

O-200-11

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2510559
IN THE NAME OF JOHN ROSSALL**

IN RESPECT OF THE TRADE MARK

THE GLITTER BAND FEATURING JOHN ROSSALL

IN CLASS 41

AND

**THE OPPOSITION THERETO (NO 99336)
BY
PETER PHIPPS**

Trade Marks Act 1994

**In the matter of
trade mark application 2510559
in the name of John Rossall**

in respect of the trade mark:

THE GLITTER BAND FEATURING JOHN ROSSALL

in class 41

**and the opposition thereto (no 99336) by
Peter Phipps**

Introduction

1. On 9 March 2009, John Rossall applied to register the above trade mark in class 41 of the Nice Classification system¹. Following publication of the application in the *Trade Marks Journal* on 17 April 2009, Peter Phipps filed notice of opposition against the application which is for the following services:

Providing musical entertainment by way of live shows and tours played in public and private venues and by appearances on television; recording and publishing of music.

2. Mr Phipps' opposition is brought under sections 3(6), 5(1), 5(2)(a), 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). After reviewing the case, the registrar gave case management directions under rule 62(1)(h) of the Trade Mark Rules 2008² to separate the proceedings in order that the grounds of opposition under section 5(2) should be determined first. The remaining grounds of opposition would only be returned to if the section 5(2) grounds did not dispose of the proceedings in the opponent's favour. No objection to these directions was made by either party. This decision is, therefore, solely concerned with the objection to registration under sections 5(2)(a) and (b) of the Act.

3. Section 5(2) of the Act states:

"(2) A trade mark shall not be registered if because –

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

² "62.—(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may...(h) direct that part of any proceedings be dealt with as separate proceedings."

(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.”

4. Mr Phipps relies upon all the goods and services of two earlier registered trade marks, as follows:

(i) UK trade mark 2037739



Class 41: *Playing of music as entertainment.*

Date filed: 23 September 1995

Date of completion of the registration procedure: 28 June 1996.

(ii) Community Trade Mark (“CTM”) 7176019



Class 09: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.*

Class 16: *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional*

and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

Class 41: *Education; providing of training; entertainment; sporting and cultural activities.*

The notice of opposition also referred to a third mark: international registration 981884; however, this is only designated in the United States, using the UK as the Office of Origin based upon Mr Phipps' UK registration 2037739 (as above). Consequently, this is a duplicated reference to 2037739 and does not need to be considered in these proceedings.

5. Mr Phipps' UK mark 2037739 was registered more than five years prior to the date the opposed application was published; consequently, it is subject to the proof of use regulations³. Mr Phipps has made a statement of use in relation to the services relied upon (playing of music as entertainment). Mr Phipps' CTM was registered less than five years prior to the publication date and so is not subject to the proof of use regulations; it may, therefore, be considered for the full breadth of its specifications.

6. Mr Rossall filed a counterstatement; in relation to the section 5(2) ground he states that his mark has been used to avoid confusion, which is taken to mean that he denies a likelihood of confusion.

7. Neither side asked for a hearing, both being content for a decision to be made from the papers on file. Both parties filed evidence, and Mr Phipps filed written submissions in lieu of a hearing. I bear the parties' evidence and submissions in mind in reaching my decision (but see my comments below in this regard).

Evidence

8. Both the earlier marks are the same. In terms of specification coverage, Mr Phipps' strongest case rests with his CTM. I will consider only the CTM compared to the application because, in addition to the specification of the CTM being wider than that of Mr Phipps' UK mark, the CTM is also not subject to the proof of use regulations. Bearing this in mind and in view of the fact that this decision deals only with the ground brought under section 5(2), I do not intend to make a full summary of the evidence but I will, instead, draw out facts which I consider to be relevant to this decision.

9. The evidence comes from Mr Phipps and Mr Rossall, and from Mr Phipps' solicitor in these proceedings, Rory Khilkoff-Boulding. Messrs Phipps and Rossall were founder members of The Glitter Band in 1973. Mr Rossall left the band in 1974 and Mr Phipps in 1978; however, Mr Phipps rejoined the band in

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

1985 and traded from that date as The Glitter Band in partnership with Gerry Sheppard. After Mr Sheppard's death in 2003, Mr Phipps continued performing and trading as The Glitter Band (having been assigned Mr Sheppard's interest in the intellectual property rights in the name via Mr Sheppard's executors). Mr Phipps' band performed in the UK and internationally. It is not clear what the position was regarding The Glitter Band between 1978 and 1985, although a defence and counterclaim in 1997 High Court proceedings claims that the band stopped performing in 1977 after musical tastes changed, but reformed in 1981 once a new audience had been found in universities. A High Court writ issued on 19 July 1983 refers to The Glitter Band (as represented by Mr Sheppard) as possessing substantial goodwill and reputation in the field of popular music, both on its own and in conjunction with Gary Glitter (the stage name of Paul Gadd).

10. Bookings for the Glitter Band declined in 2000 following the adverse publicity surrounding the conviction of Gary Glitter (even though he had not been involved with the band for more than twenty years). However, the evidence shows that the band continued to perform after that date in the UK and in Europe. There is evidence that at times Messrs Phipps and Sheppard performed under the name separately, there having been an estrangement between them; however, each retained 50% of the rights to the name (as a partnership) and there was an agreement that they could both perform with separate groups of musicians under the name. I note that Mr Kilkhoff-Boulding states that the personalities of The Glitter Band are not as well-known as other bands (e.g. The Beatles and The Rolling Stones).

11. Having left the band in 1974, Mr Rossall has also performed variously as The Glitter Band, John Rossall's Glitter Band and The Glitter Band featuring John Rossall, releasing a CD ("Glitteresque") in 2008 under the latter name. Mr Rossall also experienced the adverse effect of the Gary Glitter conviction, in terms of reduced bookings.

Decision

12. Although Mr Phipps has brought these proceedings under section 5(2)(a) and 5(2)(b) of the Act (as well as section 5(1)), the section 5(2)(a) ground of objection is plainly unsustainable owing to the presence in the application of the words FEATURING JOHN ROSSALL, which means that the marks cannot be considered as identical⁴. The remainder of this decision will therefore address the ground of objection under section 5(2)(b) of the Act. The leading authorities which guide me in relation to this section are from the CJEU (Court of Justice of

⁴ In *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00 the European Court of Justice stated: "54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that 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."

the European Union): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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 BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Comparison of goods and services

13. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the CJEU stated at paragraph 23 of its judgment:

“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.”

The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services 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, taking into account how goods/services are classified in trade.

14. Since both parties' marks cover services in class 41, I will begin by assessing this class only. The services are set out in the table below:

Mr Phipps' class 41 services	Mr Rossall's class 41 services
Education; providing of training; entertainment; sporting and cultural activities	Providing musical entertainment by way of live shows & tours played in public and private venues and by appearances on television; recording and publishing of music

Mr Phipps' term *entertainment* is a wider term than the Mr Rossall's *providing musical entertainment by way of shows and tours playing in public and private venues and by appearances on television*; Mr Rossall's term therefore falls within the ambit of Mr Phipps' *entertainment* and so these services of the respective parties are considered to be identical with one another⁵. Entertainment includes live and recorded performances; recorded performances could be a studio recording of a band or artist's musical work or recordings of their live performances. The purpose of the entertainment service is to listen to music; the purpose of recording and publishing the music is so that consumers can listen to it. Although their nature is not the same, the purpose of each is the same or, at the very least, nearly identical. The service of recording and publishing music is inextricably linked to the result: the recorded musical performance itself. Recording and publishing of music is complementary to the entertainment/performance, whether live or in a studio; there can be no recording without a performance. Mr Rossall's *recording and publishing of music* is highly similar to Mr Phipps' *entertainment services*.

⁵ See *Gérard Meric v Office for Harmonization in the Internal Market (OHIM)*, General Court ('GC'), case T-133/05: "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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."


Average consumer and the purchasing process

15. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. The average consumer is the general public. An entertainment service, particularly musical entertainment, is an audio/visual experience. Being present at a live performance entails listening and watching the band or artist. 'Watching' a band or musical artist on the television will involve listening to them as much as the visual perception. Buying a music CD or downloading music requires a visual selection of the relevant recording; listening to a streamed audio file over the Internet requires a visual selection of the relevant file. However, listening to music on the radio is an entirely aural experience (unless one includes the possibility that the audio equipment being used displays the name of the artist or track which is playing). The average consumer will encounter the marks both visually and aurally so these are both important when considering the manner in which the marks are perceived. His level of attention will be no greater and not less than is the norm for the purchase of entertainment.

Comparison of trade marks

16. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

17. The marks to be compared are:

Mr Phipps' mark	Mr Rossall's mark
	THE GLITTER BAND FEATURING JOHN ROSSALL

18. Mr Phipps' mark contains a stylised capital G, the flourishes of which extend the length and breadth of the whole mark. The stylised G forms the capital letter of GLITTER; it is not a separate or independent part of the mark. As regards the words themselves, although 'THE' and 'BAND' are subordinate to the word 'GLITTER' as this is the word which describes (or is the name of) the band itself, the phrase exists as a single dominant and distinctive element. Mr Rossall's

mark is twice as long, in terms of word components, as Mr Phipps' mark. It commences with the identical words of Mr Phipps' mark. The composition of the mark is split into essentially two parts. The dominant part of Mr Rossall's mark is THE GLITTER BAND. It appears at the front of the mark and the remaining words play a subordinate role: they convey information that THE GLITTER BAND features an individual named JOHN ROSSALL. Both marks, therefore, share the same dominant distinctive component: the words THE GLITTER BAND.

19. The stylised G is not present in Mr Rossall's mark and his mark contains the extra three words not present in Mr Phipps' mark. That said, the shared word component (THE GLITTER BAND) is at the beginning of Mr Rossall's mark and is the only word component of Mr Phipps' mark. The average consumer, as a rule of thumb pays more attention to the beginnings of marks⁶. The words in the earlier mark will clearly be read and said as THE GLITTER BAND. There is a reasonably high amount of similarity between the marks on both visual and aural levels.

20. Both marks contain the shared concept of a band named GLITTER. The additional concept in Mr Rossall's mark is that it also contains his name. Although Mr Rossall's evidence reveals that he considers the presence of his name to indicate that this is John Rossall's Glitter Band, this is not way his name is presented in the mark. It is The Glitter Band featuring John Rossall (emphasis added). The effect of this is that the concept of the mark will either be as a band called The Glitter Band which includes a member called John Rossall (as if it were, for example, The Rolling Stones featuring Mick Jagger) or as a band called The Glitter Band which features or is accompanied by a guest artist called John Rossall, i.e. someone who is not ordinarily part of the band's line-up. Either way, the concept of Mr Rossall's mark is that it is a band called The Glitter Band which also features an individual named John Rossall. The sole meaning of Mr Phipps' mark is that it is a band called The Glitter Band. There is a high degree of conceptual similarity between the marks. Overall, the degree of similarity between the marks is reasonably high.

Distinctiveness of the opponent's mark

21. It is necessary to consider the distinctive character of Mr Phipps' mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁷. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant

⁶ This is not a hard and fast rule; if the beginning of both marks is a descriptive or common combining form, the importance may be reduced: *Castellani SpA v OHIM*, T-149/06 and *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, Case T-438/07.

⁷ *Sabel BV v Puma AG* [1998] RPC 199.

public⁸. There is nothing directly descriptive about the mark “The Glitter Band”. The most that can be said is that the entertainment services involve glitter in some respect. The opponent’s mark is, inherently, distinctive to a good degree. The evidence from both parties shows that, at some point in the past (several decades ago), The Glitter Band enjoyed a degree of fame and success in the ‘glam rock’ genre of musical entertainment. This declined owing to changes in musical taste and further declined after the conviction of Gary Glitter (Paul Gadd). There is no evidence that, at the relevant date (the application date), The Glitter Band’s previous reputation (i.e. in its 1970s heyday) endured to the current average consumer of musical entertainment. The evidence does not support a claim to an enhanced level of distinctive character on the basis of use of the mark. I will therefore approach the global comparison on the basis of its inherent character which, as I have said, is distinctive to a good degree.

Likelihood of confusion

22. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). The services of the application are identical or are highly similar to the class 41 services of the earlier mark and I have found that there is a reasonably high degree of similarity between the marks. The earlier mark is inherently distinctive to a good degree. The question is whether, as is Mr Rossall’s intention from his evidence, the presence of his name serves to differentiate his mark from that of Mr Phipps.

23. The first point to note in this regard is that Mr Phipps’ mark does not, in turn, incorporate a personal name to identify his band as featuring or incorporating any particular individual. It is simply THE GLITTER BAND (albeit stylised). Secondly, as Mr Kilkhoff-Boulding states, the fame of The Glitter Band is not such that the average consumer will be aware of the names of the members. This means that the average consumer will not attach any significance to the presence of Mr Rossall’s name other than the bare fact that someone called John Rossall is appearing with the band. That is to say, because the average consumer will be unaware of exactly who the band members are/have been, he will not regard the presence of the name as an indicator of the provenance of The Glitter Band. He will either assume it is a band member, without being able to form a view as to whether that affects the identity or origin of the band, or will assume that The Glitter Band is performing with a guest artist called John Rossall. Neither of these assumptions will militate against the average consumer assuming that the Glitter Band referred to in Mr Phipps’ mark is the same Glitter Band as in Mr Rossall’s mark. The assessment under section 5(2)(b) is on the basis of Mr Phipps’ earlier trade mark and the application and the notional use of

⁸ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

both parties of their marks; it cannot take account of how the marks have been used or their factual context. Confusion works both ways⁹. The inclusion of Mr Rossall's name in his mark will not counteract confusion. Not only is there a likelihood of confusion, I consider that confusion is inevitable. The opposition succeeds. As this disposes of the opposition in Mr Phipps' favour, it is unnecessary to return to the other grounds of opposition.

Costs

24. Mr Phipps has been successful and is entitled to an award of costs, which I award on the following basis¹⁰:

Filing a statement of opposition (including statutory fee)	:	£400
Preparing evidence and considering and commenting on the other side's evidence:		£750
Written submissions in lieu of a hearing:		£400
Total:		£1550

25. I order to pay John Rossall to pay to Peter Phipps the sum of £1550. 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 10 day of June 2011

**Judi Pike
For the Registrar,
the Comptroller-General**

⁹ *Omega v OHIM*, GC, Case T-90/05, paragraph 14.

¹⁰ As per the scale in Tribunal Practice Notice 4/2007.