

O/666/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 3464907 AND 3485194

BY MR ILYAS DEMIRCI

FOR THE TRADE MARK

NARCOS

IN CLASS 32

AND

NARCOS

IN CLASSES 30 AND 33

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS. 420481 AND 420482

BY NARCOS PRODUCTIONS LLC

Background and pleadings

1. On 7 February 2020 Mr Ilyas Demirci (“**the Applicant**”) applied to register the plain word “NARCOS” (“**the First Application**”) as a UK trade mark.

2. On 14 February 2020, the First Application was published for opposition purposes in the Trade Marks Journal in respect of the following goods:

Class 32: *Beers; ales; lagers; shandy; beer-based beverages; craft beers; de-alcoholised drinks; non-alcoholic beers; non-alcoholic beverages.*

3. On 29 April 2020 the Applicant applied to register the plain word “NARCOS” (“**the Second Application**”) as a UK trade mark.

4. On 15 May 2020 the Second Application was published for opposition purposes in the Trade Marks Journal in respect of the following goods:

Class 30: *Tea-based beverages; coffee based beverages; grain-based beverages; cocoa-based beverages; cocoa for use in making beverages; cocoa-based products; cocoa-based creams in the form of spreads; cocoa-based foodstuffs; powdered beverages containing cocoa; chocolate-based products; chocolate-based beverages; chocolate beverages containing milk; beverages made with a base of chocolate; coffee, tea, cocoa and artificial coffee; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread; pastries; brioches (buns); confectionery; sweets; biscuits and cookies; chocolate; chocolate powder; drinking chocolate; ice cream; sorbets and other edible ices; sugar; honey; treacle; seasonings; spices; preserved herbs; vinegar, sauces and other condiments; golden syrup; yeast; baking powder; salt, mustard; ice.*

Class 33: *Alcoholic beverages, except beers; alcoholic preparations for making beverages; alcoholic wines; sparkling wines; fortified wines; alcoholic cider; perry; spirits; liqueurs; alcopops; alcoholic cocktails; distilled beverages; alcoholic tea-based beverages; coffee based liqueurs; cordials (alcoholic beverages); whisky based beverages; whisky based drinks; alcoholic aperitif bitters.*

5. On 5 June 2020, the First and Second Applications were opposed, in full, by Narcos Productions LLC (**“the Opponent”**).¹ The oppositions are based upon sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (**“the Act”**).² Under section 5(3), the Opponent relies upon the following trade marks, claiming a reputation in all the goods and services covered by the registrations:



EUTM no. 16318388

Filing date 6 February 2017; registration date 29 May 2017

Registered for goods in Classes 3, 9, 18, 24 and 25³

“the First Earlier Mark”⁴

NARCOS

International trade mark designating the EU, No. 1411337

Designation date 9 March 2018; date of protection 7 February 2020

Protected for goods and services in Classes 3, 9, 14, 16, 18, 20, 21, 25, 28, 34 and 41

“the Second Earlier Mark”

6. Under section 5(3), the Opponent claims that use, without due cause, would:

- (i) take unfair advantage of the goodwill and repute acquired by the Opponent;
- (ii) be detrimental to the reputation of the Opponent’s mark;
- (iii) be detrimental to the distinctive character of the Opponent’s mark.

7. Under section 5(4)(a), the Opponent relies upon the sign NARCOS which it claims to have used throughout the UK, continuously, since August 2015, in respect of a television programme, merchandise and licensed goods. The Opponent claims that

¹ The opposition against the First Mark was filed outside the two/three months allowed for the opponent to file a TM7 but was accepted in these proceedings as the Opponent’s deadline fell within the period of interrupted days.

² Grounds under sections 5(2)(a) and 5(2)(b) were dropped by the Opponent.

³ A full list of the goods and services relied upon under section 5(3) is contained within the annex to this decision.

⁴ EUTMs and international marks designating the EU are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – see Tribunal Practice Notice 2/2020 for further information.

use of the Opponent's marks would misrepresent a connection in the course of trade with the Opponent and cause damage to the Opponent's reputation.

8. The Applicant filed a counterstatement denying the claims made and putting the Opponent to strict proof of its claims under sections 5(3) and 5(4)(a). In respect of section 5(4)(a), the Applicant also submits that the Opponent's claim that it has used its sign on "*merchandise and licensed products*" is unclear and imprecise and should be disregarded.

9. In these proceedings, only the Opponent filed evidence. Both parties filed written submissions during the evidence rounds. Neither party requested a hearing and neither party filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the Opponent's evidence and all the submissions received. The Applicant is represented by London IP Ltd; the Opponent is represented by Lewis Silkin LLP.

EVIDENCE AND SUBMISSIONS

10. The Opponent filed evidence in chief in the form of the witness statement of Dominic Farnsworth, Partner at Lewis Silkin LLP and representative for the Opponent. Mr Farnsworth provides some background information about the Opponent's business and explains that the evidence provided in the two exhibits, DF1 and DF2 is the same evidence and submissions provided by the Opponent in response to the ex officio refusal of its international trade mark designating the EU (the Second Earlier Mark). Mr Farnsworth explains that the evidence filed in the proceedings before the EU Intellectual Property Office ("**the EUIPO**") attests to the fame of the Opponent's mark and is therefore replicated in these proceedings, in the interests of procedural economy.

11. Exhibit DF1 consists of the submissions and 14 exhibits⁵ provided to the EUIPO examiner in response to the objection to the Opponent's mark. Exhibit DF2 consists

⁵ Exhibits 6, 9 and 17 to 23 from Exhibit DF1 are excluded by the Opponent as they refer exclusively to use outside the UK.

of the submissions and 8 further exhibits⁶ filed in the Opponent's appeal against the EUIPO examiner's refusal of its trade mark at first instance. I note that the correspondence in DF1 is not dated, however, it was filed at the EUIPO in response to a provisional notice of refusal, issued on 18 February 2018. The statement of grounds of the appeal in Exhibit DF2 is dated 18 June 2019.

12. Mr Farnsworth's witness statement also includes four images from different websites showing whisky and wine bearing a reference to a television programme, or famous person's name. Mr Farnsworth provides these examples as evidence that it is common for television series and films to license their marks for use on food and drink products, although I note that no examples were provided in respect of food products.

DECISION

13. Although the UK has left the EU, 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

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

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

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

⁶ The ex officio total refusal of protection and Exhibits 25, 26, (part of) 28, 30 to 35, 38 and 39 from Exhibit DF2 are excluded by the Opponent.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

15. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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* and *Environmental Manufacturing, paragraph 34*.

(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*).

16. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier mark is similar to the Applicant's mark. Secondly, that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between



the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Comparison of the marks:

17. The Applicant's and Opponent's marks are as follows:

The Opponent's earlier marks	The Applicant's marks
First Earlier Mark: 	First Application: NARCOS
Second Earlier Mark: NARCOS	Second Application: NARCOS

18. The Opponent submits that the marks are visually, aurally and conceptually identical and this is not disputed by the Applicant.

19. I agree that the Opponent's Second Earlier Mark, "NARCOS" is identical to both of the Applicant's marks. With respect to the Opponent's First Earlier Mark, , I agree that this is aurally and conceptually identical to both of the Applicant's marks. However, , is not visually identical to the Applicant's marks, being figurative in nature, with the letters forming the word "NARCOS" appearing in a grey and white font, on a black background. The Opponent's First Earlier Mark nevertheless contains the same series of six letters as the Applicant's marks and I find it to be visually similar

to the Applicant's marks to a high degree. Overall, I find the Opponent's First Earlier Mark to be similar to the Applicant's marks to a very high degree. As a result of this, and due to the identity of the Opponent's Second Earlier Mark and Applicant's marks, the first condition of similarity under section 5(3) is satisfied.

Reputation:

20. The next condition is reputation. Reliance upon section 5(3) requires evidence of a reputation amongst a significant part of the relevant public. In *General Motors*, the CJEU held that:

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

21. In the present case, the Opponent's use of its marks commenced in 2015 when the first season of its programme was broadcast. This date is around five years prior to the relevant dates in these proceedings, these being the filing dates of the Applicant's marks, 7 February 2020 and 29 April 2020. According to the Opponent's

submissions, the show ran for three series, with the latest being released in 2017, however, I note that Exhibit DF1 and DF2 refer to a fourth season released in 2018 and an upcoming fifth season, which was scheduled for release in 2019. From the evidence, these later seasons appear to be referred to interchangeably as “NARCOS” seasons four and five, and “NARCOS: Mexico,” seasons one and two.

22. The market for television programmes is huge, with most households watching on a regular basis, often daily. The Opponent’s television programme is shown on Netflix, which operates in the digital, or streaming, sector of the market. From Exhibit DF1 it can be seen that Netflix had over 130 million subscribers worldwide in quarter 2 of 2018, although the proportion of these subscribers that are in the EU is not indicated. Netflix appears to dominate the digital market, with the majority of “digital original” programmes between 2016 and 2018 being shown on its platform. For example, Exhibit DF1 shows that in Germany in July 2017, 9 out of the 10 most in demand digital original programmes were on Netflix; in the UK this was 8 out of the top 10; and all 10 out of the top 10 in Spain.

23. Focusing on the Opponent’s television programme, Exhibits DF1 and DF2 include the following:

(i) articles and reviews from various UK online news outlets and magazines including The Telegraph, The Independent, GQ, Empire, The Express and The Economist, and from EU press in Forbes Spain, La Nueva España.

(ii) confirmation of significant numbers of viewers (termed in the exhibits as “demand expressions”). For example, Exhibit DF1 indicates that the third season of the programme was, on its release, the number one “digital original” in several EU markets, including the UK, Germany, France and Italy in 2017. Viewing figures indicate that in the week to 16 July 2017, the programme had 2.5 million viewers in Germany. The evidence also indicates viewing figures of 3.75 million in Spain in the week ending 18 December 2018 and Exhibit DF2 shows average UK monthly viewing figures of between 3 million and 5.3 million around the launch of each new season of the programme.

(iii) confirmation that Narcos was nominated for, and won, various awards for its television programme. The most famous awards for which NARCOS was nominated are the Golden Globes, BAFTAs, and EMMYs. The Applicant contends that most of the awards are not of UK origin. In this respect, I find that the Content Innovation Awards are based in Cannes, within the EU and so within the relevant market. With regards to the US-based awards, I take judicial notice of the fact that the ceremonies of the more famous awards listed above are usually broadcast internationally, including in the UK and are widely reported here, so there is a spill over effect to the UK. I therefore decline to discount these awards entirely in my consideration of the evidence and will accord them a weight which recognises that they are US-based.

(iv) Information on the Opponent's social media presence, with over a million Facebook fans worldwide at the end of 2016.

(v) a survey conducted in Spain showing that when asked the question "do you know the TV series "NARCOS?" 92% of respondents aged between 15 and 44 answered "yes." The survey was conducted by the firm GfK who asked 1009 people in a face-to-face interview, at home. The date of the survey is not shown in the report; however, the copyright is stated to be from 2019.

24. While the Opponent has not provided turnover in respect of its marks and has expressed advertising expenditure only in broad terms of "*substantial sums*" having been spent, I find that the Exhibits show cogent evidence of the fairly strong reputation its television series NARCOS has in the EU (including the UK). Although the evidence does not show NARCOS to be in the top 10 television programmes overall, it is shown to have a significant number of viewers, in the low millions in several EU member states and to be a significant player in the sector of digital programmes.

25. In respect of the rest of the goods and services in the Opponent's marks, I have disregarded the evidence that appears to show sales in the US market – identifiable either through the name of the website "Pyramid America," or the fact that prices are shown in dollars. In terms of the EU market for the remaining goods, Exhibit DF1 shows some examples of "NARCOS" used on t-shirts, a computer game available on consoles or via an app, and DVDs. Exhibit DF2 shows some examples of use on drinks bottles, mugs and clothing and includes a sales summary of NARCOS licensed

merchandise, which covers France, Italy, Portugal, Spain and the UK in varying periods between 1 January 2016 and 31 March 2019. The figures cover a wide range of products, including posters, DVDs, clothing, bags, water bottles, mugs and calendars. Most of the unit sales are low considering the nature of the goods, which are marketed to the general public. The highest number of units sold are in respect of clothing, headwear, footwear, bags and accessories, where, adding all the unit sales for each country together, indicates that around 70,000 unit sales over the various periods. In a market the size of the EU, for this broad spectrum of goods, which are targeted to the general public, and considering that sales figures are provided over periods of up to two years, I find that the Opponent has failed to show that it has a reputation on the goods listed in this paragraph, or any of the other goods in its marks, for which it has claimed a reputation.

26. In conclusion, my view is that the evidence clearly shows that:

- (i) NARCOS had a qualifying reputation in the EU at the relevant dates in relation to the services of *“ongoing television programmes; and production and distribution of television programmes”* from its Second Earlier Mark.
- (ii) The evidence fails to show a qualifying reputation at the relevant dates in relation to the remaining services in the Opponent’s Second Earlier Mark, nor in respect of any of the goods in Classes 3, 9, 14, 16, 18, 20, 21, 25, 28 and 34.
- (iii) The evidence fails to show a qualifying reputation at the relevant dates in relation to any of the goods in Classes 3, 9, 18, 24 and 25 in the Opponent’s First Earlier Mark. This being the case, I will not consider the Opponent’s First Earlier Mark any further under section 5(3).

27. As the conditions for section 5(3) are cumulative, the analysis of the remainder of the conditions will focus on the Opponent’s *“ongoing television programmes; and production and distribution of television programmes”* from its Second Earlier Mark.

Link

28. As I noted above, my assessment of whether the public will make the required mental “link” between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

29. The Opponent’s Second Earlier Mark and the Applicant’s marks are identical.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between the goods or services, and the relevant section of the public

30. The Opponent submits that the goods in the Applicant’s marks could be seen as licensed products of the Opponent and provides examples of what it describes as various television series that have food and drink produced under the same name. The examples provided are of Johnnie Walker whisky, where a Game of Thrones “White Walker whisky” has been produced; “Walking Dead bourbon”; “Graham Norton” wine; and “Phillip Schofield” wine. In respect of these examples, I note that two consist of names of famous people, and not television programmes. The “Walking Dead bourbon” is reported in US press, so does not show the situation on the UK market. As for the “White Walker whisky,” it is not clear that the goods are made available on the UK market, with the product shown in the evidence being on the manufacturer’s website, rather than a retailer and there is no price visible in the extract, nor an option to purchase the product. As a result, I do not consider the Opponent to have established that consumers would see food and drink, or even alcohol as a common form of merchandise relating to a television programme.

31. Comparing the Applicant’s goods in Classes 30, 32 and 33 to the Opponent’s “ongoing television programmes; production and distribution of television programmes” for which the Opponent’s Second Mark has a qualifying reputation, I find that the only similarity between them is that there is an overlap in users because they are all aimed at the general public. However, that much could be said of very many

entirely disparate goods/services. By contrast, I find that the Opponent's services and for that matter the product of those services – the programmes themselves – are wholly different in nature to the Applicant's goods, serve a completely different purpose, and their method of use is different. There is no material similarity between them.

The strength of the earlier mark's reputation

32. The Opponent's television programme is clearly very popular within the digital sector of the market, but I keep in mind, that this is only part of the market for television programmes as a whole. It is ultimately the perception of the earlier mark in the minds of the UK consumers that determines whether use of the contested mark will create a relevant link with the earlier mark.⁷ In this respect, I note that viewer figures were often higher in other EU member states, such as Italy and Spain, the survey on recognition of NARCOS as the name of a television programme was conducted only in Spain and the evidence of social media presence in Exhibit DF1 consists of the screen shot of what appears to be an Italian Facebook page. In terms of the UK market, I am satisfied that the Opponent's mark had a reasonably strong reputation for television programmes at the relevant dates, but not a huge reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

33. 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-

⁷ See *Iron & Smith kft v Unilever NV*, CJEU, Case C-125/14 and *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, Case BL O/281/14

109/97 WindsurfingChiemsee 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).*”*

34. In Exhibit DF2, the Opponent’s statement of grounds (submitted to the EUIPO in its appeal⁸), the Opponent states that “*the Spanish word “narco” derives from the Ancient Greek word “narke”*” and that “*many Spanish dictionaries indicate as a meaning of the word “narco” both: drug dealer/drug; and sleepiness.*” Neither of the parties have made submissions on the meaning of the word “NARCOS” in the UK.

35. “NARCOS” is not a dictionary word in the UK. Invented words are usually considered to possess a high degree of distinctive character. I acknowledge that there may be some part of the average consumer group that recognise the pre-fix “narco” from words such as “narcoleptic” and “narcotics” and may understand this as a reference to sleep. However, where this meaning is perceived, it has no relevance in respect of the Opponent’s services. Taking account of this, and the lack of submissions or evidence from the parties on the question of the understanding of “NARCOS” in the UK, I find the Opponent’s earlier mark to be inherently distinctive to a high degree.

36. Distinctive character is a measure of how strongly the mark identifies the services of the Opponent. The Opponent’s evidence shows that it has used its mark for around

⁸ See Exhibit DF2.

five years and has attracted a significant number of viewers for its television programme. The evidence also shows fairly broad press coverage and nominations for prestigious awards. On this basis, I consider the Opponent's mark to be highly distinctive in respect of television programmes, particularly taking account of the use that has been made of it in respect of "*ongoing television programmes; and production and distribution of television programmes.*"

Whether there is a likelihood of confusion

37. The Opponent's Second Earlier Mark is identical to the Applicant's marks and I have found the Opponent's mark to be highly distinctive. On the other hand, I have found the Opponent's services to be dissimilar to the Applicant's goods and that although the Opponent has shown a reasonably strong reputation, the reputation is not huge. Weighing these factors, I conclude that there is no risk that the use of the contested marks in relation to goods in classes 30, 32 and 33 will confuse the public into thinking that those goods are connected with the owner of the earlier mark.

Conclusion

38. Taking all of the above into account, I find that use of the contested marks in relation to the goods covered by Classes 30, 32 and 33 of the First and Second Applications would not have caused the UK public to make a mental link between the contested mark and the earlier marks. In respect of the First Earlier Mark, this is because no reputation was shown on the goods covered by the mark.

39. In respect of the Second Earlier Mark, I have found a reputation in respect of only certain services and none in respect of the goods covered by the mark. For the services where I have found a reputation, my finding that the UK public will not make a mental link between the respective marks is mainly due to (a) the respective goods and services being so distant, and (b) the reputation of the earlier mark for "*ongoing television programmes; and production and distribution of television programmes,*" although reasonably strong, was not so huge as to bridge the gap between television programmes and the goods at issue. Since I find that no link will arise, the section 5(3)

claim must fail, and, in the circumstances, it is unnecessary to consider the claimed bases of damage.

The section 5(4)(a) ground of opposition

40. Section 5(4)(a) states:

“(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, where the condition in subsection (4A) is met,

(aa) [...]

(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.”

41. Subsection (4A) of section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

42. 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 as follows:

“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)."

43. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 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.”

44. The Applicant has not filed any evidence that it has used its mark. This means that the position under section 5(4)(a) must be assessed at the dates when the Applicant applied to register its trade marks, 7 February 2020 and 29 April 2020.⁹

Goodwill and distinctiveness

45. Sufficient goodwill, although an evidence-based assessment, is different from the questions looked at earlier in this decision, for enhanced distinctive character and reputation of the earlier registered marks. The sign relied upon is the plain word “NARCOS,” which is the same as the Opponent’s Second Earlier Mark. The Opponent must show that its business had sufficient goodwill which was distinguished by use of “NARCOS” at the relevant dates so that it can be concluded that misrepresentation

⁹ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person.

would occur, and damage would follow. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1902] AC 217 at 223:

“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.”

46. The Opponent claims that it has *“developed significant goodwill in respect of television series and official merchandise.”* The Applicant disputes this, stating that there were only three seasons of the programme, with 10 episodes in each, shown between 2015 and 2017. The Applicant submits that the number of television programmes shown is minimal, considering the size of the market for television programmes across all platforms on which they are shown. The Applicant also submits that the Opponent has failed to show minimal evidence of goodwill in the UK market and has provided no indication of market share.

47. In *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.”

48. 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.”

49. As previously set out, the Opponent in these proceedings opted to reuse the evidence that it had filed at the EUIPO in proceedings concerning its international trade mark. It is therefore unsurprising that this evidence frequently refers to the EU market, in particular the Spanish market, which was the focus of the grounds for objection by the EUIPO examiner. I am satisfied that at the relevant dates, the Opponent had customers in the relevant jurisdiction of the UK.

50. In terms of extent, I have previously commented on the fact that the Opponent, in its submissions made during the evidence rounds, refers to only three seasons of NARCOS being shown, up to 2017, although it is clear from the evidence that a fourth season has been shown in the UK, and a fifth season is anticipated. It is clear therefore that the Opponent's use extends beyond 2017 and that there have been more than 30 episodes of the programme. The evidence shows that the programme has attracted at least three million UK viewers each month in the periods when a new series has been released and confirms the UK press attention that the programme has attracted. The programmes' recognition in the trade is evidenced through the numerous awards for which it has been nominated, and in some instances has won.

51. Taking account of these factors, I accept that the Opponent has established that, at the relevant dates, it had acquired goodwill in the UK under the sign “NARCOS” in relation to its television series. I also accept that the sign “NARCOS” is distinctive of that goodwill, with the evidence showing that use of the sign has been for the purpose of distinguishing the Opponent’s services.

52. In respect of “*official merchandise*,” I agree with the Applicant’s view that such a term is unclear, as the goods covered by it are not evident. In any event, I do not accept that, on the basis of the evidence, the Opponent has shown that it had acquired actionable goodwill for the sign NARCOS in the UK at the relevant dates and in respect of the goods that could be considered to be forms of merchandise including t-shirts, mugs and DVDs, where some limited use is shown in the evidence.

Misrepresentation and damage

53. The goods for which the Applicant seeks to register its contested marks are dissimilar to the services for which I have found the Opponent has established goodwill, i.e. food, drinks and alcoholic beverages v a television series. The respective goods and services are normally traded in different fields of commercial activity. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millett L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by Wynn-Parry J. in McCulloch v. May (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd. (1898) 15 R.P.C. 105 (cameras and bicycles); Walter v. Ashton [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the Advocaat case Lord

Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the Lego case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration:

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the Lego case Falconer J. likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In Stringfellow v. McCain Foods (G.B.) Ltd. [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any

member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that:

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the Advocaat case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the Advocaat case, be substantial.' "

54. In my judgement, the nature and extent of the Opponent's goodwill under "NARCOS" was insufficient at the relevant dates to cause a substantial number of its UK customers, or potential customers, to believe that the Applicant's goods in Classes 30, 32 and 33 marketed under the contested mark, were connected with a "television series" produced under the name "NARCOS." In reaching this conclusion, I have in mind that the Opponent's "NARCOS" has not become a "household name" in the way that *Lego* had in the *Lego* case. Also, given the distance between the parties' fields of activity, it was necessary for the Opponent to show "clear and cogent proof of actual or possible confusion or connection," which has not been demonstrated. At the most, I consider that the identical nature of the marks may have reminded a small number of consumers of the Opponent. But even if that caused an even smaller number of

them to wonder whether the Applicant's goods in Classes 30, 32 and 33 were somehow connected with the Opponent, that would not justify the Opponent's complaint that use of the contested mark constitutes a misrepresentation to the public.¹⁰

55. As misrepresentation would be avoided, no damage will occur meaning that the opposition under section 5(4)(a) fails in its entirety.

Overall conclusion

56. The opposition under sections 5(3) and 5(4)(a) fail in relation to all of the Applicant's goods in both of its applications. Subject to any appeal, the contested marks may proceed to registration.

Costs

57. The Applicant has been successful and is entitled to a contribution towards its costs, based upon the published scale.¹¹ I have reduced the costs award to take into account the economies of consolidation and the fact that the Applicant did not submit evidence.

Considering the grounds of opposition and preparing counterstatements x 2	£500
Considering and commenting on the other side's evidence	£600
Total	£1100

¹⁰ *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC at paragraphs 16-17 Jacob LJ's judgment. Mere causing customers to wonder is not enough. The use of the contested sign must cause a substantial number of the opponent's customers or potential customers to believe that the applicant's goods are connected with the opponent.

¹¹ Tribunal Practice Notice 2/2016.

58. I order Narcos Productions LLC to pay Mr Ilyas Demirci the sum of £1100. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of September 2021

Charlotte Champion

For the Registrar

ANNEX A – the Opponent's goods and services

The First Earlier Mark:



EUTM no. 16318388

Class 3: Perfumery; Fragrances; Perfumes; Soaps for personal use; Skin cleansers; Ethereal oils; Cosmetics; Hair care lotions.

Class 9: Covers for glasses; Cases for smartphones; Head protection; Mobile telephone covers made of cloth or textile materials; Cell phone covers; Spectacles; Sunglasses; Spectacle frames; Spectacle cases.

Class 18: Leather and imitations of leather; Bags; Handbags; Clutches [purses]; Travel baggage; Overnight bags; Holdalls for sports clothing; Rucksacks; Trunks and suitcases; Duffel bags; Key cases; Key-cases of leather and skins; Leather purses; Coin purses, not of precious metal; Pocket wallets; Credit card cases [wallets]; Card cases [notecases]; Folding briefcases; Business cases; Cosmetic bags sold empty; Cross-body bags; Garment bags for travel made of leather; Beach bags; Vanity cases, not fitted; Umbrellas.

Class 24: Linens; Bed clothes and blankets; Towels of textile; Beach towels; Bed covers; Sheets [textile]; Table napkins of textile; Drapery; Curtains made of textile fabrics.

Class 25: Clothing; Tee-shirts; Hosiery; Polo shirts; Tops [clothing]; Trousers shorts; Sweaters; Cardigans; Pullovers; Shirts; Casual shirts; Trousers; Skirts; Denim jeans; Overcoats; Dresses; Coats; Raincoats; Pelerines; Waist belts; Shawls; Collar protectors; Cravats; Bathing suits; Lingerie; Headgear; Hats; Footwear.

The Second Earlier Mark:

International trade mark designating the EU, No. 1411337 NARCOS

Class 3: Nonmedicated toiletry preparations; shaving preparations; nonmedicated skin preparations.

Class 9: Downloadable computer games; virtual products to be sold or exchanged in mobile computer applications, online worlds, online games, and set top boxes; computer games; audio/visual recordings; decorative magnets; games for mobile phones and mobile computing devices; protective covers for mobile phones and computing devices; computer application software for mobile phones, tablets and other computing devices, namely, for games, emoji, virtual worlds, television programmes, and other entertainment.

Class 14: Key chains; watches; jewelry; jewelry being dog tags for wear by humans for decorative purposes; neck chains.

Class 16: Books in the field of entertainment; notebooks; stationery; stickers; posters; calendars.

Class 18: Backpacks; all-purpose carry bags; wallets; luggage tags; shoulder bags; sports bags; handbags; change purses; luggage; luggage crates; pouches sold empty.

Class 20: Cushions; pillows; wall plaques made of wood; picture cases; picture frames.

Class 21: Beverageware; shot glasses; water bottles sold empty; drinking steins; plastic coasters; travel mugs; decorative sand bottles and containers; fake books hollowed out for use as containers.

Class 25: Footwear; headwear; handwear, namely, gloves and mittens; neckwear; aprons; clothing, namely, shirts, dresses, t-shirts, tank tops, sweatshirts; pants, shorts,

loungewear, jackets, sleepwear, leggings, socks, tops, hooded shirts, undergarments; wrist bands; leather belts.

Class 28: Slot machines; online slot machines; playing card tinsets; puzzles; board games and accessories therefor; toy construction sets; collectible toy figures; playing cards.

Class 34: Cigars; cigarette lighters; cigar cutters; cigar boxes; cigar cases; butane torches for smoking articles.

Class 41: Providing online computer games; entertainment in the nature of art competitions; ongoing television programmes; production and distribution of television programmes; entertainment information.