

O-0252-23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3701083
BY BRITPRINT EVENT LIMITED
TO REGISTER AS A SERIES OF 3 MARKS



IN CLASSES 16, 35, 39, 40, 41 AND 42
AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 430222
BPI (BRITISH RECORDED MUSIC INDUSTRY) LIMITED

BACKGROUND AND PLEADINGS

1. BRITPRINT EVENT LTD (“**the Applicant**”) filed an application on 26 September 2021 to register the series of three figurative UK trade marks shown on the front page of this decision, in respect of a various goods and services in classes 16, 35, 39, 40, 41 and 42. Those applied-for goods and services are set out in full in **Annex 1** at the end of this decision.
2. The application was published for opposition purposes in the Trade Marks Journal on 15 October 2021 and is opposed by BPI (British Recorded Music Industry) Limited (“**the Opponent**”). The opposition is based on three grounds under the Trade Marks Act 1994 (“**the Act**”), namely, sections **5(2)(b)**, **5(3)** and **5(4)(a)**.
3. The statement of grounds begins with a claim based on passing off under **section 5(4)(a)** of the Act, which is directed against all of the goods and services under the application. The Opponent states that it owns a substantial goodwill and reputation under and by reference to the trade marks: “BRIT”; “BRITS”, “THE BRIT AWARDS” and “THE BRITS” (“**the Signs**”), in respect of the following :

*Entertainment; organisation, conduct, presentation and broadcast of events ceremonies and awards relating to music and the music industry; advertising, promotion and endorsement services; provision of downloadable and streamed music, music videos, programmes, entertainment and other content; photographs; videos; recordings; providing information, news and data relating to music and the music industry. (“**the Opponent’s business activities**”)*

4. The statement of grounds explains the basis of the above claimed goodwill and reputation: the Opponent is the trade body for the British record industry, and since the 1970s has “conducted the BRIT music awards scheme, also known as “the BRITS”, involves awards programmes and ceremonies which act as a showcase for established, current and emerging musical and related talent. The Opponent attracts substantial sponsorship and advertisers by reference to its BRIT Marks [*the Signs*] and receives substantial and continuous press comment and publicity.” The Signs are used “on signage, in advertising and informational materials for its products and services, on its websites, in its domain names, in its email addresses, in social media, on business papers and stationery, and in other ways customary to the business it operates.”

5. The Opponent claims that the UK public recognises the Signs as exclusively distinctive of the Opponent and the Opponent's business activities. The fields of business represented by the goods and services listed in the contested application are in some respects identical, closely similar or directly competitive with those in respect of which the Opponent has, over the years, developed its reputation, or else would include goods and services for use in connection with or linked to music and entertainment, which is the central field of activity of relevance to the Opponent under the Signs. It is consequently claimed that use of the applied-for trade marks would be a misrepresentation that they were and are connected with the Opponent, which would cause damage to the Opponent, its goodwill and its business.
6. Under the **section 5(2)(b) claim** only some of the applied-for goods and services are challenged. All three earlier registered marks set out in the table below are invoked against the applied-for goods and services in classes 16, 35 and 41, and the third earlier registered mark is invoked additionally against the applied-for services in class 42. The Opponent claims that those marks are similar to the applied-for marks, that goods and services under those registrations are identical or similar to those under the contested application, and that there will be a likelihood of confusion on the part of the average consumer.

Mark 1: "BRIT AWARDS"

Trade mark No: 911982551

Filing date: 15 July 2013

Registered on 10 December 2013 in respect of a long list of goods and services across 13 classes, of which the following are relied on in this opposition:

Class 9: *sound, audio, visual and audio-visual content and recordings; sound, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the internet and the world wide web.*

Class 16: *Printed matter.*

Class 35: *Advertising, promotion, publicity, marketing services and endorsement services;*

Class 41: *Entertainment; providing internet television and radio programmes; streaming of and providing of non-downloadable recordings; providing publications, online publications, web sites, databases, information, news and commentary, including in the fields of music, youth, entertainment, news, culture, fashion, style, people, film, art and photography; examining for and granting of qualifications and awards; organising and operating award schemes and ceremonies in the fields of music and entertainment;*

Mark 2: “THE BRITS”

Trade mark No: 911982535

Filing date: 15 July 2013

Registered on 10 December 2013

The goods and services relied on are exactly those in Classes 9, 16, 35 and 41 above, with the addition of:

Class 38: *Broadcasting; broadcast of music, of recorded music and of audio and audio-visual recordings; broadcast of television, radio and internet programmes*

Mark 3: “BRIT CERTIFIED - PLATINUM, GOLD & SILVER AWARDS”

Trade mark No. 917966323

Filing date: 8 October 2018

Registered on 1 July 2019

At paragraph 8 of its statement of grounds, the Opponent identifies that it relies on all of its goods and services registered in Classes 9, 16, 35 and 41, which are set out in full in **Annex 2** at the end of this decision.

7. The **section 5(3) claim** is directed against all of the applied-for goods and services (all six classes). The Opponent asserts a reputation based on the first two of the earlier registered marks set out in the table above. The claim is that use of the applied-for marks would create

in the minds of the relevant public a link with the Opponent and its Marks 1 and 2, such that consumer behaviour would be materially changed and the use would take unfair advantage of and/or be detrimental to the distinctive character and/or repute of the Opponent's earlier marks.

The Applicant's defence

8. The Applicant submitted a notice of defence, including a counterstatement denying the grounds.
9. The defence counterstatement emphatically asserts that the word BRIT is used as an abbreviation for "Briton" or "British" and that "giving protection to a widely and commonly used term "BRIT" would restrict competition and create language monopolies on words belonging to the public domain."
10. It states that "'Britprint" is a distinctive trade mark and its difference from "The Brits", "Brit Awards" and "Brit Certified" trade marks can easily be understood from the perspective of the eyes of the public. The "print" term is the dominant element of the Applicant's trade mark." It denied that the marks are similar, and denied a likelihood of confusion. It also denied that the parties' goods or services are identical or similar.
11. It denied any risk of a link being made between the parties' marks and denied that use of the Britprint trade mark would have any effect on the behaviour of consumers of the services in question.
12. The Applicant requested costs.

Hearing, representation and papers filed

13. An oral hearing took place before me by video conference on 13 December 2022. Ian Bartlett of Beck Greener LLP attended for the Opponent and Vahap Atalay attended on behalf of the Applicant. I understand Mr Atalay to be a legal professional, but the registry's case file lists the Applicant's representative as Mustafa Nafi Kaya. The latter is not a legal professional and does not purport to act in that capacity. Beyond his attendance at the hearing, the extent to which Mr Atalay provided assistance to the Applicant is unclear.

14. During the evidence rounds only the Opponent filed evidence, which I shall refer to where appropriate in this decision. Mr Bartlett filed a skeleton argument ahead of the hearing. Beyond the defence form and counterstatement, no papers were filed on behalf of the Applicant.

THE EVIDENCE

15. The Opponent's evidence comprised a witness statement of Kiaron Whitehead, who is director and the Secretary of the Opponent, and has been its General Counsel since 2008. He is also the Secretary of Brit Awards Limited ("BAL"). Mr Whitehead's evidence is supported by 19 exhibits. I note the following points:

16. BPI was established as a trade body in 1973 by the major record labels to represent the UK's music industry. BPI's business under its BRIT marks is conducted via BAL, which is a wholly owned subsidiary of BPI.

17. The BRIT awards were established by BPI in 1977 and have been held continuously since that date. The BRIT awards culminate in an annual ceremony at which the awards are presented in various categories for exceptional contribution to the UK's music industry.¹ The BRIT awards are one of biggest events in the UK's popular music calendar, broadcast live throughout the UK by ITV since 2007 and attracting Press and media coverage, including on BBC radio.² The 2019 ceremony, for example, attracted a TV audience of over four million viewers. For the February 2021 BRIT awards, the digital engagement included:³

- YouTube live stream – 1.7 million viewers;
- More than 800,000 views on Twitter, TikTok and YouTube of BRITs Red Carpet Live Show;
- 2 million Instagram "Likes" on the day of the 2021 event.

18. Website and social media figures have also been substantial:⁴

- BRITs website – 1 January to 31 August 2021 694,000 visitors;

1 Exhibit KW2 – extract from www.brits.co.uk website

2 Exhibits KW18 to KW19

3 Exhibit KW9

4 Exhibits KW11 to KW16

- BRITs YouTube channel – 1 January to 31 August 2021 – 25 million views;
- BRITs Facebook page – 1.4 million followers;
- BRITs Twitter account – 750,000 followers;
- BRITs Instagram page – 750,000 followers;
- BRITs TikTok page – 800,000 followers.

19. Annual Revenue from the BRIT awards has been between £10 - 12 million since 2016,⁵ derived from:

- broadcast and recording rights;
- advertising and sponsorship – where the lead sponsor is the financial payments company, Mastercard;
- revenue from tickets to the event, offered to record labels, sponsors and the general public (the 2020 event at the O2 Centre in London accommodated around 13,000 attendees).

20. The evidence contains various images from the awards event where the sign used is typically along the lines in the press in the form of the definitive article).⁶



of: . Marks 1 and 2 are used and reported “BRIT awards” and “BRITs” (with or without

THE STATUTORY PROVISIONS

21. Section 5(2)(b) of the Act is as follows:

“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”.

22. Section 5(3) states:

5 KW10 shows Companies House accounts return.
6 Eg. KW14, KW18 and KW19

“(3) A trade mark which-

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 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.”

23. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

24. Section 5(4)(a) of the Act provides that: "... a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented 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." Section 5(4) also states that "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'."

OUTCOME AND BASIS OF MY DECISION

25. Having set out the details of the opposition, indicated the evidence filed and set out the statutory provisions, I am content at this stage to give the outcome of this decision, which is that **the opposition fails on all ground and the Applicant's series of marks may therefore proceed to registration**. I reach this conclusion even having taken account of Mr Bartlett's assiduous submissions, which included an emphasis on comparing notional and fair use of the respective trade mark registrations/application. The main reason why I reject each of the grounds of opposition is that the respective marks/signs themselves are not similar enough to give rise to any of the conditions against which protection is provided by sections 5(2)(b), 5(3) and 5(4)(a) of the Act, particularly factoring in the very limited distinctiveness that I find should be accorded to the shared common component. I reject the grounds of opposition, notwithstanding that other factors are favourable to the Opponent, notably that some of the goods and services at issue are identical, that the BRIT awards are well known in the UK and that, at least in relation to some goods and services, the

Opponent's Signs and earlier marks (or some of them) benefit from enhanced distinctiveness, a reputation and goodwill. With this common thread in mind, the remainder of this decision addresses the grounds in more detail.

The section 5(2)(b) claims

26. Mr Bartlett's skeleton argument noted that an assessment under section 5(2)(b) is multi factorial and that the relevant factors derived from case law are well settled and well known. Nonetheless, for the information of the Applicant, it is worth recording here that determination of a section 5(2)(b) claim must be made in light of the following principles, which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.⁷ The principles are:

- (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;

⁷ 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 retained EU trade mark case law.

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The Opponent's earlier marks and their levels of distinctiveness

27. All three of the trade mark registrations relied on by the opponent have filing dates that pre-date the filing date of the Applicant's contested application. Each is therefore an "earlier trade mark" for the purposes of section 5(2)(b) as set out in my paragraph 21 above.⁸
28. Marks 1 and 2 (BRIT AWARDS and THE BRITS) had been registered for more than five years at the filing date of the Applicant's contested application and are therefore subject to the use conditions set out in section 6A of the Act. In its Form TM7 notice of opposition, the Opponent ticked the box to indicate that it had used marks one and two in respect of all the goods and services relied on under those earlier marks. The Applicant, in its Form TM8 notice of defence, ticked the box to indicate that it did not request proof of the Opponent's claimed use. Consequently, the Opponent is able to rely on all of those goods and services in classes 9, 16, 35, 38 and 41 for its section 5(2)(b) ground.
29. Mark 3 (BRIT CERTIFIED - PLATINUM, GOLD & SILVER AWARDS) had been registered less than five years at the filing date of the Applicant's contested application, so the use conditions in section 6A of the Act do not apply. Consequently, the Opponent is able to rely on Mark 3 in respect of all of the goods and services in Classes 9, 16, 35 and 41 set out in Annex 2.
30. It is in respect of Opponent's goods and services that I now consider the distinctive character of each of the Opponent's earlier trade marks.
31. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.⁹ However, as pointed out in relevant case law "*it is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.*"¹⁰
32. In *Lloyd Schuhfabrik*, the Court of Justice of the European Union ("CJEU") stated that:

8 Section 6 of the Act gives the meaning of an "earlier trade mark"

9 *Sabel* at [24]

10 *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis QC as the Appointed Person

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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)”.

33. Before I consider each of the earlier marks individually, I consider it useful to make a few initial observations with regard to the word element “BRIT”, which appears in all three of the earlier marks, and which is the component shared with the Applicant’s contested series of marks. At the hearing, Mr Bartlett built on submissions he made in his skeleton argument that bear on the distinctiveness of the Opponent’s mark. He addressed the Applicant’s defence statement that BRIT is commonly used in everyday language, in support of which the Applicant provides a reference from what it says is “Brewer’s Dictionary of Phrase and Fable” (which refers for example to Brit art). Mr Bartlett submitted that a word may be commonly used and yet inherently be highly distinctive as a trade mark, giving APPLE as an example. Mr Bartlett accepted that BRIT is sometimes used by people in other countries, particularly in the USA, to indicate a person of British descent or origin, but submitted that the word is not normally used to mean a product or a service, and in any event, there is no evidence to support that contention.

34. In my view, probably most people in the English-speaking world, and certainly in the UK, would understand the word BRIT, prima facie, as signifying someone or something from or

connected to Britain. It naturally and obviously may be seen as an abbreviation for Britons or British. It is a word therefore that has strong geographical connection, and one that is of particular relevance and immediacy for consumers and businesses in the UK. It is true that the word is not normally used to mean a product or a service, inasmuch as no consumer seeks to purchase “a Brit” nor to secure some “Brit services”. It does not directly describe or define any particular goods or services as such. However, while both “Brit” and “Apple” are commonplace and ordinary English words – not invented, inherently highly distinctive words - it seems to me that an average consumer in the UK (whether a member of the general public or a business) would not perceive those two words as equally distinctive.

35. I would accept that, even on an inherent basis, the ordinary word “Apple” may be considered to be distinctive at least to a medium degree for most any goods and services that are not concerned with or dealing in that form of round, green or red fruit. Thus, a trade mark “Apple” for a computer is, on an inherent basis, distinctive at least to a medium degree (and possibly higher than medium degree), since the word has no allusive reference to the nature or other characteristic of those computer goods, and there is no obvious reason why it would be used by more than one undertaking to distinguish their supply of those goods and services. However, in my view, that the word “Brit” may feature in more than one UK trade mark is entirely unsurprising and its presence is not enough “to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin”, which is the essential function of a trade mark.¹¹

Distinctive character of Mark 1

36. I turn to consider the distinctive character of BRIT AWARDS in respect of the goods and services relied on, which, broadly put, are:
- audio/visual content and recordings (including streamed) (Class 9);
 - Printed matter (Class 16);
 - promotional services (Class 35); and
 - providing entertainment programmes and publications including in the fields of music, news and culture (Class 41)

11 (Case C-40/01 *Ansul* [2003] ECR I-2439, paragraphs 35 and 36, and Case C-442/07 *Verein Radetzky-Orden* [2008] ECR I-0000, paragraph 13)

- and, also in Class 41, “*examining for and granting of qualifications and awards; organising and operating award schemes and ceremonies in the fields of music and entertainment*”

37. In my view, the words BRIT AWARDS on an inherent basis convey some formal recognition in respect of some field of activity connected to Britain. Thus, in respect, for example, of the last listed services in Class 41, concerning awards and ceremonies in the field of music, the trade mark in the UK is of limited distinctiveness on an inherent basis, since “AWARDS” is essentially descriptive for those services, and “BRIT” will be understood as referring to Britain and will carry the limited distinctiveness as I discussed in my earlier paragraphs in this part of my decision. For these services Mark 1 is, on an inherent basis, low in distinctive character.
38. In relation to the goods in Classes 9 and 16, the services in Class 35 and the programmes and publications services in Class 41, the relationship between “BRIT AWARDS” is more distant than it is with the Class 41 services concerning awards and ceremonies in the field of music that I considered in my previous paragraph. However, the two words – BRIT AWARDS – inter-relate with each other to form a unitary phrase of sorts, since the BRIT element tells a consumer something about the quality or nature of the AWARDS. As such, the words BRIT AWARDS are apt to tell the consumer something about the nature or subject matter of those goods and services in Classes 9, 16, 35 and 41. I find that in relation to those services, the unitary phrase BRIT AWARDS, comprised as it is of two commonplace words, and apt to be allusive to subject matter is, on an inherent basis, lowish in distinctive character (though not as low as in relation to the other Class 41 awards and ceremonies services).
39. The distinctive character of a trade mark may be enhanced through its use. The evidence filed readily establishes that the Brit Awards have operated for several decades, have long been televised and will have come to the attention of the UK general public (including interested businesses). The trade mark will be recognised as referring to a prominent annual official award process and event through which the music industry in the UK celebrates outstanding accomplishments, notably in the field of popular music (though the evidence also refers to the Classic BRIT awards, which are now held every other year).¹² The trade mark will have been seen on social media and websites, in newspaper coverage, on ITV,

12 Exhibit KW17

including on the backdrops against which winners and attendees at the awards event present themselves for photo-opportunities. The mark will have been heard on the radio, including the BBC, especially in the run up to and during the annual awards in February. The awards have a self-promotional aspect for the Opponent, since the BPI is the trade body for the British Recorded Music Industry. This, in my view, limits the extent to which the evidence can be said to show the mark being used in respect of *advertising, promotion, publicity, marketing services and endorsement services* since those Class 35 services are services for others, rather than promotion of one's own goods and services. On the other hand, the nominees for and winners of any BRIT award will each naturally benefit from the promotional and marketing effect of the awards and the associated ceremony. Moreover, the trade mark will also will have been seen alongside the Mastercard logo, where the endorsement has a mutual effect, notwithstanding that the sponsorship emanates from Mastercard.

40. The factors in the above account have undoubtedly led to a significant enhancement of the distinctiveness of Mark 1. The evidence is not especially granular, which limits the confidence with which this tribunal may gauge the enhancement in relation to each aspect of the specified goods and services relied on – for example there is not much evidence in relation to *printed matter* specified in Class 16, or *providing publications in the field of film and photography* in Class 41.
41. There is, however, very strong evidence in relation to the core concern of *organising and operating award schemes and ceremonies in the fields of music* in Class 41 and strong evidence too of the attention that principal activity draws on UK television, radio and social media. The evidence identifies a range of well-known people who have hosted the awards ceremonies, including Russell Brand, Ant and Dec and Jack Whitehall,¹³ such that the programming arising from award ceremony has an “entertainment” footprint beyond a pure music focus. The nature of a red-carpet event leads naturally to the content of publications extending peripherally to the fields of “*youth, entertainment, news, culture, fashion, style, people*” specified under the Class 41 services. There is also evidence of the involvement of artist Damien Hirst as the designer of the 2012 award statuette “following in the footsteps of Sir Peter Blake and Dame Vivienne Westwood.”

42. Taking the evidence in the round, I find that the distinctiveness of Mark 1 has been enhanced to some degree in respect of more or less all of the goods and services relied on and is highly distinctive insofar as those goods and services relate to music awards and ceremonies (and the related coverage).

Distinctive character of Mark 2

43. I turn to consider the distinctive character of Mark 2 - THE BRITS, used in respect of the goods and services relied on, which are the same as those under Mark 1, as I considered above, with the addition of the broadcasting services in Class 38. In respect of the latter broadcast services, the evidence indicates that broadcasting of and around the annual Brit awards is primarily through ITV, and some coverage on BBC radio, rather than by the Opponent itself. Nonetheless, Mr Whitehead states that the broadcast and recording rights are one of the main sources of income under the Opponent's trade marks, which are used by others under licence.

44. Mark 2 comprises simply the definite article "THE" and the plural of "BRIT", where that word, preceded by "the", presents as a noun rather than an adjective. On a purely inherent basis, the words "THE BRITS" convey the idea of the people of Britain. The connection or potential connection of those words to the goods and services is more nebulous than is the case with Mark 1, which carried the more formed phrasal message of an award process with a connection to Britain. In my view, the words THE BRITS may, on an inherent basis, be considered more distinctive therefore than Mark 1, but still fairly low in distinctiveness.

45. I must next consider whether the distinctiveness of Mark 2 has been enhanced through use. Mark 1 appears to be the fuller, more formal form of the Opponent's trade mark – it is, as I have noted, BRIT AWARDS, typically followed by the relevant year, that appears as the backdrop at the annual ceremonies. However, the evidence shows Mark 2 has been used more or less interchangeably with Mark 1, particularly by third parties. For instance, a Daily Mail headline from 2014 reads "Ellie Goulding crowned queen of the BRITS";¹⁴ and the BBC website is shown referring (in 2021) to "Backstage at the BRITS".¹⁵ The much-viewed "BRITS" YouTube channel,¹⁶ is shown at Exhibit KW12 to refer to "Best of the BRITs | The BRIT awards 2022". I note that the latter exhibit dates from after the filing date of the

14 Exhibit KW18

15 Exhibit KW7

16 883,000 subscribers in 2022

Applicant's contested series of marks, but it is in line with usage by third parties from before that relevant date, such as The Guardian headline "Brits 2019: who will – and should – win every award".¹⁷ In my view this use, notwithstanding that it is primarily by third parties, indicates that the UK general public (and interested businesses) would, in the context of awards in the field of music, recognise that Mark 2 "THE BRITS", is synonymous with Mark 1 "BRIT AWARDS". In as much as there may be audio-visual goods, printed matter, endorsement activity, and broadcasting derived from that annual music award ceremonies, I find that the distinctive character of Mark 2 may fairly be considered to have been enhanced through use, nearly comparably to Mark 1.

Distinctive character of Mark 3


46. I find that on an inherent basis, the words "BRIT CERTIFIED - PLATINUM, GOLD & SILVER AWARDS" are of low distinctive character in respect of the goods and services Classes 9, 16, 35 and 41 (as set out in Annex 2). This is because, as I have earlier discussed, the word "BRIT" is of low distinctive character and the remaining words will be understood as describing three different levels of recognition, which carries to the goods and services a highly allusive message in relation to their quality. The evidence shows no enhancement of Mark 3 through use.

Comparison of the marks

47. It is clear from *Sabel* 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 in *Bimbo* 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.*"

17 Exhibit KW19

48. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

<p>Opponent's earlier trade marks</p>	<p>Mark 1. BRIT AWARDS</p> <p>Mark 2. THE BRITS</p> <p>Mark 3: BRIT CERTIFIED - PLATINUM, GOLD & SILVER AWARDS</p>
<p>APPLICANT's contested trade mark series</p>	

49. I consider the strongest case in terms of similarity of marks is the Opponent's Mark 1. I take this view because Mark 1 is comprised of two words ("BRIT AWARDS"), which matches the number of words that form the dominant verbal elements of the contested series ("BRIT PRINT"), and Mark 1 commences with the same first word element as the series marks ("BRIT"). Mark 2, in contrast, starts with "THE" and is followed the plural word "BRITS"; and whilst Mark 3 also starts with the same first word element as the series marks ("BRIT"), the words that follow it – "CERTIFIED - PLATINUM, GOLD & SILVER AWARDS" obviously lower its similarity.

50. Moreover, though I must consider the challenge to all three marks in the Applicant's series, I find the black and white version to offer the strongest seam of similarity. This is because the verbal content of all three marks in the series is identical, and whether the three words "EVENT EXPERIENCE MEDIA" are positioned below or to the right of the dominant verbal elements of the contested series ("BRIT PRINT") makes no difference to the level of similarity. Those things being equal, I consider the third mark in the series marginally more similar to the earlier marks simply because it is presented in black and white, which eliminates, in particular, the difference that arises from the tri-colour effect (red, white and blue) present in the BP device. (Registration in black and white covers use of the logo in any colours, provided they respect the contrast of dark/light tones depicted in the black and white mark,¹⁸ and likewise, the protection afforded to the notional use of the Opponent's word-only marks extends to any colour.)
51. I will therefore focus my analysis on the black and white mark in the series, since this offers the Opponent its strongest basis of similarity, but most of my findings will also apply to the first two marks in the series, and I shall also comment on those where warranted.
52. The overall impression of the Opponent's earlier marks comes from the words themselves, which I have considered previously in this decision when addressing distinctive character.
53. The overall impression of the marks in the applied-for series is that they comprise three elements. The first is "BRIT PRINT", which two-word phrase is lowish in distinctive character for some of the goods and services, but not devoid of distinctive character. That element is set alongside a sizeable device element. The device and the two-word phrase are more or less equally dominant, though again the distinctive character of the device is limited since its shapes are simple and essentially represent the letters BP, reflecting the initials of the dominant word element, and even the tri-colour versions tend only to echo the colours of the British flag. Nonetheless, the device contributes to the distinctiveness of the mark overall. The third element in the mark comprises the three words "EVENT EXPERIENCE MEDIA", which are significantly smaller than the dominant element and are of little or no distinctiveness since the three words are likely to be taken as a broad characterisation of goods

18 The Court of Appeal has stated on two occasions following the CJEU's judgment in C-252/12 *Specsavers*, that registration of a trade mark in black and white covers use of the mark in colour (see paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47).

or services. Nonetheless, those words are not negligible and contribute something to the overall impression of the marks in the series.

Visual comparison

54. The only point of overlap between the marks themselves is the word “BRIT” (which I have found to be low in distinctive character). Even in respect of Mark 1, which may be considered the earlier mark most similar to the opposed series, the marks contain significant visual differences, notably the different second words (AWARDS and PRINT), which in no way resemble one another, but also the absence from the earlier marks of the BP device and three-word element found in series marks. I find there to be a low degree of visual similarity in respect of Mark 1. In line with my comments above, I find a lower degree of visual similarity for Mark 2, and a very, very low degree for Mark 3. The coloured versions of the series marks, especially the red, white and blue of the device, heighten the visual difference for those marks in the series.

Aural comparison

55. The device element in the series will not be voiced, nor do I consider it likely that “EVENT EXPERIENCE MEDIA” will be. In my view the marks in the opposed series will be spoken as “BRIT PRINT”. Mark 1 shares the identical first word, but then differs in the second word “awards”, two syllables entirely unlike the single-syllable word PRINT. Furthermore, “BRIT PRINT” contains an internal near-rhyme, whereas the earlier marks do not. I find there to be lower than medium degree of aural similarity based on Mark 1. I find a lower degree for Mark 2, and still lower aural similarity for Mark 3.

Conceptual comparison

56. The respective marks both reference the concept Britain or British, through the shared word BRIT (or “BRITS” in the case of Mark 2). (The red white and blue applied to the BP device reinforces that concept of Britishness.) However, the respective marks differ in concept by virtue of the other words present in the earlier marks and the word “PRINT” which forms the second half of the dominant verbal element of the marks in the series. The P component of the device may reinforce the conceptual difference, since if perceived, it will be seen as the initial letter of PRINT. The earlier marks contain no concept of PRINT, and Marks 1 and 3

contain the different concept of “AWARDS”. The marks may be considered conceptually similar to a low degree (at most).

Comparison of the goods and services

57. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)* the European Court ruled that goods can be considered as identical when the goods designated by the trade mark application the earlier mark are included in a more general category designated by the earlier mark or vice versa.¹⁹ This inclusion principle also applies in relation to services.
58. Section 60A of the Act states goods and services are not to be regarded as being similar to each other simply because they appear in the same class, nor are they to be regarded as being dissimilar from each other on the ground that they appear in different classes.
59. It is settled case law that assessing whether goods and services at issue are similar must be on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary.²⁰ Goods and services are complementary when “... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”²¹
60. In construing the meaning of terms, I keep in mind the guidance from case law that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise, but that “where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”²²
61. I also note following summary by Arnold LJ of the correct approach to interpreting broad and/or vague terms:

19 See paragraph 29 of the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05

20 see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]

21 *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

22 See paragraph 12 Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch)

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”²³

62. The goods and services to be compared are:

The contested goods and services under Mark 1 and Mark 2	
Class 16	– All goods claimed in that class (see Annex 1 at the end of this decision).
Class 35	– All services claimed in that class (see Annex 1).
Class 41	– All services claimed in that class (see Annex 1)
Opponent’s goods and services relied on under Mark 1	
Class 9:	<i>sound, audio, visual and audio-visual content and recordings; sound, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the internet and the world wide web.</i>
Class 16:	<i>Printed matter.</i>

23 Paragraph 56 of *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch)

Class 35: *Advertising, promotion, publicity, marketing services and endorsement services;*

Class 41: *Entertainment; providing internet television and radio programmes; streaming of and providing of non-downloadable recordings; providing publications, online publications, web sites, databases, information, news and commentary, including in the fields of music, youth, entertainment, news, culture, fashion, style, people, film, art and photography; examining for and granting of qualifications and awards; organising and operating award schemes and ceremonies in the fields of music and entertainment;*

Opponent's goods and services relied on under Mark 2

The goods and services relied on under Mark 2 exactly mirror those in Classes 9, 16, 35 and 41 above, with the addition of:

Class 38: *Broadcasting; broadcast of music, of recorded music and of audio and audio-visual recordings; broadcast of television, radio and internet programmes*

The goods and services contested based on Mark 3

Mark 3 is again invoked against all goods and services claimed in Classes 16, 35 and 41 (see **Annex 1**) and is additionally invoked against the applied-for services in Class 42.

Opponent's goods and services relied on under Mark 3

The Opponent relies for its section 5(2)(b) claim on all of its goods and services registered in Classes 9, 16, 35 and 41 (see **Annex 2** at the end of this decision).

63. The Opponent claimed that all of the products and services of the Application at which the opposition is directed under section 5(2)(b), are either identical or similar to at least some of

the asserted goods and services of Opponent's three earlier trade mark registrations. Although the Applicant's counterstatement contained a denial that the parties' goods or services are identical or similar, this was not a point pursued at the hearing Mr Atalay.

64. I reproduce below from Mr Bartlett's skeleton argument his submissions in support of that position.

"Taking the goods and services of the application in class order:

Class 16

The class 16 goods claimed in Brit Print's application are expressly "printed matter" (eg "prints; printed programmes) or are goods which would include "printed matter" (eg "plastic bags for packaging" which would include such bags which had been printed). The class 16 goods of the Application are therefore identical with the asserted class 16 goods of BPI's registrations each of which specifically claim "printed matter". (The asserted class 16 goods of BPI's '323 registration for the mark BRIT CERTIFIED cover a broader range including for instance wrapping and packaging materials, plastic bags, publications etc. which again are either identical or similar to all the class 16 goods of Brit Print's application."

65. I accept that most of the goods in Class 16 may be considered identical on the basis of the inclusion principle from *Meric* – for instance the Applicant's "souvenir event programs" and "Printed event admission tickets" fall within the Opponent's specification of "printed matter" under Marks 1 and 2; and the Opponent's "wrapping and packaging materials" under Mark 3 covers the Applicant's "Air bubble plastics for packaging;". If any of the goods are less than identical, they are at least similar, based on the relevant factors such as nature, purpose, user and channels of trade. Mr Bartlett's submissions continued:

"Class 35

The class 35 services claimed in the Application open with the term "retail services relating to printed matter". "Retail services" includes and is a form of advertising and promotion and therefore is identical to the asserted class 35 services of each of BPI's registrations. This term is also similar to the class 16 goods of BPI's registrations, discussed above, which include "printed matter"."

66. I do not accept that the Applicant's "*retail services in relation to printed matter*" are identical to the Opponent's Class 35 marketing and advertising services. Having regard to the guidance from *Sky v Skykick*, that terms in specifications of services should be given only the core of the possible meanings of the words used, I consider that advertising and marketing services cover commercial services provided to others, usually for remuneration, to advertise/market their goods/services. These services appear to be fundamentally different in nature, purpose, etc. to those provided by a retailer, which are directed at encouraging consumers to buy goods/services from them rather than from another retailer of those goods/services. I do, however, accept that there is a degree of similarity between the Applicant's "*retail services in relation to printed matter*" and the Opponent's Class 16 goods "*printed matter*" based on shared user and channels of trade. Moreover, I also note that Mark 3 includes "*Retail services connected with the sale of ... printed matter*". The services are identical.

67. Mr Bartlett's skeleton argument continued:

"The class 35 services of the Application proceeds to recite a long list of various kinds of advertising and promotion services all of which are therefore identical to the class 35 services covered by each BPI's registrations, until one is met with the term "retail services relating to jewellery". Again "retailing" includes advertising and promotion and is therefore identical to the asserted class 35 services of BPI's registrations."

68. I do not accept the latter submission that "*retailing includes advertising and promotion and is therefore identical*", but I do accept that the Applicant's long list of various kinds of advertising and promotion services specified in Class 35 are either identical or similar to the Opponent's advertising, promotion and marketing services in 35 services.

69. I reject that argument for similarity under Mark 1 and 2, but as Mr Bartlett also pointed out, the many services specified under Mark 3 include: "*Retail services connected with the sale of jewellery*", which are identical services.

70. Mr Bartlett's skeleton argument continued:

"There then follows two claims to "arranging subscriptions for...". Again, these terms are, or would be part of an advertising and promotion service and again are identical to the asserted class 35 goods in each case of BPI's three registrations."

71. The two specified terms that Mr Bartlett is referring to are: “*Arranging subscriptions to media packages;*” and “*Arranging subscriptions to information media*”. It seems to me that these services may be understood as services that link a business to media outlets or platforms that may promote that business. I therefore accept that they are similar to the Opponent’s *Class 35 Advertising, promotion, publicity, marketing services*.

72. Mr Bartlett’s skeleton argument continued:

“Brit Print’s class 35 services then pick up again with claims to various kinds of promotion services, including terms in the form “presentation of ...”. “Presentation” in this context means for advertising and promotion and again these terms fall squarely within the asserted class 35 services of each of BPI’s registrations.”

73. I accept that those terms, such as, “Presentation of goods on communications media, for retail purposes” are at least similar to the Opponent’s promotional and advertising services.

74. Mr Bartlett’s skeleton argument continued:

“The class 35 services of the Application finish with a claim to “retail services in relation to computer software”. That again includes advertising and promotion of the software in question and so once more is identical to the asserted class 35 services of BPI’s registrations.”

75. I reject that argument for similarity, but again as Mr Bartlett pointed out in his skeleton argument, the many services specified under Mark 3 include: “retailing of software” which are identical services.

Class 41

76. The long list of the Applicant’s services in Class 41 includes services such as “*Arranging of musical events; Production of live entertainment events; Dance events; Organising sporting events; Ticket reservation and booking services for entertainment events.*” Mr Bartlett submitted as follows:

“The class 41 services of the Application open with claims to the organization and other services connected with various kinds of events. Those events either expressly or would

implicitly include entertainment events and are therefore identical to the asserted “entertainment” services in each of BPI’s registrations.

The potential exception to the above, are the claims in the Application to “organization and arranging of educational events”. However, that does not preclude such events from being entertainment at the same time as being educational. In any case, such services are similar to “examining for and granting of qualifications and awards;” as listed in the asserted class 41 services of the BPI’s registrations (and which would therefore include educational qualifications and awards.)”

77. I accept that the Opponent’s Class 41 services are identical or similar to the Applicant’s Class 41 services.

Class 42

78. The applied-for services in Class 42 are opposed under section 5(2)(b) only on the basis of Mark 3. Mr Bartlett’s skeleton argument addressed the similarity as follows:

“The Class 42 services of Brit Print’s application can be broken down into the following main categories:

Packaging design services

Such services are similar and complementary to advertising and marketing services which frequently including branding and design services.

They are also similar to the class 16 packaging listed in BPI’s ‘323 registration.

Software services:

Such services are similar to the software and other computing goods covered by BPI’s ‘323 registration in class 9.

Social media research:

Social media is used by businesses to target their markets and to maximize the impact of social media. Such services are therefore highly similar to the class 35 services asserted

by BPI. (They are also similar, if not identical to the market research services covered by BPI's '323 registration)."

Electronic storage and conversion services including those relating to entertainment and media:

These services are similar to the entertainment and streaming services listed in class 41 of BPI's registrations. They are also highly similar to the class 9 goods of BPI's '323 registration as well as to the database services (compilation of databases) listed in that '323 registration in class 35."

79. I am prepared to accept that the Applicant's Class 42 services have some low degree of similarity with the specification under Mark 3.

The average consumer and the purchasing process

80. In *Hearst Holdings Inc*,²⁴ Birss J. explained that "... 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 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 word "average" denotes that the person is typical ...".
81. The average consumer of the goods and services at issue will variously include businesses and members of the general public.
82. For instance, the *packaging design* services in Class 42 will be sought out by businesses, whereas *Electronic storage of entertainment media content* is a service that may be of interest both to businesses and to members of the general public.
83. The entertainment services in Class 41 such as *Production of live entertainment events* and *Ticket reservation and booking services for entertainment events* may be sought out by businesses or local authorities, but the end-user of the services will include the general public seeking to attend the various entertainment events.

²⁴ *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), at paragraph 60.

84. The average consumer of the printed matter and packaging goods in Class 16 will include both businesses and members of the general public, who may equally have an interest in buying, for instance, *Planners [printed matter]; Diaries [printed matter]; Digital printing paper; Air bubble plastics for packaging*; whereas some of the goods are more clearly directed to businesses such as *Industrial packaging containers of paper; Advertising signs of cardboard*.
85. The level of attention paid by the average consumer will vary between the goods and services: for instance a fairly low degree of attention will attach to the purchase of *Digital printing paper in Class 16*; but a business may be expected to pay a fairly high degree of attention in securing the services of, for example, *Cinematographic film advertising in Class 35* or *Organisation of automobile racing events in Class 41*.
86. The goods may be bought from a physical shop or online from a website. The services typically be accessed via the internet, though a consumer may also visit business premises. The consumer will see the marks used as branding in advertising for the goods and services. Therefore, visual considerations are important, but I also take into account the aural impact of the marks in the assessment, since word-of-mouth recommendations may also play a part in the purchasing process.

Conclusion as to likelihood of confusion

87. I turn now to make a global assessment of likelihood of confusion if the parties' marks were used concurrently in respect of their respective goods and services. This assessment takes account of my findings set out in the foregoing sections of this decision and of all of the various principles from case law outlined in my paragraph 26 above.
88. It requires a realistic appraisal of the net effect of the similarities and differences between the marks and the goods and services in issue, giving the similarities and differences as much or as little significance as the relevant average consumer would attach to them, noting that such a consumer is taken to be reasonably well-informed and reasonably observant and circumspect. The average consumer is a hypothetical person - a legal construct - created to strike the right balance between the various competing interests including, on the

one hand, the need to protect consumers and, on the other hand, the promotion of free trade in an openly competitive market.²⁵

89. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods and services down to the responsible undertakings being the same or related.
90. The assessment of likelihood of confusion involves factoring in the potential for a greater degree of similarity (or identity) to offset a lesser degree of similarity between the marks. The strongest factor weighing in favour of the Opponent's claim is that many of the respective goods and services are identical and others may be considered similar. Another favourable factor is that the average consumer will exercise various degrees of attention in purchasing the goods and services which in some instances may be fairly low. I have also found that the distinctiveness of Mark 1 (and Mark 2) has been enhanced to some degree in respect of more or less all of the goods and services relied on and is highly distinctive insofar as those goods and services relate to music awards and ceremonies (and the related coverage). A trade mark's distinctiveness is intimately tied to the scope of the protection to which it is entitled.²⁶ However, I find firstly that the average consumer will consider Mark 1 and 2 to be distinctive of the goods and services essentially primarily in the context of its source – which is the UK music industry awards – and secondly that the distinctiveness of Mark 1 and 2 sits within those marks as registered – BRIT AWARDS and THE BRITS. I have addressed in this decision the limited distinctiveness of the word “BRIT”, which is the only shared element of the marks.
91. The great differences between the parties' marks rule out the possibility of the average consumer mistaking one for the other. Even on what I consider the most similar of the earlier marks – Mark 1 “BRIT AWARDS” – there is no possibility of a consumer directly mistaking that mark for BRIT PRINT as presented in the Applicant's series of marks. Mark 1 has only a low degree of visual similarity, lower than medium aural similarity and has conceptual differences; Mark 2 is less similar and Mark 3 still less so. Even allowing for the imperfection

25 *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ, particularly paragraph 34.

26 *Comic Enterprises* (above)

of the picture of the marks kept in mind by the average consumer, there will be no direct confusion.

92. Indirect confusion (and its distinction from direct confusion), was considered by Iain Purvis KC, sitting as the Appointed Person,²⁷ in *L.A. Sugar Limited v By Back Beat Inc*,²⁸ 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 recognised 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case)*

- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).*

27 An Appointed Person is a senior lawyer, expert in intellectual property law, who hears appeals against decisions of the trade mark tribunal.

28 Case BL-O/375/10

(c) *where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).*²⁹

93. Sitting as the Appointed Person in *Eden Chocolat*,³⁰ James Mellor KC stated as follows:

“81.4 ... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

94. It is also clear that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion” and that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.³¹

95. In the present case, the shared element “BRIT” is insufficiently distinctive to lead the average consumer, encountering that common element in the context of the Applicant’s series of marks as a whole, to conclude that it is another brand of the Opponent, even where the goods or services may be identical. I find there is no likelihood of indirect confusion.

The section 5(3) claims

96. This ground is directed against all of the applied-for goods and services. The statutory provision is set out at my paragraph 22 above. The Opponent relies on a reputation based on Mark 1 and Mark 2.

97. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel Corporation*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v*

29 The example categories listed by Mr Purvis of where indirect confusion may arise are not intended to be exhaustive.

30 Case BL O-547-17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017).

31 *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC, as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16).

Bellure, Case C-487/07 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact 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*).
98. The function and value of a trade mark are not confined to its being an indicator of origin of goods or services (which section 5(2)(b) safeguards); a trade mark can also convey messages, such as a promise or reassurance of quality or a certain image of, for example, lifestyle or exclusivity (‘advertising function’).³² Section 5(3) aims at protecting this advertising function and the investment made in creating a certain brand image by granting protection to reputed trade marks, irrespective of the similarity of the goods or services or of a likelihood of confusion, provided that it can be demonstrated that the use of the contested application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.
99. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I “*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.*” I also note that the counterstatement filed by the Applicant contained no denial of the reputation, though even in that absence I would need to assess the strength of the

32 (judgment of 18/06/2009, C-487/07, L’Oréal, EU:C:2009:378)

claimed reputation. I have previously found that the distinctiveness of Marks 1 and 2 has, through use, been enhanced to some degree in respect of their goods and services relied on in Classes 9, 16, 35, 38 and 41. While the Brit Awards (or the Brits) may be considered a well-known annual event in the UK, I have also emphasised that Marks 1 and 2 are highly distinctive only insofar as they are used in respect of goods and services relate to music awards and ceremonies (and the related coverage). I similarly find that Marks 1 and 2 may be considered to enjoy a reputation insofar as they are used in respect of goods and services relate to music awards and ceremonies (and the related coverage). It is the award process that is the basis of the reputation.

Link

100. I next proceed to make a global assessment as to whether or not, a significant part of the relevant public would make a link between Mark 1 and 2 and the Applicant's series of marks, taking account all relevant factors as required by Intel, as per my paragraph 97(c) and (d) above, 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 marks' reputation and distinctiveness for the goods and services registered.
101. I accept Mr Bartlett's submission that "BRIT AWARDS" and "THE BRITS" have for several decades been well-known trade marks in the UK and are "factually distinctive of the entertainment services provided via the awards and the award ceremony and the [considerable] publicity it generates." I have found above that Mark 1 and 2 benefit from a reputation in that context.
102. I also note Mr Bartlett's point that "there is no relevant limitation in the specifications of the goods and services of the Application and virtually all would include goods and services for use in connection with, or linked to music and entertainment. The goods and services in question are aligned therefore." I have also found the goods and services either identical or similar on some basis.
103. I further note Mr Bartlett's point that "there is no evidence of any third-party use of "BRIT(S) marks in the UK whether in the form THE BRITS, the BRIT AWARDS or otherwise." Mr Bartlett put forward this latter point to advance an argument based on the "uniqueness" of the earlier marks.

104. However, notwithstanding the points in the above paragraphs, I conclude that the relevant public will make no mental link between the parties' respective trade marks. This is because the similarity of the marks, which I considered under the section 5(2)(b) ground, is not sufficient to provoke that mental link, especially taking account of my finding that the common word "BRIT" of itself is low in distinctiveness, being an abbreviated form of "British" and apt naturally to feature in more than one UK trade mark. In this case, the marks in the Applicant's series suggest 'British printing'.
105. Since I find that no link will arise, the section 5(3) claims fail. In the circumstances it is not necessary for me to consider the claimed bases of damage.

The section 5(4)(a) claim

106. This ground is directed against all of the applied-for goods and services. The statutory provision is set out at my paragraph 22 above. The Opponent relies on the Signs: "BRIT"; "BRITS", "THE BRIT AWARDS" and "THE BRITS", claiming goodwill in respect of the Opponent's business activities as follows: *Entertainment; organisation, conduct, presentation and broadcast of events ceremonies and awards relating to music and the music industry; advertising, promotion and endorsement services; provision of downloadable and streamed music, music videos, programmes, entertainment and other content; photographs; videos; recordings; providing information, news and data relating to music and the music industry.*
107. The onus is on the Opponent to satisfy the Tribunal that its unregistered signs would have been protectable by virtue of the law of passing off at the date of filing the application, 26 September 2021 ("**the relevant date**").
108. *Requirements for passing off:* The criteria for a passing off claim have been well established through UK case law. As set out in the decision by the House of Lords in *Reckitt & Colman Ltd v Borden Inc*³³, the following three points must be established in order to claim passing off successfully:
- (a) First, the plaintiff must establish a **goodwill** or reputation attached to the goods or services which it supplies in the mind of the purchasing public by association with the

³³ [1990] 1 All E.R. 873

identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which its particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiffs goods or services.

- (b) Second, the plaintiff must demonstrate a **misrepresentation** by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are the goods or services of the plaintiff.
- (c) Third, the plaintiff must demonstrate that it suffers or that it is likely to suffer **damage** by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

Goodwill

- 109. The first element described in *Reckitt & Colman* refers to “goodwill or reputation”, although case law has developed so as to distinguish between goodwill and “mere reputation” – the latter being insufficient alone to sustain a claim of passing off. To satisfy the first element of the tort, the Opponent is required to show that it has goodwill among UK consumers.
- 110. I accept that the Opponent’s business activities have generated goodwill based on the music awards. The evidence indicates that the Opponent’s business activities have been carried on by reference to BRIT AWARDS followed by the relevant year - for instance BRIT AWARDS 2019. I accept the Opponent’s business activities have generated goodwill distinctive of the Opponent under the signs “THE BRIT AWARDS” and “THE BRITS”. I would also accept that “BRITS” too may be a sign distinctive of the Opponent’s business activities.
- 111. While I of course acknowledge that a successful nominee for, say, the Brit Award for Album of the Year, may be referred to as “Brit nominee” or “Brit winner” or “winner of a BRIT”, I do not accept that the goodwill operates to protect “BRIT” solus except in circumstances where it clearly substitutes for the fuller expression “BRIT AWARD”. In reaching this conclusion I do not overlook that the evidence contains some references to BRIT – as in BRIT SCHOOL and BRIT TRUST - on the 2018 website of the Opponent.³⁴ However this evidence is

34 For instance Exhibit KW17.

insufficient to show goodwill for BRIT in respect of the Opponent's business activities. At any rate, I do not accept that the goodwill operates to protect against use of BRIT with PRINT and the elements in the Applicant's series of mark.

Misrepresentation

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

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

113. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

114. Having rejected a likelihood of confusion under section 5(2)(b), there is in my view no factor in the present case that would lead me to reach a different conclusion on misrepresentation.

COSTS

115. In its letter of 8 November 2022, the registry informed the Applicant as follows:

What to do if you intend to request costs

If you intend to make a request for an award of costs you must complete and return the attached pro-forma by **14.00, 2 working days** before the hearing. **That is on or before Friday 09 December 2022** and copied to the other side. Please send these by e-mail to tribunalhearings@ipo.gov.uk.

If the proforma is not completed and returned, no costs, other than official fees arising from the action (excluding extensions of time), will be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.

116. The Applicant has filed no such proforma and in the circumstances I make no reward for costs in these proceedings.

Dated this 7th day of March 2023

Matthew Williams

For the Registrar

Annex 1
Goods and services applied for

Class 16

Prints; Printed programmes; Printed music; Printed matter; Printed periodicals; Forms, printed; Printed forms; Photographic prints; Printing paper; Printing papers; Printed questionnaires; Printed brochures; Printed stationery; Giclee prints; Printed publications; Publications (Printed -); Art prints; Print wheels; Printed timetables; Printing sets; Printed newsletters; Printed invitations; Photographs [printed]; Photo prints; Printed curricula; Printed lessons; Printed vouchers; Printed tables; Printed booklets; Printed cards; Printed menus; Prints [engravings]; Engravings [prints]; Printing blocks; Print blocks; Lithographic prints; Printed charts; Printed tickets; Printed awards; Printed certificates; Printed coupons; Printed books; Printed horoscopes; Printed photographs; Print letters; Printing characters; Printed visuals; Printed emblems; Cartoon prints; Printed diagrams; Printed plans; Printed leaflets; Printed pamphlets; Printed diplomas; Printed patterns; Printed guides; Printed calendars; Timetables (Printed -); Printed reports; Printed advertisements; Printed flyers; Printing type; Printing fonts; Print characters; Graphic prints; Pictorial prints; Printed lectures; Color prints; Printed manuals; Canvas prints; Printed art reproductions; Portable printing sets; Planners [printed matter]; Diaries [printed matter]; Digital printing paper; Printed cartoon strips; Printed comic strips; Printed training materials; Printed seminar notes; Printed answer sheets; Printed flip charts; Annuals [printed publications]; Printed promotional material; Advertising pamphlets; Advertising posters; Advertising publications; Advertisement boards of paper; Advertising signs of cardboard; Advertisement boards of card; Advertisement boards of cardboard; Packaging materials; Gift packaging; Cardboard packaging; Adhesive packaging tapes; Packaging cartons of cardboard; Airtight packaging of cardboard; Paper pouches for packaging; Packaging cartons of card; Bubble packs for packaging; Plastic material for packaging; Paper bags for packaging; Plastic films for packaging; Plastic sheets for packaging; Packaging boxes of paper; Blister packs for packaging; Packaging bags of paper; Plastic bags for packaging; Bows for decorating packaging; Plastic foil for packaging; Packaging boxes of cardboard; Packaging boxes of card;

Packaging containers of paper; Plastic materials for packaging; Packaging wrappers of plastic; Packaging containers of card; Lining papers for packaging; Airtight packaging of paper; Plastic film for packaging; Paper envelopes for packaging; Industrial packaging containers of paper; Waterproofing film (Plastic -) for packaging; Printed packaging materials of paper; Packaging material made of starches; Foils of plastic for packaging; Plastic bags for packaging ice; Cartons of card for packaging; Containers of card for packaging; Packaging materials made of cardboard; Starches (Packaging material made of -); Cling film plastics for packaging; Containers of cardboard for packaging; Adhesive plastic film for packaging; Cartons of cardboard for packaging; Containers of paper for packaging; Paperboard boxes [for industrial packaging]; Paperboard boxes for industrial packaging; Air bubble plastics for packaging; Paperboard trays for packaging food; Packaging containers of regenerated cellulose; Cellulose acetate film for packaging; Plastic film roll stock for packaging; String dispensers for use in packaging; Bags incorporating bubble plastics for packaging; Packaging materials made of recycled paper; Event albums; Events programmes; Events albums; Event programs; Souvenir event programs; Printed event admission tickets; Decoration and art materials and media.

Class 35

Retail services in relation to printed matter; Advertising; Advertising and advertisement services; Online advertising; Radio advertising; Cinema advertising; Advertising agencies; Online advertisements; Newspaper advertising; Television advertising; Advertising analysis; Classified advertising; Elevator advertising; Banner advertising; Advertising planning; Advertising consultation; Advertising research; Advertising copywriting; Response advertising; Advertising services; Recruitment advertising; Magazine advertising; Outdoor advertising; Advertising and marketing; Electronic billboard advertising; Cinematographic film advertising; Promotional advertising services; Press advertising services; Providing advertising services; Online advertising services; Direct mail advertising; Mail-order advertising; Direct market advertising; Political advertising services; Providing advertising space; Creating advertising material; Mediation of advertising; Personnel recruitment advertising; Arrangement of advertising; Advertising of cinemas; Dissemination of advertisements; Advertisement hoarding

rental; Rental of advertisement space and advertising material; Press advertising consultancy; Advertisements (Preparing of -); Updating advertising material; Graphic advertising services; Advertising agency services; Publicity and advertising; Taxi top advertising; Preparation of advertisements; Advertising flyer distribution; Advertisements (Placing of -); Advertising and publicity; Compilation of advertisements; On-line advertising; Classified advertising services; Digital advertising services; Advertising research services; Advertising for others; Provision of advertising space; Advertising and marketing consultancy; Production of advertising matter; Production of radio advertisements; Promotional and advertising services; Distribution of advertising leaflets; Hire of advertising equipment; Advertising and publicity services; Promotion [advertising] of travel; Preparation of advertising material; Advertising via the Internet; Rental of advertising space; Consultancy relating to advertising; Consultations relating to advertising; Pay per click advertising; Scriptwriting for advertising purposes; Distribution of advertising samples; Distribution of advertising materials; Hire of advertising billboards; Hire of advertising hoardings; Advertisement billboards (Rental of -); Production of advertising material; Reproduction of advertising material; Advertising services for architects; Promotion [advertising] of business; Publication of advertising texts; Updating of advertising material; Hire of advertising aids; Rental of advertising matter; Direct mail advertising services; Preparation of advertising matter; Radio advertising and commercials; Preparation of advertising campaigns; Distribution of advertising material; Advertising matter (Dissemination of -); Design of advertising logos; Rental of advertisement hoardings; Advertising, including on-line advertising on a computer network; Advertising services of a radio and television advertising agency; Rental of advertising space on the Internet for employment advertising; Advertising services provided by a radio and television advertising agency; Production of advertising materials; Advertising and promotion services; Provision of advertising information; Advertising material (Updating of -); Publication of advertising literature; Distribution of advertising announcements; Radio and television advertising; Planning services for advertising; Rental of advertising material; Hiring of advertising materials; Promotion [advertising] of concerts; Market research for advertising; Production of advertising films; Advertising space (Rental of -); Negotiation of advertising contracts; Displaying advertisements for others; Dissemination of advertising matter; Advertising material (Dissemination of -); Design of advertising brochures; Leasing of advertising billboards;

Development of advertising concepts; Publication of advertising matter; Advertising and marketing services; Preparing advertisements for others; Advertising matter (Production of -); Retail services relating to jewelry; Arranging subscriptions to information packages; Arranging subscriptions to media packages; Event marketing; Promotion of special events; Marketing services relating to esports events; Arranging and conducting of marketing events; Arranging and conducting of promotional events; Advertising services relating to esports events; Promotion of sports competitions and events; Arranging and conducting of advertising events; Promotion services relating to esports events; Arranging promotion of charitable fundraising events; Arranging and conducting sales events for livestock; Arranging and conducting sales events for cattle; Organisation of events for commercial and advertising purposes; Arranging and conducting marketing promotional events for others; Media relations services; Media buying services; Arranging subscriptions to information media; Sales promotion using audiovisual media; Subscription to an information media package; Promotional marketing services using audiovisual media; Organisation of promotions using audiovisual media; Rental of advertising time on communication media; Provision of advertising space on electronic media; Organisation of promotions using audio-visual media; Market research services relating to broadcast media; Provision of advertising space, time and media; Advertising via electronic media and specifically the internet; Presentation of goods on communication media, for retail purposes; Provision and rental of advertising space, time and media; Retail purposes (Presentation of goods on communication media, for -); Providing business information in the field of social media; Providing marketing consulting in the field of social media; Communication media (Presentation of goods on -), for retail purposes; Presentation of goods on communications media, for retail purposes; Presentation of companies on the Internet and other media; Retail services in relation to computer software.

Class 39

Packaging services; Package delivery; Collection of packages; Storage of packages; Packaging of products; Pallet packaging services; Packaging of goods; Packaging of food; Transport of packages; Packaging and storage services; Packing and packaging services; Packaging articles for transportation; Wrapping and packaging services;

Collection of packages by road; Packaging and storage of goods; Packaging of goods in transit; Wrapping and packaging of goods; Collection of packages by air; Arranging the collection of packages; Collection of packages by sea; Packaging clothing articles for transportation; Package holiday services for arranging travel

Class 40

Printing; Silkscreen printing; Textile printing; Letterpress printing; Printing (Pattern -); Printing (Photographic -); Photogravure printing; Screen printing; Portrait printing; Offset printing; Wool printing; Intaglio printing; Pattern printing; Lithographic printing; Discharge printing; Photographic printing; Photo-printing; Printing (Lithographic -); Printing (Offset -); Printing services; Digital printing; 3D printing; Printing of books; Digital printing services; Printing of advertising matter; Printing of documents from digital media; Printing of photographic images from digital media; Reclamation of solids from aqueous media by chemical precipitation.

Class 41

Dance events; Organising gymnastics events; Sporting event organization; Organising sporting events; Organising dancing events; Special event planning; Organisation of musical events; Special event planning consultation; Arranging of sporting events; Organising of sports events; Conducting of educational events; Organisation of cycling events; Timing of sports events; Organising of recreational events; Organisation of cultural events; Organization of sporting events; Organisation of educational events; Arranging of educational events; Conducting of cultural events; Organisation of esports events; Organising community sporting events; Provision of recreational events; Organising of football events; Musical events (Arranging of -); Conducting of sports events; Organisation of sporting events; Organising of sporting events; Provision of sporting events; Organisation of entertainment events; Sports events (Timing of -); Gymnastics events (Organising of -); Arranging of musical events; Organization of dancing events; Production of sporting events; Handicapping for sporting events; Arranging of cultural events; Conducting of entertainment events; Production of esports events; Organising community cultural events; Handicapping services for sporting events; Providing facilities for sports events; Organising events for entertainment purposes; Organisation of automobile racing events; Organising of motor racing events;

Ticket reservation for cultural events; Conducting of live esports events; Organizing cultural and arts events; Ice-skating events (Organising of -); Publication of calendars of events; Organising events for cultural purposes; Conducting of live entertainment events; Production of live entertainment events; Conducting of live sports events; Providing information on congress events; Organization of cosplay entertainment events; Video editing services for events; Horse jumping events (Organising of -); Organisation of vehicle racing events; Ticketing and event booking services; Presentation of live entertainment events; Sound engineering services for events; Lighting technician services for events; Organizing community sporting and cultural events; Organisation of entertainment and cultural events; Arranging and conducting of educational events; Organising of sports and sports events; Wine tasting events for educational purposes; Production of esports events for television; Management of events for sporting clubs; Organisation of sporting events and competitions; Organising of sports competitions and events; Ticket procurement services for entertainment events; Production of sporting events for film; Ticket procurement services for sporting events; Booking of seats for entertainment events; Ticket information services for esports events; Organization of sporting events and competitions; Production of sporting events for television; Preparing subtitles for live theatrical events; Production of sporting events for radio; Organization of events for cultural purposes; Arranging and conducting of sports events; Time recording services for sporting events; Provision and management of sporting events; Ticket information services for entertainment events; Ticket information services for sporting events; Organisation of stock car racing events; Arranging and conducting of entertainment events; Organizing and conducting college athletic events; Entertainment services relating to sporting events; Services for the organisation of football events; Organisation of sporting competitions and sports events; Provision of information relating to sporting events; Entertainment services in the nature of skating events; Ticket reservation and booking services for esports events; Disc jockeys for parties and special events; Organising of sports competitions and sports events; Entertainment provided during intervals of sporting events; Arranging and conducting of live entertainment events; Services for the organisation of sports events; Rental of equipment for use at athletic events; Entertainment services provided during intervals at sports events; Ticket reservation and booking services for sporting events; Disc jockey services for parties and special events; Organising of sports events and of

sports competitions; Booking of seats for shows and sports events; Ticket reservation and booking services for entertainment events; Organisation of automobile rallies, tours and racing events; Organization of sporting events and competitions, involving animals; Publication of printed matter and printed publications; Library services and rental of media; Providing multi-media entertainment via a website; Provision of entertainment services through the media of publications; Provision of audio and visual media via communications networks; Publication of texts in the form of electronic media; Provision of entertainment services through the media of television; Publication of material on magnetic or optical data media.

Class 42

Packaging design; Packaging designs; Design services (Packaging -); Design of packaging; Packaging design services; Design services for packaging; Packaging design for others; Industrial packaging design services; Custom design of software packages; Design services relating to packaging; Electronic storage of entertainment media content; Research in the field of social media; Conversion of images from physical to electronic media; Software authoring; Software installation; Software research; Software engineering; Software creation; Software design; Software development; Software customisation services; Computer software integration; Computer software engineering; Software consulting services; Consultancy (Computer software -); Design of software; Computer software maintenance; Software maintenance services; Smartphone software design.

Annex 2

The Opponent's Mark 3 goods and services in Classes 9, 16, 35 and 41

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming,

accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computer software and telecommunications apparatus to enable connection to databases, local area networks and the Internet; computer software to enable teleconferencing, videoconferencing and videophone services; computer software to enable searching and retrieval of data; computer software for accessing databases, telecommunications services, computer networks and electronic bulletin boards; protective clothing, footwear and headgear; sound, video, television and radio apparatus and instruments; communication, telecommunication, telephone and mobile telephone apparatus and instruments; telephones, mobile telephones, communications devices and cases therefore; ringtones [downloadable]; screen savers and screen wallpaper; communication, wireless communication and mobile communication devices; reading tablets and other devices for reading and viewing text, images and audio-visual content; software applications (apps), including apps for installation on telephones, mobile telephones and communications and wireless communication devices; accessories for telephones, telephone handsets, communication and wireless communication devices; battery chargers and adapters including battery chargers and adapters for use with and telephone, mobile telephone, communication and wireless communication devices; bags and cases adapted for holding or carrying telephones, mobile telephones communications and wireless communications equipment and accessories; electronic and computerised personal organisers; aerials; batteries; micro processors; key boards; modems; calculators; display screens; electronic global positioning systems; electronic navigational, tracking and positioning apparatus and instruments; apparatus and instruments for geolocation; monitoring apparatus and instruments; recordings; analogue and digital recordings; films; animations; cartoons; sound, audio, visual and audio visual content and recordings; sound, audio, visual and audio-visual recordings and content provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web; apparatus for access to broadcast or transmitted programmes; holograms; satellite broadcast receiving and decoding apparatus and instruments; apparatus and instruments for use in recording, storing, generating, carrying, transmitting, manipulating, processing,

reproducing and playback of text, sounds, images, signals, data, software, code, information and audio-visual content; computer hardware, firmware and software; computer games and entertainment software; instructional apparatus and instruments; non-printed, electronic, optical and digital publications; security apparatus and instruments; printed holograms for certifying authenticity; electronic certificates including electronic certificates of authenticity; data cards; memory cards; electronic, magnetic, and optical identity cards; encoded gift cards; payment cards, credit cards, charge cards, debit cards and smart cards; cameras; photographic transparencies and films; cinematographic and motion picture films; spectacles; sunglasses; cases for spectacles and sunglasses; parts, fittings and accessories for all the aforesaid goods; downloadable computer games; mathematical and geometrical instruments and cases therefor.

Class 16

Paper and cardboard; printed matter; bookbinding material; photographs; stationery; writing, drawing and marking instruments and cases therefor; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites; instructional and teaching materials; wrapping and packaging materials; plastic materials for packaging; paper for gift wrapping; paper and plastic bags; tissues; tissue paper; prints; posters; cards; greetings cards; gift tags; calendars; diaries; printers' type; printing blocks; publications; books; pamphlets; manuals; magazines; journals; periodical publications; newspapers; newspaper and magazine columns, sections and supplements; newsletters; printed programmes; decalcomanias; pressure sensitive stickers; book covers; book marks; printed certificates and printed certificates of authenticity; gift cards; printed gift certificates; non-magnetically encoded prepaid purchase cards for the online purchase of goods and services; printed visuals in the nature of promotional materials for others; parts, fittings and accessories for all the aforesaid goods.

Class 35

Advertising; Business management; Business administration; Office functions; marketing, promotion and endorsement services; market research services; auditing services; compiling, analysing, presenting, auditing and verification of market research data and sales data, including in relation to the music, film, video and entertainment industries; business information services; sales research for the music, video, film and entertainment industries; opinion polling; promotion services; publicity services; publication of publicity texts; compilation of databases; compilation of directories; provision of advertising, marketing and promotional space on web sites, publications and in other content and media; business and commercial analysis, research and information services; business information directory services; providing business, marketing and sales awards schemes in relation to the sale and supply of audio and visual content and recordings; retailing of the following: recordings, recorded content, sports, entertainment and educational content and recordings, audio recordings, audio-visual recordings, music, films, videos, film clips, music clips, photographs, images, artistic works, including, where applicable, by downloading and/or streaming from computer and telecommunications networks, the Internet and the World Wide Web; retailing of the following: photographs, images, artistic works, including, where applicable, by downloading and/or streaming from computer and telecommunications networks, the Internet and the World Wide Web; retailing of the following: software, games, electronic games, books, magazines, publications, television and radio programmes, broadcasts and podcasts; including, where applicable, by downloading and/or streaming from computer and telecommunications networks, the Internet and the World Wide Web; Retail, online retail and mail order and product exchange services connected with the sale of the following: bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, non-medicated toilet preparations, preparations and substances for the conditioning, care and appearance of the skin, body, face, eyes, hair, scalp, teeth and nails, soaps, personal cleansing preparations, shower gels, bath gels and bath preparations; Retail services connected with the sale of perfumery, eau de parfum and toilet waters; Retail services connected with the sale of deodorant preparations for personal use, anti-perspirants, cosmetics, colour cosmetics, eye cosmetics, nail cosmetics, lip cosmetics, make up removers, cosmetic impregnated tissues, shampoos, hair conditioners, preparations for the hair, hair lotions, dentifrices, sun tanning preparations, suncreening preparations,

shaving preparations, after shave and pre shave lotions and oils; Retail services connected with the sale of depilatory preparations, essential oils, oils for toilet purposes, pomanders, potpourris, perfumed drawer liners, fragranced sachets for drawers, room fragrance, incense, aromatic plant extracts; Retail services connected with the sale of visual, optical, scientific, measuring, signalling, checking, nautical, surveying, security, fire extinguishing, lifesaving, television, telephone, communications, radio and cinematographic apparatus and instruments, satellite broadcast receiving and decoding apparatus and instruments; Retail services connected with the sale of protective clothing, footwear and headgear, communications, optical and photographic instruments and apparatus, telephones and mobile telephones, cameras, music players, audio and audio-visual, recording, downloading, and reproduction apparatus and instruments, mp3 players and recorders, computer hardware, firmware and software, arcade games, coin freed apparatus, electronic amusement apparatus adapted for use with television receivers; Retail services connected with the sale of computer games and computer games software, electronic games, teaching and instructional apparatus and instruments, racks, stands and cases for storing, displaying and transporting audio and audio-visual recordings, non-printed publications; Retail services connected with the sale of spectacles, sunglasses, spectacles cases, sunglasses cases, electronic, magnetic, and optical identitycards, credit cards, charge cards, debit cards and smart cards, photographic transparencies, precious metals and their alloys, silverware, jewellery, precious stones, horological and chronometric instruments, costume jewellery, watches, key rings, cufflinks, lighters made of precious materials, musical instruments and electronic musical instruments; Retail services connected with the sale of paper and cardboard, printed matter, bookbinding material, photographs, stationery, writing, drawing and marking instruments and cases therefor, mathematical and geometrical instruments and cases therefore, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites, instructional and teaching materials, wrapping and packaging materials, plastic materials for packaging, gift wrapping, paper and plastic bags; Retail services connected with the sale of tissues, tissue paper, prints, posters, photographs, cards, greetings cards, gift tags, calendars, diaries, printers' type, printing blocks, publications, books, pamphlets, manuals, magazines, periodical publications, newspapers, newsletters, decalcomanias, pressure sensitive stickers, book covers, book marks; Retail services connected with

the sale of clothing, belts, collars and leads for animals, whips, harness and saddlery, umbrellas, parasols, walking sticks, animal skins, hides, luggage, bags, shopping bags, trunks, travelling bags, hand bags, shoulder bags, backpacks and rucksacks, bicycle bags, purses, wallets, key fobs and key cases; Retail services connected with the sale of household, toilet and kitchen utensils, cosmetics cases, combs and sponges, brushes, toothbrushes, brushmaking materials, articles for cleaning purposes, steel wool, unworked or semi-worked glass, kitchenware, glassware, tableware, crockery, drinking vessels, porcelain and earthenware, vanity cases, ornaments, models and figurines, money boxes, textiles, fabrics, textile and fabric piece goods, wall coverings, furnishing and decorating textiles and fabrics; Retail services connected with the sale of blinds, curtains and pelmets, bath linen, table linen, bed linen, household linen; Retail services connected with the sale of clothing, footwear, headgear, clothing and textile article decorations, lace and embroidery, ribbons and braid, buttons, hooks, clasps and eyes, pins and needles, belt clasps, artificial fruit and flowers, slide fasteners, hair grips, badges, rosettes, patches, appliqués, buckles, boot and shoe laces, hat and headbands, games, toys and playthings, computer games, handheld and handheld computer games, games for playing on mobile communications devices; Retail services connected with the sale of gymnastic, fitness and sporting articles and equipment, Christmas decorations, bags, cases and carriers for sporting, fitness and gymnastic equipment; Retail services connected with the sale of beers, mineral and aerated waters, nonalcoholic drinks, energy drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, alcoholic drinks, wines, spirits, liqueurs and cocktails and of parts and fittings related all the aforesaid goods; barter services; auction services; provision of business and commercial information research, advice and assistance relating to goods, services and suppliers of goods and services; compiling and maintaining directories and databases of business, commercial and consumer information relating to goods and services and their suppliers; business introduction services; representation and agency services for artists, writers, actors, models, performers, photographers and others involved in the entertainment, educational, cultural, content, advertising, fashion and media industries; dissemination of advertising, marketing, promotion, public relations, endorsement and publicity materials; compilation and transcription of data; compilation of advertisements for use as web pages on the Internet; advertising, marketing and promoting goods and services by distribution and

transmission of advertisements including advertisements in the nature of audio, video, text messages and emails via wireless and mobile devices; distribution of samples; organization of fairs and trade shows for business, advertising and promotion purposes; shop-window dressing; auctioneering services; business information, research, assistance and advice; accountancy services; data-processing services; sorting and editing of information in computer databases; searching for data in computer databases; personnel and human resource services; recruitment services; purchasing services; organisation and management of business incentive and loyalty schemes; administrative processing and organising of mail order services; arranging of business introductions; business research and survey services; business forecasting services; provision of business, clerical and secretarial services; news and current affairs clippings services; provision of business and commercial information research, assistance and advice to prospective purchasers of goods and services; answering and message handling services; managing remote monitoring centres; data management and electronic stocktaking services; providing web sites and web pages relating to any of the aforesaid; information, advice and assistance relating to all the aforesaid; provision of all the aforesaid services including (but not limited to) online, and/or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless communication networks.

Class 41

Entertainment; Education; Sporting and cultural activities; internet, online, television, radio, sporting and musical entertainment services, recreation services, cultural services and educational services; presentation and production of radio, television and internet programmes; presentation of radio, television and internet programmes; entertainment, educational and cultural services by providing non-downloadable recordings and playback of audio, visual and audio-visual recordings, publications and content; providing web sites featuring entertainment, gaming, cultural, sporting and educational content, information, advice and assistance; providing non-downloadable music, audio, visual and audio-visual recordings and content; providing publications, online publications, web sites, databases, information, news and commentary in the fields of

music, entertainment, education, culture, popular culture, films, books, sports, games, gaming, current affairs, culture, literature, film, art and photography; providing publications, online publications, web sites, databases, information, news and commentary in the fields of music, entertainment, education, culture, popular culture, films, books, sports, games, gaming, current affairs, culture, literature, film, art and photography whereby users provide content for, contribute to and update the aforesaid; organising and operating games and competitions; online games; gaming and lottery services; organising and operating educational and entertainment shows, talent shows and fashion shows; conducting auditions; arranging contests; publishing; music publishing; recording; music mixing; production of music, films and of recordings and of audio, visual and audio-visual content; direction of music, films and of performances; examining for and granting of qualifications and awards; organising, hosting and operating award schemes and ceremonies including in the fields of education, music, videos, film, recordings, music culture, popular culture, sports and entertainment; organising and conducting parties, festivals, ceremonies and entertainment, cultural, sporting and educational events; performances and live performances; music writing and composition services; music group services; musical, radio, dramatic and television entertainment; disc jockey services; photography services and photographic syndication services; photographic reporting; news and current events reporting and syndication; educational, cultural, sports and entertainment events ticketing and ticket reservation services; providing information in the field of entertainment, sports, culture and education via a global computer network, providing web sites and web pages relating to any of the aforesaid; advice, information and assistance relating to all the aforesaid; provision of all the aforesaid services including (but not limited to) online, and/or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless communication networks or devices