

O-257-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2653055
IN THE NAME OF TRENT SOUND LIMITED

AND

OPPOSITION THERETO UNDER NO 400456
BY THIS IS GLOBAL LIMITED

Background

1. Application No 2653055 is for registration of the trade mark Radio Trent. It has an application date of 18 February 2013, stands in the name of Trent Sound Limited (“the applicant”) and seeks registration for the following services:

Class 38

Telecommunications services; electronic communication services; radio broadcasting, digital radio broadcasting and television broadcasting services; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means of a global computer network; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; telecommunication of information including web pages, computer programs, text and any other data; providing access to digital music websites on the Internet or other computer network; delivery of digital music by telecommunications; webstreaming being the transmission of data, information and audio-visual data via the Internet or other computer network; news agency services; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus and equipment.

2. Following publication of the application in *The Trade Marks Journal* on 22 March 2013, notice of opposition was filed by This is Global Limited (“the opponent”). The opposition is founded on two grounds:

- 1) Under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) based on the opponent’s registered trade mark no 2554833 for the mark TRENT FM:
- 2) Under section 5(4)(a) of Act based on use of the mark RADIO TRENT since 3 July 1975 in relation to a range of services.

3. The applicant filed a counterstatement in which, essentially, the grounds of opposition are denied.

4. Only the opponent filed evidence. The opponent requested a decision be taken from the papers and filed written submissions in lieu of attendance at a hearing. The applicant did not request to be heard. I therefore take this decision after a careful review of all the papers before me.

The evidence

5. The opponent’s evidence takes the form of two witness statements. The first is from Clive Potterell who is the opponent’s Director of Legal, Business and Company Affairs, the second by Jeff Cooper who states he is the owner and programmer of an online commercial radio station Radio Trent.

6. Mr Potterell gives evidence of the establishment of a commercial radio station broadcasting in the Nottingham area which, subsequently, underwent a number of changes of name (which I highlight below in bold) and ownership as follows:

- July 1975: Radio Trent Ltd and Midlands Radio plc begin broadcasting to the Nottingham area. The station is named **Radio Trent**;

- 1988: The FM and medium wave frequencies were split, with the FM frequency being formally renamed **Trent FM**;
- 1993: Midlands Radio plc is acquired by GWR Group with Trent FM renamed **96 Trent FM** for the Nottingham area;
- 2005: GWR Group merges with Capital Radio Group as part of GCap Media;
- 2008: GCap Media is acquired by Global Radio Holdings Ltd;
- 3 Jan 2011: Trent FM is formally renamed **Capital East Midlands**.

7. Mr Potterell states he has been unable to identify listening, turnover or marketing figures for the period between 1975 and 1988 but submits that during this time, RADIO TRENT was “a leading radio station”. In support of this he exhibits, at CP3, some 24 pages containing a number of articles from various national newspapers. The articles, published in e.g. the Times, Financial Times and the Guardian, date from between 11 August 1984 and 12 December 1988. The subject matters vary greatly from e.g. government training initiatives to strike action and from court and coroner’s hearings to elections but all make reference to Radio Trent.

8. Whilst the RADIO TRENT station underwent its first change of name in 1998, Mr Potterell states:

“I know personally and have been told by other Global colleagues that many listeners and people in the radio industry still remember and refer to the name Radio Trent, when referring to the Capital East Midlands station”.

In support of this claim, he exhibits, at CP4 and CP5, a number of printouts identified through the *NEXIS* database.

9. At CP4 are articles dating between January 2008 and January 2013. Whilst the vast majority of them are taken from the Nottingham Evening Post, others are from the Derby Evening Telegraph with a few from other regional papers. A number of the articles exhibited are duplicates (see, for example those at pages 83 and 74 or pages 76 through to 81) and some refer not to RADIO TRENT but to the station’s later adopted names. Of those that refer to Radio Trent, most do so in historical terms i.e. refer to the period when the station was called RADIO TRENT (e.g page 1: “January 28, 1983, was a fairly relaxed day in the Radio Trent newsroom...”, page 24: “In 1983 teams from the Evening Post, Central TV, Radio Trent, the QMC and Grand Central diner took part in”, page 42: “It was late 1979 and I had been offered the role of sports editor at Radio Trent...”).

10. The exhibits at CP5 date from between January 1989 and November 2007. They refer to articles in various newspapers (again largely the Nottingham Evening Post). Again some are duplicates (e.g. pages 8 and 9), refer not to RADIO TRENT but to the station’s later adopted names or are clearly historical references (e.g. page 23 “...who launched Radio Trent in the 1970s...”), however, because this exhibit

consists of very brief extracts from articles (rather than the article itself) it is not possible to put the majority of them in context.

11. Mr Potterell refers in his witness statement to particular articles within CP4 which he states: “include references to Radio Trent as the station’s current name” (his emphasis). There are 6 articles. Three of them use the letters FM (two of these also use the numeral 96) and so are not references to Radio Trent per se as he suggests. Of the remaining three articles, two date from 2008 and one from 2010 and therefore from a time the station was officially known as 96 Trent FM.

12. Mr Potterell states that between 1975 and 1977, Mr Jeff Cooper was a presenter and producer at Radio Trent. He goes on to state that “as of around 3 July 2011” the opponent granted Mr Cooper a licence to “use the Radio Trent trade mark in relation to an Internet and Digital Audio Broadcasting (“DAB”) radio station for the Nottingham area.” He states the licence includes use of the opponent’s unregistered trade mark rights as well as its registered trade mark no 2656244. This registration is for the trade mark RADIO TRENT and has a filing date of 12 March 2013.

13. In his evidence, Mr Cooper states he worked for RADIO TRENT as a presenter and producer between 1975 and 1977. He states that in 2011, he sought to re-launch the RADIO TRENT name as a radio station serving the Nottingham area and employed the “help and experience” of several ex colleagues who had also worked at the original station. In April 2011, he applied for registration of the trade mark Radio Trent under no 2578315 (later withdrawn) which he states was done “without giving thought to whether [the opponent]...might own the rights in the name”. At some unidentified later date he was contacted by the opponent. He states that as a result of discussions between them, an agreement was reached which resulted in a licence which was executed on 11 July 2013.

14. The licence is exhibited at JC1. It sets out the following recitals.

“Recital A: [Mr Cooper] applied for UK trade mark application no. 2656244 for RADIO TRENT in class 38 on 12 March 2013 (the “**Trade Mark**”). [Mr Cooper] has also used the mark RADIO TRENT under licence from [the opponent] since on or around 3 July 2011.

Recital B: [The opponent] is the owner of the earlier common law rights, including all goodwill in the mark RADIO TRENT since at least 1975, and for the avoidance of doubt, including any common law rights and goodwill generated by [Mr Cooper] since 3 July 2011.

Recital C: [Mr Cooper] now wishes to enter into an assignment of all beneficial title in and to the Trade Mark to [the opponent] on the terms set out herein and to execute this Deed of Assignment.

Recital D: [The opponent] then wishes to grant [Mr Cooper] a licence to use the Trade Mark in the course (sic) providing radio services, on the terms set out below.”

The document then sets out in greater terms the agreement between the two parties. It makes it clear that all and any beneficial right, title and interest Mr Cooper may generate through his use, which includes all such common law rights and goodwill in the Mark RADIO TRENT, is assigned to the opponent.

15. Mr Cooper gives the following details of approximate turnover and marketing expenditure for “Radio Trent’s radio services (in excess of)”:

	2011	2012	To end 02/2013
Revenue (generated for Radio Trent by our sales house)	£30,000	£45,000	£14,000
Marketing	£13,000	£5,000	£2,000

16. Approximate tune-in listening figures (in excess of) are given by Mr Cooper as 120,000 in 2011, 225,000 in 2012 and 50,000 to end of February 2013. He states the radio station has a facebook page as well as a website at www.radiotrent.co.uk which is said to have had the following:

	2011	2012	To end 02/2013
Visitors	90,000	136,000	30,000
Page views	1,300,000	3,500,000	500,000

17. Mr Cooper states the mark has been advertised and promoted in a variety of ways including by the town crier in Nottingham itself, in advertisements appearing on the back and sides of buses, on facebook and its own website and in articles in local papers and newsletters. Evidence of these activities are exhibited at JC5, JC6 and JC7 which includes copies of newspaper and newsletter articles and photographs.

18. That concludes my summary of the evidence.

The objection under section 5(2) of the Act

19. Section 5(2)(b) of the Act states:

“5 (2) A trade mark shall not be registered if because -

- (a) ...
- (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.”

20. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or 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,

(b)

(c)

(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.”

21. As set out above, under this ground, the opponent relies on its registration no 2554833 TRENT FM. It has a filing date of 3 August 2010 and was entered in the register on 7 January 2011 so is an earlier mark within the meaning of the Act. Given it had not completed its registration process more than five years before the filing date of the application the subject of this decision, it is not subject to the proof of use requirements set out in section 6A of the Act. This means the opponent is entitled to rely on it for all services for which it is registered.

22. In considering this ground of objection and the likelihood of confusion between the respective marks, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *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 and *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). In the case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR] O/333/10, Mr Hobbs Q.C., acting as the Appointed Person, set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

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

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

23. In essence, the test under section 5(2)(b) is whether there are similarities in the respective marks and services which, when taking into account all the surrounding factors, would combine to create a likelihood of confusion.

Comparison of services

24. For ease of reference, the services to be compared are set out below:

Opponent's earlier mark	Application
Telecommunications services; electronic communication services; radio broadcasting, digital radio broadcasting and television broadcasting services; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means	Telecommunications services; electronic communication services; radio broadcasting, digital radio broadcasting and television broadcasting services; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means

<p>of a global computer network; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; telecommunication of information including web pages, computer programs, text and any other data; providing access to digital music websites on the Internet or other computer network; delivery of digital music by telecommunications; webstreaming being the transmission of data, information and audio-visual data via the Internet or other computer network; news agency services; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus and equipment.</p>	<p>of a global computer network; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; telecommunication of information including web pages, computer programs, text and any other data; providing access to digital music websites on the Internet or other computer network; delivery of digital music by telecommunications; webstreaming being the transmission of data, information and audio-visual data via the Internet or other computer network; news agency services; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus and equipment.</p>
--	--

25. Given that each of the respective specifications is identically worded, it follows that the respective services are also identical.

The average consumer and the nature of the purchasing process

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services and then to determine the manner in which these services are likely to be selected by the average consumer in the course of trade.

27. In its written submissions, the opponent states:

“The services in question – including radio broadcasting, telecommunications and related services – are intended for all consumers. Further, based on the nature of the services, the relevant public should be deemed to be composed of the average consumer, reasonably well informed and reasonably observant and circumspect, displaying a normal level of attention.”

28. Whilst some of the services are such as may be bought by businesses (e.g. telecommunications services, news agency services, leasing and rental services in connection with telecommunications apparatus and instruments) all may be bought by members of the general public. In *Adelphoi Limited v DC Comics (a general partnership)* BL O/440/13 Professor Annand, sitting as the appointed person stated:

“21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v. OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41).”

29. Consequently, it is necessary to consider the lowest common denominator, in relation to the relevant public. They are services which are widely available and,

whether bought by a business or a member of the general public, they are likely to be bought with an average degree of care. The purchasing decision for services such as telecommunication services and computer-based services is likely to rely primarily on the visual aspects of the marks though in relation to radio broadcasting and related services, the aural aspects are likely to come to the fore. However the purchasing decision is made, it will not be to the degree that the other aspects are unimportant or can be ignored.

Comparison of marks

30. For ease of reference, the marks to be compared are:

Earlier mark	Application
TRENT FM	RADIO TRENT

31. The word TRENT is common to both marks. Whilst it appears as the first of two elements in the earlier mark and as the second in the applicant's, its presence in both means there is a degree of both visual and aural similarity between them. There are also some visual and aural differences between the respective marks caused by the presence of the FM and RADIO elements.

32. The TRENT is the name of a river in the Midlands, a fact that is likely to be well-known especially to those from or in that area. Whilst I am not prepared to find that the average consumer will know what, exactly, the letters FM are an abbreviation of, its use is not uncommon in relation to radio broadcasting and I think it likely the average consumer will, on seeing the earlier mark, bring to mind such a broadcaster. This leads me to find there is a high degree of conceptual similarity between the respective marks. The respective marks are similar to a fairly high degree.

The distinctiveness of the earlier mark

33. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

34. In my experience, it is not unusual for an area to be defined with reference to its main river (i.e. the Thames region, Severnside, Merseyside) and I consider the word TRENT is not distinctive for services provided in, for or about that area. The letters FM will indicate to the average consumer the medium through which the services are supplied and are also not distinctive. The distinctiveness of the earlier mark rests in the mark as a whole but is one which, inherently, is very low.

35. There is some, limited, evidence of use of TRENT FM by way of newspapers articles but no details are given of e.g. listener figures, turnover or advertising expenditure from the time the station was called this name. Mr Potterell provides some figures of turnover and marketing expenditure in relation to what he calls 'radio goods and services' for the years 2008 to 2010 but these are not broken down in any way between goods and services and, on his own evidence, this period equates to a time when the name of the radio station was not TRENT FM but 96 TRENT FM. And whilst he provides figures for the years 2006-2009 to show the population of people aged over 15 who lived within the transmission area along with figures of those who listened to a radio station for at least 15 minutes per week, no figures are provided to show the number of listeners TRENT FM might have had at any time. Whilst there is some evidence of TRENT FM being used in relation to the name of an arena in Nottingham, presumably by way of some form of sponsorship, there is no claim, nor is there any evidence, to show the extent to which, at the relevant date in these proceedings, which is 18 February 2013, this earlier mark had been used in relation to the services for which it is registered. That being the case, the distinctiveness of the earlier mark has not been shown to have been enhanced through its use.

The likelihood of confusion

36. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind.

37. Earlier in this decision I found that:

- the respective services are identical;
- the purchase of some of the services are more likely to be made by businesses though all may be made by the general public who will exercise an average degree of care with that purchase;
- the purchase may be either a visual or aural one but in either case, not to the extent that other aspects are unimportant or can be ignored;
- the respective marks share a fairly high degree of similarity;
- the earlier mark is of very low inherent distinctive character which has not been shown to have been enhanced through use.

38. Whilst the respective services are identical and the marks share a fairly highly degree of similarity, this is offset by the fact that the earlier mark has a very low degree of inherent distinctive character. In my experience, it is not uncommon for radio broadcasters to use names which refer to the area they are intended to serve and the relevant public is well used to distinguishing between them, even where those differences are relatively minor (as they do with slightly different magazine

titles which have a common subject matter). Taking all matters into account, I find there is no likelihood of direct or indirect confusion and the objection under section 5(2)(b) fails.

The objection under section 5(4)(a) of the Act

39. Section 5(4)(a) of the Act states:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in the Act as the proprietor of an “earlier right” in relation to the trade mark.”

40. In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs Q.C., in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

41. Goodwill was described by Lord Macnaughton in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

42. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business."

43. Millett LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 stated:

"It is well settled that (unless registered as a trade mark) no one has a

monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property which is protected by an action for passing off is not the plaintiff's proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant's misrepresentation: see *Reddaway v. Banham* [1896] A.C. 199 per Lord Herschell; *Spalding v. Gamage* (1915) 32 R.P.C. 273 at page 284 per Lord Parker; *H.P. Bulmer Ltd. and Showerings Ltd. v. J. Bollinger SA and Champagne Lanson Pere et Fils (the Bollinger case)* [1978] R.P.C. 79 at page 93-4 per Buckley L.J.”

44. Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 commented upon the evidence that is required to establish goodwill (which is often referred to as reputation):

“28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

45. The judgments in *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 and *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), however, show that the question of goodwill cannot be established by the application of a formula. In the latter judgment Floyd J stated:

“8 Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

46. Matters must be judged at a particular point(s) in time. In *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 the General Court stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

47. In these proceedings, the relevant date at which the opponent must establish that its business had goodwill, and that the use of the mark was liable to be prevented under the law of passing-off, is 18 February 2013 which is the date of filing of the application under attack.

48. In its notice of opposition, the opponent claims to have used the mark RADIO TRENT for *radio broadcasting services; electronic communication services; broadcasting over the internet; entertainment services; news agency services; electronic mail services; the production of radio programmes and advertising services.*

49. Whilst the claim is made to use dating from 1975, I intend to limit my consideration to the later period of claimed use (i.e. from 2011). Mr Cooper’s evidence is that he began commercial broadcasting under this mark around 3 July 2011. He has provided details of revenue and marketing expenditure for the period 2011 to the end of February 2013 along with details of tune-in listening figures and website visitors for the same period. He has provided examples of promotional activities from this period which includes material that appeared in the press and on buses. Also exhibited is the licence he entered into with the opponent which, in essence, shows that he entered into an agreement that any goodwill accruing from his use of the mark in relation to the services he has provided under the mark, rests with the opponent. The applicant has not challenged this evidence and I am satisfied that the opponent has shown that it had the requisite goodwill at the relevant date and that, as a commercial broadcaster, the goodwill extends to each of the services claimed.

50. In terms of misrepresentation, I must be satisfied that the services offered under the applicant’s mark would be taken (or would be likely to be taken) by a substantial number of the opponent’s customers to be the responsibility of the opponent or that there is some form of economic connection between the opponent and the applicant. Although an intention to misrepresent would be a highly relevant factor, it is not a prerequisite. Misrepresentation can be found in innocent circumstances. Given that the marks and services of both parties are identical, I find that misrepresentation and damage will follow. The opposition brought on grounds under section 5(4)(a) of the Act succeeds.

Summary

51. The opposition fails on grounds under section 5(2)(b) of the Act but succeeds on grounds under section 5(4)(a) of the Act.

Costs

52. The opponent, having succeeded, is entitled to an award of costs in its favour. I take note that only the opponent filed evidence. Whilst that evidence was of some volume, much of it was not particularly well directed to the issues to be determined. I also take note that no hearing took place. Taking all matters into account, I make the award on the following basis:

For filing a statement (inc fee) and reviewing the other side's statement:	£500
For preparing and filing evidence:	£400
For preparation of written submissions:	£100
Total:	£1000

53. I order Trent Sound Limited to pay This is Global Limited the sum of £1000 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of June 2014

**Ann Corbett
For the Registrar
The Comptroller-General**