TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2146979A
BY EMAP PERFORMANCE LIMITED (PREVIOUSLY EMAP RADIO LIMITED)
TO REGISTER THE MARK
RADIO CITY IN CLASSES 9 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No 50047
BY RADIO CITY TRADEMARKS LLC

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2146979A
by Emap Performance Limited (Previously Emap Radio Limited)
to register the mark RADIO CITY in Classes 9 and 41

and

IN THE MATTER OF Opposition thereto under No 50047
by Radio City Trademarks LLC

DECISION

1. On 3 October 1997 EMAP Radio Limited applied to register the mark RADIO CITY for the following specification of goods and services

Class 9:

Records, discs, tapes, cassettes, cartridges, cards or other carriers all bearing sound recordings.

Class 41:

Organisation, conducting and production of events for sporting purposes; organisation, conducting and production of parties.

2. The application is numbered 2146979A.

3. On 5 August 1999 Radio City Trademarks LLC filed notice of opposition to this application. They are the proprietors of the following earlier trade marks.

No.	Mark	Class	Specification
2009209	RADIO CITY	25	Articles of leisure clothing and articles of casual clothing; shirts, T-shirts, tank tops, sweatshirts, polo shirts, windbreakers, jackets, sweatpants, sweatbands, hosiery, scarfs, shawls, skirts, shorts, slacks, trousers, jumpsuits, dresses, bathing suits, bathrobes, sweaters, hats, visors, headbands, wristbands, ties, belts, gloves, pyjamas, nightgowns, articles of underclothing, braces, overalls, boxer shorts, rompers, layettes, socks and dance costumes; athletic apparel;

			children's apparel; adorned leotards, tights, skirts, jackets, dresses, gloves, hats, masks, braces, headgear and shoes, all being for dance costumes; headgear, footwear, boots, shoes and slippers.
		41	Entertainment services relating to dance, theatre and musical performances and to movie shows and performances; production and presentation of theatrical, musical and cinematic shows and performances.
2122853	RADIO CITY ROCKETTES	25	Articles of clothing, headgear, footgear, boots, shoes and slippers.
		41	Entertainment services relating to dance, theatre and musical performances and to movie shows and performances; production and presentation of theatrical, musical and cinematic shows and performances; entertainment services by a dance group; live stage performances, recorded and transmitted performances for television, and performances and appearances in connection with parades, contests, promotions, concerts, theatre productions, stage shows and movies.

4. The opponents also say that RADIO CITY is a well known mark within the meaning of Article 6 bis of the Paris Convention. Objection is said to arise under Sections 5(2)(b) and 5(4)(a). In fact the supporting text refers to identical or similar marks and thus appears also to contemplate an objection under Section 5(2)(a). There is also a request for the exercise of any discretion available to the Registrar. I have no general or overriding discretion so need make no further reference to this aspect of the opposition.

5. The applicants filed a counterstatement denying the above grounds.

6. Both sides ask for an award of costs in their favour.

7. Both sides filed evidence. Neither side has asked to be heard and neither side has made written submissions beyond the observations made in the evidence itself. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

8. Section 5(2) reads:

> "5.-(2) 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, or

(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."

9. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

10. Although I consider there is some conflict between the wording of the opponents' objection and the sub paragraph reference it is evident that they have one mark (No. 2009209) which is identical to the mark applied for and one (No. 2122853) which is similar. I propose therefore to take the objection at its broadest, that is to say that it arises under both sub paragraph (a) and (b) of Section 5(2). No. 2122853 has a slightly wider specification of goods and services but nothing in my view turns on the point. I will therefore approach the matter on the basis of the opponents' registration No. 2009209 which gives rise to an objection based on identical marks. Having regard to the ECJ cases I bear in mind particularly that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa, the latter being the case here (Canon v MGM, paragraph 17) and that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it (Sabel v Puma, paragraph 24).

11. In the latter context the opponents have filed a declaration by Mechelle Evans, their Vice President. I can find nothing in this declaration or the supporting exhibits that remotely supports any claim to use in this country or any enhanced degree of distinctive character for the mark as a result of such use. In the circumstances I do not propose to summarise this evidence. The character of the mark therefore rests on its inherent attributes. Although the words that make up the mark are dictionary words the combination is perhaps somewhat unusual in the context of the goods and services at issue. I, therefore, consider it to be a moderately strong mark.

12. The opponents have not identified in their statement of grounds or evidence the basis for their view that similar goods/services are involved and confusion likely. Nor have they filed any written submissions to assist me. They seek refusal of the application in its entirety. I therefore take it to be a blanket objection to the full range of goods and services tendered for registration.

13. As the applicants' Class 9 goods have no obvious point of similarity with any of the goods/services of the opponents' registrations I dismiss the opposition in relation to that Class. The position with regard to Class 41 necessarily requires a little more attention because the opponents' registration also covers services in that Class.

14. In this respect I bear in mind Jacob J's remarks in Avnet Incorporated v Isoact Limited 1998 FSR 16 to the effect that

> "..... definitions of services ..... are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes".
>
> 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."

15. The essence of the opponents' specification (for this purpose I also take into account the slightly wider specification of No. 2122853) is entertainment services and the production and presentation of shows and performances. They are set particularly in a theatrical, musical and cinematic context but in the case of the RADIO CITY ROCKETTES registration encompass a slightly wider range of performing arts. In my view these services are distinct from the applicants' services of "organisation, conducting and production of events for sporting purposes; organisation, conducting and production of parties". It may, of course, be the case that the organisation of a party might entail some kind of show, a magic show at a children's party say. Also many large sporting events have an opening and closing ceremony which may involve what might loosely be called a show (parades, dancing etc.) but that does not make entertainment services similar to the services applied for. Without unduly stretching the natural meaning of the terms used in the applicants' Class 41 specification I conclude that they are different to those of the opponents' registrations. Even allowing for the fact that, in the case of No. 2009209, identical marks are involved there is no likelihood of confusion.

16. The Section 5(4)(a) case is, I assume, based on the law of passing off. On the evidence before me the objection does not get off the ground. It would, I think, be fair to say that there is some awareness in this country of the Radio City Music Hall in New York (a brochure for which is at Exhibit D of Mechelle Evans' evidence) if only amongst those who have visited the city. But there is no evidence to suggest that any such awareness has been translated into a protectable goodwill in this country let alone that use of the mark in relation to the goods and services applied for would result in a misrepresentation. The Section 5(4)(a) case is bound to fail.

17. The opposition as a whole has failed. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17TH day of August 2001

M REYNOLDS
For the Registrar
The Comptroller-General