

BL O/0542/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3758341

BY

RKO PICTURES, INC.

TO REGISTER THE TRADE MARK:

SUSPICION

IN CLASSES 9 AND 41

-AND-

THE OPPOSITION THERETO UNDER No. 434409

BY

KESHET PRODUCTIONS UK LIMITED

Background and pleadings

1. RKO Pictures, Inc. (“**the Applicant**”) applied to register the trade mark ‘SUSPICION’ (“**the Contested Mark**”) in the UK on 23 February 2022. It was accepted and published in the Trade Marks Journal on 18 March 2022 in respect of the following goods and services:

Class 9

Video recordings; Audio-video recordings; Motion pictures; Pre-recorded digital video discs, compact discs, featuring motion picture films covering a wide variety of entertainment themes, namely, comedy and drama; Series of television recordings; Pre-recorded digital video discs, compact discs, featuring a television series covering a wide variety of entertainment themes, namely, comedy and drama; Digital media, namely downloadable media content in the fields of entertainment, television, and film; Digital media, namely, downloadable audio-visual media content in the fields of entertainment, television, and film; Digital media, namely downloadable media content in the fields of entertainment, films, television, and videos; Downloadable podcasts in the field of entertainment, film, television, and theater.

Class 41

Entertainment services in the nature of development, creation, production, distribution, and post-production of motion pictures; Film production; Entertainment services in the nature of development, creation, production, distribution, and post-production of motion pictures; Film production; Television production; Multimedia entertainment services in the nature of development, production and post-production services in the fields of video, television, and films; Live theater performances; Live musical theater performances; Entertainment services in the nature of development, creation, and production of live theater performances; Production of podcasts; Providing non-downloadable podcasts in the field of entertainment, film, television, and theatre.

2. Keshet Productions UK Limited (“**the Opponent**”) opposes the application on the basis of section 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“**the Act**”). The opposition is directed at all the applied-for goods and services.
3. The Opponent relies on its UK trade mark, ‘SUSPICION’ (“**the Earlier Mark**”), details of which are shown below:¹

Registration Number:	3526527
Filing date:	25 August 2020
Registration Date:	11 December 2020

4. The Earlier Mark is registered in respect of the following goods and services in Classes 9 and 41, all of which are relied upon by the Opponent for the purposes of this opposition:

Class 9

Audio and video recordings featuring a dramatic television series; downloadable dramatic television shows; digital and multimedia productions in the nature of sound and video recordings featuring drama; downloadable television films and programs featuring drama; pre-recorded audio and/or video media in the nature of DVDs, HD video discs, 3D video discs, audio mini-discs, phonograph records, audio tapes, audio cassettes, discs and flash drives, all featuring drama; downloadable multimedia files in the nature of audio, image, data and video files provided from the Internet, relating to drama; downloadable multimedia files in the nature of digital video and image files relating to television programs, provided from the Internet; Downloadable multimedia files featuring text, audio and artwork transmitted by electrical or electronic means, featuring content related to television programs.

¹ Given the respective filing dates, the Opponent’s mark is an earlier trade mark in accordance with section 6 of the Act.

Class 41

Entertainment services in the nature of an ongoing dramatic television series;
production and distribution of an ongoing dramatic television series.

5. The Opponent claims that the respective marks are identical and that, the services covered by its earlier mark are identical (as per its section 5(1) claim) or similar (as per its section 5(2)(a) claim) to all the goods and services applied for; and under its section 5(2)(a) claim, that the identity of the marks and the similarity of the goods and services gives rise to a likelihood of confusion.
6. The Applicant filed a counterstatement neither denying nor admitting the claims made, rather, the Applicant stated that it *“admits the existence of the earlier UK trade mark registration”* but it *“makes no admission as to the validity of such, nor to its relevance”*; and put the Opponent to *“strict proof of the allegations”* and *“to strict proof that the provisions of sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 apply”*.
7. In its submissions, dated 3 February 2023, the Applicant states that it denies that the application is contrary to section 5 of the Act and makes submissions in relation to a selection (as opposed to all) of the applied-for services in Class 41, insofar as it submits that those select few are not similar to the Opponent’s Class 41 specification. The Applicant made no submissions in relation to the remainder of the applied-for goods and services.
8. Neither party filed evidence and only the Applicant elected to file submissions during the evidence rounds. No hearing was requested and only the Opponent elected to file submissions in lieu of a hearing. I make this decision following a careful consideration of the papers.
9. In these proceedings, the Opponent is represented by Osborne Clarke LLP and the Applicant is represented by Foot Anstey LLP.
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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

Approach

11. The marks themselves are self-evidently identical - visually, aurally and conceptually. Since there is no requirement to consider a likelihood of confusion under a section 5(1) claim, I shall first consider whether any or all of the goods and services are identical. Then, if necessary, I shall move on to considering the claim under section 5(2)(a).

DECISION

Legislation and Case Law

12. Sections 5(1), 5(2)(a) and 5(A) of the Act are as follows:

“5(1) 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.”

“5(2) 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, [...]

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

“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.”

13. In considering a claim under section 5(2)(a) of the Act, I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:
- (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

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*,² (“**Meric**”), the General Court held to the effect that goods and services can be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

15. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

- (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification
- (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

16. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:³

- (1) the physical nature of the goods or acts of service;
- (2) their intended purpose;
- (3) their method of use / uses;
- (4) who the users of the goods and services are;
- (5) the trade channels through which the goods or services reach the market;
- (6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (7) whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors)

or

- (8) whether they are complementary to each other. Complementary means *“there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the*

3 See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

same undertaking".⁴ I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.⁵ Complementarity can be clearly distinguished from 'use in combination' the latter being where goods/services are merely used together, whether by choice or convenience (e.g. bread and butter; or wine and wine glasses⁶), this means that they are not essential for each other.

17. When interpreting the terms in a specification I bear in mind:

- (1) that it is *"necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise"*, although *"where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods [and services] in question"*,⁷
- (2) where *"the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services"*,⁸
- (3) the following applicable principles of interpretation:

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

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

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

5 *Kurt Hesse v OHIM*, Case C-50/15 P

6 As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13 - *"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."*

7 *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

8 *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

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

(4) A term which cannot be interpreted is to be disregarded.”⁹

18. For the purposes of making a comparison, the goods and services can be grouped together where the same reasoning applies.¹⁰

19. The goods and services to be compared are set out below:¹¹

Earlier Mark	Contested Mark
<p><u>Class 9</u></p> <p>Audio and video recordings featuring a dramatic television series; downloadable dramatic television shows; digital and multimedia productions in the nature of sound and video recordings featuring drama; downloadable television films and programs featuring drama; pre-recorded audio and/or video media in the nature of DVDs, HD video discs, 3D video discs, audio mini-discs, phonograph records, audio tapes, audio cassettes, discs and flash drives, all featuring drama; downloadable multimedia files in the nature of audio, image, data and video files provided from the Internet, relating to drama; downloadable multimedia files in the nature of digital video and image files relating to television programs, provided from the Internet; Downloadable multimedia files featuring text, audio and artwork transmitted by electrical or electronic means, featuring content related to television programs.</p>	<p><u>Class 9</u></p> <p>Video recordings; Audio-video recordings; Motion pictures; Pre-recorded digital video discs, compact discs, featuring motion picture films covering a wide variety of entertainment themes, namely, comedy and drama; Series of television recordings; Pre-recorded digital video discs, compact discs, featuring a television series covering a wide variety of entertainment themes, namely, comedy and drama; Digital media, namely downloadable media content in the fields of entertainment, television, and film; Digital media, namely, downloadable audio-visual media content in the fields of entertainment, television, and film; Digital media, namely downloadable media content in the fields of entertainment, films, television, and videos; Downloadable podcasts in the field of entertainment, film, television, and theater.</p>

⁹ See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

¹⁰ *Separode Trade Mark* BL O/399/10, paragraph 5

¹¹ I note that the Applicant’s Class 41 contains duplicated terms, namely: “Entertainment services in the nature of development, creation, production, distribution, and post-production of motion pictures” and “Film production”. For clarity and ease, I have removed the duplicated terms in the table.

<p><u>Class 41</u></p> <p>Entertainment services in the nature of an ongoing dramatic television series; production and distribution of an ongoing dramatic television series.</p>	<p><u>Class 41</u></p> <p>Entertainment services in the nature of development, creation, production, distribution, and post-production of motion pictures; Film production; Television production; Multimedia entertainment services in the nature of development, production and post-production services in the fields of video, television, and films; Live theater performances; Live musical theater performances; Entertainment services in the nature of development, creation, and production of live theater performances; Production of podcasts; Providing non-downloadable podcasts in the field of entertainment, film, television, and theatre.</p>
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Class 9

20. The Opponent has made the following submissions in relation to the comparison between the parties' Class 9 goods:¹²

18. In particular:

Contested goods in class 9

- (a) The Applicant's "*Video recordings; Audio-video recordings; Series of television recordings*" are broad terms that encompass the Opponent's "*Audio and video recordings featuring a dramatic television series*" in class 9 and are therefore identical.
- (b) "*Motion pictures*" in the Applicant's class 9 goods is identical to the Opponent's "*digital and multimedia productions in the nature of sound and video recordings featuring drama*" in class 9, as the latter would cover motion pictures.

¹² Opponent's submissions dated 7 March 2023.

(d) The Applicant's "Digital media, namely downloadable media content in the fields of entertainment, television, and film; Digital media, namely, downloadable audio-visual media content in the fields of entertainment, television, and film; Digital media, namely downloadable media content in the fields of entertainment, films, television, and videos" are broad terms that encompass the Opponent's "downloadable dramatic television shows; downloadable television films and programs featuring drama; downloadable multimedia files in the nature of audio, image, data and video files provided from the Internet, relating to drama; downloadable multimedia files in the nature of digital video and image files

relating to television programs, provided from the Internet; Downloadable multimedia files featuring text, audio and artwork transmitted by electrical or electronic means, featuring content related to television programs". The goods are therefore identical.

(e) The Applicant's "Downloadable podcasts in the field of entertainment, film, television, and theatre" fall within the Opponent's "downloadable multimedia files in the nature of audio, image, data and video files provided from the Internet, relating to drama". In addition, the Applicant's aforementioned goods overlap with the Opponent's "Downloadable multimedia files featuring text, audio and artwork transmitted by electrical or electronic means, featuring content related to television programs". The respective goods are therefore identical.

21. I agree with the Opponent submissions and adopt the Opponent's conclusions. It is my opinion that the respective parties' Class 9 goods, as detailed in the Opponent's submissions in its paragraphs 18(a), (b), (d) and (e), are **identical** on the principle outlined in *Meric*.

22. The Opponent has submitted in its paragraph 18(c) that (my emphasis):

*The Applicant's "Pre-recorded digital video discs, compact discs, featuring motion picture films covering a wide variety of entertainment themes, namely, comedy and drama; **Series of television recordings**; Pre-recorded digital video discs, compact discs, featuring a television series covering a wide variety of entertainment themes, namely, comedy and drama" are all encompassed by, or alternatively overlap with (and are not clearly separable from), the Opponent's "pre-recorded audio and/or video media in the nature of DVDs, HD video discs, 3D video discs, audio mini-discs, phonograph records, audio tapes, audio cassettes, discs and flash drives, all featuring drama" and are therefore identical.*

- (1) In paragraph 18(a) of its submissions, the Opponent had already submitted that the applied-for **“Series of television recordings”** is identical to the Opponent’s *“Audio and video recordings featuring a dramatic television series”*. I agree with this primary submission, therefore I shall not consider it further by comparing it to any other of the Opponent’s terms. The respective terms are identical on the principle outlined in *Meric*.
- (2) I note that the term ‘namely’ in a specification is exclusive, and has the effect of limiting the scope of the specification to the specifically listed terms.¹³ Therefore reference to *“namely, comedy and drama”* in the Applicant’s terms has the effect that the goods cover ‘comedy and drama’.
- (3) As such, to the extent that the Applicant’s ‘pre-recorded discs’ relate to films and television series in the ‘drama’ genre, I consider the following applied-for terms:¹⁴

“Pre-recorded digital video discs, compact discs, featuring motion picture films covering a wide variety of entertainment themes, namely, ~~comedy~~ and drama;

Pre-recorded digital video discs, compact discs, featuring a television series covering a wide variety of entertainment themes, namely, ~~comedy~~ and drama”

to be **identical**, on the principle outlined in *Meric* to the following term in the Opponent’s specification, given that the Opponent’s goods all feature ‘drama’:

“pre-recorded audio and/or video media in the nature of DVDs, HD video discs, 3D video discs, audio mini-discs, phonograph records, audio tapes, audio cassettes, discs and flash drives, all featuring drama”

13 Unlike the term ‘in particular’, which indicates that the terms listed are only examples of items included in the category, and that protection is not restricted to them.

14 For ease of reference, I have struck through the parts of the specification that are not identical.

- (4) I also consider the Applicant's *"Pre-recorded digital video discs, compact discs, featuring a television series covering a wide variety of entertainment themes, namely, ~~comedy and~~ drama"* to be identical on the principle outlined in *Meric* to the Opponent's *"Audio and video recordings featuring a dramatic television series"*.
- (5) To the extent that the Applicant's terms relate to 'comedy' as a genre, I consider the following applied-for terms:

"Pre-recorded digital video discs, compact discs, featuring motion picture films covering a wide variety of entertainment themes, namely, comedy and drama;

Pre-recorded digital video discs, compact discs, featuring a television series covering a wide variety of entertainment themes, namely, comedy and drama"

to be at least **highly similar** to the Opponent's:

"pre-recorded audio and/or video media in the nature of DVDs, HD video discs, 3D video discs, audio mini-discs, phonograph records, audio tapes, audio cassettes, discs and flash drives, all featuring drama"

since drama and comedy are not mutually exclusive genres, and the respective goods overlap in nature and purpose; they would have the same user and uses; they would share the same trade channels; and they would be in competition with each other.

Class 41

23. 'Entertainment and production services'

- (1) The Opponent's entire Class 41 specification consists of the following terms (my underlining):

"Entertainment services in the nature of an ongoing dramatic television series;

production and distribution of an ongoing dramatic television series"

- (2) I consider the Applicant's "television production" services to be **identical**, on the principle outlined in *Meric*, to the Opponent's "production and distribution of an ongoing dramatic television series".
- (3) I consider the following applied-for services to be **identical** to the Opponent's Class 41 services, on the principle outlined in *Meric*:¹⁵

"Multimedia entertainment services in the nature of development, production and post-production services in the fields of video, television, and films;"

- (4) The Applicant's specification contains the following terms (my underlining):¹⁶

"Multimedia entertainment services in the nature of development, production and post-production services in the fields of video, television, and films;

Entertainment services in the nature of development, creation, production, distribution, and post-production of motion pictures;

Film production."

To the extent that these services relate to entertainment services and production services in the fields of motion pictures,¹⁷ and films, I consider them to be **highly similar** to the Opponent's "production and distribution of an ongoing dramatic television series". This is because the respective services overlap in nature and purpose; they would likely have the same user and uses; they would likely share the same trade channels; and they would be in competition with each other.

15 For ease of reference, I have struck through the parts of the specification that are not identical.

16 For ease of reference, I have struck through the parts of the specification that I have already found to be identical to the Opponent's.

17 i.e. a cinematographic film / movie.

24. 'Theatre performances'

- (1) The Applicant's specification contains the following terms:

"Live theater performances;

Live musical theater performances;

Entertainment services in the nature of development, creation, and production of live theater performances"

- (2) The 'live performance services' are entertainment services that would be delivered to members of the public who wish to see a live theatre performance.
- (3) With regard to the Applicant's *"entertainment services in the nature of development, creation, and production of live theater performances"*, whilst it is an entertainment service, it is for the 'development, creation and production' of live performances, therefore the user of such a service would not be a member of the public who wishes to see the performances. Put simply, a consumer wishing to see a live performance, would not seek the services for the 'development, creation and production' of such services.
- (4) Both parties have made submissions in relation to these applied-for terms. The Applicant submits that they are not similar to the Opponent's Class 41 services on the basis that its applied-for services are *"provided live in a theatre and the show is a one-off event, whereas the dramatic television series are aired on TV and are a collection of episodes. They are delivered in very different channels and their purposes are very different. Consumers would not confuse these services even if provided under an identical mark as the methods of paying for them and viewing them is very different."*
- (5) The Opponent submits that the respective services are highly similar on the basis that *"it is common for live theatre shows (for example, stage shows and musicals) to be spin-offs of television programs or vice versa; relevant consumers would reasonably expect that a television series and a live*

theatre show offered under the same trade mark originate from the same entity or from commercially related entities (for example, a television program based on a play, or a musical based on a film or television series). Indeed, the Applicant's own class 41 services encompass film, television, theatre and podcast production, which indicates that the Applicant also expects consumers to assume that such services all offered under the Applicant's Sign originate from the same entity."

- (6) The Opponent has not provided evidence to support its submission and I am not convinced that it is so notorious that I should take judicial notice of it. However, as a member of the general public, I am aware that there are instances where live theatre shows can be spin-offs of television series.
- (7) With that in mind, I firstly turn to the following applied-for services, namely:

"Live theater performances; Live musical theater performances"

and compare them with the Opponent's:

"Entertainment services in the nature of an ongoing dramatic television series"

- (a) The core meaning of these terms is 'entertainment services' for amusement and enjoyment. It is my opinion that whether the entertainment service relates to a live theatre performance, or whether it is pre-recorded to be televised, they still both involve actors performing and following a script, therefore the respective services share a similarity in nature.
- (b) The Opponent has made the point that the average consumer may reasonably expect that a theatre production of a particular television programme originates from the same entity that produced the television programme or from a related undertaking and I acknowledge that there is a certain fluidity between television and stage, and it is not uncommon for there to be a cross over between various entertainment formats.

- (c) Indeed, the average consumer may at least believe that they are in some way affiliated and /or the live theatre performance is available by permission of the television series producer or vice versa. In that sense, the live production could not exist had there not been a television programme of it for instance. I also do not overlook that television series can be filmed live in a studio in front of an audience, therefore, notwithstanding they are recorded, they would have also been live performances.
- (d) The consumer's perception is key, and in my opinion there is at least a **low degree of similarity** between the Applicant's services and the Opponent's "*entertainment services in the nature of an ongoing dramatic television series*" since both overlap in their nature and purpose – particularly since they are entertainment services in the sense that they are actors telling a story; they would likely have the same user, since for example, the consumer who is a fan of a TV show may want to see a live performance of it; they may overlap in trade channels since it cannot be ruled out that the same entity may provide both forms of entertainment (i.e. live performance and a televised series); and the respective services would be in competition with each other since the consumer may choose live performances above TV shows and vice versa.

(8) I now turn to the following applied-for term:

"Entertainment services in the nature of development, creation, and production of live theater performances"

Taking into account the core meaning of this service, I consider it overlaps in nature and purpose with the Opponent's "*production and distribution of an ongoing dramatic television series*"; the Applicant's service may also have the same use as the Opponent's since the service would be used for the production of a show for entertainment purposes. As such, the respective services may also overlap in user and may share the same trade channels. For example, a production company may produce live

performances as well as recorded television series. The respective services are therefore **similar to at least a low degree**.

25. 'Production and provision of podcasts'

- (1) The Applicant's specification contains the following terms:

"Production of podcasts; Providing non-downloadable podcasts in the field of entertainment, film, television, and theatre."

- (2) Both parties have made submissions in relation to these applied-for terms. The Applicant submits that they are not similar to the Opponent's Class 41 services on the basis that (my underlining): *"A podcast or the production of a podcast would involve a digital audio file being made available on the internet for downloading to a computer or mobile device. Podcasts would not be dramas but short recordings about a variety of topics, most usually to convey information. These are not similar to the class 41 services covered by the Earlier Mark, which will be delivered on television (as opposed to the internet) and are provided for different purposes to podcasts. Podcasts and dramas are not in competition with each other and are not complementary in any way. Consumers would not confuse these services even if provided under an identical mark."*

- (3) The Opponent on the other hand submits that the Applicant's services are highly similar to the Opponent's Class 41, stating that (my underlining): *"it is common for podcasts to be spin-offs of television programmes and relevant consumers would reasonably expect that a television series and a podcast offered under the same trade mark originate from the same entity or from commercially related entities."*

- (4) Whilst I do not rule out the idea that podcasts can transfer to TV in as far as, it is conceivable that a television adaptation could be made of a podcast (and vice versa), I must point out that the comparison to be made is not between a podcast and a television series, but rather (my emphasis), the services for the **production and provision** of podcasts on the one hand

and the services for the **production and distribution** of television series on the other.

- (5) My understanding is that ‘podcasts’ typically tend to be audio programmes that are split into a series of episodes. They are a form of entertainment and can be focused on a theme or topic. They are made available on the internet and in addition to being audio files they can also include ‘vlogs’ or so called ‘video podcasts’.¹⁸
- (6) I interpret the core meaning of the Applicant’s *“production of podcasts”* as being a service provided for the production of an entertainment series, in the form of an audio programme. The term ‘production’ would refer to the process of developing, creating, recording, editing etc., and generally the bringing to life of the actual show itself.
- (7) I also interpret the core meaning of the Applicant’s service of *“providing non-downloadable podcasts in the field of entertainment, film, television, and theatre”* as the provision, i.e. ‘distribution’ or publishing of podcasts (the theme of the podcasts being ‘entertainment, film, television and theatre’).
- (8) With this in mind, to the extent that the Applicant’s services are ‘production services’ and ‘distribution services’ relating to the production and distribution of an entertainment series, in the form of an audio programme i.e. a ‘podcast’, I consider them to be **similar, to a low degree**, to the Opponent’s service of *“production and distribution of an ongoing dramatic television series”*.
- (9) This is because the respective services may overlap in their nature and purpose, since they are both for the production and distribution of an entertainment series, albeit on the one hand, the podcast is more likely to be an audio series, whereas the television series would be visual.

18 See the Oxford English Dictionary definition for ‘podcasts’ – www.oed.com.

- (10) They may also have the same user. It is easy to envisage a real-world example where a consumer seeking the services of production and distribution of a television series may also seek the services for the production and distribution of a podcast series, as they may wish to have a podcast to promote the television series and engage with fans.
- (11) As such I find that there may also be an overlap in trade channels since I do not rule out the possibility that corporations that provide production and distribution services for television programmes may also provide production and distribution services for podcasts. There may also be a small degree of competition between the respective services.

Conclusion on the comparison of the goods and services

26. I have found some of the respective goods and services to be identical and some to be similar. I have found no instances of dissimilarity between the respective goods and services. For ease, I have set this information out in the table below:

Identical	Similar
<p><u>Class 9</u></p> <p>Video recordings; Audio-video recordings; Series of television recordings; Motion pictures; Digital media, namely downloadable media content in the fields of entertainment, television, and film; Digital media, namely, downloadable audio-visual media content in the fields of entertainment, television, and film; Digital media, namely downloadable media content in the fields of entertainment, films, television, and videos; Downloadable podcasts in the field of entertainment, film, television, and theatre; Pre-recorded digital video discs, compact discs, featuring motion picture films covering a wide variety of entertainment themes, namely, drama; Pre-recorded digital video</p>	<p><u>Class 9</u></p> <p>Pre-recorded digital video discs, compact discs, featuring motion picture films covering a wide variety of entertainment themes, namely, comedy; Pre-recorded digital video discs, compact discs, featuring a television series covering a wide variety of entertainment themes, namely, comedy.</p>

discs, compact discs, featuring a television series covering a wide variety of entertainment themes, namely, drama.	
<p><u>Class 41</u></p> <p>Television production; Multimedia entertainment services in the nature of development, production and post-production services in the fields of video and television.</p>	<p><u>Class 41</u></p> <p>Multimedia entertainment services in the nature of development, production and post-production services in the field of films; Entertainment services in the nature of development, creation, production, distribution, and post-production of motion pictures; Film production; Live theater performances; Live musical theater performances; Entertainment services in the nature of development, creation, and production of live theater performances; Production of podcasts; Providing non-downloadable podcasts in the field of entertainment, film, television, and theatre.</p>

Conclusion of the section 5(1) claim

27. The opposition under section 5(1) is successful in relation to the Applicant's goods and services that I have identified as being identical to those under the earlier registration.
28. Although my primary finding is that some of the applied-for goods and services are identical to the Opponent's, if I am wrong in my finding of identity, I nevertheless would consider those goods and services to be at least highly similar to the Opponent's, and on that basis, in the alternative, they would nonetheless fall under the consideration of the section 5(2)(a) claim.

THE CLAIM UNDER SECTION 5(2)(A)

29. Given that I have made a finding that the respective marks are identical and that some of the applied-for services are similar to the Opponent's, I will proceed with considering whether there would be a likelihood of confusion.

The average consumer and the nature of the purchasing act

30. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical.¹⁹ It is therefore necessary to determine who the average consumer of the respective goods and services is, and how the consumer is likely to select those goods.
31. Although my primary finding is that all the applied-for Class 9 goods are identical to the Opponent’s, I proceed with the consideration of the average consumer of those goods, in the alternative event that they are deemed similar.
32. I note that the respective goods and services have a different scope of average consumer than others. For instance, the respective parties’ Class 9 goods can be characterised as audio-video recordings of television series and films, being either downloadable digital copies or tangible copies stored on discs; and audio recordings. The average consumer of such goods would be members of the general public.
33. The respective parties’ Class 41 services can be characterised broadly as entertainment services that can be subdivided into two distinct categories. On the one hand, they relate to television series and live theatre performances – the average consumer of such services would be members of the general public as they are the audience of such services. On the other hand, the remainder of the respective parties’ Class 41 services relate to entertainment services that are for the production, development, creation and distribution of television series, films, live theatre performances and podcasts – the average consumer of such services are likely to be businesses/professionals, script writers etc. since they are not entertainment services that the viewer (i.e. members of the public) would consume, as they are ‘behind-the-scenes’ services.

¹⁹ *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), paragraph 60; also see *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98, as to what “average” means

34. The goods themselves are likely to be sold through a range of retail outlets (and their online equivalents). Where the goods are in their physical form, they are likely to be displayed on shelves in stores. Where the physical goods can be bought online, an image of them will likely be displayed on a webpage – a similar process will apply where the goods can be downloaded or streamed. In each instance, the consumer will select the goods having viewed them or an image or description of them first.
35. The selection of the goods is therefore primarily visual, although I do not discount that aural considerations would also play a part by way of word-of-mouth recommendations and advice from sales assistants.
36. A similar process will apply when selecting the Class 41 services aimed at the general public. The average consumer is most likely to encounter the trade mark on promotional materials, brochures and through marketing campaigns etc. (including their online equivalents). The same is true of the Class 41 services where the average consumer is a business / professional i.e. the consumer is likely to encounter the trade mark in a similar way. The selection process of all the applied-for services will be predominantly visual (although aural consideration may play a part by way of word-of-mouth recommendations).
37. The goods and services aimed at the general public will, for the most part, be inexpensive and will generally be consumed on a regular basis and the selection of those goods and services will not require an overly considered thought process. The average consumer is likely to demonstrate a low to medium level of attention when selecting those goods and services. For the services aimed at businesses / professionals, i.e. where they are of a specialised nature, the level of attention paid by the relevant average consumer is only likely to increase although it is unlikely to be considerably higher than medium.

Distinctive character of the Earlier Mark

38. As there is a requirement to consider a likelihood of confusion under a section 5(2)(a) claim, the degree of distinctiveness of the Earlier Mark is one of the factors that must be taken into account when assessing whether there is a likelihood of

confusion. This is because the more distinctive the Earlier Mark, the greater the likelihood of confusion may be.²⁰

39. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with higher inherent distinctive character, such as invented words which have no allusive qualities.
40. The Opponent makes no claim to enhanced distinctiveness through the use made of the Earlier Mark, therefore I only have the inherent distinctiveness of the mark to consider.
41. The distinctive character of the mark lies solely in the word 'SUSPICION', which is an ordinary English word that would be widely understood by the relevant consumer therefore the mark would possess no more than a medium degree of inherent distinctive character.

Conclusions on likelihood of confusion under section 5(2)(a)

42. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.²¹ I must also consider the average consumer of the services, the nature of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa.²²
43. The Contested Mark is identical to the Earlier Mark. I have determined that the Earlier Mark is an ordinary word with no more than a medium degree of distinctive character and that the relevant respective services are similar to varying degrees.

20 Although it is always important to bear in mind what it is about the earlier mark which gives it distinctive character. See *Kurt Geiger v A-List Corporate Limited*, Case O-075-13, paragraph 39

21 *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

22 *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

44. I find that a significant proportion of the relevant average consumer would be directly confused as to the trade origin of those services. I make this finding even where the services are similar to a low degree, and where the average consumer is paying at least a medium degree of attention when selecting those services, as these factors are largely offset by the identity of the marks and the inherent level of distinctive character of the Earlier Mark.
45. Indeed, the average consumer, when seeing or hearing an identical mark (with a medium degree of distinctiveness) in relation to services that are similar (even to a low degree), would conclude that the services come from the same (or at least economically linked) undertaking, thus giving rise to a likelihood of confusion.

OUTCOME

46. The opposition is successful under section 5(1) and 5(2)(a) of the Act. Subject to any appeal, the Contested Mark, trade mark application number 3758341, shall be refused registration for all the goods and services applied for.

COSTS

47. The Opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£100
Preparing the Statement of Grounds and considering the Counterstatement	£200
Preparing written submissions	£300
TOTAL	£600

48. I therefore order RKO Pictures, Inc. to pay the sum of **£600** to Keshet Productions UK Limited. This sum should be paid within twenty-one days of the expiry of the

appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 12th day of June 2023

Daniela Ferrari

For the Registrar