BL O/0621/24

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
AGAINST DECISION NO O/0340/23
AND IN THE MATTER OF UK TRADE MARK APPLICATION NO.00003606950 FOR 'NRG'
IN THE NAME OF HARD CARRY GAMING, INC.
AND OPPOSITION NO.426020 THERETO
IN THE NAME OF NRJ GROUP SOCIÉTÉ DE DROIT FRANÇAIS

DECISION

INTRODUCTION

1. The Appellant appeals decision No. O/0340/23 dated 05 April 2023 (**'the Decision'**) of Hearing Officer Arran Cooper for the Registrar in which he refused the Appellant's Opposition against Hard Carry Gaming, Inc's (**'the Respondent'**) UK Trade Mark Application No.00003606950 for the word mark '**NRG**' in Classes 35 and 41 (**'the NRG Mark'**). The Application for the NRG Mark was made on 9 March 2021.

2. The opposition was made under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 and relied upon the following earlier registered marks (collectively **'the NRJ Marks'**):

    a. UKTM No.00900136150 for 'NRJ' in Classes 35, 38 and 41 with a filing date of 21 May 1996 and a registration date of 9 March 1999 (**'the NRJ Word Mark'**).

    b. UKTM No. 00918003407 for the mark set out below in Classes 9, 16, 25, 35, 38 and 41 with a filing date of 21 December 2018 and a registration date of 18 May 2019 (**'the ENERGY NRJ (Logo) Mark'**).

3. As is apparent from their registration numbers, the NRJ Marks are both comparable trade marks (EU) created from equivalent EU Trade Marks on 1 January 2021 in accordance with Article 54 of the Withdrawal Agreement between the EU and UK. It follows that the provisions of Schedule 2A of the Trade Marks Act 1994 applies to them.

MATERIALS

4. I am asked to decide this matter on the papers. I have received detailed submissions prepared for this appeal from the Appellant but none from the Respondent. In addition, have been provided with the following papers that were also provided to the Hearing Officer:

    a. <u>On behalf of the Appellant</u>:

        i. TM7 for Opposition No. OP000426020;

        ii. First and second witness statements of Aurélie Guilloteau;

        iii. Written submissions on behalf of the Opponent dated 11 January 2023, and

        iv. Statement of Grounds of Appeal.

    b. <u>On behalf of the Respondent</u>:

        i. TM8 for Opposition No. OP000426020.

THE STANDARD OF REVIEW ON APPEAL

5. There is no dispute that the principles which I must apply when considering this appeal are as set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24] and [25].

THE HEARING OFFICER'S FINDINGS

6. The Hearing Officers findings can be summarized as follows.

Goods and Services covered by the NRJ Marks

7. The NRJ Word Mark was subject to proof of use and therefore also to a determination of a fair specification in relation to that use. The Hearing Officer' found that a fair specification of the opponent's services under the NRJ Word Mark was as follows:

    Class 35: Advertising.

Class 38: Broadcasting of radio and television programs.

Class 41: Entertainment, namely via radio, television, podcasts, music award shows and music tours; production of radio shows, music award shows and music tours.

8. The ENERGY NRJ (Logo) Mark was not subject to proof of use. The services for which it is registered (which are numerous) in classes 9, 16. 25, 35, 38 and 41 and are as reproduced at Annex A of the Decision.

9. The Hearing Officer's findings in relation to Class 38 and 41 are the subject matter of Ground 1 of this Appeal.

Comparison of the NRJ Marks and the NRG Mark

NRJ Word Mark

10. The Hearing Officer found that the NRJ Word Mark and the NRG Mark were:

    a. visually similar to a medium degree;

    b. aurally similar to a medium to high degree, and

    c. either conceptually neutral or conceptually dissimilar (see below).

ENERGY NRJ (Logo) Mark

11. The Hearing Officer found that the ENERGY NRJ (Logo) Mark and the NRG Mark were:

    a. visually similar to a low degree;

    b. aurally similar to a low to medium degree, and

    c. conceptually dissimilar.

12. The Hearing Officer's conceptual comparison of the word marks (see paragraph 10(c)) above is explained at paragraph 83 of the Decision as follows:

> *The opponent's submissions on the conceptual comparison hinge on the fact that the letters 'NRJ' in the opponent's marks will be understood as 'energy'. I see no reason why, upon being confronted with the letters 'NRJ', that the average consumer would believe that it was meant to be read as 'energy'. I appreciate that this may be the case in France (being the territory where the bulk of the opponent's evidence relates), however, the assessment I must make at present is based on the perception of the average consumer in the UK. The opponent's first mark, will, therefore, be seen simply as a three letter initialism with no obvious meaning. As for the applicant's mark, I agree that the connection to the word 'energy' will be*

understood by at least a significant proportion of average consumers for the services at issue. This is on the basis that the articulation of 'NRG' sounds similar to the word 'energy', thereby resulting in the consumer making such a connection. That being said, I also consider that there is a separate (but also significant) proportion of consumers that would simply see 'NRG' as an initialism with no obvious meaning. In the scenario where the consumer views 'NRG' as being connected to the word 'energy', I find that the marks are conceptually dissimilar on the basis that one mark has a graspable meaning whereas the other does not. Alternatively, for those consumers that do not see 'NRG' as being connected to the word 'energy', I find that despite both marks being initialisms, the fact that neither one carries any obvious meaning results in a conceptual neutrality between them.

13. These findings are the subject matter of Ground 3 of this Appeal.

Comparison of Goods and Services

14. The Hearing Officer's comparison of goods and services (which related solely to classes 35 and 41) can be summarized as follows:

CLASS 35	**NRJ Word Mark**	***ENERGY NRJ (Logo) Mark***
"Promotion of electronic sports teams; promotion […] of professional video gaming sports teams; advertising and marketing services, namely, promoting the goods and services of others; endorsement services, namely, promoting the goods and services of others"	Identical	Identical
"Business management of professional video gaming sports teams"	No similarity	No similarity

CLASS 41	**NRJ Word Mark**	***ENERGY NRJ (Logo) Mark***
"Entertainment services in the nature of video game and eSports tournaments and competitions; entertainment services, namely, provision of livestreams featuring video game play and video game competitions delivered by the internet and streaming video platforms; entertainment services in the nature of organizing, promoting, conducting, and participating and performing in video game and eSports exhibitions, tours, tournaments, activities, and competitions; entertainment services, namely, providing news and information in the field of video gaming and eSports; entertainment services, namely, production of multimedia and audiovisual	Similar to no more than a medium degree	Identical

content in the field of video gaming, eSports, and related consumer interest topics".		
Entertainment services relating to the video gaming and eSports industry, namely, providing classes, seminars and workshops in the field of video gaming and eSports	Similar to a low degree	Identical
Educational […] services relating to the video gaming and eSports industry, namely, providing classes, seminars and workshops in the field of video gaming and eSports; provision of training in the field of video gaming and eSports.	No similarity	Identical

15. These findings are the subject matter of Ground 2 of this Appeal

Acquired Distinctive Character of the NRJ Marks

16. The Hearing Officer rejected the submission that the NRJ Marks had any acquired distinctiveness. This is the subject matter of Ground 4 of this Appeal.

Likelihood of Confusion

17. The Hearing Officer rejected the submissions that was a likelihood of direct or indirect confusion between either of the NRJ Marks and the NRG Mark. The s. 5(2)(b) opposition therefore failed. This is the subject of Ground 5 of this Appeal.

Link between the marks for the purposes of section 5(3)

18. The Hearing Officer rejected the submission that there was a link between either of the NRJ Marks and the NRG Mark for the purposes of section 5(3). The s. 5(3) opposition therefore failed. This is the subject of Ground 6 of this Appeal.

GROUNDS OF APPEAL

Ground 1

19. Ground 1 of the Appeal addresses the determination of a fair specification for the NRJ Word Mark. It has two parts:

"When assessing proof of use in relation to the NRJ Word Mark, the [Hearing Officer]

a. *applied the incorrect test when interpreting the relevant specification, and, or*

b. *and/or erred in his assessment of whether proof of use had been established in relation to some services in Classes 38 and 41"*

20. The Appellant asserts that if the Hearing Officer had directed himself correctly, he would have found that the fair specification for the NRJ Word mark in classes 38 and 41 was as follows:

> *Class 38: Electronic data, image and document transmission via computer terminals and all other means of transmission such as waves, cables, satellites, Internet; data transmission; data and voice telecommunications, namely radio communications; communications by computer terminals and other means of transmission*
>
> *Class 41: entertainment via online and internet platforms; Organisation of competitions relating to entertainment.*

Ground 1a

21. The Appellant submits that the Hearing Officer failed to apply the test correctly for the following reasons:

> *The HO applied the incorrect test when interpreting [the Class 38 specification]. In particular, rather than referring to how the average consumer would construe the specification, the HO ought to have given the words within the specification their natural and usual meaning with neither such a broad interpretation that the limits of the specification become fuzzy nor so strained as to produce a narrow meaning. Whilst it is noted that Titanic refers to "how the average consumer would fairly describe the services in relation to which the trade mark has been used" (a) this is not the same as interpreting a specification, where the words are already defined, and (b) in any event, the proposition must not be taken too far, particularly in cases where a specification includes technical/complex terminology which may differ from, but mean the same as, the language which an average consumer may use. In other words, the focus must remain on the specification and an assessment be made as to whether the use shown in evidence falls within that specification.*

22. Both the Hearing Officer and the Appellant relied upon to the decision of *Henry Carr J in Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) as a correct summary of the principles to be applied.

23. The Appellant also relies upon the judgment of Arnold J in *Omega Engineering Inc v Omega SA* [2012] EWCH 3440, and in particular [at 33]:

> *In YouView TV Ltd v Total Ltd [2012] EWHC 3158 (Ch) at [12] Floyd J summarised the correct approach as follows:*
>
> > *"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not a 'dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."*

24. And upon the judgment of Arnold J in *Aveda Corp v Dabur India* [2013] ETMR 33) at [56]:

> *"I reviewed the correct approach to the construction of the specification of goods and/or services of a registered trade mark in Omega Engineering Inc v Omega SA [2012] EWHC 3440 (Ch) at [21]-[33]. In short, the words used in the specification should be given their natural and usual meaning. They should neither be given such a broad interpretation that the limits of the specification become fuzzy, nor strained to produce a narrow meaning."*

25. I understand the Appellant's criticism of the Hearing Officer's application of the law to be directed most particularly to his findings at paragraphs 46-47 of the Decision:

> " Electronic data, image and document transmission via computer terminals and all other means of transmission such as waves, cables, satellites, Internet; data transmission; data and voice telecommunications, namely radio communications; communications by computer terminals and other means of transmission.
>
> *46. I note that the opponent has provided detailed submissions in respect of the above services. I do not intend set these out in full but note that the opponent claims that it has shown use of these services on the basis that it offers various websites to provide its electronic and data transmissions and its communication services. It also argues that use is demonstrated by use of the opponent's mobile applications and via standalone games website called 'NRJ Games'. While noted, I do not consider that the average consumer would construe the services described above as covering the provision of a website, mobile applications or computer games. I consider that the above terms are very broad and cover a multitude of different types of services that the evidence does not show. For example, the types of transmissions covered in the above term go beyond the transmission of radio and television broadcasts which, in my view, is the only type of 'transmission' shown in the evidence.*
>
> *47. If I were to consider limiting the above terms in accordance with the evidence filed,*

> *I am of the view that such a limitation would be so that the terms fall in line with radio and television broadcast services. However, I am of the view that the services covered by those discussed at paragraph 45 above are sufficient to cover such use. Therefore, I do not consider it appropriate or necessary to seek to limit the above terms in accordance with the use provided in the evidence as it does not further the opponent's position. Instead, I will proceed on the basis that the opponent has not provided evidence of genuine use in respect of the above services.*

26. I reject the Appellant's submission that the Hearing Officer misapplied the relevant law. I do not understand his analysis in paragraphs 46 and 47 of the Decision, and in particular, the use of the word *"construe"* to be intended to be in anyway different from the approach set out in *Titanic*. More importantly, the conclusions he draws on the facts are, in my view, conclusions that are consistent with correct application of the principles set out in *Titanic*, and equally consistent with the principles set out in *Omega* and *Aveda*. Finally, the conclusions reached by the Hearing Officer lie within those which he was entitled to make based on the evidence. There is therefore no error in law of principle, and I reject Ground 1a.

Ground 1b

27. The Appellant submits that the Hearing Officer erred in his assessment of whether proof of use had been established in relation to some of the Class 38 and 41 services for which the NRJ Word Mark was registered.

28. In relation to class 38, the Appellant submits that its evidence in relation to class 38 clearly went beyond the narrow scope of *"radio and television broadcasts"* and showed genuine use of the NRJ Marks across various forms of transmission and communication services, including the broadcasting of radio signals via the internet, transmission of data, images and information via the Internet, radio communications and communications by computer terminals and other means of transmission.

29. It also asserts that the Hearing Officer failed to take into, or into sufficient, account various parts of Ms Guilloteau's evidence relating to the operation of four radio stations operated by the Appellant (and in particular listening to those stations through multi-media devices) and the operation by the Appellant of 6 websites, 230 digital radio stations and 8 mobile applications.

30. This evidence is expressly discussed in the Decision. Furthermore, in my view it is clear that the Hearing Officer directed his mind to whether this evidence was such as that the average consumer would have described the services in which the NRJ Word Mark was used as covering the broad specification argued for by the Appellant. The criticism of that process is the basis for the appeal under Ground 1a, which I have already dismissed. For these reasons I reject this limb of the appeal in relation to class 38.

31. I can deal with class 41 briefly. The reasons raised by the Appellant are of the same nature as those raised in relation to class 38. They do not disclose, in my view, any error of principle and therefore are to be dismissed.

32. For these reasons I reject Ground 1b, and therefore Ground 1 in toto.

Ground 2

33. The Appellant submits that the Hearing Officer erred in his assessment of the comparison of goods and services.

34. The Appellant submits, correctly, that if it is correct on Ground 1 then the comparison process has to be repeated to take into account the additional services. As I have rejected Ground 1, I do not need to address this further.

35. In my clear view, the remaining submissions under Ground 2 do not in my view disclose an error of principle. Instead, they amount to no more than an invitation to go through the comparison process again and reach a different conclusion.

36. I therefore dismiss Ground 2.

Ground 3

37. Ground 3 asserts that the Hearing Officer erred in his assessment of the similarity of marks for the purposes of section 5(2)(b).

38. The Appellant has set out, in detail, how it says the Hearing Officer should have approached each aspect of the comparison between the NRG Mark and the NRJ Marks (visual, aural and conceptual). The Appellant's submissions do not, in my view, identify any error of principle on the part of the Hearing Officer. Properly understood they are again no more than an invitation to reconsider the issue and come to a different conclusion. In particular, the conclusions on the comparisons made by the Hearing Officer lie with the range of conclusions that he, in my view, fully entitled to make on the evidence before him.

39. There is one issue raised by the Appellant that I do need to address separately. That is the criticism that the Hearing Officer failed to take into account the unchallenged evidence of Ms Guilloteau as to how the average consumer in the UK would perceive the marks. I start by noting that the (a) the Appellant submitted to the Hearing Officer that the average consumer in relation to the class 41 services was a member of the general public (which he accepted and is not challenged on appeal). The Appellant made no submissions in relation to the class 35 services, but the

Hearing Officer concluded (and this is not challenged on appeal) that the average consumer was a business user. Ms Guillouteau's evidence was directed to the perception of a member of the UK public. There was in my view nothing in in her evidence which put her in better position on this issue than the Hearing Officer. He was therefore fully entitled reach a finding which differed from the conclusions expressed in Ms Guillouteau's evidence.

40. I therefore reject Ground 3.

Ground 4

41. Ground 4 asserts that the Hearing Officer erred in his assessment of whether the NRJ Marks or each of them enjoyed enhanced distinctiveness. The Appellant's submissions do not, in my view, identify any error of principle on the part of the Hearing Officer. Properly understood they are no more in my view than an invitation to reconsider the evidence and come to a different conclusion. There is nothing in the conclusions made by the Hearing Officer that is inherently wrong or lies outside the range of conclusions he was, in my view, entitled to make on the evidence. I therefore reject Ground 4.

Ground 5

42. Ground 5 asserts that the Hearing Officer erred in his assessment of whether there is a likelihood of confusion for the purposes of section 5(2)(b).

43. My consideration of the issues under Ground 5 necessarily engage my conclusions on Grounds 1-4. Taking into account my rejection of those grounds, the Appellant's submissions do not, in my view, identify any error of principle on the part of the Hearing Officer. Properly understood they are no more in my view than an invitation to reconsider the evidence and come to a different conclusion. There is nothing in the conclusions made by the Hearing Officer that is inherently wrong or which lies outside the range of conclusions he was, in my view, entitled to make on the evidence. I therefore reject Ground 5.

Ground 6

44. The Appellant asserts that the Hearing Officer erred in his assessment of whether a link exists between the marks for the purposes of section 5(3). The Appellant accepts that the Hearing Officer applied the correct legal principles. Instead, it asserts that that evidence clearly indicated that a *"Commercially significant part of the relevant public in the UK would have been aware of the NRJ Marks [..] and would have made a link between them and the Application Mark given*

the significant reputation enjoyed by the NRJ marks and the overlap in services particularly in class 41".

45. The Hearing Officer found that the NRJ Marks enjoyed a "fairly sizeable" reputation across the EU. However, he also found that the evidence in respect of the UK market was limited. As section 10 of the Schedule 2 to the Trade Marks Act 1994 makes clear the hearing officer was correct to judge the questions of link and reputation by reference to the UK, as that question is to be determined after IP Completion day (i.e. 1 January 2021).

46. As to the findings of fact made by the Hearing Officer, they fall in my view within the scope of those open to him on the evidence. The Appellant has therefore identified no error which in my view entitles me to go behind those findings. On that basis Ground 6 must fail.

CONCLUSION

47. For the reasons set out above, I dismiss the appeal. I also therefore dismiss the Appellant's application for costs before the Hearing Officer or on this Appeal.

GEOFFREY PRITCHARD
APPOINTED PERSON
1st July 2024