

O-191-18

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION No. 3077324 FOR THE TRADE MARK



**STANDING IN THE NAME OF
INDEPENDENT LOCAL RADIO LIMITED AND ANDREW LLOYD
AND**

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No.500841
BY ONBRAND GROUP LIMITED**

AND

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3107657
BY ONBRAND GROUP LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS**



**IN CLASSES 38 & 41
AND**

**IN THE MATTER OF JOINT OPPOSITION THERETO
UNDER No. 60000276
BY INDEPENDENT LOCAL RADIO LIMITED and ANDREW LLOYD**


BACKGROUND

1) Originally the invalidity and opposition cases were consolidated with a rectification request regarding trade mark 3077324 under number 84750. However, this was initially decided under decision O-616-16 which was set aside and then under decision O-104-17 when it was determined that UK Trade Mark 3077324 is registered correctly in the name of Independent Local Radio Ltd (company number 09709512) hereinafter ILR. However, leave to appeal this decision was not granted, the appeal period for this decision is intrinsically linked to this decision.

2) Decision O-104-17 also required ILR to provide a written undertaking to stand for any costs awarded at the conclusion of the proceedings and that Mr Lloyd will also join as a co-opponent/respondent. These undertakings were provided on 2 March 2017.

Further to your letter and written decision on the rectification et al, I write with regard to sections 13-14 dealing with the 'Identity of opponent in opposition 600000276 and respondent in invalidation 500841'. I wish to give the required confirmation that Independent Local Radio Limited should now be clearly recorded as the sole company party to the matters currently before the IPO, moreover as I have been the sole signatory on all IPO-related matters for all companies (current and dissolved) I am willing to put myself forward as co-opponent/respondent thus creating joint and several liability for costs.

3) The following trade mark is registered in the name of ILR:

Mark	Number	Filing & registration date	Class	Specifications relied upon
	3077324	16.10.14 16.01.15	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.
--	--	--	--	---

4) By an application dated 13 May 2015 OnBrand Group Limited (hereinafter OGL) applied for a declaration of invalidity in respect of this registration. The grounds are, in summary:

- a) OGL contends that it has used the mark CENTRE RADIO in respect of, radio broadcasting; telecommunications services; messaging services; script writing; provision of entertainment and information by radio; advisory services relating to all the aforementioned services since 18 September 2009 throughout the UK. It acquired the rights to the mark from the liquidator for Chesham Corporation Ltd in September 2009. It contends that use of the mark in suit will offend against section 5(4)(a) of the Act.
- b) It also contends that the mark offends against section 3(1)(b) & (c) as the words describe radio provided at or from a centre or radio that is broadcast from a centre or central location.

5) ILR provided a counterstatement, dated 7 July 2015, in which it claims that it has no knowledge of OGL and points out that whilst OGL is engaged in providing piped music to shopping centres ILR are trying to register the mark for radio broadcasting. It states that it has been unable to substantiate the claims of OGL regarding use, but point out that even if the claims were true the general public would not be aware of who provides the piped music in a shopping centre. ILR contend that the mark CENTRE RADIO was the name of a radio station in Leicester from 1981-1983. The assets were acquired by Radio Trent Ltd (later Midlands Radio Plc) who re-launched as Leicester Sound. This means that the term CENTRE RADIO ceased use in 1983. In 2008 work started on the creation of an online radio station with the company being incorporated in January 2009. It contends that the marks are distinctive by dint of the device and colour elements. It also points to OGL's own application in relation to the question of whether the mark is inherently registrable.

6) On 7 May 2015, OGL applied to register the series of two trade marks shown on the front page of this decision in respect of the following services:

In Class 38: Telecommunications services; broadcasting services; radio broadcasting; radio information services; radio broadcasting of information; television broadcasting; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; telecommunication of information; delivery of music by telecommunications; news agency services; transmission of written and digital communications; transmission of radio programmes; radio messaging; voice messaging services; message sending; transmission of television programmes; music broadcasting; audio broadcasting; video broadcasting; provision of communications via radio; leasing and rental services in connection with telecommunications apparatus and equipment; leasing and rental of radio equipment; advisory services relating to all the aforementioned services.

In Class 41: Entertainment; radio entertainment; television entertainment; radio production services; radio entertainment production; preparation of radio programmes; presentation of radio programmes; editing of radio programmes; production and distribution of radio programmes; production of special effects for radio; arranging of musical entertainment; arranging of visual entertainment; provision of musical entertainment; provision of visual entertainment; script writing services; speech writing; rental of radio and television equipment; information services relating to entertainment; educational information; information services relating to sport; provision of information relating to radio and television programmes; advisory services relating to all the aforementioned services.

7) The application was examined and accepted, and subsequently published for opposition purposes on 5 June 2015 in Trade Marks Journal No.2015/023.

8) On 6 July 2015 ILR filed a notice of opposition. ILR is the proprietor of the trade mark shown at paragraph 3 above.

ILR contends that its marks and the mark applied for are very similar and that the goods applied for are identical / similar to the goods for which the earlier marks are registered. It does not object to the mark being used to provide “piped music for shopping centres” but does object to radio broadcasting and radio related activities. It claims the mark in suit offends against Section 5(2)(b) of the Act.

9) On 12 January 2016 OGL filed a counterstatement. A number of points were made in the counterstatement about the validity of the TM7 filing, whether the opponent owned the trade mark relied upon and whether it was entitled to trade as it did. All of these points were dealt with in decision O-104-17 and I do not intend to repeat the grounds or the outcome suffice to say that the Hearing Officer dismissed them all. OGL contend that the marks and services of the two parties are different.

10) Both sides filed evidence. Both sides ask for an award of costs. The matter came to be heard on 8 March 2018 when Mr Parnell of Messrs Laytons LLP represented OGL; ILR was represented by Mr Lloyd a Director of the company.

OGL’s Evidence

11) OGL filed a witness statement, dated 27 April 2007, by Daniel Simon Graham the Managing Director of On Brand Group Ltd which until July 2015 was incorporated under the name of Brand Audio Ltd. He states that his company has used the mark CENTRE RADIO in the UK since 7 September 2009 for the “provision of radio broadcasts, telecommunications services, messaging services and the provision of entertainment and information by radio and electronic means”. He also states:

“5.....My company has its own proprietary software and hardware units which forms part of a computer network with localities across the United Kingdom having a radio station onsite broadcasting my company’s radio service which includes music, news information, as well as advertising and information specific to the locality concerned. The Internet is a key part of the service as it is continuously broadcasting a tone enabling the detection of the status of units in each locality. Each locality is connected to my company’s computer servers and broadcasts take place by downloading audio files via electronic and communication networks according to the playlists, music and

messages ordered and paid for in advance or in real-time on-line via a client login web page. Each day my company provides written and digital communications streamed directly to the hardware units. The technology of my company allows my company to provide live feeds. The services of my company are also provided as a telecommunication service played out via a telephone system to callers when they are connected to the phone system or placed on hold.”

12) Mr Graham states that such services have been broadcast at shopping and garden centres, car dealerships, department stores, leisure centres, call centres and on-board trains, in cinemas and holiday parks, throughout the UK. He provides names of clients such as, *inter alia*, Sytner, Lookers, John Lewis, Fortnum and Mason, Animal, Multiyork, Davis Lloyd Leisure, Tesco, M&S, Virgin Trains, Barclays, Saga, Allianz, Haven Holidays and Butlins. He provides the following turnover figures for the trade mark above in the UK in relation to the services outlined in the previous paragraph.

Year	Turnover UK£
2009	600,000
2010	600,000
2011	650,000
2012	680,000
2013	700,000
2014	780,000

13) He states that prior to 2009 the same services were provided in the UK from 2003 in shopping centres under the same trade mark by Chesham Corporation Ltd (CCL) a company of which he was a director. OGL and its predecessors, acquired the rights in 2009 from CCL (see DSG2). He states that the services offered by his company are advertised in retail industry publications such as *Shopping Handbook*, *Shopping Centre* and *Media Week*. The company has also attended trade fairs, exhibitions and conferences. He estimates that the company has spent approximately £30,000 per annum since 2009 promoting the company in the various ways outlined. He states that there has been no use of the term “Centre Radio” in the UK by anyone, other than his company, since 1983. He

points out this is contained in statements made by Mr Lloyd. He also provides the following exhibits:

- DSG1: A list of over 200 shopping centres in the UK to which the company provided its services, as set out earlier, during the period September 2009- September 2014. He states that this is approximately one third of those in the UK.
- DSG2: Copies of documents regarding the purchase of the mark from CCL in 2009. This includes the mark and the goodwill.
- DSG3 & 4: Copies of invoices and purchase orders between OGL and its customers. The invoices are dated between September 2009- December 2014 and they show clients being billed under the mark shown below for tannoy messages, on hold services, provision of music and messaging, script writing, technical services, updating services, audio advertising broadcast on a PA system, Radio WOHN music and messaging solution, Mega day radio message, audio messaging on the PA system, on-hold music and messaging, creative support, technical support, script writing, IVR and tone of voice design, voice messages and music tracks; and the provision of hardware such as PA systems. The purchase orders are within the above period and are in relation to most of the services outlined earlier in this paragraph.



- DSG5: Copies of order forms and agreements between OGL and its predecessors such as CCL as provided to customers. It is clear that OGL write and produce the advertising from a brief given to them by the clients and that these are broadcast directly in the shopping centre etc. by OGL.
- DSG6: A selection of advertising material. These make it clear that the company offers a music and advertising service with other messages such as safety, competitions etc. also included. At page 211 is a page from Media Week, dated

April 2008, which states, “Centre Radio, which provides a live radio service in shopping centres across the UK and Ireland, is set for a full launch today (Tuesday). The company, owned by its founders Alexis Tousij and Daniel Graham, will be present in 220 shopping centres, which, as well as music, offers advertisers 20 to 30 second spot ads.”

ILR’s Evidence

14) ILR filed a witness statement dated 12 November 2017 by Andrew Paul Lloyd a Director of the company. He states that there is no intention of misrepresentation as he was not aware of OGL prior to the instant proceedings. He states that the name “CENTRE RADIO” was chosen as it was a name used in the early 1980s by a conventional radio station in the Leicester area. In the instant case his company is providing an on-line radio station but again being localised to Leicestershire. He disputes that the word “Centre” suggests that the broadcasts come from a shopping or garden centre, it is because Leicestershire is in the centre of England and its previous use. He contends that the logo element makes the mark distinctive. He states that his company provides a traditional radio station with weather, news, travel and sports specific to the area which would be instantly recognisable by the average consumer whereas OGL provide piped music with advertisements. He points out that he registered the name Centre Radio Limited with Companies House on 21 January 2009. He contends that the evidence of use by OGL does not amount to the provision of a radio station but merely tannoy messages and pre-recorded announcements.

OGL’s Evidence in reply

15) OGL filed a witness statement, dated 28 July 2017, by Mr Graham who has already provided evidence in his case. He states:

“7....the broadcasts of my company include but are not limited to pre-recorded announcements which are delivered as “ON HOLD” announcements for a telephone system or pre-recorded commercial advertising delivered via a tannoy system in a shopping centres. In this respect I refer to paragraph 5 of my witness statement of 27 April 2017 setting out the services provided by my company. The exhibits to my

aforementioned witness statement clearly indicate that live broadcasts *see for example page 211) are provided and which include both music and information. Furthermore, the general public visiting shopping centres are and have been made aware of the trade mark CENTRE RADIO of my company continuously since 2009 by radio broadcasts at shopping centres across the United Kingdom.”

16) He states that approximately 65% of the annual turnover referred to in his earlier statement relates to radio broadcasting to the general public at shopping centres throughout the UK. He provides the following exhibit:

- DSG12: A CD and a written transcript which shows that OGL use the broadcasts in shopping centres to advertise their advertising services to the shops within the centre and use the name CENTRE RADIO which will be broadcast and heard by the shop owners and also the general public.

17) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

18) The relevant section regarding invalidity states:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if –

- (a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

19) The first ground of invalidity is under Section 5(4)(a)

“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

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

20) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in 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. It 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.”

21) 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.”

22) First I must determine the date at which OGL’s claim is to be assessed; this is known as the material date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘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.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed,

in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ

1132 [2004] 1 WLR 955: “date of commencement of the conduct complained of”. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

23) The mark in suit was applied for on 16 October 2014, and is, therefore, the material date. However, if ILR had used its trade mark prior to this then this use must also be taken into account. It could, for example, establish that ILR is the senior user, or that the status quo should not be disturbed; any of which could mean that ILR’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer. As ILR has not provided any evidence of use of its mark then the date of application falls to be the relevant date. ILR contended that incorporation of the Limited company showed intention to use but I do not accept this contention, as registering a company name is entirely separate from trade mark use. For the purposes of this ground of invalidity **the material date must be 16 October 2014.**

Goodwill

24) I now turn to consider the evidence filed by OGL to determine when it began use of its mark and upon which goods and services. In determining this I take into account of the guidance in the case of *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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 to 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 probabilities that passing off will occur.”

25) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] 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.”

26) From the evidence filed by OGL it is clear that they have had goodwill in radio broadcasting, including music, weather, messaging, advertising and production; telecommunication services; advertising services and script writing services; and the

provision of hardware since 2010 at least. Given that these radio programmes are broadcast in a third of all UK shopping centres as well as other venues and include station identifiers and advertisements for its services **I conclude that OGL has shown it has goodwill in the mark CENTER RADIO (as registered) in respect of the aforementioned services amongst a substantial proportion of the population of the UK.**

Misrepresentation

27) As part of the test under this ground of invalidity I must take into account the distinctiveness of the sign being relied upon. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

28) In the instant case I regard the mark relied upon CENTRE RADIO as being distinctive for the services for which it has goodwill. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have

accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

29) In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

30) In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

31) When considering misrepresentation it is the plaintiff’s customers or potential customers that must be deceived. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff’s customers or potential customers had been deceived for there to be a real effect on the plaintiff’s trade or goodwill.”

32) The customers of the plaintiff (OGL) are, broadly speaking, shop owners and the owners of shopping and garden centres. They pay for OGL to provide a mix of music, messages/information, weather and advertising, albeit one which is tailored to their specific location. ILR claim that they will be operating a radio station which presumably will provide a mix of music, messages / information, news, weather and advertising. The marks both consist of the words "CENTRE RADIO" and, given they are in the field of broadcasting in sound only, the words assume greater importance than any device elements. This is because when identifying the source of the material being broadcast only the words will be enunciated. It is clear that when engaged in similar fields of activity there will be misrepresentation. I must therefore consider what aspects of the specification sought to be registered I would regard as being similar to the activity for which OGL has reputation.

33) OGL contended:

"10. With regard to the services of UK Trade Mark No. 3077324 The Honourable Mr Justice Sales at paragraph 61 in ***Total Limited v YouView TV Limited*** [2014] EWHC 1963 held "... that the term "telecommunication services" has a broad meaning, which includes services such as digital audio visual streaming via broadband connections or mobile or fixed line telephone networks of audio visual TV content to mobile telephones and other devices, including to set top boxes".

11. Radio has a number of definitions. Collins English Dictionary gives 9 definitions which include broad meanings such as "***an electronic device designed to receive, demodulate, and amplify radio signals from sound broadcasting stations, etc***", "***a similar device permitting both transmission and reception of radio signals for two-way communications***" and "***the broadcasting, content, etc of sound radio programmes***" and "***relating to, produced for, or transmitted by sound radio***".

12. Television broadcasting is similar to radio broadcasting in that both provide news, information, entertainment etc, have the same or a similar audience and can be provided by the same businesses (eg BBC).

13. In relation to services such as “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” covered by the Proprietor’s registration the Applicant’s representative has not been able to locate any decided UK cases in which a relevant comparison has been made. However, although not binding on the UK IPO, the Opposition Division of OHIM (now EUIPO) made the following comments at pages 6 and 7 in its decision of 19 February 2009 in Opposition No. B1244328 (SIC Sociedade Independente de Comunicacao, S.A. v James Elliot Bourne):

“This class includes services allowing at least one person to communicate with another by sensory means. In particular, the opponent's mark is registered for **'news broadcasting, broadcasting of television and radio programmes and television and radio broadcasts through all media, including cable and satellite'** which services cover transmitting messages and information to people by placing them in oral or visual communication through a medium. The nature and intended purpose of these activities basically overlap with that of **'communications services; broadcasting services; transmission of music and information; video text, digitised data, teletext and view data services; computer aided transmission of messages and images; transmission of news and current affairs information'** from the list of the application. They cover the same method of production and therefore they require the same and very specific facilities from the provider which are, consequently, companies coming from the same sector. It follows that the above mentioned conflicting services are identical.

As far as **'communication access services, providing user access to the Internet or to any other communications network including wireless, cable or satellite; providing communications connections to the Internet or to databases or to any other communications network; providing access to digital music websites on the Internet or any other communications network; delivery of digital music by communications; operating search engines; provision and operation of electronic**

conferencing; discussion group and chat rooms' are concerned from the applicant's specification it must be held that these are services to provide access to certain communication channels and media in general and in terms of internet in particular. Their common intended purpose is to accomplish to receive information and data. It follows that they are indispensable and essential for the smooth operation of the above communication services such as the earlier mark's broad category of **'broadcasting'** as well as to get access to **'television and radio programmes'** in particular. Consequently, the applicant's above services are considered to be complementary to the services of the opponent and thus they are similar."

14. Having regard to the above the Applicant contends that all the services of the Proprietor's registration are identical or similar to the services in which the Applicant has acquired goodwill such that use of the Proprietor's trade mark for them is likely to lead, the public to believe that goods or services offered by the defendant are goods or services of the claimant, or connected with it, and thus to a misrepresentation by the defendant.

34) I do not regard the example of the BBC as persuasive as this is not a commercial organisation but a quasi-government body funded by a tax on the populace. I take the other contentions into account in my consideration. To my mind, the following are similar to the services for which OGL has reputation as they involve the provision of audio services in a variety of ways, and telecommunications services.

"Telecommunications services; electronic communication services; radio broadcasting, digital radio broadcasting; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio files via electronic and communications networks as well as by means of a global computer network; 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 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.”

36) It therefore follows that the remainder are services which I consider to be dissimilar to those for which OGL has goodwill. However, it is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade (*Harrods Ltd v Harrodian School Ltd* [1996] RPC 697). I must therefore consider whether, despite the services being dissimilar, there would be deception amongst a significant number of OGL clients. For ease of reference the services in question are as follows: “television broadcasting services; electronic transmission of streamed and downloadable 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; webstreaming being the transmission of visual data via the Internet or other computer network”.

37) To my mind, use of ILR’s mark upon visual communication modes or interactive written messaging such as chat rooms would not cause misrepresentation to the owners of retail malls & outlets. Such businesses would not see the provision of television services or the provision of on-line chat rooms as a natural extension of OGL’s radio and telecommunications business.

Damage

38) In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's

reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

39) In a *quia timet* action it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* 56 RPC 429 Goddard L.J. stated:

“But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man’s business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage.”

40) Consequently in the instant case if OGL has established a goodwill and shown deception/misrepresentation then damage can be considered as the automatic sequitur and the three elements of the classic trinity of passing-off will have been established. In the instant case the ground of invalidity under section 5(4)(a) is successful in respect of the following services:

“Telecommunications services; electronic communication services; radio broadcasting, digital radio broadcasting; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio files via electronic and communications networks as well as by means of a global computer network; 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 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.”

41) However, the ground of invalidity under section 5(4)(a) fails in respect of the following services:

“television broadcasting services; electronic transmission of streamed and downloadable 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; webstreaming being the transmission of visual data via the Internet or other computer network”.

42) I next turn to the grounds of invalidity based upon Section 3(1)(b) & (c) which state:

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

43) I note that sections 3(1)(b) and (c) are independent and have different general interests. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

44) I turn first to consider Section 3(1)(b). The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

45) I take note that in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2013] F.S.R. 29, Arnold J. held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. He found that:

"116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b) .

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative fig leaf of distinctiveness, and refuse registration of such marks in the first place.”

46) Under Section 3(1)(c) the position is different. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1)

must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

47) In order to determine whether a mark is descriptive it must be assessed through the perception of the relevant parties, including those in the trade. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice held that:

"24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50)."

48) Whilst in *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, the Court of Justice of the European Union stated that:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40 However, such a combination may not be descriptive within the meaning of Art.3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41 Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

49) OGL contend under both section (b) and (c):

“23. The dominant element of the Proprietor’s trade mark is the words CENTRE RADIO. The average consumer will perceive nothing of the stylisation of the letter

“o” of the Proprietor’s mark and it adds nothing to its distinctiveness (paragraph 20 and Exhibits DSG7 and 8 of the Applicant’s first witness statement).

24. The average consumer is a consumer of the services for which the mark is registered and which includes both businesses and the general public.

25. The words CENTRE RADIO are a description of a characteristic the services and would be understood by the average consumer as being, for example, radio services provided from or at a centre or a central location. From Collins English Dictionary “a centre is a building where people have meetings, take part in a particular activity, or get help of some kind” or “the centre of something is the middle of it”.

26. Paragraph 2 of the witness statement of Mr Lloyd indicates that the choice of mark was for a descriptive reason, namely ***“in this instance the use of ‘centre’ for us and historically for the 1980s version of ‘Centre Radio’ was because Leicester is situated at the heart (or centre) of England”***. In Case C-363/99 ***Koninklijke KPN Nederland NV v Benelux Merkenbureau*** (“POSTKANTOOR”) at paragraph 97 it was stated: ***“A word must....be refused registration if at least one of its possible meanings designates a characteristic of the goods or services concerned”***. In this case it is clear that the Proprietor intends to provide radio services or the services of a radio station in or targeted at an audience in central England. Accordingly, the registration should be declared invalid under Article 7(1)(c). The stylisation of the letter “o” should not alter the conclusion.

27. In MEZZANINE Trade Mark (BL O-044-04, 16 February 2004) Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, found that registration of the word MEZZANINE would be contrary to Section 3(1)(c) for “....; disc jockey services; audio and audio visual entertainment services” in Class 41. The Appointed Person stated at paragraphs 26 and 27:

“[26] Is the location of such an establishment a characteristic of the services provided by the proprietor of that particular establishment? According to the approach identified in paragraph 22 above, I think it is. I am therefore required

by Section 3(1)(c) to regard it as an attribute that is fully and freely describable by means of signs or indications that do not possess a distinctive character.

[27] Does the concept of location include, for this purpose, the location of an establishment within a building or complex of buildings? I think it does. The physical setting in which services are provided is, in terms of consumer perception, part of the package on offer. I see no reason to exclude descriptiveness as to services-in-situ from the scope of Section 3(1)(c)."

28. If the stylisation of the letters including the letter "o" means that the trade mark does not consist exclusively of the words CENTRE RADIO the trade mark should be considered as devoid of distinctiveness and unregistrable having regard to Section 3(1)(b).

29. As The Honourable Mr Justice Arnold pointed out in ***Starbucks (HK) Ltd and Others v-British Sky Broadcasting Group Plc and Others*** [2012] EWHC 3074 (Ch) at paragraph 117: "...Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative fig leaf of distinctiveness, and refuse registration of such marks in the first place".

50) I agree with OGL that the relevant consumer is both the general public and businesses. The objection seems to fall into two parts. Firstly that the mark CENTRE RADIO is descriptive of radio services "provided from or at a centre or a central location". Secondly, that ILR clearly intends to "provide radio services or the services of a radio station in or targeted at an audience in central England".

51) Even if the relevant consumer heard the radio services in a garden centre or shopping centre and heard the identification tag of CENTRE RADIO I do not accept that they would assume that the services were provided by the particular centre they happened to be standing in. It would, in my opinion, require the use of the name of the centre such as Meadowhall, Wyevale or Blue Water for the average consumer to make such a leap of thought. This is simply because the average consumer would not expect a shopping centre or garden centre to operate its own radio station. There is a simple

reason behind this, and that is that none of them actually do such a thing, or at least OGL have failed to provide evidence that any such centre has diversified to this extent.

52) Similarly, the idea that the mark describes a radio station targeted or providing such services in central England, is similarly fanciful. One might be caused to wonder if this were the case, but of course just like South/Southern it is somewhat nebulous. Quite where is central England. ILR might regard it as the Leicester area, most consumers would probably venture Birmingham as being the centre of England, whilst those of a higher geographical bent would plump for Manchester which is nearer to the mid-point of England, although this of course depends partly on where the measurement is taken from. Either way it is not descriptive of radio services, merely giving a (very) rough idea of where they might be targeted. It is not even clear that the average consumer would leap to a geographical idea, it might be thought to refer to the kind of mindless wallpaper music that such shopping centres play, sometimes referred to as middle of the road, the sort of thing your granny would not object to, or at least not much. In reaching this conclusion I have not taken into account that the mark has a degree of stylisation which would have been taken into account if the words alone were not registrable.

53) The ground of invalidity based upon section 3(1)(b) and (c) fail.

CONCLUSION

54) The invalidity action has succeeded in part and so the services in paragraph 40 above will be removed from the Register and regarded as never having been part of the registered specification. However, the mark will remain on the register for the services listed in paragraph 41 above.

55) I now turn to consider the opposition filed by ILR in respect of the application made by OGL. The sole ground of opposition is under section 5(2)(b) which reads:

“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.”

56) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

57) ILR is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. Given the dates involved the issue of Proof of Use does not bite.

58) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

59) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

60) The services in the instant case cover, inter alia, telecommunications; audio and visual broadcasting as well as internet services. To my mind, the average consumer for these services would be the general public, including businesses. Such services would be sold in a wide variety of ways such as retail outlets, via the internet, via telesales or face to face. However, it is likely that the initial selection will be a visual one as it is most likely to be viewed on-line or via advertising, although I must also take into account word of mouth recommendations, and telesales. Therefore, whilst I consider the visual aspect as being the most important in selection, aural considerations also apply. The prices of the services will vary enormously as will the level of attention which the average consumer will pay to the selection, **but to my mind it will range from a low to medium degree of attention.**

Comparison of services

61) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

62) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

63) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

64) Following the invalidity case earlier in this decision the specification of ILR is reduced. The services of the two parties are as follows:

- ILR: “television broadcasting services; electronic transmission of streamed and downloadable 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; webstreaming being the transmission of visual data via the Internet or other computer network”.
- OGL: In Class 38: Telecommunications services; broadcasting services; radio broadcasting; radio information services; radio broadcasting of information; television broadcasting; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; telecommunication of information; delivery of music by telecommunications; news agency services; transmission of written and digital communications; transmission of radio programmes; radio messaging; voice messaging services; message sending; transmission of television programmes; music broadcasting; audio broadcasting; video broadcasting; provision of communications via radio; leasing and rental services in connection with telecommunications apparatus and equipment; leasing and rental of radio equipment; advisory services relating to all the aforementioned services.
- In Class 41: Entertainment; radio entertainment; television entertainment; radio production services; radio entertainment production; preparation of radio programmes; presentation of radio programmes; editing of radio programmes; production and distribution of radio programmes; production of special effects for radio; arranging of musical entertainment; arranging of visual entertainment;

provision of musical entertainment; provision of visual entertainment; script writing services; speech writing; rental of radio and television equipment; information services relating to entertainment; educational information; information services relating to sport; provision of information relating to radio and television programmes; advisory services relating to all the aforementioned services.

65) I shall first consider the class 38 services of the two parties. The following are clearly identical as they have the same description.

ILR's specification	OGL's specification
television broadcasting services; electronic transmission of streamed and downloadable video files via electronic and communications networks as well as by means of a global computer network;	broadcasting services; television broadcasting; transmission of television programmes; video broadcasting;
electronic mail services;	electronic mail services;
providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; webstreaming being the transmission of visual data via the Internet or other computer network".	providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services;

66) For the same reasons why I did not find misrepresentation, and taking into account the comments at paragraph 30 above, I find the following class 38 services of OGL to be not similar to the services of ILR.

In Class 38: Telecommunications services; radio broadcasting; radio information services; radio broadcasting of information; telecommunication of information; delivery of music by telecommunications; news agency services; transmission of written and digital communications; transmission of radio programmes; radio messaging; voice messaging services; message sending; music broadcasting; audio broadcasting; provision of communications via radio; leasing and rental

services in connection with telecommunications apparatus and equipment; leasing and rental of radio equipment; advisory services relating to all the aforementioned services.

67) Next I turn to consider the class 41 services of OGL to the class 38 services of ILR. To my mind the following class 41 services of OGL are clearly highly similar to the class 38 services of ILR:

- Entertainment; television entertainment; arranging of visual entertainment; provision of visual entertainment; rental of television equipment; provision of information relating to television programmes; advisory services relating to all the aforementioned services.

68) The provision of radio services is significantly different to television services and there is no evidence of anyone, the publically funded BBC, aside providing both. Television is not a natural extension of radio and vice versa, the BBC notwithstanding as this is a quasi-government organisation funded by a tax not a genuine commercial organisation. Similarly, the provision of chat room services and email services are wholly different to telecommunications services and radio services. I therefore find the following class 41 services of OGL to be not similar to those class 38 services of ILR:

- In Class 41: radio entertainment; radio production services; radio entertainment production; preparation of radio programmes; presentation of radio programmes; editing of radio programmes; production and distribution of radio programmes; production of special effects for radio; arranging of musical entertainment; provision of musical entertainment; script writing services; speech writing; rental of radio equipment; information services relating to entertainment; educational information; information services relating to sport; provision of information relating to radio programmes; advisory services relating to all the aforementioned services.



Comparison of trade marks

69) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, Bimbo SA v OHIM, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

70) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

ILR's mark	OGL's marks
	

71) Visually both marks consist of the same two words CENTRE RADIO. The fact that ILR's mark is in lower case whereas OGL's is in upper case makes no difference to the fact that the words are identical. Nor does the fact that the second of OGL's marks is a negative image. The only difference is that ILR's mark has a "play" sign of an arrow head in the letter "O" whilst OGL's marks have a "volume" device in front of its marks. As anyone blessed with the gift of sight would attest the marks are visually highly similar. Aurally the device elements would not be enunciated and so the marks are aurally identical. Both provide the same message and so must be considered to be conceptually identical. **The marks of the two parties are highly similar.**

Distinctive character of the earlier trade mark

72) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

73) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*.

However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out''.

74) ILR's mark consists of two well-known words which for the average consumer will equate to the provision of a radio service, so in the context of television services, chat rooms and mail they are inherently distinctive to a medium degree. ILR has not provided any evidence of use and so cannot benefit from enhanced distinctiveness through use. **Overall ILR's mark is inherently distinctive to a medium degree, it cannot benefit from enhanced distinctiveness.**

Likelihood of confusion

75) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of ILR's trade mark as the more distinctive the trade mark 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 upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the services is a member of the general public, including businesses, who will select the services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay a varying degree (ranging from low to medium) of attention to the selection of such services.
- the marks of the two parties are highly similar.
- ILR's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the following services in class 38 are identical whilst the services shown below in respect of class 41 are highly similar to the services for ILR's mark is now registered.

Class 38: broadcasting services; television broadcasting; transmission of television programmes; video broadcasting; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services;

Class 41: Entertainment; television entertainment; arranging of visual entertainment; provision of visual entertainment; rental of television equipment; provision of information relating to television programmes; advisory services relating to all the aforementioned services.

- the following services of OGL in classes 38 and 41 are not similar to the services in class 38 for which ILR's mark is now registered.

In Class 38: Telecommunications services; radio broadcasting; radio information services; radio broadcasting of information; telecommunication of information; delivery of music by telecommunications; news agency services; transmission of written and digital communications; transmission of radio programmes; radio messaging; voice messaging services; message sending; music broadcasting; audio broadcasting; provision of communications via

radio; leasing and rental services in connection with telecommunications apparatus and equipment; leasing and rental of radio equipment; advisory services relating to all the aforementioned services.

In Class 41: radio entertainment; radio production services; radio entertainment production; preparation of radio programmes; presentation of radio programmes; editing of radio programmes; production and distribution of radio programmes; production of special effects for radio; arranging of musical entertainment; provision of musical entertainment; script writing services; speech writing; rental of radio equipment; information services relating to entertainment; educational information; information services relating to sport; provision of information relating to radio programmes; advisory services relating to all the aforementioned services.

76) I also take into account the comments of Lady Justice Arden in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where she stated that:

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

77) I also note that if the similarity between the goods/services is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not

published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

78) Thus where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar.

79) In view of all of the above, and allowing for the concept of imperfect recollection there is a likelihood of consumers being confused into believing that the services (identified as identical or highly similar earlier in this decision) in OGL’s application are those of ILR or provided by some undertaking linked to it. The ground of opposition under section 5(2)(b) succeeds in respect of the following:

Class 38: broadcasting services; television broadcasting; transmission of television programmes; video broadcasting; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services;

Class 41: Entertainment; television entertainment; arranging of visual entertainment; provision of visual entertainment; rental of television equipment; provision of information relating to television programmes; advisory services relating to all the aforementioned services.

80) However, in view of all of the above, and allowing for the concept of imperfect recollection there is no likelihood of consumers being confused into believing that the services (identified as not similar earlier in this decision) in OGL’s application are those of ILR or provided by some undertaking linked to it. The ground of opposition under section 5(2)(b) fails in respect of the following:

In Class 38: Telecommunications services; radio broadcasting; radio information services; radio broadcasting of information; telecommunication of information; delivery of music by telecommunications; news agency services; transmission of written and digital communications; transmission of radio programmes; radio messaging; voice messaging services; message sending; music broadcasting; audio broadcasting; provision of communications via

radio; leasing and rental services in connection with telecommunications apparatus and equipment; leasing and rental of radio equipment; advisory services relating to all the aforementioned services.

In Class 41: radio entertainment; radio production services; radio entertainment production; preparation of radio programmes; presentation of radio programmes; editing of radio programmes; production and distribution of radio programmes; production of special effects for radio; arranging of musical entertainment; provision of musical entertainment; script writing services; speech writing; rental of radio equipment; information services relating to entertainment; educational information; information services relating to sport; provision of information relating to radio programmes; advisory services relating to all the aforementioned services.

CONCLUSION

81) The ground of invalidity was partly successful as was the ground of opposition.

COSTS

82) As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 26th day of March 2018

**G W Salthouse
For the Registrar
the Comptroller-General**