

O-367-21

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION No. 3458313

BY LAMEEK LIMITED

TO REGISTER:

CRYPTIC COUNTDOWN

AS A TRADE MARK IN CLASS 41

AND

OPPOSITION THERETO (UNDER No 420123)

BY ITV STUDIOS LIMITED

Background and pleadings

1. The details of the mark the subject of these proceedings are:

Mark: CRYPTIC COUNTDOWN

Filing date: 15 January 2020

Publication date: 24 January 2020

Applicant: LAMEEK LIMITED (“the applicant”)

Specification: Various services in class 41, which I set out later.

2. ITV Studios Limited (“the opponent”) oppose the registration of the mark on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). A brief summary of the grounds is:

- Under section 5(2)(b), the opponent relies on two earlier¹ UK trade marks, both of which consist of the word **COUNTDOWN**. Both are subject to the proof of use provisions contained in section 6A² of the Act and, consequently, they can only be relied upon to the extent that they have been used. To this extent, the opponent made a statement of use in relation to: “live or broadcast entertainment services, all provided by television, and film or recording studios; all included in Class 41” (earlier mark 1277474) and “production of television programmes; all included in Class 41” (earlier mark 1580994). The opponent states that the contested services are identical or similar to its services, and that the marks are highly similar. The opponent also states that the “CRYPTIC”

¹ The dates of filing of these marks are clearly earlier than the application – there is no dispute about this.

² The provisions apply to earlier marks which completed their registration processes five years or more before the filing of the application being opposed. Both earlier marks fall into this category.

element of the applicant's mark is less significant (because it is an adjective often used to describe the nature of a game) and, thus, more focus will be placed on the COUNTDOWN element of the applicant's mark.

- Under section 5(3), the opponent relies on the same earlier marks/services and claims that on account of its claimed reputation, the applicant will derive an unfair advantage if it were to use the applied-for mark, and that the use of the applicant's mark would be detrimental to the opponent's reputation and the distinctive character of its marks.
- Under section 5(4)(a), the opponent claims that it has used the sign **COUNTDOWN** since 1982 in relation to the same services for which it has made statements of use (see above). The opponent considers that it has a protectable goodwill as a result of such use, and that the use of the applicant's mark would constitute a misrepresentation that will damage its goodwill.

3. The applicant filed a counterstatement denying the grounds of opposition. In particular, I note the following points made:

- No request is made that the opponent prove use of the earlier marks under sections 5(2)(b) and 5(3). Consequently, the opponent is entitled to rely on the services set out in its statement(s) of use, as referred to above.
- That the applicant's mark is a combined term, constituting a novel concept with greater meaning than COUNTDOWN alone.
- That the applicant's mark includes use via audience participation on the internet, something not covered by the opponent's services.
- That the applicant's mark is not dominated by the word COUNTDOWN as the consumer would not associate it "with the aging conceptual element of the stand-alone term "Countdown"" (which the applicant says is also in common usage) but rather with its new concept.

- There are various other marks in class 41 that have been accepted despite earlier one-word marks existing. Reference is made to the marks BOARDROOM MASTERMIND and FINTECH'S MASTERMIND living alongside MASTERMIND, and THE SORCEROR'S APPRENTICE, MUSLIM APPRENTICE and OZWIN'S APPRENTICE living alongside THE APPRENTICE.
- That "in the age of the Internet", the applicant's new mark/concept would not have to rely on the opponent's reputation. It is added that "stimulating interest in a more mentally-demanding and participatory television experience, can only be to the advantage of the industry as a whole".
- That the viewing public would be quite capable of distinguishing between the long-running mark of the opponent, and the new and exciting concept of the applicant, which, "in all probability to be featured by a different broadcasting channel in competition with which in itself would engender a different identity in the mind of the consumer" (sic).
- That without wishing to impute or imply improper conduct by the opponent, the applicant nevertheless questions whether the opponent's actions might be an "unconscious attempt at restriction of trade", and given the opponent's resources, such actions might be an abuse of a dominant position in contravention of Section 18 of the Competition Act 1998.

4. Only the opponent filed evidence. Neither side requested a hearing, but both sides filed written submissions instead. The applicant has represented itself during the proceedings. The opponent is represented by CMS Cameron McKenna Nabarro Olswang LLP.

The evidence

5. The opponent's evidence is given by way of witness statement, the witness being Mr Richard Buckley, the opponent's Deputy Director of Business Affairs.

6. Mr Buckley gives some background information about the opponent and its parent company, ITV Plc. The former produces content for broadcast by the latter (and others). In relation to the mark COUNTDOWN, Mr Buckley explains that this is the name of a television programme the opponent produces, which has been broadcast since 1982. It is a quiz type programme, based on words and numbers. The programme is broadcast by Channel 4 rather than ITV. The programme is based on an original French format called “Des Chiffres et des Lettres” which ITV Plc have a licence for. A lot of evidence is provided in Mr Buckley’s witness statement about the popularity and success of the programme. Whilst I will of course come back to any specifics of the evidence to the extent that it becomes necessary, I do not intend to summarise the evidence in significant detail here. This is because it is abundantly clear from the evidence that the COUNTDOWN television programme is indeed a long-running one and it achieves significant viewing figures. I note that in recent years viewing figures have declined, but I also note Mr Buckley’s point that this is largely down to the availability of so many alternative channels/programmes compared to when COUNTDOWN was first broadcast. I also note that whilst the programme is still broadcast live, the programme is also viewed via on-demand services, including via Channel 4’s Internet-based “All 4” video on demand service.

7. One area of the evidence that is worth noting at this stage relates to activities beyond the production/broadcast of COUNTDOWN itself. I note a number of points:

- Since 2012, a crossover show has been broadcast called “8 OUT OF 10 CATS DOES COUNTDOWN”, which constitutes a “mashup” of COUNTDOWN and another popular quiz show broadcast on Channel 4 called 8 OUT OF 10 CATS. The evidence shows that this show has become popular in its own right and was still being broadcast in 2020.
- There has been licensing/merchandising activity in the form of:
 - A 2015 licence of the trade mark and the programme’s “look and feel” to Barnstorm Games, as the name of a mobile game. The witness has been advised (so this evidence is hearsay) that the game has been

downloaded over 165k times. An extract from the Google Play store shows availability since 2006 with 10k+ downloads (Exhibit RB21).

- A licence to Mindscape of the trade mark COUNTDOWN in respect of a video game available to buy from UK retailers including Amazon. Exhibit RB22 consists of a screen print from Amazon of said video game. There is no indication as to the sales volume of this product.
- Licensing between 2010-2015 by Deluxe Digital Studios Limited of another mobile game. In 2012, this game, according to a post on the website DigitalSpy.com, was ranked fifth in the number of paid applications available on the Apple iPad in the UK (Exhibit RB23 refers).
- Since 2014, a licence to Rocket Games Limited has been in play in relation to board and card games. Retailers' webpages selling this game can be seen in Exhibit RB24. There is no indication as to how many of these games were sold.
- Since 2015, a licence to Vista Stationery & Print Ltd to create a COUNTDOWN calendar between the years 2015-2021 has been in play. Retailers' webpages selling such calendars can be seen in Exhibit RB25. There is no indication as to how many calendars have been sold.
- Between 2012-2015, two of COUNTDOWN's programme sponsors (Lloyds Pharmacy and Vitabiotics) were granted a licence to use the COUNTDOWN mark in respect of consumer competitions.

Section 5(2)(b)

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. The following principles are gleaned from the judgments 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 greater 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.

10. I highlight, particularly for the benefit of the applicant (who is self-represented), why the above principles are taken from EU case-law despite the UK having left the EU. This is because section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive, so this is why this decision continues to make reference to the trade mark case-law of EU courts.

Comparison of marks

11. 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 the marks, 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.”

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

13. Although there are two earlier marks to consider, they are same mark: COUNTDOWN. Consequently, the comparison is between:

CRYPTIC COUNTDOWN and **COUNTDOWN**

14. The overall impression of the earlier COUNTDOWN marks is based solely on the word of which they are comprised. In relation to the applicant's mark, there is a dispute as to whether the word COUNTDOWN dominates its overall impression, given what the opponent submits is adjectival use of the word CRYPTIC. However, in terms of overall impression, and whilst it is necessary to keep in mind the meaning and significance of words that make up marks when deciding whether there is a likelihood

of confusion, I am conscious that the applicant's mark presented here is clearly comprised of two words, CRYPTIC and COUNTDOWN. Neither word is presented in a way which gives it greater impact or significance over the other. As I will come on to, the words form a unit, with a meaning as a whole, one in which the word cryptic qualifies the word countdown. The overall impression is based on the mark as a whole, with both CRYPTIC and COUNTDOWN playing a role in the overall impression, roles of roughly equal weight.

15. Visually and aurally there is a point of similarity (the common presence of the word COUNTDOWN) and a point of difference (the absence/presence of the word CRYPTIC, and the resulting difference in length, visually and aurally). I consider this equates to a medium degree of visual and aural similarity existing between the marks.

16. Conceptually, the word COUNTDOWN is a known dictionary word. The same word is included in the applicant's mark. Whilst the addition of the word CRYPTIC gives some additional context, in the sense that the countdown referred to is cryptic in some way, this does not change the inherent meaning/concept of the word COUNTDOWN within that mark. Thus, both marks refer to a countdown, albeit one is a cryptic countdown. I consider there to be a reasonably high (but not the highest) degree of conceptual similarity. In making this finding, I have kept in mind the applicant's point about its "exciting new concept". However, this submission appears to be focused on the nature of the service it offers ("involving simultaneous audience participation over the Internet") rather than the inherent meaning of the marks themselves.

Comparison of services

17. The applicant seeks registration for:

Entertainment; entertainment by or relating to radio and television; entertainment, education, and instruction, relating to quizzes, competitions, cryptic clues, crossword clues, and general knowledge; entertainment, education, and instruction, relating to time-limited quizzes, competitions, solving of cryptic clues and crossword clues, and general knowledge;

production, presentation, distribution, syndication, networking and rental of television and radio programmes and of films and sound and video recordings, interactive compact discs and CD-ROMs; providing online entertainment; organisation, production, and presentation of live and recorded performances and audience participation events; provision of entertainment, education, and instruction for accessing via communication and computer networks; provision of information relating to any of the aforesaid services; all of the aforesaid services relating to, or featuring live or recorded, time- unlimited or time-limited, quizzes, competitions, featuring cryptic and crossword clues, and general knowledge.

18. It is useful to highlight that all of the above terms are subject to the limitation in the last line of the specification. This means that every service the applicant seeks to register relates to, or features:

- i) live or recorded quizzes or competitions;
- ii) of a time-limited or unlimited nature;
- iii) which all feature cryptic and crossword clues and general knowledge.

19. Between the two earlier marks, the opponent is able to rely on the following class 41 services:

Live or broadcast entertainment services, all provided by television, and film or recording studios; all included in Class 41 (earlier mark 1277474)

Production of television programmes; all included in Class 41 (earlier mark 1580994)

20. The first point I make is that services can be considered identical if a term of one specification falls within the ambit of a term in the other, or vice versa. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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 for 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.”

21. In relation to what is sought to be registered, the following can be considered *Meric* identical to the opponent’s services (in particular, when compared to the “live or broadcast entertainment services, all provided by television, and film or recording studios”). This is because the scope of the competing terms means that they include entertainment services potentially of the same nature:

- Entertainment.
- Entertainment by or relating to radio and television – the finding of identity applies to radio as well as television entertainment because the opponent’s entertainment services include those produced by recording studios (which includes radio recording studios) not just television.
- Entertainment,, relating to quizzes, competitions, cryptic clues, crossword clues, and general knowledge.
- Entertainment,, relating to time-limited quizzes, competitions, solving of cryptic clues and crossword clues, and general knowledge.
- Providing online entertainment - the finding of identity arises because the opponent’s live or broadcast entertainment services could be via online methods such as streaming.
- Provision of entertainment, for accessing via communication and computer networks - as per the last bullet point, the finding of identity arises because the opponent’s live or broadcast entertainment services could be via communication and computer networks.

22. The assessment of whether the services conflict is not simply about identity. Whether the services are similar (and to what degree) is also important to keep in mind. In terms of assessing similarity, all relevant factors relating to the services in the competing specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“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.”

23. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

24. Further, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the GC stated that “complementary” means:

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

25. In relation to the services I have already held to be identical (under the various bullet points of paragraph 21), I should stress that if for some reason I am found to have erred in my assessment, the services are nevertheless highly similar. The services all provide entrainment, and all, potentially, include quizzes or forms of competition within their scope. Thus, the core purpose is the same, the nature potentially the same, the users the same. Even if the methods of delivery are held not to be identical, they are not wholly remote from one another, and could potentially compete.

26. I now turn to the other services and consider whether they are identical, similar, or not similar, to the opponent’s terms.

Production, presentation, distribution, syndication, networking and rental of television and radio programmes and of films and sound and video recordings, interactive compact discs and CD-ROMs

27. The opponent is able to rely on its term “production of television programmes”. Clearly, the above services are identical to this, to the extent that the applicant’s term covers “production” of “television...programmes, and ofvideo recordings”. For the production of “radio programmes and of films and sound...recordings”, the services are highly similar. The nature, purpose, methods of use, users are all highly similar, the only real difference is the medium - TV programmes in contrast to radio, film, audio recordings.

28. In relation to the production of interactive compact discs and CD-ROMs, I keep in mind that the service relates (as all of the services in the applicant's specification do) to live or recorded quizzes and competition (of the nature described earlier). I also keep in mind that the service is not the end product (the interactive compact disc or CD-ROM) but the production service itself. To that extent, and whilst the final produced output may be in a different form, the nature and purpose of the production may be quite similar in terms of the production process, filming, editing etc. and content creation. The users will be similar (businesses who are trying to get such things to market either by way of television or fixed forms of media). There could be competition between the services, although this will likely depend more on the user's preferences as opposed to a competitive choice, but there is also likely to be complementarity, with the production of the fixed form of media being seen as an ancillary service with the live or recorded content being important for the production of the former. I consider there to be a reasonably high degree of similarity here.

29. That then leads to presentation, distribution, syndication, networking and rental. To my mind, these are all clearly related to the production process, and form the next logical step in bringing the product to market. Once the production has happened, these next steps are undertaken to get the content to the eyes and ears of the end user. Where I have found the production service to be identical, I consider these next complementary steps to be highly similar. Where I have found the production services to be highly (or reasonably highly) similar, I find the next steps to have a reasonable level of similarity.

Organisation, production, and presentation of live and recorded performances and audience participation events

30. There is no reason why such services could not be for television (regardless of how that might subsequently be broadcast). I therefore consider the services to be either identical or highly similar to the opponent's production of television programmes. Even if the services were not television-based, the production is still likely to be highly similar. Organisation and presentation of the same is also likely to be reasonably high in similarity especially keeping in mind that all of the applicant's services relate to, or feature, live or recorded competitions/quizzes.

Education, and instruction, relating to quizzes, competitions, cryptic clues, crossword clues, and general knowledge; education, and instruction, relating to time-limited quizzes, competitions, solving of cryptic clues and crossword clues, and general knowledge; provision of, education, and instruction for accessing via communication and computer networks

31. One would normally expect an education service to be inherently different to an entertainment service. However, it is not as though the applicant's services can be construed as typical educational services such as schools and colleges, or specific training activities, especially when one bears in mind the limitation to its terms as I have highlighted earlier in this decision. The potential relationship between the applied-for services (with their limitation) is therefore likely to be close to the earlier mark's entertainment services. This is because, whilst the entertainment service's primary purpose may be to entertain, it could do so in a way which is also educational in nature, and vice versa. This is especially so when one considers that the actual limitation includes features such as crossword clues and general knowledge. Bearing all this in mind, I consider there to be a medium degree of similarity.

Provision of information relating to any of the aforesaid services

32. I consider that information services relating to the terms I have found similar above to also be similar, to the same extent as I have set out.

Average consumer and the purchasing act

33. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”

34. I find it necessary to break this down between what can be characterised as entertainment (and educational services of the sort specified by the applicant), and those which are aimed more at production etc.

35. In relation to the former, the average consumer will be a member of the general public. Services of this nature will be chosen frequently. The services might often be provided free (albeit one may need a licence fee to watch) or paid for as part a subscription, which could be accessed via traditional broadcast methods, or via the Internet. They could potentially be subject to a one-off cost, although this would normally be low in value. The services are unlikely to represent important or significant choices by the average consumer. Whilst this points towards, and I find, a lower degree of care and consideration than the norm, I do not consider it is a completely casual selection where little care and consideration is deployed.

36. In relation to the production (etc) type services, the average consumer will be a person in the trade, who wishes an end product to be produced (or distributed, syndicated etc) for them rather than doing it themselves. These services are more specialist in nature. They are likely to be reasonable costly. Whilst this points towards, and I find, a higher degree of care and consideration than the norm, I do not consider it is the highest degree possible.

Distinctive character of the earlier trade marks

37. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“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).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”³

38. I will start with the inherent perspective, and, again, I consider it necessary to break this down in the same way as I broke the average consumer down. For the entertainment services covered by the earlier mark, I consider that there is a degree of allusion in that the average consumer will assume that the live or broadcast entertainment service has some form of countdown, that features within the content they will watch or listen to. That said, I consider this to be only mildly allusive and whilst the distinctiveness may be less than a medium level, it is only slightly so. For the production (etc) services, that mild allusion does not really exist. I consider the mark to have a medium level of inherent distinctive character.

39. That then leads to the evidence filed, and whether this enhances the distinctive character of the earlier marks. There can be no doubt from the evidence that the

³ C-342/97, paras. 22-23

television programme produced by the opponent and broadcast on Channel 4 is a well-known and popular one. However, I bear in mind that the question to answer here isn't purely a knowledge-based question, but whether the capacity of the mark to distinguish its services from those of others has been enhanced. I come to the view that there will have been an enhancement of distinctive character, such that the word COUNTDOWN, used as a name of a television programme, is high in distinctive character.

Likelihood of confusion

40. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

41. I will start with the applicant’s entertainment services. I have found medium levels of visual and aural similarity, and a reasonably high level of conceptual similarity between the trade marks. I have found the services to be identical or else highly similar. I have found the degree of care and consideration when selecting the services to be lower than the norm, although not completely casual in nature. I found the earlier mark to be possessed of a slightly lower than medium level of inherent distinctiveness, but in relation to television programmes highly distinctive. I come to the view that there is a likelihood of direct confusion, particular bearing in mind imperfect recollection. Notwithstanding what I have said about the overall impression of the mark, it is in my view likely that whilst the average consumer will recall that both marks make reference to a countdown, they may misrecall that one of the marks qualified the nature of the countdown and its crypticness. In view of this they may directly confuse the marks.

42. I accept, though, that the above finding is a borderline decision, so I will next consider, in the event that the average consumer does recall that one mark was COUNTDOWN and the other CRYPTIC COUNTDOWN, whether they would put the similarities that exist between the marks down to the same or economically linked undertakings being responsible for the services. In my view they will. Whilst I have guarded against finding indirect confusion on the basis simply that the marks have a word in common⁴, I come to the view that the average consumer will assume that this is a related service offered under a brand variation with, perhaps, some new feature or aspect, with the programme focusing on more cryptic quizzes and competitions than before. I have not mentioned the distinctiveness of the earlier mark in this finding yet. This is because I would have come to this conclusion whether I was considering the mark on the basis of its inherent level of distinctiveness, or its enhanced distinctiveness. However, when one does take the enhanced distinctiveness into account then confusion is even more likely as the public will assume that CRYPTIC COUNTDOWN is an offshoot or spin-off of the television programme broadcast solely under the COUNTDOWN name. When making this finding, I have not placed

⁴ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

significant weight on the cross-over evidence relating to 8 OUT OF 10 CATS DO COUNTDOWN. This is because the structure of that cross-over name is different, and is just one example. That said, it at least shows the capacity of well-known and popular programmes to create spin-offs or alternative versions. I have also borne in mind that the applicant's service could be provided more via the Internet and have an interactive element (a point the applicant makes in its counterstatement and submissions) but I come to the view that this does not avoid confusion, and, in fact, may just as easily fit into the spin-off assumption on the part of the average consumer.

43. I come to the same findings as above in relation to the education services as, given their nature and limitation, they may in reality be little different to what might be classed as entertainment. The average consumer will still see the services as coming from the same or economically linked undertakings.

44. I turn now to the production type services. One difference here is that although enhanced distinctiveness does not assist (because the use relates to the programme not the production service) the inherent level of distinctiveness is at least medium. I bear in mind that I have also assessed the level of care and attention of the average consumer to be higher than the norm, which, to a degree, mitigates, but does not rule out, the impact of imperfect recollection. However, when all these factors are combined, I likewise conclude that there is a likelihood of direct confusion for all of the services, but if I am wrong on that then the average consumer will still put the similarities down to the same or related undertaking being responsible for the services, perhaps indicative of a separate arm of the same company specialising in certain aspect of the services concerned.

45. I conclude that there is a likelihood of confusion for all the applied-for services, so the opposition under section 5(2)(b) succeeds.

46. There are two further points upon which I will remark before commenting on the other grounds of opposition. First, I have noted the applicant's points regarding other two-word marks which appear to co-exist with one-word marks e.g. MASTERMIND and BOARDROOM MASTERMIND (other examples are quoted earlier, and further examples are referenced in the applicant's written submissions). The reason why I

have yet to comment is because I do not see how this can assist. Marks apparently co-existing on the register tells me nothing about the situation in the marketplace. Nor does it assist me in working out whether the average consumer is likely to be confused even in relation to the marks exemplified by the applicant, let alone the marks at issue here. Further, the co-existence, on registers, is a matter for the owners of the earlier marks and it is up to them whether they oppose or not.

47. I have also not commented thus far on the applicant's claim that the opponent may unfairly be attempting to restrict trade and competition. In relation to this, it is not clear to me on what basis the applicant would have the Tribunal throw the opponent's claims out. Even if it was clear that there was such a power, the point becomes moot because the opponent, on my findings, has succeeded, so it cannot possibly be said that the opponent has acted unfairly or improperly. Even if they had not succeeded, the case is clearly one within the realms of argument and bringing the claim could not be viewed as improper. The Act provides for an opposition process before new trade marks are registered, the opponent is simply availing itself (successfully in this case) of that right to oppose.

48. I will now move to the other grounds of opposition, although, as the opponent has already succeeded, I will provide my views in less detail than I have already done.

Section 5(4)(a)

49. Section 5(4)(a) of the Act reads:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(b)...

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

50. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and, iii) damage. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

51. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), where the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

52. Notwithstanding that this is a wholly independent ground to section 5(2)(b), and that the legal tests differ, and, further, that there may be circumstances in which one ground succeeds but not the other (or vice versa), in this case it is extremely difficult to see why the opponent's case under section 5(4)(a) is any different (or better) to its 5(2)(b) case. In fact, the prism through which one looks under section 5(4)(a) is somewhat narrower to section 5(2)(b) because the goodwill it owns is predominantly in relation to a television show of a particular nature whereas its specification under 5(2)(b) is wider than that. Thus, if I am wrong to have refused the applicant's mark under section 5(2)(b), I see little scope that this further ground will change things. For the record though, I am prepared to make the following findings:

- I have no doubt that the opponent has the requisite goodwill associated with the name of a quiz-based television programme (featuring words/numbers), a strong goodwill at that.
- Even though the programme is broadcast by Channel 4, the goodwill belongs to the opponent, the producer.
- For the reasons I have already given under section 5(2)(b), I still feel that misrepresentation will arise in relation to all of the entertainment (and education services) applied for by the applicant.
- Although a borderline decision, I extend this finding to the applied-for production (etc.) services.
- The misrepresentation is likely to lead to damage, even if that is limited to being in the more general sense that a wrongful association may create⁵.

53. The consequence of the above is that the ground under section 5(4)(a) also succeeds.

⁵ See, for example, *Ewing v Buttercup Margarine Ltd* (1917) 34 R.P.C. 232

Section 5(3)

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

55. The law appears to be as follows.

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is

weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; Intel, paragraphs 76 and 77.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

Reputation

56. I have already commented on the evidence. The COUNTDOWN television programme is a well-known and popular one, which easily establishes the requisite reputation in relation to television entertainment services. It is a strong reputation at that.

The link

57. Given the similarity of marks/services (albeit bearing in mind only where the reputation exists) together with the distinctiveness of the mark and the strength of the reputation, I consider that a link will be made by the relevant public, particularly bearing in mind that there is a likelihood of confusion and misrepresentation as already held. Even if I am held to be wrong on those findings (or partially wrong), I still consider that a link will be made although, in such a scenario, I would need to accept that the link will be stronger in relation to some of the services (such as those with a clear entertainment angle) than others (such as the production type services). That then leaves the three potential (and pleaded) heads of damage, with my findings being:

- Unfair advantage – even on the basis of the narrower prism under section 5(4)(a), I have found that a misrepresentation will occur. Given this, I conclude that an unfair advantage will arise because the applicant would be benefiting from such misrepresentation. Even if I am wrong on that finding, and also on my core findings in relation to likelihood of confusion, I have no doubt that for all of the services the relevant public will likely wonder if there is a connection with the opponent, or, alternatively, assume that the applied-for services have a nature similar to the opponent's reputed television programme. Thus, even if they are not confused, the relevant public will be attracted to them on account of such familiarity and, thus, an unfair advantage is gained. This applies to all the applied-for services including the production (etc.) type ones, as the assumption will either be that this is the production arm of the COUNTDOWN programme, or that they will be producing similar entertainment (etc.) as the COUNTDOWN programme.
- Detriment to reputation, often referred to as tarnishing, occurs when the earlier mark's power of attraction is reduced due to the use of the applied for mark, normally on account of some negative characteristic of such use. I see no obvious negative characteristic here. Whilst the COUNTDOWN programme is clearly well regarded, it is simply hypothetical that the form of use of the applied for mark would be detrimental. I reject the argument here.

- Detriment to distinctive character occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark. On the basis of my current finding that all of the services would constitute a misrepresentation, that action will dilute the mark's distinctiveness.

Conclusion

58. The opposition has succeeded, and subject to appeal, the applied-for mark is refused registration.

Costs

59. I have determined these proceedings in favour of the opponent. It is, therefore, entitled to an award of costs. I award the sum of £1800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition fee: £200

Filing the statement of case and considering the counterstatement: £300

Filing evidence: £800

Preparing and filing written submissions: £500

60. I therefore order Lameek Limited to pay ITV Studios Limited the sum of £1800. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 17th day of May 2021

Oliver Morris
For the Registrar
the Comptroller-General