

O/0360/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003603290
BY CLASSIC ROCK BROADCASTING LIMITED T/A RADIO NOVA
TO REGISTER THE FOLLOWING TRADE MARK:



(SERIES OF 2)

IN CLASS 38

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 426883
BY LAWRENCE JOHN

BACKGROUND AND PLEADINGS

1. On 2 March 2021, Classic Rock Broadcasting Limited t/a Radio Nova (“the applicant”) applied to register the series of 2 trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 18 June 2021 and registration is sought for the following services:

Class 38 Telecommunications; broadcasting services; broadcasting or transmission of audio, visual and audio visual programmes; transmission of information by electronic means; delivery of digital music, pictures, videos, clips and news by telecommunications and other digital communications networks.

2. On 15 September 2021, Mr Lawrence John (“the opponent”) opposed the application based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Under section 5(1) and 5(2)(a), the opponent relies upon the following trade mark:

Radio Nova International

UKTM no. 3566300

Filing date 10 December 2020; registration date 16 July 2021

Relying upon all services for which the mark is registered, namely:

Class 38 Radio broadcasting via an online not-for-profit tribute radio station.

Limitation: The rights conferred are limited to services provided only in Northern Ireland.

3. Under section 5(2)(b), the opponent sought to rely upon the above trade mark and the following trade mark:



UKTM no. 3619649

Filing date 31 March 2021; registration date 6 August 2021

Relying upon all goods for which the mark is registered, namely:

Class 25 T-shirts; sweat shirts; caps.

4. The applicant filed a counterstatement denying the claims made.

5. Only the opponent filed evidence. A hearing took place before me on 1 March 2023, by video conference. The applicant was represented by Mr Paul Kelly of FR Kelly and the opponent represented himself. Mr Kelly filed a skeleton argument in advance of the hearing.

EVIDENCE

6. The opponent filed evidence in the form of his own witness statement dated 16 August 2022, which is accompanied by 3 exhibits.

7. I have taken the evidence into account in reaching this decision.

PRELIMINARY ISSUES

The earlier marks

8. As noted above, the opponent sought to rely upon two earlier marks under section 5(2)(b): 1) a word-only mark and 2) a logo mark. The filing date of the logo mark is 31 March 2021. This is after the filing date of the application in issue. I explained to the opponent at the hearing that, as a result of this, the logo mark could not be relied upon as an earlier mark by virtue of section 6 of the Act. In any event, I noted that the goods for which that mark were registered were unlikely to be found similar to the applicant's services and, consequently, it would not have put the opponent in any stronger position.

9. Consequently, the opposition proceeds only on the basis of the word-only mark (no. 3566300).

Application to file further evidence

10. The night before the hearing, the opponent filed a letter sent by a previous representative of the applicant in these proceedings to the opponent. The letter was essentially a letter before action, notifying the opponent that the applicant was considering seeking injunctive relief in the High Court, due to the opponent's "widespread use of [the applicant's] business name and similar logo".

11. The opponent sought to rely upon this document because, he stated, the applicant had changed its position in its skeleton argument by stating that it did not consider the marks in issue to be similar.

12. I heard submissions from both the opponent and Mr Kelly on the point and took these submissions into account in making my decision.

13. The factors to be considered in determining an application to file late evidence were considered in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) and are:

- a) The materiality of the evidence in question to the issues that the Registrar has to determine;
- b) The justice and fairness of subjecting the opposite party to the burden of the evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;
- c) Whether the admission of the further evidence would prejudice the opposite party in ways that cannot be compensated for in costs (e.g. excessive delays); and
- d) The fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence.

14. The opponent submitted that the letter had two key points of relevance. Firstly, it showed that the applicant accepted that the marks were similar. Secondly, the opponent points to a particular part of the letter which, referring to the opponent's Facebook posts containing the logo in question, stated:

“These posts use a logo and branding that are so similar to our client's business name, logo and branding that, by way of example, one of the directors of the [applicant] saw one of these posts online and believed that the post was from the [applicant].”

The opponent submitted that, if a director of the applicant could find the marks confusingly similar, then so would members of the general public.

15. However, as noted above, it is only the opponent's word-only mark that can be considered for the purposes of these proceedings. Any similarities created by a logo mark used by the opponent cannot be taken into account. Given this lack of materiality, I do not consider that any significant prejudice will be suffered by the opponent as a result of me refusing the request.

16. The request was clearly made at a very late stage in proceedings. I also note that the applicant stated in its TM8:

“[...] The Trade Mark of the Applicant is not identical to or confusingly similar to either of the rights relied upon by the Opponent. The differences between the respective Trade Marks are such that they can be distinguished visually, aurally and conceptually such that there would be no likelihood of confusion.”

The position as set out in Mr Kelly's skeleton argument is not different, in my view, from the statement set out above. Consequently, the opponent should have been aware that the similarity of the marks was in issue and could have filed the letter during the evidence rounds if he wished to rely upon it.

17. As a result, I refused the request to file further evidence.

Motivations of the applicant

18. The opponent has made various comments regarding the motivations of the applicant in applying for this trade mark. Mr John stated in his evidence that the application had been made in bad faith. However, as this opposition is brought under sections 5(1) and 5(2) only, the applicant's conduct in applying for the trade mark is irrelevant. Consequently, I do not need to consider these submissions any further.

Authorities referenced by the opponent

19. At the hearing, Mr John cited several authorities that he wanted me to consider in reaching my decision. These were cases concerning various marks (other than those the subject of these proceedings) that this Tribunal has found to be confusingly similar. Mr Kelly took issue with Mr John raising these at the hearing, because he had not had the opportunity to review them in advance. Ultimately, the fact that the Tribunal found confusion in respect of marks that are different to those in these proceedings does not assist Mr John. Consequently, I need consider the authorities referred to no further in any event.

RELEVANCE OF EU LAW

20. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

Section 5(1) and 5(2)(a)

21. Section 5(1) of the Act reads as follows:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

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

“A trade mark shall not be registered if because –

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

(b) [...]

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

23. As it is a prerequisite of sections 5(1) and 5(2)(a) that the marks be identical, it is convenient to begin by assessing this point. The respective marks are shown below:

The opponent’s trade mark	The applicant’s trade mark
Radio Nova International	

24. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

25. Clearly, Mr John considers the marks to be identical. Mr Kelly submitted that they are not identical and that the 5(1) and 5(2)(a) grounds should be dismissed. The opponent’s trade mark is a word-only mark and could, therefore, be used in any standard typeface or colour. Consequently, I do not consider that the use in different fonts and colours is important. However, I do not consider that the additional word ‘International’ in the opponent’s mark would go unnoticed by the average consumer. Consequently, I do not consider the marks to be identical.

26. For that reason, the oppositions based upon sections 5(1) and 5(2)(a) must fail.

Section 5(2)(b)

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

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

(a)...

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

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

29. 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 OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of trade marks

30. It is clear from *Sabel BV 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. 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.”

31. 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 of the marks which are not negligible and therefore contribute to the overall impressions created by the trade marks.

32. The respective trade marks are replicated below, for ease of reference:

The opponent’s trade mark	The applicant’s trade mark
Radio Nova International	

Overall Impression

33. The opponent’s trade mark consists of the words RADIO NOVA INTERNATIONAL, presented in title case. The overall impression lies in the combination of these words. I bear in mind that the words RADIO and INTERNATIONAL are likely to be seen as descriptive for these services.

34. The applicant’s trade marks consist of the words RADIO NOVA presented in a stylised font, with a star device positioned above the V. I do not consider that the use in colour/black and white will have any impact and so the same comparison applies to both. The word NOVA plays a greater role in the overall impression due to its size.

The word RADIO plays a lesser role, as will the star device. I bear in mind that the word RADIO is likely to be seen as descriptive for these services.

Visual Comparison

35. The marks clearly overlap in the presence of the words RADIO NOVA. The additional word INTERNATIONAL in the opponent's mark acts as a point of difference, as does the star device in the applicant's marks. Consequently, I consider the marks to be visually similar to between a medium and high degree.

Aural Comparison

36. The words RADIO NOVA will be pronounced identically in the marks. The word INTERNATIONAL in the opponent's mark will act as a point of aural difference. Mr Kelly submitted at the hearing that some consumers may articulate the star device in the applicant's marks. I disagree; in my view, it is unlikely that the average consumer will articulate anything other than the words. Consequently, I consider the marks to be aurally highly similar.

Conceptual Comparison

37. The word RADIO will have the same meaning in the marks. The word NOVA may be seen as a reference to a type of star or may be seen as invented. However, in either case, the position will be the same for both parties' marks. The word INTERNATIONAL in the opponent's mark acts as a point of conceptual difference. The star device will either reinforce the meaning of the word NOVA or will be attributed very little in terms of conceptual messaging, other than the fact that it is a star. Taking all of this into account, I consider the marks to be conceptually similar to between a medium and high degree.

Comparison of services

38. The competing services are as follows:

Opponent's services	Applicant's services
<p data-bbox="204 253 336 286"><u>Class 38</u></p> <p data-bbox="204 309 785 398">Radio broadcasting via an online not-for-profit tribute radio station.</p>	<p data-bbox="809 253 941 286"><u>Class 38</u></p> <p data-bbox="809 309 1390 734">Telecommunications; broadcasting services; broadcasting or transmission of audio, visual and audio visual programmes; transmission of information by electronic means; delivery of digital music, pictures, videos, clips and news by telecommunications and other digital communications networks.</p>

39. When making the comparison, all relevant factors relating to the 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.”

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

41. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

Broadcasting services; broadcasting or transmission of audio, visual and audio visual programmes;

42. In my view, these services are identical on the principle outlined in *Meric* to the opponent’s services. To the extent that the applicant’s broadcasting services cover services wider than those of the opponent, there is still potential for there to be an overlap in purpose, trade channels, user, nature and method of use. There is potential for competition. Consequently, I consider the services to be highly similar.

Telecommunications; transmission of information by electronic means; delivery of digital music, pictures, videos, clips and news by telecommunications and other digital communications networks.

43. Whilst these services may not be identical to those of the opponent, they are likely to overlap in purpose and user with the opponent's services. I also consider it possible that there could be an overlap in method of use and nature. I have no evidence as to whether there would be an overlap in trade channels. However, it seems reasonable to me that there could be competition. Consequently, I consider these services to be similar to between a medium and high degree.

The average consumer and the nature of the purchasing act

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

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

45. The average consumer for the services will be a member of the general public. The opponent submits that a high level of attention will be paid during the purchasing process. I disagree. The services are unlikely to be particularly costly or highly considered purchases. I accept that the average consumer is likely to take factors such as type of music, method of transmission and hosts into account. However, in my view, this is likely to result in a medium degree of attention being paid during the purchasing process.

46. The services are likely to be selected following perusal of signage on advertisements, websites or apps (depending upon how the services are accessed). However, I recognise that some selections may be made aurally. Consequently, I consider that visual and aural considerations both play an important role.

Distinctive character of the earlier trade mark

47. 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-2779, paragraph 49).

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

48. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words

which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

49. As noted above, the opponent filed evidence. The evidence relates to his use of the earlier mark. However, the evidence filed is of limited assistance. For example, I have no information about listener numbers, advertising expenditure or market share. Consequently, I am not satisfied that there is any enhanced distinctive character. As a result, I have only the inherent position to consider. The word NOVA, as noted above, is likely to be viewed as an invented word or a reference to a type of star. The words RADIO and INTERNATIONAL will be seen as descriptive. Taking the mark as a whole, I consider it to be inherently distinctive to at least a medium degree.

Likelihood of confusion

50. 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 the trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

51. I have found as follows:

- a) The services are either identical, highly similar or similar to between a medium and high degree;

- b) The average consumer will be a member of the general public who will pay a medium degree of attention;
- c) The purchasing process will be both visual and aural;
- d) The marks are visually and conceptually similar to between a medium and high degree and are aurally highly similar;
- e) The earlier mark is distinctive to at least a medium degree.

52. Bearing in mind the similarities between the marks and the services, it is my view that there is potential for direct confusion. I consider it likely that the average consumer will misremember the INTERNATIONAL element of the opponent's mark because it is descriptive and will overlook the star device in the applicant's mark. Even if these differences are recognised, the average consumer is likely to view the additional word INTERNATIONAL as simply a reference to the fact that the same undertaking is now offering a global service and the star device will simply be seen as an alternative version of the same mark. Consequently, I also consider there to be indirect confusion.

53. I have considered Mr Kelly's submission that, if I find confusion, the applicant should still be able to retain its mark for the UK (except Northern Ireland) due to the limitation on the opponent's mark. However, the nature of the services for which the opponent's mark is registered are such that, whilst those services may be provided in Northern Ireland, there is nothing to prevent the opponent's customer base from extending to the rest of the UK. Indeed, it is the opponent's unchallenged evidence that that is, in fact, the case. Consequently, I do not consider that the proposed limitation would assist the applicant.

54. I have also considered the submission made by Mr Kelly at the hearing that the applicant's services are broader than those of the opponent and, therefore, there would only be an overlap to a limited extent. However, no attempt has been made by the applicant to put forward an alternative specification for consideration by the Tribunal. I also note that both parties are, in fact, providing radio services. Further, given the similarities between the marks, it is not clear to me how I could limit the

applicant's proposed specification to put the services far enough away from each other to avoid confusion arising. Even those services which are not radio services (such as the broad term telecommunications, or other types of broadcasting services) are similar enough for confusion to arise, particularly when taking into account the interdependency principle. Consequently, I do not consider that this submission assists the applicant.

CONCLUSION

55. The opposition is successful, and the application is refused in its entirety.

COSTS

56. The opponent has been successful and would ordinarily be entitled to a contribution towards his costs. However, at the hearing, the opponent confirmed that he did not intend to claim costs in the event that he was successful.

57. Consequently, I make no order as to costs.

Dated this 13th day of April 2023

S WILSON

For the Registrar