

O/0340/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. UK00003606950
BY HARD CARRY GAMING, INC.
TO REGISTER:**

NRG

**AS A TRADE MARK
IN CLASSES 35 & 41**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 426020 BY
NRJ GROUP SOCIETE ANONYME DE DROIT FRANCAIS**

BACKGROUND AND PLEADINGS

1. On 9 March 2021, Hard Carry Gaming, Inc. (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following services:

Class 35: Retail store services featuring clothing, general merchandise, stickers, keychains; promotion of electronic sports teams; promotion and business management of professional video gaming sports teams; business management of electronic sports teams; advertising and marketing services, namely, promoting the goods and services of others; endorsement services, namely, promoting the goods and services of others.

Class 41: Entertainment services in the nature of video game and eSports tournaments and competitions; entertainment services, namely, provision of livestreams featuring video game play and video game competitions delivered by the internet and streaming video platforms; entertainment services in the nature of organizing, promoting, conducting, and participating and performing in video game and eSports exhibitions, tours, tournaments, activities, and competitions; educational and entertainment services relating to the video gaming and eSports industry, namely, providing classes, seminars and workshops in the field of video gaming and eSports; provision of training in the field of video gaming and eSports; entertainment services, namely, production of multimedia and audiovisual content in the field of video gaming, eSports, and related consumer interest topics; entertainment services, namely, providing news and information in the field of video gaming and eSports.

2. The applicant’s mark enjoys a priority date of 9 September 2020.

3. The applicant's mark was published for opposition purposes on 7 May 2021 and, on 6 August 2021, it was opposed by NRJ Group Societe Anonyme de droit francais ("the opponent"). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and is targeted against the following services only:

Class 35: Promotion of electronic sports teams; promotion and business management of professional video gaming sports teams; advertising and marketing services, namely, promoting the goods and services of others; endorsement services, namely, promoting the goods and services of others.

Class 41: Entertainment services in the nature of video game and eSports tournaments and competitions; entertainment services, namely, provision of livestreams featuring video game play and video game competitions delivered by the internet and streaming video platforms; entertainment services in the nature of organizing, promoting, conducting, and participating and performing in video game and eSports exhibitions, tours, tournaments, activities, and competitions; educational and entertainment services relating to the video gaming and eSports industry, namely, providing classes, seminars and workshops in the field of video gaming and eSports; provision of training in the field of video gaming and eSports; entertainment services, namely, production of multimedia and audiovisual content in the field of video gaming, eSports, and related consumer interest topics; entertainment services, namely, providing news and information in the field of video gaming and eSports.

4. Under both grounds, the opponent relies on the following marks:

NRJ

UK registration no: 900136150

Filing date 21 May 1996; registration date 9 March 1999

("the opponent's first mark"); and



UK registration no: 918003407¹

Filing date 21 December 2018; registration date 18 May 2019

("the opponent's second mark").

4. In respect of both grounds of the opposition, the opponent relies on only some services in the opponent's first mark's specification, being the following:

Class 35: Advertising.

Class 38: Broadcasting of radio and television programmes; electronic data, image and document transmission via computer terminals and all other means of transmission such as waves, cables, satellites, Internet; data transmission; data and voice telecommunications, namely radio communications; communications by computer terminals and other means of transmission.

Class 41: Entertainment, among other radio entertainment; cultural activities; production of shows; organisation of competitions relating to entertainment.

5. As for the opponent's second mark, the opponent relies on all goods and services for which that mark is registered under the 5(2)(b) ground. Those goods and

¹ The opponent's marks are both comparable trade marks. They are based on the opponent's earlier EUTMs, being registration numbers 0136150 and 18003407. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

services are listed in the **Annex** to this decision. However, under the 5(3) ground, the opponent claims to have a reputation in only some of those goods and services, being those underlined in the Annex to this decision.

6. Under its 5(2)(b) ground, the opponent claims that the marks at issue are highly similar and that the services of the applicant's mark are identical or highly similar to the opponent's services. As a result, there is a serious likelihood of confusion between them. On the point of the opponent's 5(2)(b) pleading, I note that they only make reference to the services of the opponent and make no mention of the goods relied upon under the opponent's second mark.
7. In respect of the 5(3) ground, the opponent claims that its marks enjoy a substantial reputation in the goods and services (albeit the goods relate to the opponent's second mark only) and that in using and/or applying for a similar mark, the applicant will benefit from an unfair advantage. The opponent also claims that there is a real and serious risk that use and/or registration of the applicant's mark would erode the distinctiveness of the opponent's marks.
8. The applicant filed a counterstatement denying the claims made and requested that the opponent provide proof of use in respect of its first mark for all of the services relied upon.
9. The opponent is represented by Mewburn Ellis LLP and the applicant is represented by Keltie LLP. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
10. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

11. As above, only the opponent filed evidence. I note that during the evidence rounds, the opponent filed both the first and second witness statements of Aurélie Guilloteau dated 23 August 2022 and 23 September 2022, respectively. Ms Guilloteau is the Deputy Legal Director of the opponent, being a position she has held since 1 March 2022. Ms Guilloteau's first statement is accompanied by 24 exhibits, being those labelled AG1 to AG24, and her second is accompanied by a further two, being those labelled AG25 and AG26.

12. I will refer to points from the evidence and the submissions filed where necessary.

PRELIMINARY ISSUE

13. I note that in its evidence, the opponent has filed a number of foreign language exhibits. Some of which are translated via Google Translate but some are untranslated. The Tribunal, upon receipt of the opponent's evidence, wrote to the opponent on 25 September 2022 setting out the following:

“It is noted that a number of exhibits contain non English content, and a translation has not been provided. Please note the Hearing Officer will determine what weight, if any, to give the evidence if any foreign language exhibits are not translated or where a non-certified translation is provided.”

14. In filing its submissions, the opponent addressed the issue of the foreign language evidence. I do not intend to reproduce these submissions in full but note that the opponent's position is that the foreign language evidence is clear in respect of the dates upon which it was produced, published, run or released to the public. Further, the opponent sets out that the exhibits clearly show the marks relied upon and upon which services they are being used in relation to. Further, the opponent confirms that it is not seeking to rely on content that is in a non-English language meaning that translations are not required. However, the opponent but wishes to highlight that the evidence would be understood by an English speaker. The opponent has given some examples of when the foreign language evidence is

apparent. Having reviewed the evidence, I accept that some is self-evident regardless of the language used, for example, the presence of advertising of the opponent's radio stations in various publications across the EU² is clear in respect of when it was published and what marks were used. Having said that, I note that not all of the evidence is self-evident and where translations are provided, they are done by Google Translate and not a translator that has provided his/her own witness statement attesting to the accuracy of the translation.³ I will, therefore, treat such evidence with caution. Where I consider it appropriate to do so, I will discuss this issue further throughout the course of this decision.

DECISION

Proof of use

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

16. The relevant statutory provisions are as follows:

² Exhibit AG9

³ On this point, see paragraph 4.8.4.2 of the Tribunal Section of the Trade Marks Manual that sets out the expectation regarding foreign language evidence.

“Section 6A

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the

form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

17. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

18. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

19. Given their filing dates, the opponent’s marks qualify as earlier trade marks under the above provisions. While the opponent’s first mark completed its registration process over five years prior to the priority date of the applicant’s mark, the opponent’s second mark did not. As set out above, the applicant requested that the opponent provide proof of use for its first mark. As a result, the opponent’s first mark is subject to a proof of use assessment in respect of the services relied upon. As for the opponent’s second mark, this is not subject to the proof of use provisions and the opponent may, therefore, rely on all of the goods and services for which that mark is registered.

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV*

[2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*
[2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to

secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s first mark is the 5-year period ending with the priority date of the applicant’s mark, being 9 September 2020. Therefore, the relevant period for this assessment is 10 September 2015 to 9 September 2020.

22. The opponent’s first mark is a comparable mark based upon an earlier EUTM. This means that use of the mark in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.⁴ Given that the entirety of the relevant period falls prior to IP Completion Day, the relevant jurisdiction for the proof of use assessment is the EU. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for

⁴ See paragraph 4 of Tribunal Practice Notice 2/2020

which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

23. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”⁵ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Sufficient Use

24. Ms Guilloteau explains that the opponent is a private media group with activities in the EU and elsewhere. The origin of the opponent dates back to 1981 when it launched the radio station ‘NRJ’ in France. She states that it quickly became a major brand in the radio sector in France and, as a result, extended its activities to other Member States in the EU.

25. As at the date of her first witness statement, Ms Guilloteau confirms that the opponent operated four radio brands and that, over the years, its offerings have developed through the promotion of radio listening on multimedia devices including smartphones, tablets, computers, televisions and multimedia players. The opponent operates six websites, nearly 230 digital radio stations, eight mobile applications and offers both replay and original podcasts. I note that Ms Guilloteau confirms that the opponent has subsidiaries whose main activity is the marketing of advertising space on TV media, radio and internet. This includes the production of messages, commercials and banners and extends to all of the forms of broadcasting services offered by the opponent, being all radio stations, television channels and all forms of digital media.

26. Overall turnover for the opponent in the years of 2016 to 2020 have been provided by way of press releases.⁶ There are additional figures for 2021 but these are

⁵ *Jumpman* BL O/222/16

⁶ Exhibit AG1

outside the relevant period. I note that the turnover was €369.8 million in 2016, €368 million in 2017, €392.3 million in 2018, €386.2 million in 2019 and €324.8 million in 2020. I note that the 2016 and 2017 figures are broken down into four categories, being 'Music, Media and Events', 'Television', 'International Activities' and 'Broadcasting'. As for the figures from 2018 to 2020, these are broken down into just three categories, being 'Radio', 'Television' and 'Broadcasting'.

27. Ms Guilloteau goes on to confirm that the opponent's first mark is one of its major trade marks. She also confirms that a logo mark is also used and refers to the opponent's second mark which she confirms is a variant of the logo mark that is used in some countries but does not specify which ones. The opponent's second mark is not subject to the proof of use assessment I must make so is not relevant here, however, use of the same is relevant to the 5(3) grounds which I will discuss in further detail below.

28. In respect of the radio stations that the opponent operates, Ms Guilloteau has provided 2020 figures that set out how many frequencies that the opponent's radio stations broadcast on and how many daily listeners those stations attract. The figures provided are also broken down into those for specific countries within which the opponent operates. The figures are as follows:

Country	Year of first launch	Number of transmitters	Number of listeners per day
France	1981	365	5.2 million
Belgium	1988	55 + DAB+	353 338
Germany	1991	29 + DAB +	2.25 million
Sweden	1993	149	636 000
Finland	1995	47	118 000
Austria	1998	7 + DAB +	154 000
Bulgaria	2006	21	275 818

29. There are additional figures provided for 2019 which Ms Guilloteau claims to show that the opponent has continued to develop its brands, particularly 'NRJ', internationally. These figures confirm that, outside of France, the opponent attracted more than 14.8 million listening sessions of its digital radios per month,

that it had more than five million fans on its Facebook page and that its applications had been downloaded nearly 10.6 million times. An infographic has been provided showing a map of the opponent's international network.⁷ This confirms the opponent's presence in other territories and while I note some of these figures include EU countries, it also shows figures for Russia, Georgia, Egypt, Norway, Switzerland, Morocco, Sint Maarten and Mauritius, being territories that are not relevant to the present assessment.

30. Ms Guilloteau's evidence then goes into detail regarding use (and reputation, for that matter) in respect of a number of different countries. Those include Germany, Austria, Sweden, Bulgaria, Finland, France and Belgium. I do not intend to summarise this evidence in any great detail on the basis that it does not, in my view, add to the issue of use above and beyond what is covered by the turnover and broadcast figures discussed above. However, I will say that the discussion surrounding French use goes into more detail regarding the advertising services that the opponent provides. Ms Guilloteau explains that the opponent offers advertisers the opportunity to target two main advertising groups, being people aged between 25 and 49 and women under 50. It also discussed 'NRJ Television Channels' and I note that it confirms that the opponent launched a general-interest channel called 'NRJ 12' in 2005 and a national music television channel called 'NRJ Hits' in 2008. The turnover relating to these channels in 2020 was €70.7 million. While this confirms that the opponent broadcasts television channels, I have nothing to suggest that it produces any programs that air on them.

31. The bulk of the opponent's evidence does not mention the UK; however, I remind myself that the relevant territory for this assessment is the EU so this does not cause any particular issue at present. That being said, I do note that some specific evidence in relation to the UK market is provided. Firstly, Ms Guilloteau's evidence discusses figures relating to visits to the opponent's website, being 'NRJ.fr', and visits to the opponent's app from users within the UK. These are as follows:

⁷ Exhibit AG2

Year	NRJ.fr visits from the UK (approx.)	NRJ App visits from the UK (approx.)
2015	300,000	615,000
2016	225,000	435,000
2017	185,000	290,000
2018	170,000	235,000
2019	170,000	170,000
2020	155,000	150,000
TOTAL	1,205,000	1,895,000

32. In addition to the above information, Ms Guilloteau goes on to discuss a print-out showing the 2020 figures from countries where the opponent's podcasts were made available.⁸ Ms Guilloteau confirms that the UK figures represent the sixth highest country for a total number of podcasts accessed. Having reviewed the print-out provided, I note that for 2020, there were a total of 183,223 podcasts accessed from the UK. In light of the information regarding the numbers of podcasts accessed, I do not consider that the figures shown in the table above are particularly clear in what they are purported to actually show. If it is merely visits, there is nothing further before me to suggest that the app or website visits resulted in the access of the opponent's services. If the figures are meant to demonstrate visits that resulted in the access of podcasts, then the numbers are inconsistent in that, in 2020, there were approximately 305,000 combined visits but only 183,223 podcasts accessed.

33. While on the topic of use in the UK, Ms Guilloteau discusses the opponent's music awards and their presence in the UK press. Various articles are provided and I note that these include print-outs from four different publications, three of which from Mail Online and the remaining from British GQ,⁹ both of which being UK-wide publications. I note that the articles are dated between 13 November 2016 and 13 November 2019.

34. Lastly, in respect of Ms Guilloteau's first witness statement, she provides further discussions regarding the 'NRJ Music Awards' (being those that the above articles from the UK press discuss) and confirms that these awards were created in 2000 by the opponent in partnership with French TV channel TF1. Ms Guilloteau confirms that the 2019 award show was broadcast on TF1 and NRJ radio and that

⁸ Exhibit AG22

⁹ Exhibit AG23

the television broadcast attracted 4.72 million. I note that a print-out taken from Wikipedia is provided but this article is in the French language. No translation has been provided but, in any event, I do not consider that it is particularly helpful above and beyond what Ms Guilloteau confirms in her narrative evidence.

35. Moving on to Ms Guilloteau's second witness statement, I note that this focuses on advertising services. Ms Guilloteau explains that the advertising services are offered by the opponent's subsidiary companies including NRJ GLOBAL, REGIE NETWORKS (that trades under the name 'NRJ GLOBAL REGIONS') and Energy Media. The former two companies offer services in France whereas the latter offers them in Germany.

36. The turnover (in euros) in respect of the advertising services offered by these three subsidiaries have been provided. I note that for 'NRJ GLOBAL' the turnover is as follows:

	French market	Export markets	TOTAL
2015	203,947,379	14,511,596	218,458,974
2016	203,162,548	13,176,373	216,338,921
2017	197,474,201	14,352,824	211,827,025
2018	194,718,907	17,760,233	212,479,140
2019	187,969,972	18,631,539	206,601,511
2020	157,315,206	17,703,960	175,018,960

37. For REGIE NETWORKS, it is as follows:

	French market	Export markets	TOTAL
2015	59,650,000	1,969,000	61,619,000
2016	59,823,900	2,274,033	62,097,933
2017	59,400,991	2,349,563	61,750,554
2018	59,485,776	2,262,572	61,748,348
2019	60,435,405	2,238,031	62,673,436
2020	40,740,228	1,322,859	42,063,087

38. Lastly, for 'Energy Media', it is as follows:

	TOTAL Markets
2017	30, 600, 000
2018	30, 500, 000
2019	27, 700, 000
2020	23, 000, 000

39. In respect of the NRJ GLOBAL and REGIE NETWORKS turnover reproduced above, I note the inclusion of a column for 'Export Markets', however, I have no explanation as to what this covers.

40. Taking all of the evidence into account, I have no hesitation in finding that the opponent has put its first mark to genuine use throughout the relevant territory during the relevant period. The turnover figures provided are significant and while I do not have any evidence regarding the markets at issue, I appreciate that such evidence reflects a respectable market share for the services provided. The entirety of the use covers a wide range of countries and I am satisfied that, despite some being from countries outside of the EU, the majority is from within the EU with particular focus on France, Germany, Belgium, Sweden, Austria and Bulgaria. I also note the significant figures in respect of advertising in France and Germany together with the significant broadcast figures for the opponent's radio stations across the EU. The evidence clearly reflects a genuine attempt on behalf of the opponent to not only generate a market share for the mark relied upon during the relevant period but shows that the opponent conducted a large business operation during this time with the mark at issue being at the centre of such use.

Fair Specification

41. I must now consider whether, or the extent to which, the evidence shows use of the opponent's first mark in relation to all of the services relied upon. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (although it equally applies to the issue of a fair specification for proof of use assessments).

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

42. I remind myself that the services relied upon by the opponent are as follows:

Class 35: Advertising.

Class 38: Broadcasting of radio and television programmes; electronic data, image and document transmission via computer terminals and all other means of transmission such as waves, cables, satellites, Internet; data transmission; data and voice telecommunications, namely radio communications; communications by computer terminals and other means of transmission.

Class 41: Entertainment, among other radio entertainment; cultural activities; production of shows; organisation of competitions relating to entertainment.

43. I will deal with the services at issue in turn.

Advertising.

44. Clearly the opponent offers advertising services, as reflected by the significant turnover figures in respect of the same (being those discussed at paragraphs 36 to 38 above). In considering a fair specification, I bear in mind that “advertising” is a very broad term, however, I do not consider that the average consumer would necessarily look to categorise the services offered as anything other than ‘advertising’ services. I, therefore, consider that the opponent has provided evidence of genuine use for “advertising”.

Broadcasting of radio and television programmes.

45. The evidence is clear in that the opponent provides broadcasting services for radio stations and television channels. I appreciate that the range of services offered in respect of television broadcast services are a lot more limited than the radio broadcast services (in that the opponent offers two television channels compared

to the numerous radio stations), however, I do not consider that more limited services necessarily means that there cannot be genuine use. In any event, I note that the turnover associated with the opponent's television channels was €70.7 million in 2020. I, therefore, consider that the opponent has provided evidence of genuine use for the above services.

Electronic data, image and document transmission via computer terminals and all other means of transmission such as waves, cables, satellites, Internet; data transmission; data and voice telecommunications, namely radio communications; communications by computer terminals and other means of transmission.

46. I note that the opponent has provided detailed submissions in respect of the above services. I do not intend set these out in full but note that the opponent claims that it has shown use of these services on the basis that it offers various websites to provide its electronic and data transmissions and its communication services. It also argues that use is demonstrated by use of the opponent's mobile applications and via standalone games website called 'NRJ Games'.¹⁰ While noted, I do not consider that the average consumer would construe the services described above as covering the provision of a website, mobile applications or computer games. I consider that the above terms are very broad and cover a multitude of different types of services that the evidence does not show. For example, the types of transmissions covered in the above term go beyond the transmission of radio and television broadcasts which, in my view, is the only type of 'transmission' shown in the evidence.

47. If I were to consider limiting the above terms in accordance with the evidence filed, I am of the view that such a limitation would be so that the terms fall in line with radio and television broadcast services. However, I am of the view that the services covered by those discussed at paragraph 45 above are sufficient to cover such use. Therefore, I do not consider it appropriate or necessary to seek to limit the above terms in accordance with the use provided in the evidence as it does not further the opponent's position. Instead, I will proceed on the basis that the

¹⁰ Exhibit AG25

opponent has not provided evidence of genuine use in respect of the above services.

Entertainment, among other radio entertainment.

48. Entertainment is a very broad service and the wording ‘among other radio entertainment’ does not limit it in any way. It could, therefore, be said to cover any type of entertainment such as live theatre or sporting events. Based on the evidence filed, I consider that this is too broad a service to justify granting the opponent genuine use for the entirety of the term. The opponent’s submissions argue that it should be granted use for the entirety of this term and, in doing so, discusses sponsorship and promotion of music events, concerts and films under the opponent’s marks in various countries. However, to me, this evidence covers sponsorship and/or advertising services, not the provision of an entertainment service. The opponent also makes reference to the provision of online games, however, the evidence regarding this is very limited (only one example, being that referred at paragraph 46 above) and I am not convinced that it is sufficient to warrant a finding that the opponent has genuinely used its mark on such entertainment services. That being said, I do agree with the opponent’s submissions in that the evidence regarding the ‘NRJ Music Awards’ is proof that the opponent offers entertainment services. Further, I accept that the evidence covers various types of specific entertainment such as the provision of entertainment via radio, television, podcasts, music award shows and music tours.¹¹ As such, I consider it appropriate to limit the above term to “entertainment, namely via radio, television, podcasts, music award shows and music tours”.

Cultural activities.

49. I have no evidence or submissions as to what the above services cover and how the evidence demonstrates use of the same. Therefore, I do not consider that there is any evidence that points to genuine use of the above services.

¹¹ See Exhibit AG21 and paragraph 74 of the first witness statement of Ms Guilloteau

Production of shows.

50. As was the issue for some of the services discussed above, this term is too broad and it is not suitable to grant the opponent use of the same. For example, the above service can be said to cover production of theatre shows and, clearly, the evidence does not cover use of such. However, I am satisfied that the opponent has produced radio shows and while it offers broadcast services for television and provides podcasts, I am not convinced that the evidence points to the opponent actually producing the television shows and podcasts itself. Lastly, I accept that in providing entertainment services via the music award shows and music tours discussed in the evidence, it is reasonable to infer that the opponent also offers production services for the same. Therefore, I limit the above term to “production of radio shows, music award shows and music tours”.

Organisation of competitions relating to entertainment.

51. I note that the opponent’s evidence covers a range of competitions in Bulgaria regarding the winning of a car or a dream holiday¹² and a competition in France regarding a competition to win €5,000.¹³ While I accept the existence of a limited number of competitions and appreciate that the opponent, who is running the competitions, is an entertainment provider, I do not necessarily consider that they will be understood as competitions relating to entertainment. I am of the view that the plain meaning of the above service is something along the lines of a game show or competition show (such as singing or variety show competitions) where competitors actively compete against one another as a form of entertainment for the viewer. On the topic of this service, I note that the evidence shows that the opponent organises a music award competition known as the NRJ Music Awards. The issue I have with this service is that an award show is not a competition. Granted, the awards are given to musicians who technically ‘compete’ in categories against other musicians, however, the nature of the competition is not direct and is simply a by-product of musicians releasing their music in any given year. It is, in my view, somewhat of a stretch to suggest that the opponent’s award show would

¹² Exhibit AG14

¹³ Exhibit AG18

be considered a 'competition' in line with the plain meaning of the service at issue here. Lastly, the opponent's evidence does cover the organisation of events such as live music sessions and music concerts held as part of the 'NRJ Music Tour',¹⁴ however, I have nothing to suggest that these are competitive in nature so are not applicable here. Therefore, I do not consider that there is any evidence that points to genuine use of the above services.

52. For the sake of completeness and the avoidance of doubt, I consider that a fair specification of the opponent's services is as follows:

Class 35: Advertising.

Class 38: Broadcasting of radio and television programmes.

Class 41: Entertainment, namely via radio, television, podcasts, music award shows and music tours; production of radio shows, music award shows and music tours.

Section 5(2)(b): legislation and case law

53. Section 5(2) of the Act reads as follows:

“(2) A trade mark shall not be registered if because –

(a) [...]

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

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

¹⁴ Exhibit AG7

54. Section 5A of the Act states as follows:

“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.”

55. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

56. The opponent's services under its first mark are subject to my findings under genuine use and these are reproduced in full at paragraph 52 above. As for the goods and services under the opponent's second mark, these are shown in the

Annex to this decision. The applicant's goods that are subject to this opposition are set out at paragraph 3 above.

57. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

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

59. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods (although it equally applied to services) are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

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

60. I note that I have submissions from the opponent in respect of the goods and services comparison. I do not intend to reproduce those submissions here but will refer to them below, if necessary.

Class 35

Promotion of electronic sports teams; promotion [...] of professional video gaming sports teams; advertising and marketing services, namely, promoting the goods and services of others; endorsement services, namely, promoting the goods and services of others.

61. The opponent's marks both include the term “advertising” at large. This is not subject to any limitation and can, therefore, be used for the same purposes as the above terms. On the basis that promotion and marketing services are still advertising services, I find that the above goods all fall within the opponent's broader term. Therefore, I consider that the services are identical under the principle outlined in *Merici*.

Business management of professional video gaming sports teams.

62. I do not consider that the above term is similar to “advertising” in the opponent’s specifications. This is the only term in class 35 of the opponent’s first mark’s specification and I do not consider that it shares any obvious level of similarity with any of the remaining services covered by that mark. These services are, therefore, dissimilar to the services in the opponent’s first mark’s specification. As for the opponent’s second mark, I note that this includes a number of other terms in class 35 which require further consideration. I acknowledge that the opponent’s second mark includes terms that cover a type of management service, being “advertising management” and “computerised file management, namely management of advertising or informative media (advertising management).” However, these relate specifically to advertising. While the shared use of ‘management’ in these terms may be said to give rise to an overlap in nature, I consider that any such overlap is superficial as both services relate specifically to different types of management. As for the remaining factors, I see no obvious reason as to why they overlap. Overall, such a superficial overlap in nature is not sufficient to give rise to any degree of similarity.

Class 41

Entertainment services in the nature of video game and eSports tournaments and competitions; entertainment services, namely, provision of livestreams featuring video game play and video game competitions delivered by the internet and streaming video platforms; entertainment services in the nature of organizing, promoting, conducting, and participating and performing in video game and eSports exhibitions, tours, tournaments, activities, and competitions; entertainment services, namely, providing news and information in the field of video gaming and eSports; entertainment services, namely, production of multimedia and audiovisual content in the field of video gaming, eSports, and related consumer interest topics.

63. The opponent’s submissions in respect of the class 41 services are made on the basis that the entirety of its first mark’s specification survived genuine use. This was not the case and the entertainment services relied upon have been

significantly limited to “entertainment, namely via radio, television, podcasts, music award shows and music tours”. While this service and the applicant’s entertainment services (being those listed above) all relate to different types of entertainment, I still consider there to be some overlap in factors. This is on the basis that the nature of the services overlap in that they are all entertainment services (albeit relating to different entertainment industries). The core purpose of the services are also similar in that both services aim to entertain the user, albeit via different mediums. I appreciate that there is also an overlap in user in that those seeking entertainment services for television shows may also seek to consume entertainment content involving video game tournaments. As for trade channels, I am of the view that a large provider of entertainment services for television may also wish to provide various types of entertainment relating to video game tournaments via its own television channels or via online streams. While I do not consider that this points to a significant overlap in trade channels, it does point to some. Taking all of this into account, I am of the view that these services are similar to no more than a medium degree.

64. In respect of the services in the opponent’s second mark’s specification, I note that they include “entertainment” at large and, therefore, can be said to encompass all of the above services of the applicant. These services are, therefore, identical under the principle outlined in *Meric*.

Entertainment services relating to the video gaming and eSports industry, namely, providing classes, seminars and workshops in the field of video gaming and eSports.

65. In respect of the entertainment service in class 41 of the opponent’s first mark’s specification, I consider that the same overlap in nature and purpose as discussed at paragraph 63 above exists with these services also. However, the trade channels do not overlap in that the applicant’s services relate to the provision of classes, seminars and workshops and I do not consider that the same undertaking that offers television or music entertainment, for example, would offer classes, seminars or workshops in field of video games and eSports. Overall, I consider that these services are similar to only a low degree.

66. As discussed at paragraph 64 above, the opponent's second mark includes "entertainment" at large. While I appreciate that the applicant's services appear as though they are educational services, they are categorised as entertainment services so I am satisfied that the opponent's service encompasses them. As a result, I find that these services are identical under the principle outlined in *Meric*. Alternatively, if it is said that, despite their categorisation, the above services are in fact education services, then I note that the opponent's second mark includes "education" at large meaning that they would also be identical under the principle outlined in *Meric*.

Educational [...] services relating to the video gaming and eSports industry, namely, providing classes, seminars and workshops in the field of video gaming and eSports; provision of training in the field of video gaming and eSports.

67. Despite relating to video gaming and eSports (both of which can be said to be forms of entertainment) I see no reason why any of the above services would share any obvious degree of similarity with the services in the opponent's first mark's specification. However, the opponent's second mark includes the terms "education" and "provision of training", both of which encompass the above services. As a result, these services are identical under the principle outlined in *Meric*.

68. While there are varying degrees of similarity between the applicant's services and those in the opponent's first and second marks, the applicant's "business management of professional video gaming sports teams" service shares no similarity with either. As some degree of similarity between services is necessary to engage the test for likelihood of confusion, this means that the opposition under section 5(2)(b) aimed against those services will fail.¹⁵ However, the opposition against the remaining services may proceed.

¹⁵ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

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

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

70. The opponent submits that the average consumer for the entertainment services at issue will be aimed at the public at large as they are provided for recreational and enjoyment purposes. I agree. In respect of the level of attention paid, the opponent submits that the members of the general public will pay only a low degree of attention. I do not necessarily agree that this is the case for all of the services. Using radio entertainment as an example, I am of the view that some consumers will simply turn the radio on and listen to whatever is playing, paying no attention to any particular factors. For these consumers, I agree that the level attention will be low. However, I am of the view that for other consumers who are deciding which radio show to listen to, they will ordinarily consider the genre of music played, whether the broadcast is hosted and the regularity of news/travel updates (if any) during programming. For these consumers, I consider that a medium degree of attention will be paid. I am of the view that the most probable method by which the class 41 services are selected is likely to be visual in the form of adverts seen online, on television or printed publications. I appreciate that the selection process could also follow aural considerations such word of mouth recommendations or

advertisements through radio. While visual considerations are likely to be the most important, I do not discount aural considerations playing a part in the selection process.

71. As for the class 35 services, the opponent has not made submissions as to the identity of the consumer but states that the level of attention paid will be moderate. In respect of the identity, I am of the view that the majority of consumers will be business users but appreciate that the terms at issue are so broad that they may cover advertising in local newspapers or on local radio stations that members of the general public may use. As for the attention paid, I agree that it will be moderate, or medium, on the basis that the consumer will consider factors such as the reach of the publication/broadcast and the timespan within which the advertising will run. I consider that the most probable method by which the services are selected is likely to be after the consumer has considered a list of services on the provider's website or in a leaflet handed out at a physical premises, for example. I also appreciate that the services may be selected after aural recommendations or advice from sales assistants. While visual considerations are likely to be most important, I do not discount aural considerations playing a part in the selection process.

Comparison of the marks

72. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.


73. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is

sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

75. The respective trade marks are shown below:

The opponent’s marks	The applicant’s mark
<p data-bbox="311 952 710 1041">NRJ (“the opponent’s first mark”)</p>  <p data-bbox="279 1444 742 1489"> (“the opponent’s second mark”)</p>	<p data-bbox="1045 1198 1125 1243">NRG</p>

76. The opponent has provided detailed submissions as to the comparison of the marks. I do not intend to reproduce them here but will, where necessary, address them below.

Overall Impression

77. The opponent’s first mark and the applicant’s mark are word marks only that both consist of three letters, being ‘NRJ’ and ‘NRG’, respectively. As there are no other

elements that contribute to the overall impressions of the marks, their overall impressions are dominated solely by their three letters. As for the opponent's second mark, this consists of the word 'ENERGY' presented above three conjoined letters that are displayed in a red typeface. The first two letters will, in my view, clearly be seen as 'NR', however, the last letter will either be viewed as a lower case 'j' or 'i'. I make this finding on the basis that the letters are conjoined so it is not necessarily clear that the connection between the 'R' and the following letter is meant to be the tail of a letter 'j' or simply the way in which the 'R' and the 'i' are connected. Lastly, underneath the letters (but also overlaid on top of them) is a device of a black cat-like creature. Given the size and placement of the letters, I consider that they will dominate the overall impression of the mark with the word 'ENERGY' and the black cat device playing lesser roles.

Visual Comparison

78. The opponent's first mark and the applicant's mark are both made up of three letters, the first two being identical. The marks differ in the presence of their last letters, being 'J' and 'G', respectively. I appreciate that the beginnings of the marks are identical and that this is where average consumers tend to focus.¹⁶ Having said that, this point is juxtaposed with the fact that both marks are short marks. While I appreciate that there is no special test which applies to the comparison of 'short' marks,¹⁷ I am of the view that in the present case the shortness of the marks at issue means that the average consumer is more likely to notice the differences. Taking all of the above into account, I am of the view that the marks are visually similar to a medium degree.

79. I turn now to the opponent's second mark. The similarity between these marks also lies in the shared use of the letter 'NR' and, as above, the last letter of this letter string differs regardless of whether the opponent's mark is viewed as 'NRi' or 'NRj'. An additional point of difference is the way in which the three letters are displayed in the opponent's mark, being in a red, conjoined typeface. While the applicant's mark is a black and white word only mark, I do not consider that it can be displayed

¹⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

¹⁷ See paragraph 44 of *BOSCO*, BL O/301/20

in the same conjoined way. I do, however, appreciate that it can be presented in a bold red typeface. The marks differ further in the presence of the word 'ENERGY' and the cat-like device present in the opponent's mark. These elements have no counterpart in the applicant's mark. Taking all of the above into account, I am of the view that these marks are visually similar to a low degree.

Aural Comparison

80. I note that the opponent's submissions are based on the argument that the letters 'NRJ' will be pronounced as 'ENERGY'. I note that the evidence of Ms Guilloteau confirms that this is how it is pronounced in France and other EU Member States, including the UK. I intend to discuss the connection between 'NRJ' and 'ENERGY' in further detail below when considering the conceptual impacts of the marks, however, I will say here that I do not agree that 'NRJ' will be pronounced as 'ENERGY' in the UK. Put simply, this is not how UK consumers will pronounce 'NRJ' (being 'ENN-ARR-JAY') and neither is it how the UK consumer would pronounce the word 'ENERGY' (being 'EH-NUH-JEE', not 'EH-NUH-JAY').

81. The opponent's first mark and the applicant's mark both consist of three syllables that will be pronounced as their individual letters, being 'ENN-ARR-JAY' and 'ENN-ARR-JEE', respectively. The first two syllables of the marks are identical and while the last syllables are not, they are similar to a degree. Taking into account what I have said regarding the beginnings of marks but also bearing in mind the shortness of the marks at issue, I am of the view that the marks are aurally similar to between a medium and high degree.

82. Turning to the opponent's second mark, I note that the opponent's submissions make no reference to the pronunciation of the word 'ENERGY' in its second mark. Even though I have found it to play a lesser role in the overall impression of the mark, I still consider that it will be pronounced. Therefore, I find that the opponent's second mark consists of six syllables that will be pronounced as either 'EH-NUH-JEE-ENN-ARR-JAY' or 'EH-NUH-JEE-ENN-ARR-EYE' depending on whether the letters are seen as 'NRj' or 'NRi'. The applicant's mark will be pronounced as above. Aurally, I consider that there is a degree of similarity between them due to the

identity in how 'N' and 'R' are pronounced. The remaining syllables are all different (albeit I acknowledge some similarity in the pronunciation of 'j' in the opponent's second mark, if viewed that way, and 'G' in the applicant's mark) and I note that the opponent's second mark is double the length of the applicant's. Taking all of this into account, I consider that the marks are aurally similar to between a low and medium degree.

Conceptual Comparison

83. The opponent's submissions on the conceptual comparison hinge on the fact that the letters 'NRJ' in the opponent's marks will be understood as 'energy'. I see no reason why, upon being confronted with the letters 'NRJ', that the average consumer would believe that it was meant to be read as 'energy'. I appreciate that this may be the case in France (being the territory where the bulk of the opponent's evidence relates), however, the assessment I must make at present is based on the perception of the average consumer in the UK. The opponent's first mark, will, therefore, be seen simply as a three letter initialism with no obvious meaning. As for the applicant's mark, I agree that the connection to the word 'energy' will be understood by at least a significant proportion of average consumers for the services at issue. This is on the basis that the articulation of 'NRG' sounds similar to the word 'energy', thereby resulting in the consumer making such a connection. That being said, I also consider that there is a separate (but also significant) proportion of consumers that would simply see 'NRG' as an initialism with no obvious meaning. In the scenario where the consumer views 'NRG' as being connected to the word 'energy', I find that the marks are conceptually dissimilar on the basis that one mark has a graspable meaning whereas the other does not. Alternatively, for those consumers that do not see 'NRG' as being connected to the word 'energy', I find that despite both marks being initialisms, the fact that neither one carries any obvious meaning results in a conceptual neutrality between them.

84. As for the opponent's second mark as a whole, I do not consider that the average consumer will view it as carrying any immediately graspable concept. I make this finding on the basis that the three letter string will, regardless of how it is viewed, have no obvious meaning. As for the cat-like device and the word 'ENERGY', these

will have understood concepts but, in the context of the mark as a whole, I do not consider that they will be particularly striking. Even so, I consider that the word 'ENERGY' will result in a degree of similarity between the marks in circumstances where 'NRG' understood as meaning 'energy'. Having said that, I consider that any level of similarity will not be overwhelming due to the conceptual ambiguity of the opponent's second mark as a whole (being dominated by three letters with no obvious meaning). Taking all of this into account, I find that the marks are conceptually similar to a medium degree. Alternatively, in circumstances where 'NRG' is simply viewed as a three-letter initialism, I make the same finding as I have in the preceding paragraph in that the marks are conceptually neutral.

Distinctive character of the opponent's marks

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

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

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

commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

86. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. I note that, in the present case, the opponent has not submitted that its evidence shows that there is an enhanced distinctive character in its marks. Even without such, it is appropriate to consider the position in light of the fact that the opponent did file evidence of use. However, before considering the position in respect of the claim to enhanced distinctiveness, I will first consider the inherent position.

87. I have set out above that the opponent’s first mark will not be understood as being a reference to ‘energy’ and I make the same finding for the same reasons here. Instead, ‘NRJ’ will be understood simply as an initialism and while it is not allusive or descriptive of the services at issue, it is not particularly remarkable. I say this on the basis that the average consumer in the UK is used to seeing initialisms as the basis for trade marks. Overall, I consider that, inherently, the opponent’s first mark enjoys a medium degree of distinctive character. Turning to the opponent’s second mark, I find that the same finding will apply to the letters ‘NRj’ or ‘NRi’ (if that is how they are viewed). While I am of the view that, as the dominant element, the three letter string will contribute the most to the distinctiveness of the mark, I am of the view that the addition of the word ‘ENERGY’ and the use of a cat-like device will elevate the distinctiveness to an above medium degree, but not high. This is on the basis that neither additional element has any allusive or descriptive qualities in respect of the services at issue and will, instead, be seen as somewhat unusual additions with no connection to the letters ‘NRj’ (or ‘NRi’)

88. Turning to consider the position in respect of enhanced distinctiveness, I refer to the evidential summary I have provided at paragraphs 24 to 40 above. While that summary was provided in respect of the issue of genuine use, it represents my summary of the entirety of the evidence filed and I consider it is also relevant to the

present assessment I must make. I do not intend to reproduce the evidence here but note that the majority of the evidence is based on use in the EU and not the UK. I remind myself that the assessment for enhanced distinctiveness is based on the UK consumer. While the majority of the evidence was focused on the EU market, some evidence was filed in respect of use in the UK. I remind myself that this was by way of approximately 1,205,000 visits by UK users to the opponent's website, being 'NRJ.fr', and approximately 1,895,000 visits by UK users to the opponent's app. These figures are broken down for the years 2015 to 2020. The evidence also sets out that, in 2020, there was 183,223 podcasts accessed. While the figures are noted, I remind myself of the issues with this evidence as discussed above, namely that it is not clear what the visit figures are purported to show and, if intended to demonstrate the accessing of podcasts by consumers in the UK, they are inconsistent with the podcast figures. In respect of my present assessment, I am minded to treat this evidence with caution and, in my view, the only evidence I can take as sufficiently solid in pointing to the actual access of the opponent's goods or services is the podcast figures, being 183,223 in 2020. This is a very low number and covers only one year. Lastly, it certainly does not point to all of the goods/services at issue. The evidence also discusses the opponent's music awards and their presence in the UK press. Four articles are provided and I note that these include print-outs from well-known UK-wide publications.

89. Another point I wish to discuss when assessing the evidence in relation to the UK is the international evidence of the opponent, namely the evidence discussed at paragraphs 29 and 39 above. I remind myself that the evidence discussed at paragraph 29 above relates to an international audience that includes 14.8 million listeners of the opponent's radio stations, five million fans on Facebook and 10.8 million downloads of the opponent's app. However, the supporting infographic regarding this international presence does not include the UK. As such, I do not accept that this evidence includes UK use and if it was the case that it did, I consider it reasonable to expect the opponent to have filed confirmation as such. As for the evidence discussed at paragraph 39, this related to advertising figures that included figures for 'export markets'. There is nothing further by way of explanation as to what territories are covered by the 'export markets' and in the context of the evidence as a whole, I see no reason why I should conclude that this

covers the UK. Again, I consider it reasonable to expect that if it related to the UK, evidence should have been filed confirming as such.

90. Taking all of the evidence into account, I accept that the opponent has demonstrated that it does have some presence in the UK, however, it is far from demonstrative of a widespread knowledge of the marks at issue. As a result, I do not consider that it is sufficient in demonstrating that the distinctiveness of the opponent's marks have been enhanced to any degree in the UK. As a result, the position in respect of the distinctiveness of the opponent's marks is that of their inherent positions which, as above, are that the opponent's first mark is distinctive to a medium degree and the opponent's second mark is distinctive to an above medium (but not high) degree.

Likelihood of confusion

91. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

92. I have found the parties' services to range from being identical to similar to a low degree. I have found that the average consumer for the services at issue is made up of members of the general public at large and business users who will select

the goods through primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will, for the most part, pay a medium degree of attention when selecting the services at issue. However, for services such as radio entertainment, this may extend to low for some consumers. In regard to the similarity of the marks, I have found the applicant's mark to be visually similar to a medium degree, aurally similar to between a medium and high degree and conceptually dissimilar or neutral (depending on whether the connection of 'NRG' to 'energy' is made) with the opponent's first mark. I have also found the applicant's mark to be visually similar to a low degree, aurally similar to between a low and medium degree and conceptually similar to a medium degree or conceptually neutral (again, depending on whether the connection of 'NRG' to 'energy' is made) with the opponent's second mark. I have found that the opponent's first mark is inherently distinctive to a medium degree and that its second mark is inherently distinctive to an above medium (but not high) degree.

93. The opponent has filed submissions in respect of the existence of a likelihood of confusion. I do not intend to reproduce those in full but note that, generally, the opponent's position in respect of a likelihood of direct confusion is that the marks at issue are highly similar and that it is very likely that average consumers would mistake them for one another when used in relation to identical or highly similar services.

94. Despite sharing a three-letter string, the opponent's marks are quite different stylistically and I consider it appropriate to first deal with direct confusion in respect of the opponent's first mark before moving to consider its second. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I do not consider that the marks would be mistaken or misremembered for one another. I appreciate that 'NRJ' and 'NRG' are similar in that they share their first two letters. However, as I have discussed above, both marks are short and I consider that the differences will be noticed. I make this finding regardless of the position of the differences being at the end of the marks. On this point, I remind myself that it is not always the case that similar beginnings are important or

decisive.¹⁸ Further, as I have set out above, the concept of 'NRG' will, to some average consumers, be understood as meaning 'energy'. I do not consider that the same will apply to 'NRJ' and, instead, the opponent's mark will be distinctly understood as an initialism with no obvious meaning. In respect of this position, I remind myself of the case of *The Picasso Estate v OHIM*, Case C-361/04 P wherein the CJEU found that conceptual differences may counteract visual and aural similarities and I find that to be the case here in that the different concepts will help bring the visual and aural points of difference to the mind of the consumer. Alternatively, in circumstances where both marks are seen as initialisms with no obvious meanings, there will be no shared conceptual hook. While no conceptual comparison can be made between the marks in this scenario, this does not prevent the fact that the consumer would immediately recognise them as being two different three-letter initialisms, thereby assisting the average consumer in accurately recalling and remembering which mark was which. Consequently, I consider that there is no likelihood of direct confusion between the applicant's mark and the opponent's first mark. I find that this applies even when the marks are viewed on identical services and in circumstances where the services are selected via a low degree of attention.

95. Turning to the position in respect of the opponent's second mark, I first note the stark differences between it and the opponent's first mark, particularly from a visual perspective. While I have found that these differences play lesser roles in the opponent's second mark, they will be noticed and will, in my view, create further points of difference between this mark and the applicant's mark and they will not go overlooked. While I appreciate that the conceptual difference discussed above does not apply here on the basis that I found these marks to be conceptually similar to a medium degree (in the scenario where 'NRG' is understood as meaning 'energy'), I do not consider that this furthers the opponent's position. This is on the basis that regardless of their presentation, the differences in the letters 'NRG' and 'NRj' (or 'NRi' if it is viewed that way) will still be noticed and used by the average consumer as points to accurately recall or remember the marks accordingly, regardless of the allusion to the concept of 'ENERGY' in the opponent's second

¹⁸ *CureVac GmbH v OHIM*, T-80/08

mark. Alternatively, in circumstances where these marks are conceptually neutral, the same finding applies as above in that there is no shared conceptual hook that links these marks. Taking the principles of imperfect recollection and interdependency into account, I do not consider that the average consumer would forget or misremember the differences between the marks. Consequently, I find that there is no likelihood of direct confusion between the applicant's mark and the opponent's second mark. As was the case above, this finding applies even when the marks are viewed on identical services and in circumstances where the services are selected via a low degree of attention.

96. I turn now to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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.).

(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)".

97. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 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". Arnold LJ agreed, pointing out 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.

98. In respect of indirect confusion, I will adopt the same approach as I have above in that I will address the opponent's first mark first before moving to consider its second. I have found above that the differences between 'NRJ' and 'NRG' would not be overlooked. Upon the differences being noticed, I see no reason as to why the average consumer would consider that the marks originate from the same or economically linked undertakings. The distinctive character of the opponent's mark lies in the letters 'NRJ' and the shared use of two letters, being 'NR', is not so strikingly distinctive that the average consumer that only one undertaking would use it. Further, I do not consider that the alteration of 'J' to 'G' (or vice versa, for that matter) would be seen as a change that one would expect to find in a sub-brand or brand extension and I have nothing before me to suggest otherwise. Lastly, the differences between the marks result in either different or neutral concepts (depending on whether the consumer makes a connection of 'NRG' to

'energy' in the applicant's mark) and I do not consider that the relevant average consumer, upon either noticing the conceptual dissimilarity or neutrality, would believe that one mark is entirely logical and consistent with a brand extension of the other, or vice versa. While I appreciate that the categories set out in *L.A. Sugar* (cited above) are not exhaustive, I see no reason that gives rise to any other scenario wherein a likelihood of indirect confusion would exist. Taking all of this into account, I am of the view that there is no likelihood of indirect confusion between the applicant's mark and the opponent's first mark. I find that this applies even when the marks are viewed on identical services and in circumstances where the services are selected via a low degree of attention.

99. I appreciate that the additional differences (being the word 'ENERGY', the cat-like device and the stylisation elements) may, on their own, be considered as elements that give rise to a likelihood of indirect confusion in that they may be viewed as non-distinct elements consistent with re-brands, sub-brands, brand extensions or alternative marks of the same or economically linked undertakings. However, to make such a finding in the present case, I would need to be satisfied that 'NRG' and 'NRj' (or 'NRi') would be overlooked for one another. I do not consider that this would be the case and rely on the same reasons as discussed when considering direct confusion above. The dominant element of the opponent's second mark is the three letter string (be that viewed as 'NRj' or 'NRi') and I see no reason why, upon noticing the differences between this and 'NRG', the average consumer would consider it likely that the marks originate from the same or economically linked undertakings. Consequently, I find that there is no likelihood of indirect confusion between the applicant's mark and the opponent's second mark. As was the case above, this finding applies even when the marks are viewed on identical services and in circumstances where the services are selected via a low degree of attention.

100. As a result of the above, the opposition reliant upon the 5(2)(b) ground fails. I will now proceed to consider the 5(3) ground.

Section 5(3)

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

“5(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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

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

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

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

103. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the opponent must also show that its registration has achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

104. The relevant date for the assessment under section 5(3) is the priority date of the applicant's mark, being 9 September 2020.

Reputation

105. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market

share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

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

106. Under its 5(3) ground, the opponent relies on the same marks as it did under its 5(2)(b) ground. While the opponent claims to have obtained a reputation in the same set of services of its first mark that were relied upon under that ground, it relies on a more limited range of goods and services in respect of its second mark. The relied upon goods and services are underlined in the Annex to this decision.

107. Before proceeding, it is necessary to point out that the opponent's marks are comparable marks based on pre-existing EUTMs and that the relevant date for this assessment is 9 September 2020 which is prior to IP Completion Day (being 31 December 2020). As a result, EU use is relevant to the entirety of the assessment of the existence of a reputation.

108. I have produced a summary of the opponent's evidence at paragraphs 24 to 40 above. While this evidence was focused on the issue of genuine use of the opponent's first mark, it represents the entirety of the evidence filed and is relevant to the issue of reputation also. While the opponent's second mark was not subject to the proof of use assessment, I am satisfied that the evidence covers use of the opponent's second mark also on the basis that Ms Guilloteau has confirmed that, in some countries, it is the opponent's second mark that is typically used. I do not intend to reproduce the evidence summary here but remind myself of the following particular points that are relevant to the overall assessment of reputation. The opponent's main business appears to be focused on France and, since 1981, it has offered radio stations in France and from the late 1980s/early 1990s, this expanded to several countries across the EU but I note that it does not include the UK. Turnover in respect of the overall business of the opponent between 2016 and

2020 stood at over €1.8 billion. This clearly represents the operation of a very large business across the relevant territory, being the EU. Taking the evidence as a whole, I am satisfied that it demonstrates that the opponent, as at the relevant date, had a fairly sizeable reputation across the EU in respect of both of its marks. For reasons that I will come to discuss when considering link below, I do not consider it necessary to labour over the specific goods and services for which the opponent's marks enjoy a reputation.

Link

109. As above, I am content to conclude that the opponent's marks enjoy a sizeable reputation in the EU. However, the evidence in respect of the UK market is limited. While reputation across the EU is relevant to the above assessment, a link must be made by consumers in the relevant territory in which the applicant's mark now seeks protection, being the UK.

110. On this point, I remind myself of the case of *Iron & Smith kft v Unilever NV*, Case C-125/14, wherein the CJEU held that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

111. It is apparent from the court's judgment that “*a commercially significant part of the [relevant] public*” is intended to cover a lesser, but still significant, degree of recognition of the EUTM in the Member State where the same or a similar trade mark has been applied for by a third party. This is confirmed by versions of the

judgment in other languages. The French version says that a “*commercially non-negligible*” part of the relevant public in the Member State must be aware of the earlier CTM (now: EUTM) and make a link with the later national trade mark.

112. It follows that where there is no awareness of the EU trade mark (as it would have been at that time as the relevant date fell prior to the end of IP Completion Day) in the UK, or only a negligible level of awareness of it, the relevant UK public will not make the necessary ‘link’ between the marks at issue. Consequently, the use of the national mark will not take unfair advantage of, or be detrimental to, the EU reputation and/or the distinctive character of the EU trade mark. In the present case, I remind myself that the UK evidence only shows that approximately 1,205,000 users in the UK accessed the opponent’s French website and that approximately 1,895,000 users accessed the opponent’s app between 2015 and 2020. In addition, I note that there were 183,223 podcasts accessed. I remind myself of the issues and potential inconsistencies with these figures but, in any event, even at its highest, this evidence is very limited. While I accept the presence of consumers in the UK that have accessed the opponent’s services, I do not consider that these figures are sufficient enough to point to a level of understanding across a commercially significant (or non-negligible) part of the relevant public. I also note that the opponent’s evidence shows that the opponent’s awards show has appeared in the UK press. However, I am of the view that the coverage is far from extensive and while it comes from well-known UK publications, it only covers four articles over four years in the UK, all of which are posted around the same date each year. Lastly, I remind myself of what I have said at paragraph 89 above in respect of the vague and imprecise international or ‘export market’ evidence in that I am unwilling to infer that it relates to the UK. I do not consider that the opponent’s evidence is such that it points to the fact that average consumers in the UK will have any awareness of the opponent’s use of its marks whatsoever

113. Taking the opponent’s evidence of UK use into account, I do not consider that the opponent has demonstrated that a commercially significant part of the relevant public in the UK would make a link between the opponent’s marks and the applicant’s mark. Even if I am wrong on this point, it will, at best, be only a negligible level of awareness and, as above, this is not sufficient to conclude that there exists

a link between the marks. For the avoidance of doubt, I have reached this conclusion regardless of the size of the reputation in the EU. Without the existence of any link between the marks, there can be no damage under the present ground. As a result, the 5(3) ground fails in its entirety.

CONCLUSION

114. The opposition has failed in its entirety and the applicant's mark may, therefore, proceed to registration for all services applied for.

COSTS

115. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While the applicant did not file evidence, it was required to consider the evidence filed by the opponent. I note that the opponent's evidence was extensive and covered two separate witness statements. I, therefore, consider it appropriate to make a costs award in respect of the evidence rounds. In the circumstances, I award the applicant the sum of **£700** as a contribution towards its costs. The sum is calculated as follows:

Considering the notice of opposition and filing a counterstatement:	£200
Considering the opponent's evidence:	£500
Total:	£700

116. I hereby order NRJ Group Societe Anonyme de droit francais to pay Hard Carry Gaming, Inc. the sum of £700. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 5th day of April 2023

A COOPER
For the Registrar

ANNEX

Class 9

Photographic, cinematographic apparatus and instruments; Apparatus and carriers for recording, storage, broadcasting, recovery, transmission or reproduction of sounds, images, texts, information, data and computer code; Computer peripheral devices, integrated circuit cards (smart cards) and computer, telematic, multimedia and telephone terminals, in particular for global communication networks (the internet); Modems; Audio visual apparatus and instruments; Television apparatus; Tape-recorders; Video recorders; Radios; Video projectors; Recording substrates [magnetic]; Phonograph records; Digital recording media; mobile applications; Downloadable digital music; Electronic publications, downloadable; Exposed films; Videotapes; Video game cartridges; Audio and video tapes; Discs (Compact -) [audio-video]; Music, sound, image, text, signal, information and data files downloadable online via telecommunications networks (the internet); Apparatus for games adapted for use with television receivers only; Computer software; Game software, recorded; Data processing apparatus; Computers; Electric and electronic communications and telecommunications, paging, radiotelephone and teaching apparatus and instruments; Telephones, including mobile telephones; Radio pagers; Telecommunications apparatus and instruments; Communications apparatus and equipment; Electronic notebooks; Computer programs for accessing, browsing and researching online databases; Internet appliances (computer software); Data processing equipment, namely for processing written text, images, speech and data; Satellite transmission installations, Equipment for radio relay systems, Telephony and telegraphy multiplexers, terrestrial and space networks; Cable networks, Local area networks, Systems for terminating telecommunications lines; Radiotelephones, Answering machines, Telephone recorders; Radiotelephones; Cellular telephone relays; Batteries, electric, Headphones, chargers for cellular phones, Cases adapted for mobile phones; Cases and parts of cases for mobile phones; Spectacles, sunglasses, spectacle frames, spectacle cases, spectacle glasses, optical goods.

Class 16

Paper and cardboard (untreated, semi-finished or for stationery or printing); Cardboard containers; Printed matter; Books; Picture books; Comic books; Drawings;

Newspapers; Magazines [periodicals]; Journals; Periodicals; Prints [engravings]; Tickets; Placards of paper or cardboard; Posters; Postcards; Almanacs; Pamphlets; Catalogues; Calendars; Visiting cards; Rub down transfers; Signboards of paper or cardboard; Bookbinding material; Photographs; Stationery; Envelopes [stationery]; Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Pencil sharpeners; Paper cutters; Writing instruments; Rubber erasers; Files [office requisites]; Agendas (office requisites); Folders for papers; Scrapbooks; Drawing boards; Note pads; Desk pads; Instructional and teaching material (except apparatus); Printers' type; Printing blocks; Drawing sets; Plastic materials for packaging in the form of bags; Sachets and Envelopes; Wrapping paper.

Class 25

Clothing; Footwear [excluding orthopedic footwear]; Headgear; Suspenders; Belts [clothing]; Gloves [clothing]; Neckties; Scarves; Caps [headwear]; Caps [headwear].

Class 35

Advertising; Online and mail order advertising; Dissemination of advertising matter; Public relations services; Computerised file management, namely management of advertising or informative media (advertising management); Advertising sponsorship; Rental of advertising space; Radio and television advertising; Direct mail advertising; Newspaper subscription services for others; Organization of exhibitions for commercial or advertising purposes; Advertising management; Collating and systematic ordering of data, music, sound, images, text, signals, information in a master file.

Class 38

Telecommunications; Broadcasting of radio and television programmes; Diffusion of radio and television programs; Electronic transmission of data, images, sound, videos and documents; Dissemination of music, sound, images, text, signals, information and codes by means of computer terminals and other transmission systems of all kinds such as waves, cables, satellites, the Internet; Transmission of electronic mail; Connection and access to electronic communications networks, for the transmission or reception of data, sounds, music, videos and multimedia documents; Paging

services [radio, telephone or other means of electronic communication]; Rental of telecommunication equipment, Communication by computer terminals; Communications by cellular phones; Provision of telecommunication access to video and audio content provided via an online video-on-demand service; Streaming of audio and video content on the Internet; News agencies.

Class 41

Entertainment; Education; Providing of training; Radio entertainment; Television entertainment; Entertainment via computer or other means of dissemination; Game services provided on-line from a computer network; Sporting and cultural activities; Entertainer services; Production of radio and television; production of radio and television programmes; Recording studios; Orchestra and music hall services; Theater productions; Production, organisation and presentation of live performances; Organisation, production, presentation and conducting of tournaments, festivals, music concerts and musical and cultural events and performances; Production of radio and television programmes; Publication of books, magazines and newspapers; Film production services; Arranging of competitions for education or entertainment; Arranging and conducting of conferences, colloquiums and congresses; Organization of exhibitions for cultural or educational purposes; Nightclub and discotheque services (entertainment); Online publication on computer networks of radio and television programmes; Entertainment club services, including club services provided online on a computer network; Lending of books, artist agencies, rental of films, phonographic recordings, cinema projection apparatus and accessories, stage scenery; Providing on-line music, not downloadable; Providing on-line electronic publications, not downloadable; Organisation of awards ceremonies in relation to education and entertainment; Disc jockey services; Production and editing of music and video recordings.