The distinctive character of a trade mark can be measured only, first, by reference to the goods in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. 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).”

44. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods or services will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood of confusion.

45. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

The first, second and third earlier marks

46. These earlier marks consist solely of a figurative element; a slanted impression of the letter “R” split into two pieces, with an incomplete circle surrounding it. The device appears in a light blue colour with the long diagonal straight line in the letter “R” presented in the colour dark grey, red or light green within the respective earlier marks. Nothing turns on the difference in colour between the first, second and third earlier marks as all of their constituent parts are otherwise the same. The earlier marks will be seen as a device depicting a highly stylised letter R. In my opinion the distinctive character lies in the figurative element as a whole given that the letter “R” is not particularly distinctive on its own. Furthermore, without any evidence or submissions to the contrary, the device does not seem to have any connection to the goods or services relied on. Overall, it is considered that the first, second and third earlier marks possess a medium degree of inherent distinctive character.

The fourth earlier mark

47. The fourth earlier mark also contains the same figurative element but with an orange line replacing the dark grey/red/light green line described above. The fourth earlier mark also contains the word “REFORGED” positioned below the figurative element, presented in standardised, dark grey font. The figurative element would be viewed the same as in the first, second and third earlier marks. As for the word “REFORGED”, consumers will identify the word “forge” and apply the dictionary meaning “to make or produce something, especially with some difficulty”¹⁷ i.e. to forge a close working relationship between countries or to forge a new career path. As such,

¹⁷ <https://dictionary.cambridge.org/dictionary/english/forge>

consumers will understand the word “REFORGED” to have recreated or re-established something again, maybe after a setback. The mark does not appear to have any connection to the goods or services relied on. The distinctive character of the mark lies in the figurative element (as a whole) and the word element equally. Taking all the above factors into account, the fourth earlier mark enjoys a medium degree of inherent distinctive character.

Comparison of the marks






48. It is clear from *Sabel BV v. Puma AG*¹⁸ that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] 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.”

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

50. The respective trade marks are shown below:

¹⁸ Case C-251/95, paragraph 23

First earlier mark	Contested mark
	 
Second earlier mark	
	
Third earlier mark	
	

Fourth earlier mark	
	

Overall impressions

The first, second and third earlier marks

51. The earlier marks consist solely of a device, depicting a diagonal impression of the letter “R” split into two pieces, with an incomplete circle surrounding it. The device appears in light blue with the long diagonal straight line within the “R” presented in either dark grey, red or light green. As discussed above the colour difference makes no material difference to the assessment of these earlier marks. The overall impression of the marks is dominated by the device element as a whole.

The fourth earlier mark

52. The fourth earlier mark encompasses the word “REFORGED” in standardised, dark grey font. Sat above is the same device element found in the first, second and third earlier marks, but with an orange line replacing the one in dark grey/red/light green. Although the device element is the largest element within the fourth earlier mark, the attention of consumers is naturally drawn to parts of marks that are easily read. Therefore, the overall impression resides in the device element and the word “REFORGED” in roughly equal measure, however, the device element may have slightly more impact given its size and positioning.

The contested mark

53. The contested mark comprises the words “THE RACE” with the crossbar in the letter “A” missing. However, in my opinion this will not prevent consumers from identifying the symbol as the letter “A”, especially in the context of the surrounding letters/word. Due to the letter “R” in the word element, some consumers, upon viewing the mark as a whole will perceive the device as representative of the letter “R” split on an angle with a line missing. In the first mark of the series the words and figurative element appear in white on a black square background, whereas in the second mark of the series the colours are reversed, with black words and a black device on a white square background. In my view, the colour reversal in the applied for series is not a material change that affects the overall impression of the mark. The overall impression of the mark predominantly lies in the words “THE RACE”, the element of the mark that consumers can read. Nevertheless, given the size and positioning of the figurative element, it also provides a significant contribution.

Visual comparison

The first, second and third earlier marks and the contested mark

54. The competing marks are visually similar as they both contain device elements with a diagonal impression of the letter “R. However the devices differ, in the earlier marks the device element is clearly the letter “R” split into two pieces, surrounded by an incomplete circle, whilst in the contested mark, the letter “R” is less clear as the first line of the letter “R” is missing. Furthermore, the contested mark also contains the words “THE RACE” with the crossbar missing from the letter “A”, however, as discussed above this will still be identified by consumers as representing the letter “A”. The marks are also presented in different colours, the earlier marks are presented in light blue and either dark grey, red or light green, whereas the contested mark appears in black and white. Moreover, the contested mark is located on a square background whilst the first earlier mark gives the impression of a circular frame. Taking into account the overall impressions, I find that the competing marks are visually similar to between a low and medium degree.

The fourth earlier mark and the contested mark

55. The fourth earlier mark has the same figurative element as the first earlier mark, with the exception of an orange line replacing the dark grey/red/light green line; therefore, the same differences and similarities apply in relation to the device element as with the first, second and third earlier marks. In addition, the fourth earlier mark has the word “REFORGED”, whereas the contested mark comprises two words “THE RACE”. The words within the respective marks are both in upper case and in standardised font, with the exception of the letter “A” in the contested mark. They overlap insofar as they both contain the letters “E” and “R”; however, these letters appear in different sequences within the respective marks. The colours also differ as the fourth earlier mark appears in light blue, orange and dark grey, whilst the contested mark is presented in black and white. Overall, I find that the marks are similar to a low degree.

Aural comparison

The first, second and third earlier marks and the contested mark

56. In my opinion, consumers will make no attempt to articulate the device element in the contested mark as it will be viewed as decorative. Therefore, the contested mark consists of two syllables i.e. “THE-RACE” as consumers will recognise the letter “A” in race. For the first, second and third earlier marks, consumers may attempt to verbally identify the marks somehow; noticing the highly stylised letter “R” within the device element they will endeavour to articulate this letter. Therefore, the earlier marks have a single short syllable. Consequently, none of the syllables within the respective marks overlap. Taking all the factors into account, the competing marks are aurally dissimilar.

The fourth earlier mark and the contested mark

57. For the same reasons provided above the contested mark will consist of two syllables “THE-RACE”. The fourth earlier mark contains the same figurative device element as the first, second and third earlier marks. However, the fourth earlier mark has an obvious textual element in the word “REFORGED” which has two syllables i.e. RE-FORGED. This will allow consumers to easily verbalise the mark, and

consequently, in my opinion, consumers will not look to articulate the highly stylised letter “R” within the device element. Although both marks consist of two syllables, the marks do not share any identical syllables. Accordingly, the marks are aurally dissimilar.

Conceptual comparison

The first, second and third earlier marks and the contested mark

58. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹⁹ In the first, second and third earlier marks, the device element will be recognised as a highly stylised letter “R”, which provides no concept other than its existence as a letter in the alphabet. In the contested mark, the word “RACE” will be understood as a competition where entrants compete to determine which is the fastest to cover a set course. The word “RACE” is preceded by “THE”, which will encourage consumers to conceptually interpret the mark as a definitive article. I acknowledge that the figurative element with the contested mark may also be perceived by consumers as the letter “R”. Consequently, the presence of the letter “R” (which is conceptually neutral) is the only overlap. Bearing in mind my assessment of the overall impressions, I find that the marks are conceptually dissimilar.

The fourth earlier mark and the contested mark

59. The conceptual message for the contested mark will be the same as that described for the comparison against the first, second and third earlier marks. As for the fourth earlier mark, the conceptual meaning in the figurative element will be the same as discussed above. However, the fourth earlier mark also contains the word “REFORGED”. This will be understood as meaning something has been recreated or re-established again as detailed above. As the only overlap lies in the letter “R”, which as discussed is effectively neutral, overall, I find that the marks are conceptually dissimilar.

¹⁹ *Ruiz Picasso v OHIM* [2006] E.T.M.R 29.

Likelihood of confusion

60. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor 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 also necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be aware of the fact 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.

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

62. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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).”

63. These examples are not exhaustive but provide helpful focus.

64. Furthermore, in *Liverpool Gin*,²⁰ Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

²⁰ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

The first, second and third earlier marks and the contested mark

65. I have found that the applicant's goods and services are either identical, or similar to between a low and medium degree to the services of the first and second earlier marks, and either identical or similar to a medium degree to the services of the third earlier mark. I have found that the average consumer of the goods will be the general public who will pay an average degree of attention. Whilst the average consumer of the services will be both the general public, who will pay an average level of attention, and business users who will pay an above average level of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations, especially for drinks goods which will be ordered verbally within the hospitality environment. The overall impressions of the first, second and third earlier marks is dominated by the figurative mark as a whole, whereas the overall impression of the contested mark lies predominantly in the words "THE RACE" with the figurative element also providing a significant contribution. I have found that the earlier marks and the contested mark are visually similar to between a low and medium degree, and aurally and conceptually dissimilar. I have also found that the first, second and third earlier marks have a medium degree of inherent distinctive character.

66. I acknowledge that both the earlier marks and the contested mark contain a device which is on a diagonal slant. In the earlier marks, the device clearly represents the letter "R" which is split into two pieces along the diagonal angle. In the contested mark, due to the letter "R" in the word element, consumers when viewing the mark as a whole, may also see the device in the contested mark as representative of the letter "R", split on that same angle, but with the first part missing. However, even where this is the case, consumers will also notice the differences in the stylisation of the device elements, such as the incomplete ring surrounding the letter "R" in the earlier marks. Further, the words "THE RACE" beneath the figurative element in the contested mark creates a significant difference. Additionally, the competing marks are presented in different colours and create different shaped impressions. In my opinion, the differences would not be overlooked and are of heightened importance given that I have found the purchasing process to be predominantly visual in nature.²¹ Aurally, the marks are dissimilar, having a different number of syllables with none matching.

²¹ *Quelle AG v OHIM*, Case T-88/05

Furthermore, there is no conceptual similarity between the competing marks, as the contested mark delivers the concept of a race which is not repeated within the earlier marks. It is my view that, despite the similarities between the marks, it is unlikely that the competing marks will be mistaken or misremembered for one another, even when factoring in the principle of imperfect recollection. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. In my judgement, taking all the above factors into account, the similarities between the competing trade marks are not likely to cause consumers, paying at least an average level of attention, to mistake the marks, even taking account of the principle of interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to identical services.

67. That leaves indirect confusion to be considered. I bear in mind that a finding of indirect confusion should not be made merely because the marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.²²

68. As explained above, consumers may recognise the commonality insofar as the figurative element represents a split letter “R” on a diagonal slant, albeit styled differently. However, the distinctive element of the earlier marks lies in the device as a whole which is not replicated in the contested mark. Consequently, I do not believe that consumers will assume that the applicant and the opponent are economically linked undertakings on the basis of the competing trade marks; I am unconvinced that consumers would assume a commercial association or licensing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared impression of the letter “R” split on a diagonal angle. Instead, it is my view that consumers will recognise the visual, aural, and conceptual differences between the marks. These differences between the competing marks are not conducive to any logical brand extensions, as there is no logical reason why an undertaking would remove parts of the figurative device that make it distinctive and add unrelated text that provides an entirely different conceptual meaning. Rather, the common usage of a figurative element which creates the impression of the letter “R” on a diagonal slant in

²² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

the competing marks is more likely to be seen as a coincidental when considering the overall marks as a whole, even on services that are identical. Therefore, I find that there is no likelihood of indirect confusion.

The fourth earlier mark and the contested mark

69. I have found that the applicant's goods and services are either identical or similar to between a low and medium degree to those of the earlier mark. I have found that the average consumer of the goods will be the general public who will pay an average degree of attention. Whilst the average consumer of the services will be both the general public, who will pay an average level of attention, and business users who will pay an above average level of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the fourth earlier mark is co-dominated by the word "REFORGED" and the figurative element as a whole. Whilst the contested mark is dominated by the words "THE RACE", with the figurative element also providing a significant contribution. I have found that the earlier mark and the contested mark are visually similar to a low degree, and aurally and conceptually dissimilar. I have also found that the earlier mark has a medium degree of inherent distinctive character.

70. I acknowledge that both marks contain a figurative element, which is on a diagonal slant. As with the first, second and third earlier marks, the fourth earlier mark also has a device element that clearly contains the letter "R" split into two pieces along the diagonal angle. Again, in the contested mark, due to the letter "R" in the word element, some consumers may see the device as representative of the letter "R", also split on a diagonal angle but with the first part missing. However, even where this is the case, consumers will also notice the differences in the stylisation of the device elements, such as the incomplete ring surrounding the letter "R" in the fourth earlier mark. The respective marks also contain different word elements that create a further point of difference, i.e. the words "THE RACE" in the contested mark and the word "REFORGED" in the fourth earlier mark. Additionally, the competing marks are presented in different colours, i.e. light blue, orange and dark grey in the fourth earlier mark and black and white in the contested mark. They also create different shaped impressions, i.e. circular for the fourth earlier mark and square for the contested mark.

In my view, the differences create enough variance that they would not be overlooked by consumers which is important given that I have found the purchasing process to be predominantly visual in nature.²³ Aurally, the marks are dissimilar, with no matching syllables. Furthermore, the marks are conceptually distinct due to the different word elements in the respective marks, and, as such, there is no shared meaning for consumers to connect the competing marks. In my judgment, there are sufficient differences to prevent consumers, paying at least an average degree of attention, to mistake or misremember the competing marks for one another, even factoring in the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to identical services.

71. As explained above, consumers may recognise that both marks have a device element that contains a split letter “R” on a diagonal slant. However, the figurative element as a whole is not replicated in the contested mark, and the stylisation in the device elements differ. Consequently, I do not believe that consumers will assume that the applicant and the opponent are economically linked undertakings on the basis of the competing trade marks; I am unconvinced that consumers would assume a commercial association on the part of the opponent, merely because of the shared impression of the letter “R” split on a diagonal slant within the device elements of the respective marks. The differences between the competing marks are not conducive to any logical brand extensions; there is no logical reason why an undertaking would remove parts of the figurative device that make it distinctive and exchange the word “REFORGED” for the words “THE RACE” which give an entirely different conceptual message. Rather, the commonality in the diagonal impression of the competing marks is more likely to be seen as a coincidence, even on services that are identical. Accordingly, it follows that there is no likelihood of indirect confusion.

Conclusion

72. The opposition under section 5(2)(b) of the Act has failed in relation to each of the earlier marks relied upon. Subject to any appeal, the application will proceed to registration in the UK in respect of all the applied-for goods and services.

²³ *Quelle AG v OHIM*, Case T-88/05

Costs

73. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016. Applying this guidance, I award the applicant the following as a contribution toward costs:

Considering the opponent's statement and preparing a counterstatement	£200
Preparing written submissions	£300
Total	£500

74. Accordingly, I hereby order AF Racing AG to pay Ideas + Cars Ltd the sum of **£500**. 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 15th day of February 2023

Sarah Wallace

For the Registrar

Annex

Services of EUTM no. 015750078 (First earlier mark)

- Class 35: Advertising, in particular for promoting motor racing activities and motor racing teams; Sales promotion for motor racing vehicles; Business management; Office functions.
- Class 36: Financial affairs, in particular financial support (sponsorship) in relation to motor racing vehicles and motor racing teams.
- Class 41: Entertainment; Sporting and cultural activities, in particular arranging and conducting of motor racing activities, motor racing and motor sport events, arranging and conducting of events

Services of EUTM no. 015750086 (Second earlier mark)

- Class 41: Entertainment; sporting and cultural activities, in particular arranging and conducting of motor racing activities, motor racing and motor sport events, arranging and conducting of events; planning and organisation of social occasions, including via hotlines; reservations in relation to cultural and sporting occasions, including via hotlines (concierge services).

Services of EUTM no. 015752538 (Third earlier mark)

- Class 35: Advertising
- Class 43: Services for providing food and drink, in particular preparation and providing of food and drink (catering); providing food and drink.

**Goods and services of EUTM no. 017891323
(Fourth earlier mark)**

- Class 9: Electronics for vehicles, namely vehicle electronic ignition and alarm systems, electric vehicle locks, electronic vehicle navigation systems, electrical and electronic wheel and control devices and vehicle dashboard instruments, wires for electrical signal transmission in vehicles, cable harnesses for vehicles.
- Class 35: Advertising, promotion, and marketing relating to vehicles; promotional management, in particular, seeking sponsorships, entering agreements, organizing signage for events, promoting sponsors; business management, in particular in the field of consulting, organization, assistance, analysis, planning and supervision; office work, in particular employee, company, business and financial record keeping, human resources management, company management, business management, financial records management, billing; all the aforementioned related to businesses involved in motorsport activities, racing and motorsport events.
- Class 41: Entertainment; athletic and cultural activities, in particular organizing and conducting motorsports activities, racing and motorsports events, organization and conducting of events; planning and organization of social events; provision and management of sporting events.