

O-011-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3132115
BY GEORG LEITNER PRODUCTIONS GMBH FOR THE TRADE MARK**

**THE EARTH WIND & FIRE EXPERIENCE FEATURING THE
AL McKAY ALL STARS**

IN CLASS 41

AND

**THE OPPOSITION THERETO UNDER NUMBER 406383
BY
ESTATE OF MAURICE WHITE**

Background

1. On 19 October 2015, Georg Leitner Productions GmbH (“the applicant”) filed trade mark application number 3132115, for the mark THE EARTH WIND & FIRE EXPERIENCE FEATURING THE AL McKAY ALL STARS for the following services in Class 41:

Entertainment booking services; entertainment in the nature of orchestra performances; entertainment services provided by a music group.

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 8 January 2016. Estate of Maurice White (“the opponent”) opposes the application under sections 3(6), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”)

3. Under section 5(2)(b), the opponent relies upon the following earlier trade mark registrations:

(i) International registration designating the EU (“IR EU”) 847228

EARTH, WIND & FIRE

Class 9: *Sound and video recordings featuring music; DVDs featuring musical performances; compact discs and audio cassettes featuring music.*

Class 25: *Clothing, namely, t-shirts, sweatshirts, jackets; headwear.*

Class 41: *Entertainment services rendered by a vocal and instrumental group.*

Date protection requested: 4 November, claiming International Convention priority from the US from 16 July 2004; protection granted in the EU: 11 April 2006.

(ii) EUTM 13345178

THE ELEMENTS OF EARTH, WIND & FIRE

Class 9: Sound recordings featuring music; video recordings featuring music; downloadable web casts featuring music and/or information about a musical artist or artists; downloadable pod casts featuring music and/or information about a musical artist or artists; downloadable sound recordings featuring music; downloadable video recordings featuring music.

Class 25: Clothing, namely, tops, shirts, t-shirts, polo shirts, bottoms, shorts, pants, headwear, sweatshirts, zip-up hooded sweatshirts, sweat pants, sweaters, jumpers, jackets, coats, rainwear, pullovers, caps, hats, scarves.

Class 41: Entertainment services in the nature of live performances by a musical, vocal, and instrumental groups; audio engineering, namely, recording, production and post-production services for musical and sound recordings; audio engineering consulting services, namely, recording, production and post-production consulting services for musical and sound recordings; audio and video recording services; entertainment information, namely, providing information about entertainment services performed by musical, vocal, and instrumental groups via a website; providing a website featuring musical performances, musical videos, photographs and other multimedia materials, and personal information regarding musical, vocal, and instrumental groups and their live and recorded performances; providing non-downloadable musical sound and video recordings delivered via the Internet; fan club services; entertainment services, namely, providing podcasts featuring music and/or information about musical, vocal, and instrumental groups.

Date of filing: 9 October 2014, claiming priority from 17 April 2014 from the US; completion of registration procedure: 11 February 2015.

4. The opponent claims that the marks are similar and that the goods and services are identical and/or similar, and that there is, therefore, a likelihood of confusion under section 5(2)(b).

5. For section 5(3) of the Act, the opponent relies upon mark (i), EARTH, WIND & FIRE, claiming a reputation in all the goods and services for which the mark is registered. The opponent claims that the mark has a 40-year old reputation in the UK and that use of the applicant's mark would take unfair advantage of the distinctive character, and/or cause detriment to the repute and distinctive character of its mark. Under section 5(4)(a) of the Act, the opponent claims that use of the applicant's mark is liable to be prevented under the law of passing off, owing to its goodwill attached to the sign EARTH, WIND & FIRE, which it claims to have used throughout the UK since 28 February 1971, in respect of *entertainment services rendered by a vocal and instrumental group; sound recordings featuring music*.

6. The opponent's claim under section 3(6) of the Act is that the application was filed in bad faith:

"34. ...The Opponent relies on the fact that the Applicant knew, or must have known, of the existence and use of the Opponent's prior rights in the United Kingdom, but proceeded with the Application nonetheless.

35. ... In this regard, the Opponent relies on the fact that on 8 August 2003 GLP Artist Marketing GmbH, a company connected to the Applicant, filed International Registration no. 811004 designating the United Kingdom (*inter alia*) for the word mark shown below (the "GLP IR"):

THE EARTH WIND & FIRE EXPERIENCE
Featuring the AI McKay All Stars

36. The GLP IR was based on Austrian national trade mark no. 211090 (the "Austrian Base Mark").

37. In 2008 Mr White applied to the Austrian Patent Office to cancel the Austrian Base Mark. On 05 February 2015 the Oberlandesgericht Wien (Court of Appeal, Vienna) issued its final decision and the Austrian Base Mark was cancelled with effect from the 14 July 2003.

38. As a result of the cancellation of the Austrian Base Mark, the GLP IR, including the UK designation, was also cancelled under Article (6(4) of the Madrid Agreement and the Protocol.”

7. The applicant filed a defence and counterstatement, denying all the grounds of opposition and stating:

Al McKay was a member of EARTH WIND & FIRE and the composer and co - composer of many of the famous EARTH WIND & FIRE hits. Since we registered the trademark on August 8th 2003 (see also attached the renewal), "The Earth wind & Fire experience featuring the Al McKay All Stars " have performed under this name across the globe (60 - 70 shows / year).

In our rider - we are very specific about the billing so to ensure that the public can easily distinguish between EARTH WIND & FIRE and "The Earth wind & Fire experience featuring the Al McKay All Stars ".

In an earlier decision, the IPO in the UK has agreed to our argument and proceeded with the registration.

I ask the IPO to follow suite and grant the registration to us (attached I send you an excerpt from youtube and google - so you can see that "The Earth wind & Fire experience featuring the Al McKay All Stars " has become a well recognised musical entity in its own right.

8. The opponent is professionally represented by Simmons & Simmons LLP, and the applicant by Mr Alexis Grower, who identifies himself as a consultant with SSB Solicitors and as a solicitor of the superior court. Neither party requested a hearing. In making this decision, I take into account the parties' pleadings, evidence and written submissions.

Opponent's evidence

9. The evidence comes from John Slater of Simmons & Simmons LLP. His witness statement is dated 13 April 2017. Mr Slater has overall responsibility for the opponent's part in the proceedings. Some of his evidence is information he has received from David Greenbaum, a partner of US law firm Fox Rothschild LLP, which instructs Simmons & Simmons LLP and who is, in turn, instructed by the opponent.

10. Mr Slater states that Earth, Wind & Fire is a world famous American band founded in 1970 by Maurice White. He exhibits a Wikipedia extract¹ which says that the band has sold over 100 million records. I note that the band has had 45 past members, including Maurice White (deceased) and Al MacKay. At the time of Mr

¹ Exhibit JHS1

Slater's evidence, there were ten band members. The Wikipedia extract explains that, following the release of an album called *Faces* in 1980, Al McKay left the band for personal and professional reasons. Maurice White put the band on hold in 1984, and then the band re-formed in 1987, including a new horn section called the Earth, Wind & Fire Horns. In 1994, Maurice White retired from touring with the band owing to the onset of Parkinson's disease. However, Mr White made occasional appearances at Earth, Wind & Fire performances and continued to write, record, produce and develop new recordings for the band.

11. The band performed on 13 September 2014 at Proms in the Park, Hyde Park, London with the BBC Concert Orchestra. Mr White died on 4 February 2016. The band's discography² shows that the band released 21 studio albums, 4 live albums, 17 compilation albums, 19 video albums and 62 singles worldwide, including the UK. The albums *All 'n All* (1977), *I Am* (1979), *Faces* (1980), *Raise!* (1981), *Powerlight* (1983), *The Greatest Hits* (2010) and *Now, Then & Forever* (2013) reached numbers 13, 5, 10, 14, 22, 9 and 25 in the UK albums chart. The singles *September* (1978), *Boogie Wonderland* (1979), *After the Love Has Gone* (1979) and *Let's Groove* reached numbers 3, 4, 4 and 3, respectively, in the UK singles chart. Altogether, the band had 13 albums and 21 singles in the UK charts, including ten in the top 40, and four in the top 10. I note that Exhibit JHS4 comprises a copy of the webpage for Earth, Wind & Fire on officialcharts.com and that one of the top 10 singles, *Boogie Wonderland*, was by "Earth, Wind & Fire with the Emotions".

12. Exhibits JHS5, JHS6, JHS8 and JHS 9 comprise prints from the UK Amazon website, showing that most, if not all, of the singles, albums, videos and DVDs were available for purchase at the time of Mr Slater's evidence, the release dates for some of which stretch back to the early 1970s.

13. Mr Slater states that, since the band started, it has toured extensively in the UK. He provides a table of the band's UK tour dates from 1988 until the last date prior to the filing date of the contested application:

² Exhibit JHS 2

DATE	LOCATION
14 September 2014	London Palladium, London, England
13 September 2014	Hyde Park, London, England
10 September 2014	BIC, Bournemouth, England
9 September 2014	Echo Arena, Liverpool, England
20 October 2013	O2 Apollo Manchester, Manchester, England
19 October 2013	Royal Albert Hall, London, England
14 July 2013	T in the Park, Balado, Kinross, Scotland
13 July 2013	Wireless Festival 2013, Queen Elizabeth Olympic Park, London, England
22 July 2010	The O2 Arena, London, England
21 July 2010	NIA Birmingham, England
20 July 2010	MEN Arena, Manchester, England
21 December 1999	Sheffield Arena, Sheffield, England
20 December 1999	MEN Arena, Manchester, England

19 December 1999	International Arena, Cardiff, Wales
18 December 1999	BIC, Bournemouth, England
17 December 1999	Docklands Arena, London, England
15 December 1999	Webley Arena, London, England
14 December 1999	NEC Arena, Birmingham, England
11 December 1999	Newcastle Arena, Newcastle, England
10 December 1999	S.E.C.C., Glasgow, Scotland
14 October 1990	NEC Arena, Birmingham, England
13 October 1990	Wembley Arena, London, England
12 October 1990	Wembley Arena, London, England
6 October 1988	Wembley Arena, London, England
5 October 1988	Wembley Arena, London, England
4 October 1988	Wembley Arena, London, England
1 October 1988	NEC Arena, Birmingham, England

14. Exhibit JHS12 is a copy of the Austrian decision, together with a certified translation, referred to in the notice of opposition. Exhibit JHS13 comprises a print from the TMview website, showing that IR 811004 is cancelled.

Applicant's evidence

15. The applicant's evidence comes from Alexis Grower, its professional representative. Mr Grower's witness statement is dated 18 May 2017.

16. Mr Grower states:

“It has never been disputed by the applicants. [sic] (GLP) that Earth, Wind & Fire are not a world famous and hugely successful band.”

17. Mr Grower states that Al McKay was an essential part of Earth, Wind & Fire during the time the band had most of their hits. He states that Mr McKay was inducted into the Rock and Roll Hall of fame in 2000 and a decade later into the Songwriters Hall of Fame. He wrote/co-wrote the singles *September*, *Sing a Song* and *Saturday Night*. Mr Grower states:

“Al McKay himself has been nominated for 6 Grammys in his own right and as has been stated previously is exploiting and promoting his own compositions for his own financial benefit and for the financial benefit of the estate of his co-writer Maurice White.”

18. Mr Grower states that Mr McKay has toured globally under the mark applied for since 2002. Some events, such as the Montreux Jazz Festival have booked Earth, Wind & Fire and also The Earth Wind & Fire Experience Featuring The Al McKay All Stars, at the same event.

19. Mr Grower states that there are numerous examples of other Earth Wind & Fire bands touring, providing prints from five websites. There is no information about the level of use and the area of use of these bands, which are called:

Earth Wind For Hire

Kalimba The Spirit of Earth Wind and Fire

The Earth Wind & Fire Tribute Band

Ultimate earth wind & fire

Shining Star A Tribute to Earth Wind & Fire

Decision

Section 5(2)(b) of the Act

20. 5(2)(b) of the Act states:

“(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.”

21. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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 great degree of similarity between the marks, and vice versa;

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

22. One of the opponent's earlier marks, EARTH, WIND & FIRE (the IREU) had been protected for five years (and more) on the date on which the contested application was published. It is, therefore, subject to the proof of use provisions under section 6A of the Act. However, in its evidence, the applicant states:

"It has never been disputed by the applicants. [sic] (GLP) that Earth, Wind & Fire are not a world famous and hugely successful band."

23. I intend to treat this statement a) as an admission to the reputation of the opponent's mark in relation to the goods and services covered by the IREU (*sound and video recordings featuring music; DVDs featuring musical performances; compact discs and audio cassettes featuring music; entertainment services rendered by a vocal and instrumental group*) and b) as an admission that the mark has an enhanced distinctive character for these goods and services. The natural, logical consequence of this is that the opponent has made genuine use of the mark and may rely upon the goods and services in classes 9 and 41. In any case, I consider it clear from the evidence that the opponent has used its mark in the UK in the five years prior to the publication date of the opposed mark; for example, it played concerts at eight major UK venues during 2013 and 2014. It is unnecessary to examine whether there is genuine use in relation to class 25 as the opponent's best case lies with its services in class 41. I will restrict my comparison to the parties' class 41 services.

24. I also consider the opponent's best case to rest with its IREU, EARTH, WIND & FIRE, as indicated by the opponent in its written submissions, so will assess the section 5(2)(b) claim in relation to this earlier mark only. I note that the opposition has been brought by Estate of Maurice White, but that the ownership of the IREU is recorded as Maurice White. As Mr White is deceased, ownership of his property, as

it was before he died, passed to his estate. It do not think, therefore, that this affects the opponent's ability to rely upon this registration.

25. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* 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.”

26. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

27. Additionally, 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 also include an assessment of the channels of trade of the respective goods or services.

28. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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."

29. The goods and services to be compared are shown in the table below.

Earlier mark	Application
Class 41: <i>Entertainment services rendered by a vocal and instrumental group.</i>	Class 41: <i>Entertainment booking services; entertainment in the nature of orchestra performances; entertainment services provided by a music group.</i>

30. The law requires that goods and services be considered identical where one party's description of its goods or services encompasses the specific goods or services covered by the other party's descriptions (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC. On this basis, the applicant's *entertainment services provided by a music group* are identical to the opponent's *entertainment services rendered by a vocal and instrumental group*. Although orchestral performances are not the same as performances by a vocal and instrumental group, such groups vary considerably in the amount (and type) of instruments played (the Electric Light Orchestra, being a famous example). Indeed, the opponent's evidence shows that it performed with a horn section. The nature is similar (musicians playing instruments), the purpose is the same (to produce music), the users are the same (the audience) and there may be complementarity (vocalists requiring musicians for accompaniment). If not absolute identity, there is high level of similarity between the applicant's *entertainment in the nature of orchestra performances* and the opponent's *entertainment services rendered by a vocal and instrumental group*.

31. This leaves the applicant's *entertainment booking services*. These are services provided either to customers wishing to purchase tickets and/or by promoters seeking to book venues and other arrangements necessary for putting on entertainment. A band, artist, circus, orchestra or theatrical group may provide this service themselves to customers wishing to buy tickets to see them perform. The nature, purpose and method of use varies from the services of the earlier mark. However, there is a degree of complementarity because the artist, band etc needs a means to sell tickets. The channels of trade will coincide, and the users will be the same (the audience). There is a moderate degree of similarity with the opponent's services.

The average consumer and the purchasing process

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. The parties' services are aimed at the general public and will be primarily visual purchases, with consumers purchasing tickets over the internet or from a venue itself. However, I do not ignore that there may be an aural aspect to the purchase, such as making verbal arrangements with others. The level of attention during purchase will be no higher or lower than the norm.

Comparison of marks

33. The marks to be compared are:

Opponent's mark	Applicant's mark
EARTH, WIND & FIRE	THE EARTH WIND & FIRE EXPERIENCE FEATURING THE AL McKAY ALL STARS

34. The earlier mark consists, quite literally, of three elements, EARTH, WIND and FIRE (with the ampersand in place of the word 'and'). The words form a distinctive phrase, comprising three of the four classical elements (earth, wind, water and fire), with none of the words more dominant than the others: the overall impression of the mark is the phrase as a whole. These three words form the first part of the application (with the definite, 'THE' at the beginning), but there is the additional word EXPERIENCE and a separate phrase, FEATURING THE AL MCKAY ALL STARS. The application naturally separates into two parts, THE EARTH WIND & FIRE EXPERIENCE and FEATURING THE AL MCKAY ALL STARS. THE EARTH WIND & FIRE EXPERIENCE is the more dominant part because it comprises the first half of the mark and qualifies the part that is 'featured' (THE AL MCKAY ALL STARS). The marks, therefore, have highly similar dominant components.

35. There is a medium degree of visual and aural similarity because the first half of the applicant's mark coincides with the whole of the earlier mark. However, there is the additional word EXPERIENCE in the application, plus the additional component FEATURING THE AL MCKAY ALL STARS, which is absent from the earlier mark. I do not think that the 'THE' beginning of the application will make much difference to the visual and aural perception of the marks as wholes, given the elements which are identical and the length of the application.

36. The concept of the earlier mark is three of the four classical elements, Earth, Wind & Fire. For those that do not know there are four elements, the mark will signify three well known physical properties of the world. The meanings of these do not need explanation. The same meanings will resonate in relation to the application, but slightly altered in that EARTH, WIND & FIRE is a definite ('THE') EXPERIENCE. This is somewhat nebulous, but conveys an entertainment experience once the FEATURING THE AL MCKAY ALL STARS is factored in. The reason for this interpretation is because it is commonplace in modern music for bands and artists to collaborate with other artists i.e. someone who is not ordinarily part of the band's line-up. Such collaborations are frequently described as "XXX, featuring XYZ". The application as a whole gives the impression of entertainment provided by an entity named after the classical elements EARTH WIND & FIRE, which features individuals who are collectively known as the AL MCKAY ALL STARS,

AL McKAY giving the impression of an individual responsible for the individuals known as the ALL STARS. There is a medium degree of conceptual similarity between the marks.

37. Overall, there is a medium degree of similarity between the marks.

Distinctive character of the earlier mark

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*³ 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).”

³ Case C-342/97

39. Although the mark is not invented and consists of three well-known classical elements, it does not describe or allude to any characteristics of the services (or the goods) for which the mark is registered. It has an above average degree of inherent distinctive character.

40. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that 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. With this in mind, I need to assess whether the use made by the opponent of EARTH, WIND & FIRE has improved the inherent distinctiveness of the mark. The relevant date for this assessment is the filing date of the contested application, 19 October 2015.

41. The opponent's evidence confirms my own knowledge that EARTH, WIND & FIRE is the name of a very famous, successful and long-standing soul/funk band. It played at the Proms in the Park (Hyde Park) as recently as a year prior to the relevant date, and other major venues in the UK in the five years prior to the relevant date, such as the Royal Albert Hall, the London Palladium, and the T in the Park festival. It has had four UK top 10 hits, and ten hits in the top 40. The bands' Greatest Hits album, released in 2010, reached number 9 in the UK albums chart. The opponent is entitled to claim an enhanced level of distinctive character. The opponent's mark is highly distinctive.

Likelihood of confusion

42. In support of its case, the applicant relies on the judgment of Mr Justice Carr in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). It does not specify which part of the judgment it considers to help its case. However, I do not think the judgment helps the applicant because it dealt with infringement and how the marks were actually being used. Even if I could take into account how the marks are being used, it is clear from the parties' evidence that they are both musical bands. Furthermore, in the *Titanic* case, the defendant undertook to change the way it used its mark in order

to avoid infringement. That is not a consideration under section 5(2)(b) which is a notional test⁴ governed by the list of goods/services, not marketing intentions.

43. Nor does the applicant's evidence that there are other "Earth, Wind & Fire" groups help. The evidence about these third parties is almost-non-existent; for instance as to territory, the number of concerts, and the sizes of the audiences. Without evidence that the marks are in use on a scale that might have led to confusion, it cannot be shown that the public have got used to distinguishing between them without confusion.

44. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). The three terms in the applicant's specification are either identical to, have a high level of similarity with, or are moderately similar to the opponent's services.

45. 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 (*Sabel*). This point is in the opponent's favour because its mark is highly distinctive. It forms the first half of the application. Given the length of the applicant's mark, I think that the presence of the word EXPERIENCE, positioned in the middle of a long set of words, is likely to be missed because the EARTH, WIND & FIRE element is so well-known: the eye sees what it expects to see. If it is noticed, it could simply signify that this is, for example, an Earth, Wind & Fire tour which the band has named The Earth, Wind & Fire Experience.

46. Since it is commonplace to find bands/artists 'featuring' other artists, the presence of the words FEATURING THE AL MCKAY ALL STARS will not prevent the

⁴ In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

average consumer from assuming that the band performs with guest artists called THE AL McKAY ALL STARS. Indeed, the opponent's evidence shows that, in 1987, the opponent's band performed with a new section called the Earth, Wind & Fire Horns and, even more notably, one of the top 10 singles, *Boogie Wonderland* was by Earth, Wind & Fire with the Emotions (in 1979). Despite the applicant's evidence about Mr McKay's individual public recognition, I do not think that the average consumer will be aware of the names of the band over more than four decades of its existence when there have been no less than 45 past members, and ten at the time of the opponent's evidence. Added to this is the fact that Mr McKay left the band in 1980. This means that the average consumer will not attach any particular significance to the presence of Mr McKay's name.

47. In *The Glitter Band Featuring John Rossall*, BL O/426/11, the earlier mark was The Glitter Band (stylised) and the opposed application was The Glitter Band featuring John Rossall. Mr Rossall was a former member of the band. I note that, on appeal, Mr Daniel Alexander QC, sitting as the Appointed Person stated:

“Viewed in the manner in which the law requires the comparison to be made for trade mark registration purposes, “THE GLITTER BAND FEATURING JOHN ROSSALL” is confusingly similar to the earlier CTM, the distinctive and dominant element of which is “THE GLITTER BAND”.

48. There is a likelihood of confusion, two examples of which are:

(i) the average consumer will mistake the applicant's mark for the earlier mark and assume that there is a collaboration with Al McKay and the All Stars;

(ii) the average consumer will assume that the additional words The...EXPERIENCE signify a tour or 'extravaganza' by the famous group, in which there is a collaboration with Al McKay and the All Stars.

49. The opposition succeeds under section 5(2)(b).

Section 5(3) of the Act

50. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

51. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective

marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in

particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

52. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the three types of damage claimed (unfair advantage, detriment to distinctive character and detriment to repute) will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

53. The first condition is reputation. The CJEU gave guidance in relation to assessing reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

54. It is clear from my findings above the opponent has the requisite reputation in the mark EARTH, WIND & FIRE.

55. As I have found there to be a likelihood of confusion, it follows that there is a link. It also follows that there is unfair advantage because if the relevant public is confused, the applicant will benefit from that confusion in terms of increased custom.

56. However, in case I am wrong about there being a likelihood of confusion, I will assess the section 5(3) case separately from my finding relating to confusion.

57. As said above, the opponent’s mark EARTH, WIND & FIRE has a significant reputation for the class 41 services. Whilst it is not a pre-requisite for this ground that the services be similar for a link to be established, the closer they are, the better the case for the opponent. I have found the services to be identical, similar to a high degree, and moderately similar. There is no doubt in my mind that a link would be made between EARTH, WIND & FIRE and THE EARTH WIND & FIRE EXPERIENCE FEATURING THE AL McKAY ALL STARS.

58. The applicant’s evidence indicates that the applicant’s intention is that the relevant public should make a link between Al McKay and his former membership of EARTH, WIND & FIRE. In doing so, the relevant public will make a link between the marks. It will be the reputation of EARTH, WIND & FIRE which will cause the relevant consumer to buy tickets to see the applicant’s band. If this were not the case, the applicant would only need to register AL McKAY AND THE ALL STARS. There is a clear ‘leg-up’, in my view, for the applicant. The link will confer a marketing advantage on the applicant’s mark because the later mark will therefore appear instantly familiar to the public concerned, thereby making it easier for the applicant to establish its mark without the usual marketing expenditure. I find that

the claim to unfair advantage is made out. It is unnecessary to consider the other two heads of damage.

59. The applicant has not pleaded a defence of 'due cause'. Even if it had, I would have found it to fail. Former membership of Earth, Wind & Fire does not entitle the applicant (which appears to be the promoter of the later band) to register a trade mark linking itself to Earth, Wind & Fire, the reputation of which pre-dates that of the later mark.

60. The section 5(3) ground of opposition succeeds. As the opponent has also succeeded under section 5(2)(b), it is unnecessary to consider the other grounds of opposition.

Final remarks

61. On 21 December 2017, Mr Grower emailed to the Trade Marks Tribunal a copy (in French) of a decision of the Cour d'Appel Paris, dated 15 December 2017. It appears from the judgment that the opponent in that case, Earth, Wind & Fire IP LLC, opposing an entity connected with the present applicant, relied upon unregistered rights in France. The outcome of the French case, therefore, has no bearing on the case before me, which I have decided on the basis of a right registered in the UK and its reputation in the UK. I have not found it necessary to consider the section 5(4)(a) ground, which is akin to the ground considered in the French action. Even if I had, the French case would have had no bearing on my decision because goodwill is a territorial right, and cannot be affected by determinations in other jurisdictions.

Overall outcome

62. The opposition succeeds. This application is refused.

Costs

63. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced before 1 July 2016 are governed by Tribunal Practice Notice (“TPN”) 4 of 2007. I award costs as follows:

Fee for filing Form TM7	£200
Preparing a statement and considering the counterstatement	£400
Preparing evidence and considering and commenting on the applicant’s evidence	£900
Written submissions	£400
Total	£1900

64. I order Georg Leitner Productions GmbH to pay Estate of Maurice White the sum of £1900 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 05th day of January 2018

Judi Pike
For the Registrar,
the Comptroller-General