

O/0799/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
UK REGISTRATION NO. 3353408
IN THE NAME OF
THE BEAUTIFUL DESIGN PROJECT LIMITED
IN RESPECT OF THE FOLLOWING TRADE MARK:**

BEAUTIFUL BUSINESS

IN CLASSES 9, 16, 35 & 41

AND

**AN APPLICATION FOR DECLARATION OF INVALIDITY
THERE TO UNDER NO. 505805
BY
THE BUSINESS ROMANTIC SOCIETY VERWALTUNGS GMBH**

Background & Pleadings

1. The trade mark ("**contested mark**") shown on the front page of this decision stands registered in the name of The Beautiful Design Project Limited ("**the proprietor**"). The mark was applied for on 14 November 2018 in the United Kingdom and completed its registration procedure on 8 February 2019 in respect of the following goods and services:

Class 9: Downloadable publications; Downloadable electronic books; Downloadable electronic publications and information provided online from databases or the internet; Downloadable movies; Downloadable video files; E-books; Electronic publications; Downloadable electronic newsletters; Instructional guides; Pre-recorded videos; Video recordings; Webcasts and podcasts.

Class 16: Printed matter; Books; Certificates; Educational publications; Printed publications; Teaching materials; Guide books; Newsletters.

Class 35: Assistance, advisory services and consultancy with regard to business management; Business analysis; Business consultancy; Advice relating to business organisation; Arranging and conducting of fairs and exhibitions for business purposes; Assistance, advisory services and consultancy with regard to business organization; Assistance, advisory services and consultancy with regard to business analysis; Business management consultancy in the field of executive and leadership development; Business organisation consultancy; Business planning consultancy; Business promotion; Business research; Provision of business information; Writing of business project studies; Information and advisory related to all of the aforesaid services.

Class 41: Education; Entertainment; Publishing; Coaching; Arranging and conducting conferences; Arranging and conducting of courses, seminars and workshops; Arranging and conducting of educational

events; Arranging of conferences relating to business; Arranging of conferences relating to commerce; Arranging of conferences relating to trade; Arranging of seminars relating to manager training; Book publishing; Business training consultancy services; Conducting instructional courses; Conducting of business conferences; Conducting of cultural events; Conducting of educational conferences; Conducting workshops [training]; Cultural services; Digital video, audio, and multimedia publishing services; Education services for managerial staff; Educational services in the nature of coaching; Electronic publication services; Electronic publishing; Health and wellness training; Health education; Interactive entertainment; Issue of publications; Life coaching (training); Radio services for the provision of educational content; Radio programmes (Production of-); Production of radio programmes; Online digital publishing services; Personal coaching [training]; Personal development courses; Providing on-line publications; Provision of education courses; Publication and issuing of books; Publication of printed matter in electronic form; Publication of training manuals; Publishing of books, magazines; Publishing of educational material; Publishing of electronic publications; Publishing of instructional books; Publishing of journals; Publishing of newsletters; Publishing of newspapers; Writing and publishing of texts, other than publicity texts; Writing of texts; Writing services for blogs; Information and advisory related to all of the aforesaid services.

2. On 6 February 2023, The Business Romantic Society Verwaltungs GmbH (“**the applicant**”) filed an application to have this trade mark declared invalid under the provisions of Sections 5(1), 5(2)(a) and (2)(b) of the Trade Marks Act 1994 (“the Act”)¹, which are relevant in invalidation proceedings

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

under Section 47 of the Act. The applicant relies upon the following UK trade mark registrations:

Trade Mark No.	UK00917666058 ('058) ²
Trade Mark	House of Beautiful Business
Goods & Services Registered	Classes 16, 35, 39, 41 & 42
Filing date	8 January 2018
Date of entry in register	8 June 2018

Trade Mark No.	UK00003699855 ('855)
Trade Mark	Beautiful Business
Mark Description/ Limitation	This case is filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and the EU filing date was 28/03/2020.
Goods & Services Registered	Classes 16, 35, 39, 41 & 42
Filing date	23 September 2021
Date of entry in register	18 March 2022
Priority details	Priority Date: 28 March 2018 Priority Country: European Union Intellectual Property Office (EUIPO) TM from which priority claimed: 17880955

3. The applicant relies on all of its goods and services for the purposes of these invalidation proceedings.
4. In relation to the earlier mark '855, the applicant in its notice of opposition claims that the competing marks are identical or alternatively highly similar with the competing goods and services in the contested mark. As to the earlier mark '058, the applicant asserts that the competing marks are

² On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent's earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

similar to at least a medium degree, and there is an obvious overlap and identity between the competing goods and services.

5. The proprietor filed a notice of defence denying the applicant's claims. It puts forward that the goods and services are different, with the public and channels of trade being different.
6. Neither of the parties filed evidence or submissions.
7. No hearing was requested and so this decision is taken following a careful perusal of the papers.
8. In these proceedings, the registered proprietor is represented by Mathys & Squire LLP and the applicant is represented by Kilburn & Strode LLP.

Decision

9. Section 47 of the Act states that:

“[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

10. Section 5(1) of the Act states:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

11. Sections 5(2)(a) and (b) of the Act are as follows:

“A trade mark shall not be registered if because-

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected,

(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.”

12. Under Section 6(1) of the Act, the applicant’s trade marks clearly qualify as earlier trade marks. Further, as protection of the earlier marks was completed less than five years before the registration date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act. Consequently, the applicant can rely on all the goods and services in its marks.

13. The principles, considered in this application for invalidity, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):
 - 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 the Trade Marks

- 14. It is a pre-requisite of Sections 5(1) and 5(2)(a) of the Act that the marks be identical. I will begin by assessing whether they are identical within the meaning of the case law.
- 15. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA, Case C-291/00*, the Court of Justice of the European Union (“CJEU”) held that:

“54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

- 16. The marks to be compared are:

Earlier Marks	Contested Mark
<p style="text-align: center;"><u>Earlier mark ‘855</u> Beautiful Business</p> <p style="text-align: center;"><u>Earlier mark ‘058</u> House of Beautiful Business</p>	<p style="text-align: center;">BEAUTIFUL BUSINESS</p>

Earlier mark ‘855

- 17. The competing marks share the identical word “Beautiful Business/ BEAUTIFUL BUSINESS”. Therefore, I consider that the contested mark reproduces the earlier mark. **Consequently, the competing marks are self-evidently identical.**

Earlier mark '058

18. Although the contested mark incorporates entirely the words “Beautiful Business” of the earlier mark, it is clearly not identical according to settled law as the contested mark does not reproduce the earlier mark without any modifications or additions. The guidance above states that the differences must be “so insignificant that they may go unnoticed”. However, there are differences that will not go unnoticed in this instance, namely the absence of the words “House of” at the beginning of the contested mark. On that basis I do not find that the marks are identical. **As the competing trade marks are not, in my view, identical, the opposition based upon Sections 5(1) and 5(2)(a) of the Act must fail.**
19. Taking into account my findings in the preceding paragraphs and the grounds of this invalidation proceedings, I will continue my assessment based on the earlier mark '855. I will only return to the ground under 5(2)(b) later in this decision if this is deemed necessary.

Comparison of the Goods and Services

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:
- “23. 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 complementary.”
21. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

22. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

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

23. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

24. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

25. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC

clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

26. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

27. The competing goods and services to be compared are shown in the following table:

Registered Proprietor's Goods & Services	Applicant's Goods & Services
<p>Class 9: Downloadable publications; Downloadable electronic books; Downloadable electronic publications and information provided online from databases or the internet; Downloadable movies; Downloadable video files; E-books; Electronic publications; Downloadable electronic newsletters; Instructional guides; Pre-recorded videos; Video recordings; Webcasts and podcasts.</p>	<p>Class 16: Publications (Printed-); Educational publications.</p> <p>Class 35: Business advisory and consultancy services; Strategic business consultancy; Placement of staff, namely speakers for events, presentations, seminars, courses, conferences and workshops; Placement of freelance service providers; job placement for freelance service providers.</p>
<p>Class 16: Printed matter; Books; Certificates; Educational publications; Printed publications; Teaching materials; Guide books; Newsletters.</p>	<p>Class 39: Travel arrangement; Travel organization; Arranging inspirational travel, tours and retreats.</p>

Class 35: Assistance, advisory services and consultancy with regard to business management; Business analysis; Business consultancy; Advice relating to business organisation; Arranging and conducting of fairs and exhibitions for business purposes; Assistance, advisory services and consultancy with regard to business organization; Assistance, advisory services and consultancy with regard to business analysis; Business management consultancy in the field of executive and leadership development; Business organisation consultancy; Business planning consultancy; Business promotion; Business research; Provision of business information; Writing of business project studies; Information and advisory related to all of the aforesaid services.

Class 41: Education; Entertainment; Publishing; Coaching; Arranging and conducting conferences; Arranging and conducting of courses, seminars and workshops; Arranging and conducting of educational events; Arranging of conferences relating to business; Arranging of conferences relating to commerce; Arranging of conferences relating to trade; Arranging of seminars relating to manager training; Book publishing; Business training consultancy services; Conducting instructional courses; Conducting of business conferences; Conducting of cultural events; Conducting of educational conferences; Conducting workshops [training]; Cultural services; Digital video, audio, and multimedia publishing services; Education services for managerial staff; Educational services in the nature of coaching; Electronic publication

Class 41: Arranging and conducting of educational events; Providing information on congress events; Organization of conferences; Organization of congresses and conferences for cultural and educational purposes; Arranging and conducting conferences; Organization of seminars and conferences; Arranging of conferences relating to business; Consultancy and information services relating to arranging, conducting and organization of conferences; Education services for managerial staff; Arranging of seminars relating to manager training; Arranging and conducting of courses, seminars and workshops; Electronic publishing; Multimedia publishing; Publishing of newsletters; Publishing services (including electronic publishing services); Magazine publishing; Publishing of educational material; Publishing of printed matter; Providing on-line publications; Adult education services; Providing online electronic publications; community services related to adult education, namely, organizing and promoting events, presentations, seminars, courses, conferences and workshops related to education; Providing on-line audiovisual content; Cultural services; Workshops for cultural purposes; Conducting of cultural events.

Class 42: Hosting of digital content, namely, on-line journals and blogs; Hosting of an online platform for the creation and maintenance of communities for business leaders; Hosting of an online platform for speakers that

<p>services; Electronic publishing; Health and wellness training; Health education; Interactive entertainment; Issue of publications; Life coaching (training); Radio services for the provision of educational content; Radio programmes (Production of-); Production of radio programmes; Online digital publishing services; Personal coaching [training]; Personal development courses; Providing on-line publications; Provision of education courses; Publication and issuing of books; Publication of printed matter in electronic form; Publication of training manuals; Publishing of books, magazines; Publishing of educational material; Publishing of electronic publications; Publishing of instructional books; Publishing of journals; Publishing of newsletters; Publishing of newspapers; Writing and publishing of texts, other than publicity texts; Writing of texts; Writing services for blogs; Information and advisory related to all of the aforesaid services.</p>	<p>enables the placing and booking of speakers for events, presentations, seminars, courses, conferences and workshops; Computer software development; Creating and maintaining websites; Creating of computer programs; Development of application software for delivery of multimedia content; computer services; Computer project management services; Cloud computing services; Application service provider services; IT services.</p>
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28. In its statement of grounds, the applicant claims the following:

“All the contested goods in Class 9 are similar to the earlier mark’s goods in Class 16 and services in Class 41. They consist of content (e.g. publications, multimedia files) provided in downloadable format in Class 9, whilst the earlier mark covers printed publication in Class 16, and the provision of the same publications and multimedia content in Class 41. The respective goods and services have the same purpose, are normally provided by the same undertakings and aimed at the same public. The contested "Advertising services for businesses" and "preparations and conducting of trade fairs and exhibitions for business" purposes in Class 35 can be deemed at least similar to the earlier mark's "strategic business consultancy services" in Class 35 and various event arrangement services in Class 41.

These services share the same nature and may be offered by the same undertakings. All the contested services in Class 41 can generally be considered in the field of education, entertainment and publishing. If not identical to the earlier mark's services in the same Class, they are at least similar given the shared nature, channels of distribution, target audience and origin.”

29. The proprietor asserted the following:

“Furthermore, the goods and services are not identical or similar to a high degree. The Proprietor especially draws the Office's attention to the fact that the contested trade mark is registered in class 9, which is not present in any of the earlier applications. There are also no similar goods or services in other classes that would be similar to the goods the Proprietor holds protection for.

Further, the Proprietor denies all claims and allegations of the Applicant. The marks are different, goods and services are different, target public and channels of trade are different.”

30. For the avoidance of doubt, pursuant to Section 60A(1) of the Act, goods are not to be regarded as similar or dissimilar simply because they fall in the same or different Class.

31. I note that the earlier specification contains the word “*namely*” in more than one instances. Guidance on how to treat this word is contained in the addendum to the Trade Mark Registry’s Classification Guide, which reads as follows:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean

“that is to say” and the Cambridge International Dictionary of English which states “which is or are”.” (emphasis added)

32. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.³

Class 9

Downloadable publications; Downloadable electronic books; Downloadable electronic publications and information provided online from databases or the internet; E-books; Electronic publications; Downloadable electronic newsletters; Instructional guides

33. The contested terms are largely downloadable publications. The closest comparable term in the applicant’s specification is “*Publications (Printed -)*” in Class 16. I consider that there will be an overlap in users of the proprietor’s above listed goods and the applicant’s in Class 16. Although they differ in physical nature and method of use, the overall purpose of the goods will be the same. There will also be an element of competition between the goods, with the consumer making an informed choice between the format of the goods (digital v physical copies) they wish to purchase. Overall, I consider the contested goods in Class 9 to be similar to the earlier goods in Class 16 to a medium degree.

Downloadable movies; Downloadable video files; Webcasts and podcasts; Pre-recorded videos; Video recordings

34. The contested goods cover downloadable audiovisual content from the internet. I note that the contested terms “*Pre-recorded videos; Video recordings*” are broad to also include the downloadable versions of these

³ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

goods. The applicant argues that these goods are similar to its design publications and multimedia content in Class 41 to the extent that the respective goods and services have the same purpose, and they are provided by the same undertakings and aimed at the same public. I consider that the earlier term “*Providing on-line audiovisual content*” in Class 41 is the closest comparable term. There is a degree of complementarity to the extent that consumers would believe that the respective goods are offered by the provider of the earlier services. As such, it would not be unreasonable for the consumer to expect both goods and services to be provided by the same or economically linked undertakings. As a result, there exists a complementary relationship between the competing goods and services. Moreover, the respective goods and services are targeted to the same end consumer. However, while the services relate to the provision of online audiovisual content, the nature, purpose, and method of use are different to that of the goods themselves. In addition, I do not consider that there will be overlap in trade channels, as the contested goods would be downloaded from websites or app stores, and the earlier services are provided by specialist companies. Overall, I consider the competing goods and services to be similar to a below medium degree.

Class 16

Educational publications; Printed publications; Printed matter

35. The contested terms are self-evidently identical or ostensibly the same to the earlier terms “*Publications (Printed -); Educational publications*”.

Books; Certificates; Teaching materials; Guide books; Newsletters

36. The earlier terms “*Publications (Printed -); Educational publications*” are broad terms that would readily cover the contested goods. Thus, the respective goods are identical based on the *Meric* principle.

Class 35

Business consultancy; Business organisation consultancy

37. The contested services are self-evidently or ostensibly identical to the earlier services “*Business advisory and consultancy services*”.

Business planning consultancy; Assistance, advisory services and consultancy with regard to business management; Assistance, advisory services and consultancy with regard to business organization; Business management consultancy in the field of executive and leadership development; Advice relating to business organisation

38. The contested services are all advisory and consultancy services in relation to the business planning, management and organisation. The applicant’s terms “*Business advisory and consultancy services; Strategic business consultancy*” are broad terms that would encapsulate the narrower contested services. Therefore, I find them to be *Merit* identical.

Business analysis; Assistance, advisory services and consultancy with regard to business analysis

39. The contested term “*Business analysis*” relates to identifying business needs and determining solutions to business problems. I consider these services to be niche services. However, there is similarity between the contested services and the earlier term “*Business advisory and consultancy services*”. Although they may share the same nature (that of being services), they will differ in purpose. Nevertheless, there is an overlap in users (mainly being businesses), method of use, and trade channels. However, I do not consider that they are complementary or in competition. Therefore, I find a medium degree of similarity.
40. In terms of the contested term “*Assistance, advisory services and consultancy with regard to business analysis*”, I find that there is greater

similarity to the earlier term “*Business advisory and consultancy services*”. This is because there will be an overlap in purpose, in addition to the points mentioned in the preceding paragraph. In addition, there might be a degree of competition as one can choose one over the other. I find that the respective services are similar to a high degree.

Business promotion; Business research; Arranging and conducting of fairs and exhibitions for business purposes; Provision of business information

41. These are all business-related services. I have no evidence or submissions to guide me. Therefore, I consider that the closest comparable term from the earlier specification is “*Business advisory and consultancy services*”. Although the exact purpose and method differ between the respective services, they are likely to share the same users and similar channels of trade, and it would not be unreasonable for them to be provided by the same or commercially linked undertakings. I do not consider them to be complementary in a trade mark sense in that while business advice/consultancy may prove a useful tool prior to the conduct of the contested services, these are not, as outlined in *Boston Scientific*, indispensable to each other. Thus, there is no degree of complementarity. I consider the services to be similar to a medium degree.

Writing of business project studies

42. The contested service involves the drafting of comprehensive analyses for business projects. I consider that there is similarity between the contested service and the earlier “*Business advisory and consultancy services*”. This is because the services overlap in general nature (both being services) and purpose as both services aim to inform and help businesses to improve their processes or products. They also share the same channels of trade and users. I find that they are similar to a medium degree.
43. That leaves “*information and advisory services related to all the aforesaid services*”. It is my view that it is commonly the case that the services this

term covers also provide information and advisory services. As a result, I consider that any overlap in end purpose, users and trade channels between the parties' services will also be found in relation to information and advisory services pertaining to the aforesaid services. Therefore, I consider that the findings that I have made in respect of the Class 35 services also apply in relation to the information/advisory services associated with those services.

Class 41

Arranging and conducting conferences; Arranging and conducting of courses, seminars and workshops; Arranging of conferences relating to business; Arranging of seminars relating to manager training; Arranging and conducting of educational events; Conducting of cultural events; Cultural services; Electronic publication services; Electronic publishing; Education services for managerial staff; Online digital publishing services; Providing on-line publications; Publication and issuing of books; Publication of printed matter in electronic form; Publishing of educational material; Publishing of electronic publications; Publishing of newsletters;

44. The contested terms are identically worded or ostensibly the same with the respective terms in the earlier specification. Therefore, they are self-evidently identical.

Publication of training manuals; Publishing; Publishing of books, magazines; Publishing of instructional books; Publishing of journals; Publishing of newspapers; Book publishing; Issue of publications; [...] publishing of texts, other than publicity texts

45. The earlier terms "Publishing of printed matter; Publishing services (including electronic publishing services)" are broader in scope and will readily cover the above contested terms. Therefore, they are identical as per *Meric*.

Education; Health education; Educational services in the nature of coaching

46. The contested terms are broad terms and will encapsulate the earlier term “*Adult education services*”, or vice versa. Therefore, they are *Meric* identical.

Conducting of educational conferences

47. The contested term will be encapsulated by the broad earlier term “*Arranging and conducting of educational events*”. Therefore, they are *Meric* identical.

Arranging of conferences relating to commerce; Arranging of conferences relating to trade; Conducting of business conferences

48. The contested terms will be encompassed by the earlier term “*Arranging and conducting conferences*” thereby being *Meric* identical.

Digital video, audio, and multimedia publishing services

49. The contested term will be encompassed by the earlier term “*Publishing services (including electronic publishing services)*” thereby being *Meric* identical.

Conducting instructional courses; Health and wellness training; Personal coaching [training]; Personal development courses; Provision of education courses; Life coaching (training); Business training consultancy services; Coaching; Conducting workshops [training]

50. The contested services are manifestly similar in nature to the earlier services “*Adult education services*”. The purpose of both is to impart knowledge and skills. Further, although training tends to be more vocational than education, the latter can also have a vocational focus. The services are therefore highly similar in purpose. The methods of use also

tend to be similar involving lessons and studies. The users and trade channels may overlap, and there is a degree of competition. I, thus, find that these are highly similar services.

Radio services for the provision of educational content

51. Following the approach in the preceding paragraph, I consider that the contested services will be a step apart from the earlier services “*Adult education services*”. This is because the competing services differ in nature and method of use, but they overlap in purpose (that of education), users, and trade channels. I find the services to be similar to a medium degree.

Writing of texts; Writing services for blogs; Writing [...] of texts, other than publicity texts

52. I have no evidence or submissions to guide me. Therefore, I will conduct my assessment based on the core meaning of the services in question. The contested services “*Writing of texts; Writing [...] of texts, other than publicity*” relate to the provision of writing content for the targeted audience. I consider that there is similarity between the contested terms and the earlier goods “*Publications (Printed-)*” in Class 16. Although they have different nature, the one being the actual printed matter, the other the services making them available, the goods and services have the same purpose namely to expose the public to written content. The goods and services are also complementary, as the earlier goods cannot effectively reach their intended audience without the contested services. Therefore, the public will believe that they could be provided by the same or commercially linked undertakings. I find them to be similar to a medium degree.
53. The contested term “*Writing services for blogs*” involves the professional process of creating written content for blogs. I consider that the earlier terms “*Electronic publishing; Publishing of newsletters*” are the closest

comparable terms. The competing services share the same general nature (all being services), and there is an overlap in purpose, which is to make information available to the public online through blog posts or newsletters. It is worth noting that newsletters can take the form of blog posts, resulting in an overlap in the method of use. In addition, the respective services share the same users and trade channels, and they could be provided by the same or commercially linked undertakings. I find them to be similar to a medium degree.

Production of radio programmes; Radio programmes (Production of-); Entertainment; Interactive entertainment

54. In the absence of particularised submissions or evidence, there is no obvious similarity between the contested services and the applicant's. I consider that the relationship between the contested terms and the earlier services is not sufficiently proximate to warrant a finding of complementarity; these services may operate entirely independently of one another, and I do not believe that consumers would think that they are provided by the same undertakings. Furthermore, there is no evidence to suggest that it is typical in trade for the respective services to reach the market through the same undertakings. Even though the competing services may share the same users, this is not a sufficient factor by itself to find similarity. They differ in nature, purpose, method of use, trade channels, and they are not complementary or in competition. Thus, I consider them to be dissimilar.

Information and advisory services related to all the aforesaid services

55. I adopt the same approach as in paragraph 43 above. Therefore, I consider that the findings that I have made in respect of the Class 41 services also apply in relation to the information/advisory services associated with those services. It follows that where I have found services to be dissimilar, the same will also apply to the services that this term covers.

Conclusion on the goods and services comparison

56. The likelihood of confusion does not arise in relation to the contested services which are dissimilar to the earlier mark's services.⁴ **The invalidation action cannot succeed against dissimilar services and, therefore, is dismissed insofar as it concerns the following terms:**

Class 41: Production of radio programmes; Radio programmes (Production of-); Entertainment; Interactive entertainment; Information and advisory services related to all the aforesaid services.

57. In respect of the Section 5(1) ground, the fact that I have found some goods and services to be identical means that the application in reliance upon that ground succeeds against those goods and services. It fails, however, for all remaining goods and services on the basis that I have found them either similar to various degrees or dissimilar. As a result of the above, the section 5(2)(a) ground only proceeds in relation to the similar goods and services.

58. While the section 5(1) ground has succeeded against identical goods and services, I will proceed with the assessment on the basis of the Section 5(2)(a) ground against the following goods and services:

Class 9: Downloadable publications; Downloadable electronic books; Downloadable electronic publications and information provided online from databases or the internet; Downloadable movies; Downloadable video files; E-books; Electronic publications; Downloadable electronic newsletters; Instructional guides; Pre-recorded videos; Video recordings; Webcasts and podcasts.

Class 35: Business analysis; Assistance, advisory services and consultancy with regard to business analysis; Business promotion;

⁴ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

Business research; Writing of business project studies; Arranging and conducting of fairs and exhibitions for business purposes; Provision of business information; Information and advisory related to all of the aforesaid services.

Class 41: Conducting instructional courses; Health and wellness training; Personal coaching [training]; Personal development courses; Provision of education courses; Life coaching (training); Business training consultancy services; Coaching; Conducting workshops [training]; Radio services for the provision of educational content; Writing of texts; Writing services for blogs; Writing [...] of texts, other than publicity texts; Information and advisory services related to all the aforesaid services.

59. For the avoidance of doubt, the application reliant upon Section 5(2)(a) (and 5(2)(b)), for that matter also fails in respect of those dissimilar services.

Average Consumer and the Purchasing Act

60. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person

is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

61. The average consumer for the goods in Classes 9 and 16 is likely to be either a member of the general public or business users. In either case, the goods will most likely be the subject of self-selection from catalogues, websites, stores or specialist outlets or their online equivalents. This suggests that the selection of such goods will predominantly be made on a visual basis, though aural considerations cannot be ignored as advice may be sought by the purchaser or offered by a trader. The cost of such goods is, in my experience, relatively low. However, the average consumer may examine the product to ensure that they select the correct type and that it is fit for purpose. Thus, the average consumer will pay a medium degree of attention.

62. For the services at issue, the average consumer will primarily be business users or a member of the general public. The consumer will select such services by looking through brochures and websites or signs on a physical property, so the visual element will be important. However, I do not discount the aural element, as word-of-mouth recommendations may also influence consumers’ decisions. The cost of the services will be relatively significant, contributing to the selection process of the service provider. Given the more specialist nature of the services in play, especially those selected by business users, I consider that the average consumer will pay a slightly higher than a medium degree of attention in choosing the service provider.

Distinctive Character of the Earlier Trade Mark

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

64. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
65. The applicant has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the applicant’s mark to consider. The applicant’s mark consists of the words “Beautiful Business” with the word ‘Beautiful’ qualifying the word ‘Business’. When combined, the words “Beautiful Business” do not strike me as highly distinctive since they seem to refer to the quality of the services associated with the mark, conveying a laudatory connotation. Bearing in mind when making my assessment that a registered trade mark must be considered to have at least a minimum

degree of distinctive character,⁵ and weighing all the factors, I find the earlier mark is inherently distinctive to a low degree.

Likelihood of Confusion

66. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.⁶ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁷
67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
68. Earlier in this decision I have concluded that:
- the goods and services at issue are ranging from identical and from a below medium to a high degree of similarity;
 - the average consumer is a member of the general public or business users. The selection process is predominantly visual without discounting aural considerations. As to Class 9 and 16

⁵ *Formula One Licensing BV v OHIM*, Case C-196/11P.

⁶ See *Canon Kabushiki Kaisha*, paragraph 17.

⁷ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

goods, the average consumer will pay a medium degree of attention. In relation to the services, the average consumer will pay a slightly higher than a medium degree of attention in choosing the service provider;

- the marks are identical;
- the earlier mark is inherently distinctive to a low degree.

69. Although I have found earlier in this decision that the inherent distinctiveness of the earlier mark is of a low degree, this does not prevent a likelihood of confusion.⁸ Taking all of the above factors into account, particularly given the identity of the marks at issue, I am satisfied that the average consumer would likely mistake the parties' marks for each other. I am, therefore, satisfied that there will be a likelihood of direct confusion between the parties' marks for the goods and services at issue as the identity of the marks counterbalances the low degree of inherent distinctiveness of the earlier mark. As a result, the opposition under Section 5(1) ground succeeds against the goods and services which I found to be identical, and under Section 5(2)(a) ground against only the following goods and services which I found to be similar at any degree:

Class 9: Downloadable publications; Downloadable electronic books; Downloadable electronic publications and information provided online from databases or the internet; Downloadable movies; Downloadable video files; E-books; Electronic publications; Downloadable electronic newsletters; Instructional guides; Pre-recorded videos; Video recordings; Webcasts and podcasts.

Class 35: Business analysis; Assistance, advisory services and consultancy with regard to business analysis; Business promotion; Business research; Writing of business project studies; Arranging and conducting of fairs and exhibitions for business purposes; Provision

⁸ See *L'Oréal SA v OHIM*, Case C-235/05 P.

of business information; Information and advisory related to all of the aforesaid services.

Class 41: Conducting instructional courses; Health and wellness training; Personal coaching [training]; Personal development courses; Provision of education courses; Life coaching (training); Business training consultancy services; Coaching; Conducting workshops [training]; Radio services for the provision of educational content; Writing of texts; Writing services for blogs; Writing [...] of texts, other than publicity texts; Information and advisory services related to all the aforesaid services.

Section 5(2)(b)

70. Given the success of the Section 5(2)(a) ground, I see no merit in considering the Section 5(2)(b) ground further. This is because the outcome in respect of the Section 5(2)(b) ground would be identical to that of the Section 5(2)(a) ground.

Outcome

71. Part of the application for invalidation has been successful. **The registered trade mark is declared invalid, subject to an appeal against this decision, with effect from 14 November 2018 for the following goods and services for which they are registered, and the registrations will be cancelled:**

Class 9: Downloadable publications; Downloadable electronic books; Downloadable electronic publications and information provided online from databases or the internet; Downloadable movies; Downloadable video files; E-books; Electronic publications; Downloadable electronic newsletters; Instructional guides; Pre-recorded videos; Video recordings; Webcasts and podcasts.

Class 16: Printed matter; Books; Certificates; Educational publications; Printed publications; Teaching materials; Guide books; Newsletters.

Class 35: Assistance, advisory services and consultancy with regard to business management; Business analysis; Business consultancy; Advice relating to business organisation; Arranging and conducting of fairs and exhibitions for business purposes; Assistance, advisory services and consultancy with regard to business organization; Assistance, advisory services and consultancy with regard to business analysis; Business management consultancy in the field of executive and leadership development; Business organisation consultancy; Business planning consultancy; Business promotion; Business research; Provision of business information; Writing of business project studies; Information and advisory related to all of the aforesaid services.

Class 41: Education; Publishing; Coaching; Arranging and conducting conferences; Arranging and conducting of courses, seminars and workshops; Arranging and conducting of educational events; Arranging of conferences relating to business; Arranging of conferences relating to commerce; Arranging of conferences relating to trade; Arranging of seminars relating to manager training; Book publishing; Business training consultancy services; Conducting instructional courses; Conducting of business conferences; Conducting of cultural events; Conducting of educational conferences; Conducting workshops [training]; Cultural services; Digital video, audio, and multimedia publishing services; Education

services for managerial staff; Educational services in the nature of coaching; Electronic publication services; Electronic publishing; Health and wellness training; Health education; Interactive entertainment; Issue of publications; Life coaching (training); Radio services for the provision of educational content; Online digital publishing services; Personal coaching [training]; Personal development courses; Providing on-line publications; Provision of education courses; Publication and issuing of books; Publication of printed matter in electronic form; Publication of training manuals; Publishing of books, magazines; Publishing of educational material; Publishing of electronic publications; Publishing of instructional books; Publishing of journals; Publishing of newsletters; Publishing of newspapers; Writing of texts; Writing services for blogs; Writing and publishing of texts, other than publicity texts; Information and advisory services related to all the aforesaid services.

72. Part of the application for invalidation has been unsuccessful. **The registered trade mark will remain registered, subject to an appeal against this decision, for the following services:**

Class 41: Production of radio programmes; Radio programmes (Production of-); Entertainment; Interactive entertainment; Information and advisory services related to all the aforesaid services.

Costs

73. The applicant has been largely successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs to the applicant as a contribution towards the cost of the proceedings on the following basis:

Official opposition fee	£200
Filing an application for invalidation and considering the counterstatement	£250
Total	£450

74. I, therefore, order The Beautiful Design Project Limited to pay to The Business Romantic Society Verwaltungs GmbH the sum of £450. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 20th day of August 2024

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General