

**O/429/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 343526 BY ASSOCIATED  
NEWSPAPERS LIMITED TO REGISTER:**

**THE SLICE**

**AND**

**THE SLICE**

**AS A SERIES OF TWO TRADE MARKS IN CLASSES 16 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 600001305  
BY CURIOUS MINDS**

## Background & Pleadings

1. On 10 October 2019, Associated Newspapers Limited (“the applicant”) applied to register the above series of trade marks for the following goods and services:

*Class 16: Printed matter; printed publications, including sections, columns and articles; periodical publications; newspapers, magazines, supplements, posters, periodicals, books, notebooks, reference books; brochures, leaflets, user guides and training manuals; instructional and teaching materials (other than apparatus); parts and fittings for all the aforesaid goods.*

*Class 41: Publishing services; publication of printed matter and printed publications; education, entertainment, publishing and publication services; on-line publication services; electronic publishing services; providing on-line electronic publications [not downloadable]; providing online electronic publications including non-downloadable content; publication of electronic books and journals on-line; provision of news online; provision of information relating to education, sports, politics, current events, cultural activities, music, travel, food and entertainment; organisation of competitions, quizzes, games and recreational and cultural facilities; organizing and arranging of sporting, cultural and entertainment events; ticket procurement, booking and reservation services for entertainment and cultural activities; news programme services for radio or television; news reporting services; all the aforesaid services also provided on-line from a computer database or from the Internet; information, advisory and consultancy services relating to all the aforesaid services.*

The application was published for opposition purposes on 1 November 2019.

2. On 28 January 2020, the application was opposed in full by CURIOUS MINDS (“the opponent”) under the fast track opposition procedure. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the following trade marks and all goods and services for which they are registered:

United Kingdom Trade Mark (“UKTM”) 3223477

The logo for SLICE, featuring the word 'SLICE' in a bold, sans-serif font. The letters 'S', 'L', and 'I' are green, while 'C', 'E', and 'E' are purple. The letters are slightly overlapping and have a modern, clean aesthetic.

Filing date: 6 April 2017

Registration date: 30 June 2017

UKTM 3223203

# SlICE

Filing date: 5 April 2017

Registration date: 30 June 2017

Both marks are registered for the following goods and services:

*Class 16: Printed matter; Printed educational materials; Printed research, evaluations, leaflets, case studies, Instructional manuals; instructional manuals for training and licencing purposes; Printed certificates; Printed promotional material, Newsletters, Pamphlets, Signboards of paper or cardboard; Books; Textbooks; Notebooks.*

*Class 41: Education; Education services related to the arts, Training; Advisory services relating to education and training related to the arts, Consultancy services relating to the education and training of personnel in the arts; Educational services for providing courses of education, training and instruction; Education and research services in leadership, Arranging and conducting of educational seminars, workshops, conferences and training courses; Arranging of displays for research and educational purposes; Development of research and educational materials; Development of learning networks; School services; Training of teachers; Provision of on-line electronic publications; Publication of multimedia material online; Provision of online tutorials; Publishing of educational material and matter; Publication of printed matter and printed publications; Lease of instructional and teaching materials, lease of educational material.*

3. In its Notice of Opposition, the opponent identifies what it considers visual, aural and conceptual similarities between the respective marks and provides submissions on the similarity between the respective specifications, ultimately concluding that the goods and services applied for are either the same or similar to those for which the earlier marks are registered.

4. The applicant filed a counterstatement in which it essentially denies the basis of the opposition, specifically that the applied for mark is similar to the opponent's marks and that the competing goods and services are identical or indeed similar. Consequently, it submits that there is no likelihood of confusion under section 5(2)(b).

5. Rules 20(1)-(3) of the Trade Marks Rules ("TMR") (the provisions of which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads as follows:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The net effect of the above is that parties must seek leave in order to file evidence in fast track oppositions. No such leave was sought in respect of these proceedings. The only exception to that general position is that a fast track opponent relying on an earlier mark (or marks) which is (or are) subject to the proof of use provisions must file evidence of use at the time of filing the opposition; a point which I shall return to later.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was not requested nor considered necessary in this case and only the applicant elected to file written submissions. Both parties are reminded that any earlier decisions cited within such submissions are not binding on me. This decision is taken following a careful reading of the papers which I will refer to, as necessary.

8. The applicant is represented by Bird & Bird LLP and the opponent by Counterculture Partnership LLP.

## **Decision**

9. Section 5(2)(b) of the Act reads 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.”

10. Section 5A of the Act states as follows:

“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.”

11. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. Under the provisions outlined above, the opponent’s trade marks clearly qualify as earlier marks. In accordance with section 6A of the Act, as neither had completed its registration procedure more than five years prior to the filing date of the applicant’s mark, neither is subject to the proof of use requirements. Consequently, the opponent

can rely upon its marks and all goods and services it has identified without providing evidence of use.

### **Section 5(2)(b) - Case law**

13. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

#### **The principles:**

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

14. The competing goods and services are laid out above at paragraphs 1 and 2. I have reviewed, and will keep in mind, the comments made by both parties in respect of the competing goods and services.

15. The following goods and services are listed in both the application and each of the opponent's specifications and are therefore, self-evidently, identical:

- *Printed matter; books and notebooks* in class 16

- *Publication of printed matter and printed publications; education services and on-line publication services* in class 41

16. In addition to cases of *literal* identity, the General Court (“GC”) specified a further provision as to when goods can be considered identical (though it applies equally to services) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05. It stated:

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

17. On that basis, I also find the following goods and services to be identical:

#### Class 16

*Printed publications, including sections, columns and articles; periodical publications; newspapers, magazines, supplements, posters, periodicals; reference books; brochures, leaflets, user guides and training manuals; instructional and teaching materials (other than apparatus) in the application are encompassed by the opponent’s printed matter.*

#### Class 41

The applicant’s *publication of electronic books and journals on-line* falls within the remit of the opponent’s *provision of on-line electronic publications*.

The applicant’s *electronic publishing services* encompasses the opponent’s *provision of on-line electronic publications*.



The opponent's *provision of on-line electronic publications* encompasses the applicant's *providing on-line electronic publications [not downloadable]* and *providing online electronic publications including non-downloadable content*.

The applicant's *publishing services* and *publishing and publication services* encompass the opponent's *publication of multimedia material online; publishing of educational material and matter* and *publication of printed matter and printed publications*.

18. When moving to compare the remaining goods and services, I am guided by the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, in which the Court stated at paragraph 23:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, 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".

19. 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.

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

"... 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."

21. 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."

22. For the purpose of comparing the remaining 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 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]).

## **Class 16**

23. The opponent's marks are registered for *printed matter*. The applicant seeks registration for the "parts and fittings" of all goods it has applied for in class 16 (paragraph 1 refers) which are, essentially, one form or another of printed matter. Whilst I am conscious not to apply too broad an approach, the parts and fittings for such goods are likely, therefore, to refer to items such as paper or binding materials, for example. On that basis, the goods are unlikely to target the same user group, their respective uses are different and I see little opportunity for competition. That said, though I accept that it does not necessarily signify similarity<sup>1</sup>, with one good being a component of the other, here there is likely to be some crossover in physical nature and a degree of complementarity in play. Whilst sufficient, in my view, to engage a finding of similarity, I would consider it no more than a low degree.

## **Class 41**

### **Provision of information relating to education**

24. The opponent's marks are registered for the *publishing of educational material and matter*. Whilst this is, in essence, a means of providing some degree of educational information, the applied for service allows a wider remit insofar as the provision of information is concerned, which could be delivered in a variety of ways; in person, for example. Still, the relationship between the services invites an opportunity for crossover in use and certainly in their respective users. Though there may be a difference in the nature of the services, it seems likely that they will reach the market through the same or similar trade channels. The services are not complementary but could occupy competitive roles. On balance, I find the similarity to be of at least a medium degree.

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<sup>1</sup> *Les Éditions Albert René v OHIM*, Case T-336/03

**Provision of information relating to sports, politics, current events, cultural activities, music, travel, food and entertainment**

25. It is not clear from the above term what the intended method of provision for such information is. The opponent's marks are registered for the *provision of on-line electronic publications, publication of multimedia material online and publication of printed matter and printed publications*. There is a similarity in the services' use insofar as each delivers information to consumers, within which there is likely to be an overlap, at least generally, though I accept that the opponent's terms are relatively broad and that the actual nature of the services could differ considerably. It seems likely, however, that there could be a correlation in trade channels on account of the services' shared use. The services are not complementary, though an element of competitiveness could arise where the content of the information being relayed is similar. Weighing all factors, I find the services are similar to a degree between low and medium.

**Entertainment services; organisation of competitions, quizzes, games and recreational and facilities; organizing and arranging of sporting and entertainment events**

26. In class 41, the applicant seeks registration for entertainment at large and a selection of services which are, at least generally, intended to provide entertainment, though in more definitive formats. The opponent's marks are registered for services relating either to publishing or education (or a combination of the two). Whilst I appreciate that some of the opponent's educational services could look to incorporate a degree of entertainment in their finished state (the *arranging and conducting of educational seminars, workshops, conferences and training courses* or the *arranging of displays for research and educational purposes*, for example), the purposes of the respective services, at their core, are different. Though both are accessible to the public at large, one targets consumers seeking an opportunity for learning and the other consumers seeking (primarily) recreational enjoyment. The fundamental nature of the services is consequently different, as are the respective trade channels. In my experience, educational services are often promoted via relevant channels such as

learning establishments, whereas consumers are likely to deliberately and independently seek opportunities for entertainment or recreation. I do not consider the services complementary nor competitive and, having applied the principles set out in *Treat*, I reach the conclusion that the services are not similar.

### **Ticket procurement, booking and reservation services for entertainment activities**

27. The opponent's earlier marks are registered for a variety of services which offer the arrangement of events in the field of education or research; *displays*, *seminars* and *conferences* to name a few. Whilst I accept that such arrangements are likely to require an element of the above (ticket procurement, reservations etc.), as alluded to earlier, I find there to be a clear distinction in the core purpose of educational services and those which are selected on the basis of their entertainment value. It seems reasonable to conclude, for much the same reasoning, that there will consequently be a distinction here between the services' use and users. There is a further degree of separation in the nature of the respective services and their likely channels of trade. I see little opportunity for competitiveness or complementarity and therefore conclude that there is no similarity.

### **Organizing and arranging of cultural events; organisation of cultural facilities; ticket procurement, booking and reservation services for cultural activities**

28. What the above applied-for services have in common is a specific reference to a cultural element, with each term playing a role in the organisation of cultural events. The opponent's marks are registered for *education services related to the arts*, *advisory services relating to education and training related to the arts* and *consultancy services relating to the education and training of personnel in the arts*. Whilst I have found a distinction between the opponent's services and those in the application which are directly related to *entertainment*, in my view, there is more of a relationship to be considered between services which incorporate *the arts* (even where education is at the forefront) and those which incorporate a cultural component. In my experience, there is a closeness between 'the arts' and culture, at least broadly, the former often encompassing a variety of mediums used to express cultural indications or

preferences. For that reason, though I accept that the services' respective uses, at their core, are likely to differ, there seems to be an opportunity for similarity in users and, to a degree, the services' nature. Still, given that the opponent's services are, by definition, educational, there is unlikely to be any immediate crossover in the respective trade channels and the services are not complementary nor competitive. Weighing all factors, I am minded to conclude that there is a degree of similarity here, but only of a low degree.

**News programme services for radio or television; news reporting services; provision of news online**

29. The earlier marks are registered for *newspapers* in class 16 and various services in class 41 relating to the publication of printed matter, which could include the news. The respective goods and/or services are likely to be accessed by the same consumers and, although the nature may differ, they will be accessed for the same purpose; essentially, to gain an insight into recent, notable events. Due to the differing nature(s), there is likely to be a distinction in the trade channels via which the goods or services reach the market. I see no complementarity but there may be a degree of competitiveness whereby consumers consider their preferred medium for accessing the news. It would not seem unlikely, in my view, for consumers to expect the same entity to offer both *newspapers* and *news reporting* or *news programme services* or the *provision of news online*. On balance, I find there to be at least a medium degree of similarity.

30. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49. ...I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.” [my emphasis]

31. It follows that the opposition fails at this juncture in respect of *entertainment; organisation of competitions, quizzes, games and recreational facilities; organizing and arranging of sporting and entertainment events and ticket procurement, booking and reservation services for entertainment activities; all the aforesaid services also provided on-line from a computer database or from the Internet; information, advisory and consultancy services relating to all the aforesaid services.*

### **The average consumer and the nature of the purchasing act**

32. As indicated in the above case law, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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. 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.”

33. Beginning with the goods at issue, given the broad nature of the term, the average consumer of *printed matter* and the remaining goods in class 16 is likely to be the public at large, though of course within that there will be distinct groups of consumers with a specific interest in the specialism to which the matter itself relates. Whilst the degree of attention paid during the purchasing process will be variable (as will the cost of the goods, some being offered for free), consumers will be eager to ensure that the contents are relevant and fit for purpose. Where the materials are educational, the consumer is likely, more often than not, to be pursuing an academic interest or seeking to obtain a qualification or accreditation of some degree, so it follows that they will

approach the selection with an elevated level of care. All things considered, it seems likely that consumers' attention will range from a medium degree to one which is fairly high. In my experience, the goods are primarily selected either online or from traditional retail outlets. Consequently, visual considerations are likely to play a predominant role in the purchasing process, though I do not discount the opportunity for aural interactions such as word of mouth recommendations.

34. Moving now to the services in play, I see two consumer groups likely to emerge. Generally, educational services will target academics, be it from a personal or professional perspective. Publishing services will target individuals or businesses seeking the distribution of prepared matter, though the scale, of course, can vary considerably. In my experience, the former is likely to garner a relatively high degree of attention from consumers, given the high esteem in which they are likely to hold education. When it comes to publishing, consumers will have factors such as reputation, reliability and readership to consider when making their selection. Consequently, for all services, a fairly high degree of attention is likely to be applied. To my knowledge, the services are likely to be advertised using relatively traditional means at a relevant establishment, for example, or will be promoted through online channels. However, given the care with which consumers are likely to approach the selection, it seems reasonable to me that they would also value, and deliberately seek out, the guidance or recommendations of their peers, professional or otherwise. Both visual and aural factors are therefore likely to be relevant.

### **Comparison of trade marks**



35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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.”

36. It would be wrong, therefore, 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.

37. The trade marks to be compared are displayed in the table below:

Opponent’s trade marks	Applicant’s trade mark(s)
<p data-bbox="347 1061 584 1093"><u>UKTM 3223477:</u></p>  <p data-bbox="347 1332 584 1364"><u>UKTM 3223203:</u></p> <p data-bbox="379 1395 552 1451">SLICE</p>	

38. The opponent’s figurative mark (ending 477) comprises the word ‘SLICE’, presented in block capitals, with a diagonal strikethrough (in white) beginning at the word’s first letter (S) and travelling upward towards its final letter (E).The letter segments which lie north of the strikethrough are coloured in various shades of green and those positioned south of the strikethrough in various shades of purple. The mark’s overall impression will lie predominantly in the word ‘SLICE’, with the mark’s stylisation playing a lesser role.

39. The opponent's word-only mark (ending 203) consists only of the word 'SLICE'. The S, C and E are capitalised, with the L and I presented in lower case. Whilst the unusual, or at least non-traditional, combination of letter casing may make a small contribution to the mark's character, I am mindful that fair and notional use enables the opponent to present the mark in a variety of standard fonts or casing. The mark's overall impression, therefore, resides primarily in the word SLICE.

40. Each mark in the applicant's series comprises two words; THE SLICE, or at least what will be interpreted as such. Though both words are written in block capitals, 'THE' is presented in a significantly smaller font than 'SLICE' and is positioned at the beginning of the mark in a central vertical position. Through the word SLICE, there is a strikethrough which travels diagonally downward from near the top of the second letter (L) to the centre of the final letter, effectively removing the central horizontal stroke of the three which would traditionally signify a capitalised letter 'E'. In my view, it seems clear that consumers would still recognise the second word as 'SLICE', given that only one small element is absent from the final letter, and that the word will be relatively common for the average consumer. The only difference between the marks within the series is the colour in which they are presented; the first in a dark blue and the second in black. The marks' overall impressions will reside mostly in their word elements, primarily SLICE, on account of the lesser size of the word THE, with the stylisation playing a smaller role still.

### **Visual comparison**

41. The differences between the opponent's figurative mark and the applicant's series marks are the absence (or presence) of the word 'THE', positioned at the beginning of the applicant's marks, the colours in which the marks are presented and the adopted fonts, though both appear fairly standard. The marks are similar insofar as both comprise (either solely or partially) the word SLICE, written in block capitals, with a strikethrough cutting through several of the letters, though I do note the differing orientation. Still, on balance, I find the visual similarity to be of a reasonably high degree.

42. The opponent's word-only mark is absent of any stylisation or figurative elements. It does not share a 'strikethrough' with the applicant's series and, again, the marks differ in their use, or lack, of the word 'THE'. Still, keeping in mind where the overall impressions of the respective marks are likely to lie, the visual similarity seems fairly high.

### **Aural comparison**

43. All marks at issue here are composed of standard English language words which the average consumer is likely to be not only familiar with but accustomed to articulating. The opponent's marks will be articulated identically, in one syllable; SLICE. The applicant's marks will be articulated in two syllables; THE-SLICE. On that basis, notwithstanding that the *beginnings* of marks generally have more impact on consumers than their endings<sup>2</sup>, I find the aural similarity to be of at least a medium degree.

### **Conceptual comparison**

44. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

45. In my view, the average consumer will readily grasp the concept evoked by the opponent's marks. 'SLICE' will be understood to mean a portion or share of something taken from a larger, or perhaps complete, piece (a slice of bread taken from a loaf, for example). Whilst this is, in my experience, the more common use of the word, there are a number of other meanings which consumers are also likely to be familiar with. It can be used to describe a type of kitchen utensil (a fish slice, for example) or as a verb referring either to the act of cutting through something or a particular sporting shot. In the applicant's series, the word 'SLICE' is preceded by 'THE'. Whilst this could encourage consumers to conceptually interpret the mark as a definitive article (as

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<sup>2</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

opposed to a verb, for example), in this instance, in my view it does little to alter the conceptual significance of the word which follows, particularly given the definition which I have identified as the most likely to resonate with consumers which is, in itself, a definitive article. That being so, it seems likely that consumers will recall an identical concept from each of the marks. If such an approach is incorrect, I find the respective concepts are, at least, highly similar.

### **Distinctive character of the earlier trade mark**

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

47. Given that the opponent has not made a pleading of enhanced distinctiveness, and in the absence of evidence of use, I have only the inherent distinctiveness of the earlier marks to consider. It is widely accepted, though only a guideline, that words which are invented often possess the highest degree of distinctive character, whilst words which are suggestive or allusive of the goods or services relied upon generally possess the lowest. The earlier marks are both representations of the word 'SLICE' which, though a relatively common word in the English language, to my knowledge, has no clear association or relevance to the goods or services at issue. Whilst I take into account the marks' stylisation, I have found that both marks' overall impressions lie predominantly within the word itself. Weighing all factors, I consider both of the earlier marks to possess a medium degree of inherent distinctiveness.

### **Likelihood of confusion**

48. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

49. 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 down to the responsible undertakings being the same or related.

50. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he 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.""

51. Earlier in this decision I reached the following conclusions:

- Some of the competing goods are identical; some are similar to no more than a low degree.
- Some of the competing services are identical; some are similar to at least a medium degree; some to a low to medium degree and some a low degree.
- The average consumer is likely to be a member of the general public or an academic or business user.
- Visual and aural considerations are both likely to play a key role in the selection process.
- For the goods at issue, consumers are likely to pay between a medium and high degree of attention to the selection and, for the services, a fairly high degree.
- The marks' visual similarity is of at least a fairly high degree (reasonably high in the case of the opponent's figurative mark) and the aural similarity of at least a medium degree.
- Conceptually, the marks are highly similar, if not identical.
- The earlier marks possess a medium degree of inherent distinctive character.

52. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of each of the above conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

53. I begin by considering direct confusion. Whilst I have found what I would consider a fair degree of similarity between both of the opponent's marks and the applicant's mark, to my mind it is the opponent's figurative mark which is more likely to engage direct confusion, on account of the stylistic similarities in play, namely the block typeface and diagonal strikethrough, in addition to the similarities which exist between the words themselves. In my view, such a likeness between the competing marks will likely mean that only a minimum degree of similarity between the goods and/or services would leave consumers susceptible to the effects of direct confusion, at least where only a low degree of attention is applied to their selection. I reach that finding notwithstanding the rule of thumb regarding the importance of the *beginning* of marks, which of course are different in this case. Given its traditional nature and function, I am not of the view that consumers would recall the presence, or absence, of the word 'THE' in either, or indeed any, of the marks at issue. Instead, it seems likely that consumers could easily overlook this contrast, as well as the aesthetic variations and, consequently, mistake the opponent's mark for the applicant's when used in fields which are (even vaguely) related. Where consumers' attention is elevated above a low degree, however, they are likely to be alive, at least visually, to the stylistic differences between the marks and will, as a result, bypass direct confusion.

54. If I am incorrect in my findings regarding direct confusion and, instead, the marks' differences readily allow consumers to distinguish between them when applying a low degree of attention or higher, it seems likely that consumers will still face *indirect* confusion, not only in respect of the opponent's figurative mark, but its word-only mark too. Whilst I keep in mind that such a finding should not be reached simply because the respective marks share a common element<sup>3</sup>, the clear similarities between both of the opponent's marks and the application are such that, in my view, consumers will at least conclude that they originate from a shared undertaking. I can imagine that consumers familiar with the earlier marks, upon seeing the later mark, would erroneously attribute the differences to a natural evolution in branding or marketing, for example. It would be seen as another 'SLICE' mark, which has simply undergone a stylistic revision. To my mind this is, again, the likely result for all degrees of similarity between the respective goods and/or services.

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<sup>3</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

## **Conclusion**

**55. The opposition has succeeded in respect of the following goods and services for which, subject to any successful appeal, the application will be refused:**

*Printed matter; printed publications, including sections, columns and articles; periodical publications; newspapers, magazines, supplements, posters, periodicals, books, notebooks, reference books; brochures, leaflets, user guides and training manuals; instructional and teaching materials (other than apparatus); parts and fittings for all the aforesaid goods (Class 16)*

*Publishing services; publication of printed matter and printed publications; education, publishing and publication services; on-line publication services; electronic publishing services; providing on-line electronic publications [not downloadable]; providing online electronic publications including non-downloadable content; publication of electronic books and journals on-line; provision of news online; provision of information relating to education, sports, politics, current events, cultural activities, music, travel, food and entertainment; organisation of cultural facilities; organizing and arranging of cultural events; ticket procurement, booking and reservation services for cultural activities; news programme services for radio or television; news reporting services; all the aforesaid services also provided on-line from a computer database or from the Internet; information, advisory and consultancy services relating to all the aforesaid services. (Class 41)*

**56. The opposition has failed in respect of the following services for which, subject to any successful appeal, the application will proceed to registration:**

*Entertainment; organisation of competitions, quizzes, games and recreational facilities; organizing and arranging of sporting and entertainment events and ticket procurement, booking and reservation services for entertainment activities; information, advisory and consultancy services relating to all the aforesaid services. (Class 41)*



## **Costs**

57. As the opponent enjoys a greater degree of success, it is entitled to a contribution toward its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the applicant on the following basis:

Filing a form TM7F (official fee):	£100
Preparing a statement of grounds and considering the counterstatement:	£250
<b>Total:</b>	<b>£350</b>

**58. I order Associated Newspapers Limited to pay CURIOUS MINDS the sum of £350. This sum is to be paid within two months 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 9th day of September 2020**

**Laura Stephens  
For the Registrar**