



Neutral Citation Number: [2015] EWHC 1772 (IPEC)

Case No: IP14M03624

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
INTELLECTUAL PROPERTY ENTERPRISE COURT

Royal Courts of Justice, Rolls Building
Fetter Lane, London, EC4A 1NL

Date: 2/07/2015

Before :

HIS HONOUR JUDGE HACON

Between :

**THE UKULELE ORCHESTRA OF GREAT
BRITAIN**

Claimant

- and -

**(1) ERWIN CLAUSEN
(2) YELLOW PROMOTION GmbH & CO. KG
t/a THE UNITED KINGDOM UKULELE
ORCHESTRA**

Defendants

Mark Engelman directly instructed by the **Claimant**
Thomas Elias (instructed by **Fladgate LLP**) for the **Defendants**

Hearing dates: 12-14 May and 24 June 2015

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

.....
HIS HONOUR JUDGE HACON

Judge Hacon :

1. The Claimant (“UOGB”) is a partnership of two individuals, George Hinchliffe and Marian Lux. In 1985 they founded and have since operated a group of musicians who play ukuleles and who collectively perform under the name ‘The Ukulele Orchestra of Great Britain’. Over the years their gigs have developed a certain style, with the members wearing evening dress – black tie or gowns as the case may be – telling jokes and delivering mostly well known rock songs and film themes on their ukuleles. UOGB has enjoyed considerable success, particularly in this country and in Germany.
2. The Second Defendant (“Yellow Promotion”) is a limited partnership under German law which operates another group of ukulele players, known as ‘The United Kingdom Ukulele Orchestra’ (“UKUO”). The partners are the First Defendant (“Mr Clausen”) and Dieter Tings. UKUO was set up in 2009 by Mr Clausen, Mr Tings and Peter Moss who is an experienced professional musician and part-time ukulele player. Having been approached by Mr Clausen and Mr Tings, Mr Moss brought together a group of players to form UKUO under his leadership. It is based in Germany but is comprised of British players. UKUO was first operated by another partnership, Yellow Promotion GbR, but this partnership came to an end on 31 December 2013. Yellow Promotion took over from 8 January 2014, the date on which it was registered under German law and thus came into existence.
3. UOGB owns Community Trade Mark No. 009477341 (“the CTM”) which is a word mark: THE UKULELE ORCHESTRA OF GREAT BRITAIN. It is registered in respect of the following services in class 41:

“Organisation, management, staging and provision of live events, concerts, musical performances, and theatre and stage productions; concert services, orchestra services, production of radio and television programmes; publication of electronic publications relating to music and musical instruments; entertainments services.”

The CTM is also registered in respect of various goods in classes 9, 15, 16, 18, 25 and 28, including these in class 9:

“CDs, DVDs, video and audio tapes.”

4. UOGB alleges that the defendants have infringed the CTM pursuant to art.9(1)(b) and 9(1)(c) of Council Regulation (EC) 207/2009 (“the CTM Regulation”). UOGB also alleges passing off and infringement of copyright in two dramatic works.
5. Yellow Promotion (alone) counterclaims for a declaration that the CTM is invalid pursuant to art.7(1)(b), (c), (d) and (g) of the CTM Regulation. The defendants also claim a defence to infringement of the CTM under art.12(b).

Application to strike out

6. Just under two weeks before the trial UOGB issued an application to strike out the Defence and enter judgment on the ground of an abuse of process. UOGB’s complaint concerned the defendants’ disclosure which included a large number of press articles about UKUO, three of which had been redacted.

7. The first article relied on was by Gereon Hoffmann. It appeared in *Der Rheinpfalz* published in Ludwigshafen on 11 April 2013. The headline (in translation) was: ‘Soul and Sabre Dance – The United Kingdom Ukulele Orchestra Delights with Witty Show at the Limburgerhof’. The final paragraph of the version in UKUO’s disclosure list had been deleted and it read:

“There is a joke involved too when the United Kingdom Ukulele Orchestra indicates that George Harrison copied his hit ‘My Sweet Lord’ from an old motown soul number. There is, in point of fact, the Ukulele Orchestra of Great Britain – and they claim to have started the fun with the ukulele. The colleagues are ‘not amused’ that the danger of mistaken identity is very high. That does not alter the fact that the United Kingdom Ukulele Orchestra plays felicitous arrangements and shows much wit and skill in music and in presentation.”

8. The next redacted review came from *Ruhr Nachrichten*, published in Münster on 25 March 2013, written by Heiko Ostendorf and headed ‘Well Plucked and Well Yodelled’. The second paragraph contains an ellipsis within the second sentence, implying a passage had been removed. It was this, with unredacted wording included in standard typeface to give the deleted passage meaning:

“Eight [musicians] in number. Two more than the somewhat better known Ukulele Orchestra of Great Britain, with whom the octet is often confused. The more so as the orientation of the programme of entertainment is the same, with comic presentation and in addition metamorphosed pieces of music from the realms of jazz and pop. It went down well in the Aula am Aasee on Sunday.”

9. The third review, headed ‘It’s not about size’, was by Tobias Ossyra and published on 3 May 2012 in the *Leipziger Volkszeitung*. On this occasion too, the redacted article had an ellipsis to mark the deleted passage. In full, the final paragraph of the article read (with the deleted words in italics):

“The United Kingdom Ukulele Orchestra: that is two hours of musical cabaret during which it becomes clear that Peter Moss’s band has been put together in order to have a share in the success of the longer established and rival Ukulele Orchestra of Great Britain. The gags are scripted, the fillers rehearsed. Every minute is worth it nevertheless because it is actually a damn good copy. At times it is clearly more relaxed and enjoyable than the original. And in this way the orchestra makes it clear in a charming way that it doesn’t depend on the size of the instrument. Technique alone counts.”

10. UOGB argued that these reviews of UKUO’s performances must have been redacted to prevent the court from finding out that journalists in Germany were not only aware of a separate ukulele group operating under the ‘Ukulele Orchestra of Great Britain’ name but apparently also viewed UKUO as a lookalike outfit which was inviting confusion. This was thus an abuse of process.
11. Mr Clausen’s explanation for the deletions, given in a witness statement served in response to the application to strike out, was that after these proceedings were started on 16 September 2014, which was shortly followed by an application brought before

me by UOGB on 23 September 2014 for an interim injunction, he thought that matters between the parties would be made worse if references to UOGB were left on UKUO's website. So he asked a junior member of Yellow Promotion's staff to delete them. He said that the website does not always publish articles in full, but when there is a deletion Yellow Promotion uses an ellipsis to mark that words have been removed. The source of the article is given so that a reader can look at the whole thing if he or she wishes. Mr Clausen said that when he was later told by the defendants' English lawyers about the requirement to give disclosure of relevant documents in the defendants' possession, the redacted articles as they appeared on UKUO's website were disclosed but not the unredacted articles because the originals had not been kept and were consequently not in the defendants' possession.

12. Mr Engelman, who appeared for UOGB, alleged that the deletions in the defendants' disclosure had two consequences. First, it was not going to be possible for there to be a fair trial. When this was questioned he suggested that since the defendants were capable of making the deletions that had been discovered, they were capable of other acts to mislead that court which have not been discovered and this was why a fair trial was not possible. Secondly he submitted that the defendants had by their behaviour forfeited their right to defend themselves at trial, that the defendants lacked clean hands and that to continue the trial would constitute an unjustified waste of court resources. Mr Engelman took me to *Summers v Fairclough Homes Ltd* [2012] UKSC 26; [2012] 1 W.L.R. 2004, *Arrow Nominees Inc v Blackledge* [2001] B.C.C. 591 and *Bilta (UK) Ltd v Nazir* [2010] EWHC 3227 (Ch).
13. The application was heard at the start of the trial. It was dismissed and I indicated that I would give my reasons in the judgment after trial. They now follow.
14. To my mind there was no merit whatever in the application for two principal reasons. First, the suggestion that the redactions in the three articles would prevent a fair trial made no sense at all since the full versions were before the court. The response to this – that I should infer the defendants had made other and undiscovered redactions elsewhere in documents – was based on nothing more than speculation. Secondly, to the extent that the redactions were relevant to what I had to decide at trial, in my view it would have been wholly wrong to strike out the Defence without first hearing from Mr Clausen, who was due to be cross-examined the following day. Mr Engelman submitted that I could and should find that Mr Clausen was lying without hearing from him. I say no more than that I disagree.
15. Mr Clausen was duly cross-examined on this matter and although I am taking it out of sequence, it is convenient for me to comment on this part of Mr Clausen's evidence now. Mr Clausen speaks good English but he had the occasional assistance of an interpreter when he had difficulty in understanding the questions put to him. In my view he did his best to explain honestly the events he was asked about as he knew them.
16. Mr Clausen is not a lawyer and I am prepared to accept that when he instructed his assistant to remove references to UOGB from UKUO's website he believed that leaving them there would inflame a dispute which he and his colleagues had not wanted. What seems instinctively rash to a lawyer is not necessarily viewed the same way by those in other walks of life. Also, Mr Clausen's precise understanding of the defendants' duties of disclosure in English law was not explored. It was not clear that

he understood that those duties, as they had been explained to him by his English lawyers, went beyond disclosing relevant documents in the defendants' possession and applied also to listing documents which had at one time been in either of the defendants' control – notably the unredacted articles – but which he or Yellow Promotion had discarded.

17. As it turned out, although the assistant at Yellow Promotion had been instructed by Mr Clausen to remove all references to UOGB from UKUO's website, one had been missed. Mr Engelman relied on this to suggest that Mr Clausen's statement in his witness statement that he had arranged for all references to be deleted was yet further evidence of Mr Clausen's dishonesty. I think it was evidence of Mr Clausen's assistant not having done a thorough job.

Grounds for invalidity of the CTM

18. The relevant parts of the CTM Regulation provide as follows:

Article 52

Absolute grounds for invalidity

1. *A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:*
 - (a) *where the Community trade mark has been registered contrary to the provisions of Article 7;*
 - (b) *...*
2. *Where the Community trade mark has been registered in breach of the provisions of Article 7(1)(b), (c) or (d), it may nevertheless not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.*
3. *Where the ground for invalidity exists in respect of only some of the goods or services for which the Community trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.*

Article 7

Absolute grounds for refusal

1. *The following shall not be registered:*
 - (a) *...*
 - (b) *trade marks which are devoid of any distinctive character;*
 - (c) *trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;*
 - (d) *trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;*
 - ...*
 - (g) *trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;*
 - ...*

2. *Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.*
3. *Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.*

Art.7(1) and (c)

The law

19. Marks prohibited under art.7(1)(c) fall wholly within those prohibited under art.7(1)(b), see *Campina Melkunie BV v Benelux-Merkenbureau* (Case C-265-00) [2004] E.T.M.R. 58, at [19]. So it is convenient for me to consider just art.7(1)(c).
20. The law in relation to art.7(1)(c) was recently reviewed by Floyd LJ, with whom Patten and Tomlinson LJ agreed, in *J.W. Spear & Sons Ltd v Zynga Inc* [2015] EWCA Civ 290; [2015] F.S.R. 19:

“[73] The most recent judgment of the CJEU to which we were referred is *Agencja Wydawnicza Technopol sp z oo v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34. A number of points emerge from that judgment.

[74] The court first identified the underlying interest protected by art.7(1)(c) as:

‘...that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services...’ ([37]).

[75] Secondly, in order to come within art.7(1)(c) it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes ([38]).

[76] Thirdly, it is irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration. Article 7(1)(c) does not depend for its application on the sign at issue being the usual means of referring to the goods or their characteristics ([39] and [40]).

[77] Fourthly, the context of the list of specific terms in art.7(1)(c) (quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service) shows that those terms are all regarded as ‘characteristics’ of the goods. The list is not exhaustive, as the reference to ‘other characteristics’ shows ([49]).

[78] Fifthly, and importantly, the court said this at [50]:

‘The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a

property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics ... ”.

[79] Thus it is the presumed perception of the average consumer which is relevant. It is not of course enough if the connection between the signs and a characteristic of the goods does not dawn immediately on the average consumer. If it requires any thought or explanation it is not ‘easily recognisable’.

[80] Thus, in *Agencja Wydawnicza Technopol* [2011] E.T.M.R. 34, the applicant was seeking to register the numeral “1000” in relation, for example, to puzzles. The General Court had held:

‘26. In that regard, it should be noted that, as is apparent from paragraphs 18 and 19 of the contested decision, there is from the point of view of the relevant public a direct and specific link between the sign ‘1000’ and some of the characteristics of the goods concerned. The sign ‘1000’ alludes to a quantity and will immediately be perceived by the relevant public, without further thought, as a description of the characteristics of the goods in question, in particular the number of pages and works, amount of data, or the number of puzzles in a collection, or the ranking of items referred to in them. That conclusion cannot be invalidated by the fact that the mark applied for is composed only of figures, since ... the missing information may be readily identified by the relevant public, the association between the figure and those characteristics of the goods in question being immediate.

27. In particular, as the Board of Appeal stated in paragraphs 18 and 19 of the contested decision, brochures, periodicals and magazines frequently publish ranking lists and collections, with the preference then being for round numbers in order to indicate content, the Board of Appeal referring in particular in that regard to the example of the publication ‘1000 Fragen und Antworten’ (‘1000 Questions and Answers’). This strengthens the descriptive relationship that exists from the point of view of the average consumer between the goods in question and the [sign ‘1000’]. The court considered that, in that context, the average consumer would perceive 1000 as an indication of the number of puzzles, and for that reason it was unregistrable.”

[81] Other cases make it clear that it is enough if at least one of the possible meanings designates a characteristic of the goods: see, e.g. *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (“DOUBLEMINT”) (C-191/01 P) [[2003] E.C.R. I-12447; [2004] R.P.C. 18 at [32].

[82] It is nevertheless the case that signs which are candidate trade marks lie on a continuum between the entirely generic, through the descriptive to the inherently distinctive. Not every word which alludes to or is suggestive of

some aspect of the goods or services is necessarily unregistrable. It is of course trite that it is not an objection to registration that the word has a dictionary meaning, or is an ordinary English word. The objection bites on relationships between the word and the characteristics of the goods or services for which it is sought to be registered which the average consumer will immediately perceive.

[83] I have found helpful and agree with the analysis of the Advocate General in his opinion in *DOUBLEMINT* [2003] E.C.R. I-12447 at [61]–[64]. He draws attention to the fact that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it and suggests three considerations which may determine on which side of the line the indication lies. Although the entire passage repays reading, I will summarise his three points as: (i) how factual and objective is the relationship between an indication and the product or one of its characteristics? (ii) how readily is the message of the indication conveyed? and (iii) how significant or central to the product is the characteristic? Asking these questions will assist a fact-finding tribunal to determine whether it is likely that a particular indication may be used in trade to designate a characteristic of goods.”

21. A particular point arises in relation to some of the goods in the CTM specification, in particular CDs and DVDs. In *Linkin Park LLC's Application* (Case O-035-05) [2006] E.T.M.R. 74, Richard Arnold QC sitting as an Appointed Person heard an appeal from the refusal of the Examiner acting for the Trade Marks Registrar to register the mark LINKIN PARK for printed matter, posters and books in class 16 on the ground that the mark was not distinctive and that it was constituted exclusively of descriptive matter, contrary to s.3(1)(b) and s.3(1)(c) of the Trade Marks Act 1994 respectively. These are the equivalents to arts.7(1)(b) and (c) of the CTM Regulation. The applicant was Linkin Park, a well-known rock band. Mr Arnold said this:

“[62] The name of a performer, like the name of an author of a literary or musical work, undoubtedly indicates the origin of the performance or the work, as the case may be. Accordingly performers and authors may in appropriate circumstances have a remedy in passing off if performances or works of others are marketed under their names or confusingly similar names (see, e.g. *Sutherland v V2 Music Ltd* [2002] EWHC 14; [2002] E.M.L.R. 28). As Lord Nicholls and Lord Walker say, however, it does not necessarily follow that the name of a performer or author acts as an indication of the trade origin of a product (a CD or a book or even an MP3 file) which embodies the performance or work.”

22. Mr Arnold considered the argument that a performer's name could serve as an indication of trade origin in relation to a CD or a book in the sense that the public believed that the CD or book must be licensed by the performer:

“[66] The applicant's attorney argued that the relevant consumers in the present case, being mainly fans of the Group, would be knowledgeable about intellectual property rights and would expect merchandise relating to the Group, including posters, to be licensed by the Group or its vehicle the applicant. I am not satisfied that this is correct. As the hearing officer held and

the Registrar's representative submitted, consideration of the copyright position suggests the opposite. The first owner of copyright in a photograph of the Group will be the photographer or the photographer's employer. Accordingly, exploitation of photographs of the Group will not necessarily require the Group's licence. Accordingly, even if performers' or authors' names may be registered in respect of compact discs and books on the basis that members of the public would expect such items to be authorised by the performer or author (contrary to what is suggested above), that would not mean that such marks were registrable for posters.

[67] Furthermore, this seems to me to be a matter for evidence. If the applicant wishes to secure registration on the basis that consumers would expect posters depicting the Group to be licensed by the Group, then in my judgment it is incumbent on the applicant to adduce evidence to show that the perception of the average consumer is as it contends. It has not done so.”

23. Birss J took a similar view in *Hearst Holdings Inc v AVELA Inc* [2014] EWHC 439 (Ch); [2014] E.T.M.R. 34, at [69]:

“[69] The essential problem in all these cases is one of fact. The question is always concerned with what the relevant sign signifies to the average consumer (or equivalent in a passing off case). When famous names or images are applied to merchandise they are not necessarily being used as indicators of origin of the goods at all. As Richard Arnold QC (as he then was) noted in *LINKIN PARK*, referring back to *TARZAN*, what better way is there to describe a poster depicting the band LINKIN PARK as a “LINKIN PARK poster”. So if one imagines a consumer asking in a shop for a LINKIN PARK poster, in that context the mark is being used descriptively and it would be difficult if not impossible for a trader to sell such a poster without calling it a LINKIN PARK poster.”

24. If any ground of invalidity listed in art.7(1) applies in just part of the Community, that is sufficient to establish the invalidity of the CTM, see art.7(2). Part of the Community can be just one Member State, see *Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-25/05 P)* [2006] E.C.R. I-5719 at [83], although descriptiveness in one or another Member State is not the real issue in relation to a word mark: the question is whether the Community mark is descriptive in a language spoken in Europe (such as Catalan, see *Sogepi Consulting y Publicidad SL v OHIM (Case T-72/11) EU:T:2012:424*, at [33]-[38]). If it is, the Community mark is invalid.

This case

25. Argument about the validity of the CTM was focussed at trial on ‘concert services and orchestra services’ in class 41, which I will collectively term ‘concert services’, and on CDs and DVDs in class 9. To the extent that other parts of the specification need to be revisited in the light of my judgment, I will hear argument afterwards.
26. ‘The Ukulele Orchestra of Great Britain’ is far from being a fancy term with no apparent meaning. I have no real doubt that to the English-speaking average consumer it means an orchestra of ukuleles from Great Britain. There is thus a close

factual relationship between the indication of the CTM on the one hand and concert services supplied by a group of ukulele players from Great Britain and CDs with recordings by such a group on the other. This would be readily understood by the average consumer. The indication is central to the concert services and to the performances recorded on CDs and DVDs supplied by UOGB.

27. UOGB's submission was that 'orchestra' would be understood by the average consumer to mean a large group of musicians playing different instruments and that it was precisely this disjunction between 'orchestra' and the nature of UOGB which would strike the average consumer as being distinctive. But the evidence was replete with examples of 'orchestra' being used to refer to a group of musicians playing the same instrument – though often, as is the case in UOGB, different registers of the same instrument. These included the Cambridge Guitar Orchestra, the New York Mandolin Orchestra and the Modern Banjo Orchestra. There were even many ukulele orchestras which existed before the date of filing of the CTM on 27 October 2010, for instance the Wellington International Ukulele Orchestra, the New England Ukulele Orchestra and more locally, the Ukulele Orchestra of Spalding.
28. UOGB submitted that those which operated outside the EU do not count. I do not agree. The starting point in this context is the understanding of the average consumer in the EU who is a native English speaker. That average consumer's understanding of the language is developed by influences from across the English-speaking globe and indeed from other languages.
29. To my mind the CTM is descriptive within the meaning of art.7(1)(c) in relation to concert services to the English speaking average consumer, both in the UK and elsewhere in the EU. It is therefore invalidly registered, subject to art.7(3).
30. With regard to CDs and DVDs there was no evidence that the average consumer would have expected to them to have been licensed by UOGB. When used in relation to CDs and DVDs 'The Ukulele Orchestra of Great Britain' describes the nature of the performance recorded on the CD or DVD, a central characteristic of the product, not its trade origin. The CTM is also descriptive in relation to those goods.

Art.7(1)(d)

The law

31. Art.7(1)(d) in conjunction with art.52 prevents the use of a registered trade mark to monopolise marks which are not necessarily descriptive, but which form part of the current usage in trade sectors covering the trade in the goods or services for which the mark is registered, see *Merz & Krell GmbH & Co v Deutsches Patent- und Markenamt* (C-517/99) [2001] E.C.R. I-6959, at [35]-[41]. Mr Elias, who appeared for the defendants, submitted that even if art.7(1)(c) does not apply, in the ukulele world current usage of 'The Ukulele Orchestra of Great Britain' would cover trade in ukulele concerts. There was no evidence about trade usage and it seems to me that art.7(1)(d) adds nothing.

Acquired distinctiveness under art.7(3)/art.52(2)

The law

32. Arnold J summarised the law in relation to this in *Enterprise Holdings Inc v Europcar Group UK Ltd* [2015] EWHC 17 (Ch); [2015] E.T.M.R., including the following:

“[144] I reviewed the law on this subject in *Société des Produits Nestlé SA v Cadbury UK Ltd* [2014] EWHC 16 (Ch); [2014] E.T.M.R. 17 at [39]–[48]. As I explained there, the following propositions of law are settled. First, for a trade mark to possess distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings.

[145] Secondly, the distinctive character of a trade mark must be assessed by reference to (i) the goods or services in respect of which registration has been applied for and (ii) the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.

[146] Thirdly, the criteria for assessment of distinctive character are the same for all categories of trade marks, but nevertheless the perception of the relevant public is not the same for all categories of trade marks and it may therefore be more difficult to establish distinctive character in relation to some categories (such as shapes, colours, personal names, advertising slogans and surface treatments) than others.

[147] Fourthly, in assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character.

[148] Fifthly, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression “use of the mark as a trade mark” refers solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product as originating from a given undertaking.

[149] Sixthly, a trade mark may acquire a distinctive character in consequence of the use of that mark as part of, or in conjunction with, another trade mark (which may itself be a registered trade mark).

[150] Nevertheless, there are two issues which require consideration with regard to acquired distinctive character. First, in *Nestlé v Cadbury I* I noted that

the English courts have thus far held that it was not enough to prove that at the relevant date a significant proportion of the relevant class of persons recognise the mark and associate it with the applicant for registration's goods in the sense that, if they were to consider who marketed goods bearing that mark, they would identify the applicant. Rather, the applicant must prove that a significant proportion of the relevant class of persons rely upon the mark (as opposed to any other trademarks which may also be present) as indicating the origin of the goods. Since it is not clear that this is a correct statement of the law, however, I referred the following question to the CJEU (question 1 in C-215/14):

“In order to establish that a trade mark has acquired distinctive character following the use that had been made of it within the meaning of Article 3(3) of Directive 2008/95/EC, is it sufficient for the applicant for registration to prove that at the relevant date a significant proportion of the relevant class of persons recognise the mark and associate it with the applicant's goods in the sense that, if they were to consider who marketed goods bearing that mark, they would identify the applicant; or must the applicant prove that a significant proportion of the relevant class of persons rely upon the mark (as opposed to any other trademarks which may also be present) as indicating the origin of the goods?”

I do not understand it to be in dispute that, pending the Court of Justice's answer to this question, I should continue to apply the law as stated in *Nestlé v Cadbury*.

[151] Secondly, counsel for Europcar drew attention to the following passage in the recent judgment of the Court of Justice in *Oberbank AG v Deutscher Sparkassen- und Giroverband eV* (Joined Cases C-217/13 and C-218/13) [EU:C:2014:2012] :

“43. It should also be stated that Union law does not preclude the competent authority, where it has particular difficulty in assessing the distinctive character acquired through use of the mark in respect of which registration or a declaration of invalidity is sought, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, *Windsurfing Chiemsee* EU:C:1999:230, paragraph 53 and the case-law cited). If the competent authority finds it necessary to resort to such a survey, it must determine the percentage of consumers that would be sufficiently significant (see, by analogy, Case C-478/07 *Budějovický Budvar* EU:C:2009:521, paragraph 89).

44. However, the circumstances in which the requirement concerning the acquisition of a distinctive character through use, under Article 3(3) of Directive 2008/95, may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages (*Windsurfing Chiemsee* EU:C:1999:230, paragraph 52, and *Philips* EU:C:2002:377, paragraph 62).

...

48. It follows from the foregoing that it is not possible to state in general terms, for example by referring to predetermined percentages relating to the degree of recognition attained by the mark within the

relevant section of the public, when a mark has acquired a distinctive character through use and that, even with regard to contourless colour marks, such as the mark at issue in the main proceedings, and even if a consumer survey may be one of the factors to be taken into account when assessing whether such a mark has acquired a distinctive character through use, the results of a consumer survey cannot be the only decisive criterion to support the conclusion that a distinctive character has been acquired through use.”

[152] Counsel for Europcar pointed out that, in the last sentence of [43], the Court of Justice had held that the competent authority “must determine the percentage of consumers that would be sufficiently significant”. In my judgment it is necessary to read this sentence in context. It is clear that the Court was not saying that, where an opinion poll is relied on, it has to be shown that the sign has become distinctive to any particular percentage of consumers. Rather, as I read this passage, what the Court is saying is that what percentage will suffice depends on the circumstances of the case, which it is for the competent authority to assess. This reading is supported by the Court’s reference to *Budějovický Budvar np v Rudolf Ammersin GmbH* (C-478/07) [2009] E.C.R. I-7721, which in turn refers back to *Gut Springenheide GmbH v Oberkreisdirektor des Kreises Steinfurt - Amt für Lebensmittelüberwachung* (C-210/96) [1998] E.C.R. I-4657.”

33. With regard to the reference to the Court of Justice of the European Union (“CJEU”) mentioned in paragraph [150] of *Enterprise Holdings*, Advocate General Wathelet has since delivered his Opinion in the *Nestlé* case (EU:C:2015:395). Like Arnold J, the Advocate General takes the view that a mark will acquire distinctive character only through use as a consequence of which the mark indicates to the relevant class of persons the exclusive origin of the goods or services concerned. I will assume the same. This has relevance to use of the CTM on CDs and DVDs.
34. In *Powerserv Personalservice GmbH v OHIM* (Case 553/08 P) [2009] E.C.R., the ECJ held (at [60]) that acquired distinctive character is established under art.7(3)

“... only if evidence is provided that it has acquired, through the use which has been made of it, distinctive character in the part of the Community in which it initially had descriptive character for the purposes of Article 7(1)(c) (see, to that effect, Case C-25/05 P *Storck v OHIM*, paragraph 83).”
35. This is not to do with the particular Member State in which the mark has been shown to be descriptive. The territory across which acquired distinctiveness of a word mark must be established depends on the language of the mark. Where it is English, the proof of distinctiveness required – in terms of how many Member States the proof must relate to – is liable to be substantial. In *Liz Earle Beauty Co Ltd v OHIM* (Case T-307/09) [2011] E.T.M.R. 16 the OHIM examiner refused to register NATURALLY ACTIVE for cosmetics and related products on the ground that the mark was devoid of distinctive character within the meaning of art.7(1)(b) and the applicant had not established that the mark had acquired distinctive character through use pursuant to art.7(3). An appeal to the Board of Appeal was dismissed. A further appeal to the General Court was dismissed insofar as it concerned art.7(3). The General Court said this:

“[49] It is clear from the case law that, in order to have the registration of a trade mark accepted under art.7(3) of Regulation 207/2009, the distinctive character acquired through the use of that trade mark must be demonstrated in the substantial part of the European Union where it was devoid of any such character under art.7(1)(b) of the Regulation (*Ford Motor Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (OPTIONS)* (T-91/99) [2000] E.C.R. II-1925; [2000] E.T.M.R. 554 at [27]). The part of the Community referred to in art.7(2) may be comprised of a single Member State (*Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-25/05 P)* [2006] E.C.R. I-5719 at [83]). Consequently, distinctiveness acquired through use must be demonstrated in all the Member States in which the existence of the ground for refusal had been established (see, to that effect, *Bovemij Verzekeringen NV v Benelux-Merkenbureau (C-108/05)* [2006] E.C.R. I-7605; [2007] E.T.M.R. 29 at [28]).

[50] In the present case, the Board of Appeal found, in para.18 of the contested decision, that the relevant consumers were European English-speakers. Next, it considers, in para.33 of the contested decision, that the applicant ought to have demonstrated that the word sign at issue had acquired distinctiveness not only in the English-speaking countries of the European Union, but also in all the other countries where basic English words could be understood, that it is to say in all the countries of the European Union.

[51] The applicant challenges only that last assertion and claims that the public consisting of European English-speakers cannot include persons with a very rudimentary knowledge of English.

[52] Even if the Board of Appeal construed the concept of “European English-speakers” too broadly, it is clear, and the applicant has, moreover, never claimed the contrary, that the relevant public does not only consist of nationals of the United Kingdom and Ireland whose mother tongue is English.

[53] It is settled case law that a word sign consisting of English words the combination of which is grammatically correct may have a meaning not only for a public who are native English speakers, but also for a public which has sufficient knowledge of the English language (see *NEW LOOK (T-435/07)* at [20] and the case law cited). As noted in [26] above, the General Court has previously confirmed that a basic understanding of the English language by the general public, in any event, in the Scandinavian countries, the Netherlands and Finland is a well-known fact (*NEW LOOK (T-435/07)* at [23]). As pointed out in the same paragraph, this also applies to Malta, where English is one of the official languages, and to Cyprus.

[54] With regard to all of those countries, the applicant never furnished the slightest proof that the mark applied for had become distinctive through use. In particular, the letters and statements mentioned in [46] above, and the evidence of use submitted to OHIM concern only the United Kingdom, Ireland and Germany.

[55] Consequently the applicant’s second plea must be dismissed.”

36. Thus, the proprietor of a word mark must establish acquired distinctiveness in all Member States in which the average consumer is liable to recognise its descriptive character. How many Member States will depend not only on how widely the language of the mark is spoken, but also on the mark itself. The specific issue is how that particular mark is likely to be interpreted in each Member State, see *Junited Autoglas Deutschland GmbH & Co KG v OHIM* (Case T-297/13) EU:T:2014:893, at [31]-[32] and *Matratzen Concord AG v Hukla Germany SA* (Case C-421/04) [2006] E.C.R. I-2303, at [25].
37. The burden on a CTM proprietor seeking to establish acquired distinctiveness under art.7(3) or art.52(2) is therefore potentially a heavy one. In effect it requires the proprietor to draw up an exhaustive list of Member States in which it must prove acquired distinctiveness. Where the CTM is a word mark in English the list will consist of:
 - (1) Member States in which English is either spoken as a mother tongue or is an official language, namely the UK (English is not an official language of the UK), the Republic of Ireland and Malta.
 - (2) Members States in which English is sufficiently well spoken by the average consumer for the descriptive character of the word mark to be perceived. This is likely to mean the Netherlands, Sweden, Denmark, Finland and Cyprus, see *Liz Earle* and the passage quoted above.
 - (3) Further Member States in which another relevant language is spoken. Another relevant language in this context means one in which the English word or words of the CTM are sufficiently similar to their equivalents in that language for the average consumer who speaks that language to perceive the descriptive character of the word mark, see *Matratzen* and *Junited Autoglas*, cited above.
38. Having created this list of relevant Member States, the CTM proprietor must prove acquired distinctiveness in all of them. (Where another relevant language, as I have referred to it, is spoken in part of a Member State, it will be enough to prove acquired distinctiveness in that part).
39. This seems at first glance to be severe. What if distinctiveness is proved in all relevant Member States except Malta? Malta is of itself a Member State as important as any other but in respect of goods which circulate indiscriminately throughout the Community the size of the market in Malta is modest when compared with the Community as a whole or even the parts where English is understood. By way of a national comparison, if an applicant for a UK registered trade mark were to prove acquired distinctiveness pursuant to art.3(3) of the Trade Mark Directive (equivalent to art.7(3) of the CTM Regulation) in the whole of the UK except Orkney and Shetland, it might be thought surprising that the application should be refused because of a lack of distinctiveness solely in those islands.
40. Yet considerations arise in the context of the CTM system which do not apply to national marks and the General Court has explained the reason for its strict approach. A more relaxed policy would lead to the paradox that an application for a national trade mark could be refused registration because the sign in question is descriptive in that Member State, whereas an application for a CTM in respect of exactly the same

sign could be granted because it has acquired distinctiveness somewhere else in the Community. *Louis Vuitton Malletier SA v OHIM* (Case T-237/10) [2011] E.C.R. II-00449 concerned an application for a figurative sign. The General Court said this:

“[98] As the Court of Justice held in *Storck v OHIM* (paragraph 17 above, paragraph 83), the part of the European Union referred to in Article 7(2) of Regulation No 207/2009 may be comprised of a single Member State (see also judgment of 17 May 2011 in Case 7/10 *Diagnostiko kai Therapeftiko Kentro Athinon ‘Ygeia’ v OHIM (υγεία)*, not published in the ECR, paragraph 40). *PAGO International*, paragraph 93 above, which is relied on by the applicant in support of its line of argument, supports that finding, in so far as it confirms, also as regards whether a Community trade mark has a reputation, that the territory of a single Member State may be considered to constitute a substantial part of the European Union.

[99] It follows that the absence of distinctive character of a mark (be it a word, figurative or three-dimensional mark) on the territory of a single Member State is sufficient to justify that that mark be refused registration or declared invalid if it has been registered, unless Article 7(3) or Article 52(2) of Regulation No 207/2009 applies. The application of those two provisions presupposes the production of evidence of distinctive character acquired through the use of that mark in the part of the European Union where it was devoid *ab initio* of any such character, namely in the Member State concerned.

[100] The unitary character of the Community trade mark, to which the applicant refers, does not cast doubt on that finding but, on the contrary, confirms it, since it is apparent therefrom that, in order to be accepted for registration, a sign must possess distinctive character, inherent or acquired through use, throughout the European Union (υγεία, paragraph 98 above, paragraph 40). It would be paradoxical to accept, on the one hand, pursuant to Article 3(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), that a Member State has to refuse to register as a national mark a sign that is devoid of any distinctive character in its territory and, on the other, that that same Member State has to respect a Community trade mark relating to that sign for the sole reason that it has acquired distinctive character in the territory of another Member State (see, by analogy, υγεία, paragraph 98 above, paragraph 53).”

This case

41. UOGB pleads reliance on art.7(3). I will assume in UOGB’s favour that in fact it means art.52(2) and that the date of the counterclaim, 28 November 2014, is the date as of which acquired distinctiveness must be assessed.
42. UOGB advances the following in support of acquired distinctiveness, largely given in evidence by George Hinchliffe, one of the founding members of UOGB:

United Kingdom

- (1) Over a thousand concert performances in the UK since 1985, including those given in The Royal Albert Hall, The Royal Festival Hall, Glastonbury, Hyde Park and The Barbican. Some performances have been alongside well known stars: Robbie Williams, Cat Stevens, Madness and the Kaiser Chiefs.
- (2) The release of 13 CDs and DVDs between 1988 and 2012.
- (3) A programme presented on BBC Radio 4 on 24 June 2008 by Phill Jupitus about UOGB.
- (4) A broadcast on BBC Radio 1 in 2008.
- (5) A broadcast performance on BBC Radio 3 in 2009 as part of the BBC proms of that year, which led to some controversy.
- (6) UOGB was the focus of several questions on University Challenge, in a show broadcast in 2013.
- (7) UOGB was the solution to a crossword puzzle clue in the music newspaper New Musical Express.

Elsewhere in the EU

- (8) Before 28 November 2014, the performances were given elsewhere in the EU in the following numbers:
 - 117 in Germany
 - 27 in Sweden
 - 12 in the Republic of Ireland
 - 7 in Belgium
 - 5 in each of Austria, Finland, France and the Netherlands
 - 2 in each of Italy and Luxembourg
 - 1 in each of Denmark, Estonia, Poland and Spain.
- (9) More than one broadcast on German television, including a live show on the German television channel 3SAT on 29 December 2007. According to Mr Hinchliffe one German television programme on which UOGB appeared was repeated about 15 times.
- (10) The redacted passages from the reviews of UKUO's performances in Germany which I have quoted above.

Generally

- (11) The posting of film clips of its live performances on video-sharing websites such as YouTube.
- (12) The turnover of UOGB's business conducted under the CTM in the years 2010 to 2014 has been between about £790,000 and £920,000 per annum.

43. Use in relation to CDs and DVDs did not serve to indicate to the average consumer the origin of those goods and therefore did not generate acquired distinctiveness so far as those goods are concerned, see *Nestlé* above.
44. Turning to concert services, the figures given for UOGB's turnover include activities outside the EU and need to be marked down to some degree. To the extent that turnover includes sales of CDs and DVDs, this is relevant: such sales contributed to acquired distinctiveness in relation to concert services. Taken as a whole I think that the evidence is sufficient to establish acquired distinctiveness in respect of concert services in the United Kingdom. The same goes for Germany.
45. The main evidence provided with respect to the EU Member States aside from the UK and Germany came from a list of gigs in all countries around the world between February 1989 and August 2014. The list was confirmed by Mr Hinchliffe in re-examination at trial. Mr Hinchliffe indicated that the list was not complete which, given the dates, must be true but there was nothing in evidence which would add to the list, certainly not so far as use outside the UK is concerned. Oddly, a list annexed to the Particulars of Claim indicates that concerts were given in only 14 Member States aside from the UK and Germany and there was only one performance in each of those States up to the date of the Counterclaim. I will assume in UOGB's favour that the list referred to by Mr Hinchliffe is more accurate. UOGB also sought to rely on the contents of a letter dated 22 August 2014 written by Mr Engelman under the public access rules of the Bar Code of Conduct, in particular sections of it which made assertions about UOGB's use of the CTM in the Community. These assertions were not admitted by UKUO, they were not confirmed by any of UOGB's witnesses in their witness statements and were not put to any witness at trial. I therefore disregard them.
46. Mr Elias submitted that firstly UOGB had to satisfy the burden of proving acquired distinctiveness in the UK, Ireland and Malta. Secondly, 'The Ukulele Orchestra of Great Britain' were not obscure words of English so the Netherlands, Denmark, Sweden, Finland and Cyprus should be added to the list. Thirdly, the evidence showed that the German for 'ukulele orchestra' is *Ukulelenorchester*. There was also a letter dated 17 May 2010 in evidence from the German Patent and Trade Mark Office to an agent of Yellow Promotion GbR refusing an application to register 'The United Kingdom Ukulele Orchestra' on the ground that this sign was descriptive in Germany. The officer stated that the relevant public in Germany would readily understand 'United Kingdom'. Mr Elias submitted that there must be an inference that both 'Great Britain' and 'The Ukulele Orchestra of Great Britain' would be understood by the average consumer in German to mean, descriptively, a ukulele orchestra from Great Britain. Therefore Member States in which German is spoken had to be added to the list, i.e. Germany, Austria, Luxembourg and Belgium.
47. I accept Mr Elias's submissions regarding the list of Member States relevant to the issue of acquired distinctive character. I have found that the CTM has acquired distinctiveness in the UK and Germany, so the total list of relevant Member States left in issue is Ireland, Malta, the Netherlands, Denmark, Sweden, Finland, Cyprus, Austria, Luxembourg and Belgium.
48. Save that UOGB has played in the countries indicated above and that there has been potential access to performances on YouTube, there was nothing in evidence to

indicate the extent of use of the CTM in the approximately 30 years between the foundation of UOGB and the date of the Counterclaim. There was no evidence about the degree to which, if at all, any of these concerts was advertised or otherwise promoted, or how many people attended. The concerts may have been well publicised or barely publicised at all, with UOGB as the only artists performing or alternatively UOGB finding a place at the obscure end of a long bill.

49. There was no evidence of any kind that the CTM had acquired distinctiveness in either Malta or Cyprus. In Denmark the evidence was limited to the fact of one performance and in Luxembourg only two.
50. Mr Engelman's response to this was that UKUO's arguments were based on a false premise as to the burden of proof. Once UOGB had raised a pleaded response to the allegation of invalidity, i.e. relying on defence of acquired distinctiveness under art.7(3), the burden shifted to UKUO to plead and show that this defence was not good in any particular Member State. For instance, UKUO did not plead any reliance on lack of acquired distinctiveness in Malta and Cyprus. UOGB had therefore not come to trial expecting to deal with distinctiveness in those countries and both should be deleted from the list of relevant Member States for the purposes of acquired distinctiveness, along with all the others.
51. I do not accept UOGB's argument. The usual rule on the burden of proof applies. If a CTM proprietor raises a defence to a counterclaim for invalidity, the burden rests on the proprietor, which is the party asserting the affirmative of the issue, to prove the part of its case resting on art.7(3) or art.52(2) to the full extent required by Community law. Lest there is any doubt about the usual rule applying, the General Court has made it clear that the burden in relation to art.7(3) and art.52(2) rests on the CTM proprietor, see *Liz Earle* at [49] and the cases there referred to.
52. I have come to the view that UOGB has not proved that the CTM had acquired distinctive character in relation to concert services by 28 November 2014 in all the relevant Member States, at the least not in Malta, Cyprus, Denmark or Luxembourg. Therefore UOGB has not established acquired distinctiveness within the meaning of art.52(2).

Art.7(1)(g)

53. Art.7(1)(g) and the alleged deceptive nature of the CTM was barely referred to. I understood UKUO to rely on it as a sort of squeeze: to the extent that UOGB might try to say that its musical group did not exclusively play ukuleles – taking up French horns was the example given – this would be deceptive. The French horns and the point generally did not arise.

Infringement generally

54. The only allegation against Mr Clausen with regard to trade mark infringement was that he is the owner of the domain name www.ukulele-orchestra.co.uk. There was no complaint about the domain name itself. The allegation was that the domain name pointed to UKUO's web page on which the sign complained of appears: 'The United Kingdom Ukulele Orchestra.' It was admitted that Mr Clausen knew that the sign appeared on the website, but it was not established that he was personally responsible

for this use of the sign. Joint tortfeasance was not alleged in this context. Therefore no acts of infringement of the CTM have been shown to have been committed by Mr Clausen.

55. In case I am wrong that the CTM is invalidly registered, I must consider infringement under art.9(1)(b) and 9(1)(c) by Yellow Promotion. This could only have happened since Yellow Promotion existed, i.e. since 8 January 2014. It does not follow, however, that alleged instances of confusion which happened before that date are irrelevant. If it can be shown that the use of the sign THE UNITED KINGDOM UKULELE ORCHESTRA generated a likelihood of confusion in the mind of the average consumer before 8 January 2014, it may be reasonable to infer that confusion continued after that date. I accept that the inference is not an inevitable one – it is possible that by January 2014 confusion had dissipated in the mind of the average consumer. But as will be seen, the main evidence of confusion adduced by UOGB, in the form of two witnesses who attended for cross-examination, concerned events after January 2014.

Infringement pursuant to art.9(1)(b)

The law

56. Art.9(1)(b) has been considered twice recently by the Court of Appeal, in *Spear v Zynga* [2015] EWCA Civ 290; [2015] F.S.R. 19 and *Maier v ASOS plc* [2015] EWCA Civ 220; [2015] E.T.M.R. 26, at [71]-[80]). In *Spear v Zynga* Floyd LJ said this:

“[33] There is much CJEU learning on the interpretation and application of art.9(1)(b) . In *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24; [2012] E.T.M.R. 17; [2012] F.S.R. 19 at [52] Kitchin LJ approved the following summary of the principles to be derived from the court’s jurisprudence:

- 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, in certain circumstances, be dominated by one or more of its components;

- f. and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and
- k. if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

[34] In making the global comparison the sign is to be considered in the context in which it is used. Kitchin LJ made this point in *Specsavers* [2012] F.S.R. 19 at [87]:

“In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer’s mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.”

[35] The reference in sub-para.(d) of the citation from *Specsavers* [2012] F.S.R. 19 in [33] above to the assessment by the average consumer of the “visual, aural and conceptual similarities” derives from, amongst other places, the judgment of the CJEU in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97) [1999] E.C.R. I-3819; [2000] F.S.R. 77 at [27]:

‘In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.’

[36] Mr Silverleaf also referred us to the discussion of the attributes of the average consumer in *Interflora Inc v Marks & Spencer Plc* (“*Interflora III*”) [2014] EWCA Civ 1403; [2015] F.S.R. 10 at [107]–[130]. In that case it was argued on behalf of the defendant that the judge had been wrong to ask himself whether a “significant proportion of members of the public” would be confused. The average consumer, it was suggested, was either confused or he

was not. In the course of dealing with that question the court approved the following propositions of materiality here:

- (i) the average consumer in any context is a hypothetical person or “legal construct”: a person who has been created to strike the right balance between various competing interests including, on the one hand, the need to protect consumers and, on the other hand, the promotion of free trade in an openly competitive market, and also to provide a standard, defined in EU law, which national courts may then apply.
- (ii) the average consumer test is not a statistical test. The national court must exercise its own judgment, in accordance with the principle of proportionality and the principles explained by the Court of Justice, to determine the perceptions of the average consumer in any given case in light of all the relevant circumstances.
- (iii) in a case concerning ordinary goods or services, the court may be able to put itself in the position of the average consumer without requiring evidence from consumers, still less expert evidence or a consumer survey. In such a case, the judge can make up his or her own mind about the particular issue he or she has to decide in the absence of evidence and using his or her own common sense and experience of the world.

[37] In relation to what the court described as the crucial question, namely whether the average consumer, as a hypothetical person, necessarily has a single reaction and so precludes a consideration of the perceptions of a proportion of the relevant public the court in *Interflora* [2014] EWCA Civ 1403 identified the following propositions:

- (i) the average consumer test provides the court with a perspective from which to assess the particular question it has to decide, for example whether a statement is liable to mislead purchasers.
- (ii) a national court may be able to assess this question without the benefit of a survey or expert evidence.
- (iii) a national court may nevertheless decide, in accordance with its own national law, that it is necessary to have recourse to an expert’s opinion or a survey for the purpose of assisting it to decide whether the statement is misleading or not.
- (iv) absent any provision of EU law dealing with the issue, it is then for the national court to determine, in accordance with its own national law, the percentage of consumers misled by the statement that, in its view, is sufficiently significant in order to justify banning its use.

[38] The court went on to emphasise (at [128]) that the average consumer was not ‘some form of mathematical average’.

[39] The average consumer is of course reasonably well informed, reasonably observant and reasonably circumspect. The case law of the CJEU rejects reliance on the casual or superficial consumer: see *Gut Springenheide GmbH v Oberkreisdirektor des Kreises Steinfurt - Amt für Lebensmittelüberwachung* (C-210/96) [1998] E.C.R. I-4657; [1999] 1 C.M.L.R. 1383.”

57. The CTM and the accused sign are visually and aurally similar to the extent that they both contain the words 'ukulele orchestra'. I think this is an instance in which conceptual similarity is likely to register strongly with the average consumer. In that regard mark and sign are extremely close. As was pointed out at trial, it is certainly true that 'Great Britain' and 'the United Kingdom' do not mean the same thing. But even in this country some pedants might hesitate before getting the difference right. I doubt that the distinction either means anything or matters at all to the vast majority of people elsewhere in the EU. The average consumer, in short, would regard mark and sign as having the same meaning.
58. Basing myself just on this and the other matters to be taken into account as directed by the passage from *Spear v Zynga* quoted above, I would reach the view that there is a likelihood of confusion.
59. I must also consider the evidence of alleged actual confusion. Before doing so, I should refer to an argument advanced by UKUO. It was that the confusion might have been caused by the assumption that there could only ever be one ukulele orchestra emanating from this country. If so – and it was for UOGB to prove that this was not the case – any confusion revealed by the evidence had nothing to do with the similarity of names. Reference was made to *My Kinda Town Ltd v Soll* [1983] R.P.C. 407. This was an action about passing off but an analogous point could arise in a trade mark case on certain facts.
60. At first instance in *My Kinda Town* there had been clear evidence of confusion among the public between the plaintiff's and defendant's respective pizza restaurants. There was a finding of passing off. On appeal the Court of Appeal identified four possible reasons for the confusion. One was the reason the plaintiff had relied on: that the defendant's use of the words 'Chicago Pizza Co' as part of its trading name constituted a misrepresentation that the defendant's restaurant was connected in the course of trade with the plaintiff. The plaintiff's case was that this misrepresentation had resulted in the acknowledged confusion. Yet at first instance 'Chicago pizza' had been found by the judge to be descriptive of a certain type of pizza. Consequently the defendant's use of that term could not have been the cause of any misrepresentation. The confusion among the public must have been due to something else – something which did not give rise to actionable passing off. A possibility was that the public wrongly believed that Chicago pizzas must all come from a single trade source.
61. In the present case, the CTM is invalidly registered if 'The Ukulele Orchestra of Great Britain' is descriptive, as I have found. Infringement does not then arise. But for this part of the judgment I must assume that the name is distinctive. Therefore confusion caused by the use of a confusingly similar trade name cannot be dismissed as irrelevant for reasons analogous to those discussed in *My Kinda Town*.
62. Turning to the evidence itself, I begin with the two individuals who gave evidence of confusion and who were cross-examined.
63. Philip Potter and his wife saw a flyer stating that 'The United Kingdom Ukulele Orchestra will play a gig at the Pavilion Theatre in Rhyl'. They thought they would look at the group on YouTube and Mr Potter typed 'ukulele orchestra' in a Google search. This led him to the UOGB website which featured information and videos about 'The Ukulele Orchestra of Great Britain'. The difference in name was not

noticed by Mr Potter or his wife. They looked at UOGB on YouTube, liked what they saw, and few days later bought tickets for the show in Rhyl on 17 October 2014. Before the show they bought and enjoyed UOGB DVDs. The DVDs came with a free gift from UOGB. On 6 September 2014 Mr Potter emailed his thanks for the gift, mentioning that his and his wife's interest had been sparked by the advertisement for the group's upcoming show in Rhyl. Some days later Mr Potter received a reply from Ian Wood, UOGB's merchandising officer, pointing out that the concert to be given in Rhyl would feature UKUO, not UOGB. Mr Potter and his wife attended the show but apparently liked the performance less than those of UOGB seen on screen. Mr Potter said that had he and his wife realised there were two groups and gone on to compare online video clips of rival performances beforehand, they would not have bought the tickets for the UKUO show.

64. Mr Potter's account in cross-examination meandered in detail somewhat away from what he had said in his written statement, but to my mind he was an honest witness and I accept that he and his wife had confused UOGB and UKUO because of the similarity in their names.
65. Ian Johnson knew of UOGB because he had seen their performances on YouTube. He saw an online advertisement for a ukulele orchestra performance at the Congress Theatre in Eastbourne on 21 October 2014 and booked tickets for his family. In cross-examination he said that in the advertisement there was a big 'UK' and then 'Ukulele Orchestra'. The difference in name from 'Ukulele Orchestra of Great Britain' did not register. He admitted that the booking process was quick, and he said that it was only at the concert itself that he realised his mistake.
66. In my opinion Mr Johnson was also an honest witness, who took a typical amount of care in buying tickets for a concert and who confused UKUO with UOGB because of the similarity in their names.
67. Mr Hinchliffe annexed to his third witness statement a large number instances which were alleged to show relevant confusion:
 - (1) Two individuals separately sent messages intended for UKUO to UOGB's 'contact us' web page.
 - (2) A ticket website in Germany wrongly indicated that UOGB was giving a concert in Berlin on 18 March 2014, although elsewhere it correctly identified UKUO as the performers.
 - (3) The social secretary of the British Ambassador in Luxembourg heard from a colleague that UKUO was playing in Luxembourg on 24 April 2013 and mistakenly emailed UOGB to play at the Ambassador's residence to entertain guests at a tea party.
 - (4) A disappointed fan contacted UOGB to complain that a concert in Germany had been cancelled, when the cancelled performance was to have been by UKUO.
 - (5) A woman in Dresden contacted UOGB about a concert in Berlin which in fact was to be given by UKUO.

- (6) A man attended a concert in May 2012 in Göttingen, Germany, given by UKUO and the next day emailed UOGB, referring to his enjoyment of the concert by 'The Ukulele Orchestra of Great Britain' and asking for further information.
 - (7) Five emails from fans indicating confusion between UOGB and UKUO.
 - (8) Thirty instances of a picture or video of UOGB used by the press in articles about UKUO.
 - (9) Eight instances of ticket websites using text about UOGB for the promotion of UKUO concerts.
 - (10) One use of 'UOGB' in an article about UKUO.
 - (11) Three instances of internet searches finding the wrong group.
68. It is possible that if all these instances had been fully explored and tested in cross-examination, some would have fallen away as not being proof of relevant confusion. I was left with the impression that many would support UOGB's case on confusion. In my view, if the CTM had been valid, it would have been infringed by UKUO pursuant to art.9(1)(b).

Infringement pursuant to art.9(1)(c)

The law

69. The law was summarised by Arnold J in *Enterprise Holdings Inc v Europcar Group UK Ltd* [2015] EWHC 17 (Ch); [2015] E.T.M.R. 16, at [118]-[129].
70. The absence of 'due cause' as required by art.9(1)(c) was not in dispute in *Enterprise Holdings* and so not discussed by Arnold J. In *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24; [2012] F.S.R. 19, Kitchin LJ, with whom Black LJ and the President of the Queen's Bench Division agreed, reviewed the case law of the CJEU in relation to 'due cause', in particular *L'Oréal SA v Bellure NV* (Case C-487/07) [2009] E.C.R. I-5185 and *Interflora Inc v Marks & Spencer plc* (Case C-323/09) [2012] F.S.R. 3, and said this:

[141] In my judgment these cases do reveal a development by the Court of Justice of its jurisprudence on the scope of art.9(1)(c) of the Regulation. They establish that a proprietor of a trade mark with a reputation is not necessarily entitled to prohibit the use by a competitor of his mark in relation to goods for which it is registered even though the mark has been adopted with the intention and for the purpose of taking advantage of its distinctive character and repute, the competitor will derive a real advantage from his use of the mark, and the competitor will not pay any compensation in respect of that use. Consideration must be given to whether the use is without due cause. Specifically, the use of a trade mark as a keyword in order to advertise goods which are an alternative to but not mere imitations of the goods of the proprietor and in a way which does not cause dilution or tarnishment and

which does not adversely affect the functions of the trade mark must be regarded as fair competition and cannot be prohibited.”

This case

71. I will take art.9(1)(c) briefly. I am satisfied that

- (i) the CTM has a reputation in the UK and Germany in relation to concert services for the reasons given with regard to acquired distinctiveness;
- (ii) the accused sign is similar to the CTM for the reasons given in relation to art.9(1)(b);
- (iii) on the assumption that there is no likelihood of confusion in the mind of the average consumer within the meaning of art.9(1)(b), to my mind the similarity between the CTM and the accused sign, the use of both mark and sign for concert services and the evidence which relates to confusion under art.9(1)(b) is collectively sufficient to establish that there would be a link between the sign and the CTM in the mind of the average consumer;
- (iv) use by UKUO of the sign is liable to give rise to at least one of (a) detriment to the repute of the CTM due to concert services from UKUO which, as suggested by numerous examples in the evidence, some concert-goers find to be of low quality when compared to the services of UOGB, (b) unfair advantage being taken of the distinctive character or repute of the CTM by way of enhancement of UKUO’s reputation generated by the link and therefore association with the reputation of UOGB, or (c) detriment to the distinctive character of the CTM caused by the dilution in consumers’ perception that there is one musical group trading in concert services under the CTM;
- (v) such use is without due cause; UKUO argued that there were sound descriptive reasons for adopting the name and it was used for over a year before the CTM was registered in May 2011; these do not to my mind constitute the sort of fair competition contemplated by Kitchin LJ in *Specsavers*.

72. If the CTM were validly registered, in my view UKUO would infringe the CTM pursuant to art.9(1)(c).

Defence to infringement under art.12(b)

The law

73. Article 12(b) provides:

Article 12

Limitation of the effects of a Community trade mark

A Community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

- (a) *his own name or address;*

(b) *indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;*

...
provided he uses them in accordance with honest practices in industrial or commercial matters.

74. In *Maier v ASOS* [2015] EWCA Civ 220; [2015] E.T.M.R. 26 the Court of Appeal considered an ‘own name’ defence under art.12(a) of the CTM Regulation and in particular the proviso at the end of the article, which applies equally to art.12(b). Kitchin LJ, with whom Underhill LJ agreed, said this:

“[147] ... The crucial question, therefore, is whether the use that Asos has made of the sign ASOS has been in accordance with honest practices in industrial or commercial matters. This condition qualifies all of the defences in art.12 of the Regulation and has been interpreted by the Court of Justice on numerous occasions as importing a duty to act fairly in relation to the legitimate interests of a trade mark proprietor. It also involves the balancing or reconciliation of potentially conflicting fundamental interests. The Court put it this way in *Bayerische Motorenwerke AG v Deenik* (C-63/97) [1999] E.C.R. I-905; [1999] E.T.M.R. 339 at [61]–[62] (in connection with what is now art.6 of the Directive):

“61. Lastly, the condition requiring use of the trade mark to be made in accordance with honest practices in industrial or commercial matters must be regarded as constituting in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark owner, similar to that imposed on the reseller where he uses another’s trade mark to advertise the resale of products covered by that mark.

62. Just like Article 7, Article 6 seeks to reconcile the fundamental interests of trade-mark protection with those of free movement of goods and freedom to provide services in the common market in such a way that trade mark rights are able to fulfil their essential role in the system of undistorted competition which the Treaty seeks to establish and maintain (see, in particular, *HAG II*, paragraph 13).”

[148] In considering whether a defendant is acting fairly in relation to the legitimate interests of the trade mark proprietor it will be relevant to consider, among other things, whether there exists a likelihood of confusion; whether the trade mark has a reputation; whether use of the sign complained of takes advantage of or is detrimental to the distinctive character or repute of the trade mark; and whether the possibility of conflict was something of which the defendant was or ought to have been aware. The national court must carry out an overall assessment of all the circumstances and determine whether the defendant is competing unfairly. This emerges from the guidance given by the Court of Justice in *Anheuser-Busch Inc v Budejovicky Budvar Národní Podnik* (C-245/02) [2004] E.C.R. I-10989; [2005] E.T.M.R. 27 and reiterated in *Céline Sarl v Céline SA* (C-17/06) [2007] E.C.R. I-7041; [2007] E.T.M.R. 80 at [34]–[35]:

“34. In that regard, it must be noted that, in assessing whether the condition of honest practice is satisfied, account must be taken first of

the extent to which the use of the third party's name is understood by the relevant public, or at least a significant section of that public, as indicating a link between the third party's goods or services and the trade mark proprietor or a person authorised to use the trade mark, and secondly of the extent to which the third party ought to have been aware of that. Another factor to be taken into account when making the assessment is whether the trade mark concerned enjoys a certain reputation in the Member State in which it is registered and its protection is sought, from which the third party might profit in marketing his goods or services (*Anheuser-Busch* at [83]).

35. It is for the national court to carry out an overall assessment of all the relevant circumstances in order to assess, more specifically, whether Céline Sàrl can be regarded as unfairly competing with Céline SA (see, to that effect, *Anheuser-Busch* at [84]).”

[149] The possibility of a limited degree of confusion does not preclude the application of the defence, however. It all depends upon the reason for that confusion and all the other circumstances of the case. So for example in *Gerolsteiner Brunnen GmbH & Co v Putsch GmbH* (C-100/02) [2004] E.C.R. I-691; [2004] E.T.M.R. 40; [2004] R.P.C. 39 the Court of Justice said at [25]–[26]:

“25. The mere fact that there exists a likelihood of aural confusion between a word mark registered in one Member State and an indication of geographical origin from another Member State is therefore insufficient to conclude that the use of that indication in the course of trade is not in accordance with honest practices. In a Community of 15 Member States, with great linguistic diversity, the chance that there exists some phonetic similarity between a trade mark registered in one Member State and an indication of geographical origin from another Member State is already substantial and will be even greater after the impending enlargement.

26. It follows that, in a case such as that in the main proceedings, it is for the national court to carry out an overall assessment of all the relevant circumstances. Since the case concerns bottled drinks, the circumstances to be taken into account by that court would include in particular the shape and labelling of the bottle in order to assess, more particularly, whether the producer of the drink bearing the indication of geographical origin might be regarded as unfairly competing with the proprietor of the trade mark.”

This case

75. I have found above that (i) ‘The Ukulele Orchestra of Great Britain’ is descriptive in character, albeit that it had acquired distinctiveness in the UK and Germany in relation to concert services by the date of the counterclaim and (ii) conceptually, to the average consumer it shares the same meaning with ‘The United Kingdom Ukulele Orchestra’. It follows from (i) and (ii) that ‘The United Kingdom Ukulele Orchestra’ is an indication concerning the characteristics of the concert services provided by Yellow Promotion, namely that they are performed by musicians playing the ukulele who come from the United Kingdom.

76. The main issue under this head is whether Yellow Promotion's use of its sign is in accordance with honest practices in industrial or commercial matters.
77. UKUO was set up by Mr Clausen, his business partner Mr Tings and Mr Moss in 2009. The three of them agreed upon the name. Mr Clausen admitted that at that early stage he knew about UOGB and informed himself about them by looking at their website. He must have known of their style of dress and the nature of their performances and that by 2009 they had enjoyed a good deal of success, particularly in the UK and Germany. Mr Clausen must have known that the concert services to be provided by UKUO were similar to those of UOGB. He must also have known that as a matter of language 'The United Kingdom Ukulele Orchestra' would to most people mean very much the same thing as 'The Ukulele Orchestra of Great Britain', not least in Germany where UKUO was to be based.
78. In my view, in those circumstances Mr Clausen and his colleagues either knew or ought reasonably to have known that from a commercial standpoint they risked objection from UOGB. In pressing ahead without seeking the sanction of UOGB or any kind of accommodation with UOGB, they acted outside honest practices within the meaning of art.12(b).

Scope of relief had the CTM been validly registered

79. A point arose about appropriate relief in the event that the CTM were validly registered and infringed.

The scheme of the CTM Regulation for jurisdiction of national courts

80. Art.97 of the CTM Regulation governs the allocation of jurisdiction to national courts. It provides:

Article 97

International jurisdiction

1. *Subject to the provisions of this Regulation as well as to any provisions of Regulation (EC) No 44/2001 applicable by virtue of Article 94, proceedings in respect of the actions and claims referred to in Article 96 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.*
2. *If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.*
3. *If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.*
4. *Notwithstanding the provisions of paragraphs 1, 2 and 3:*
 - (a) *Article 23 of Regulation (EC) No 44/2001 shall apply if the parties agree that a different Community trade mark court shall have jurisdiction;*
 - (b) *Article 24 of Regulation (EC) No 44/2001 shall apply if the defendant enters an appearance before a different Community trade mark court.*

5. *Proceedings in respect of the actions and claims referred to in Article 96, with the exception of actions for a declaration of non-infringement of a Community trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened, or in which an act within the meaning of Article 9(3), second sentence, has been committed.*

81. Regulation (EC) No. 44/2001, referred to in art.97(4) above, has now been superseded by Regulation (EU) No. 1215/2012. Art.26 of Regulation 1215/2012 is in the same terms as the old art.24 of Regulation 44/2001 and so far as is relevant it states:

Article 26

1. *Apart from jurisdiction derived from other provisions of this Regulation, a court of a Member State before which a defendant enters an appearance shall have jurisdiction. This rule shall not apply where appearance was entered to contest the jurisdiction, or where another court has exclusive jurisdiction by virtue of Article 24.*

82. Where the jurisdiction of a national court is based on art.97(5) of the CTM Regulation, the territorial scope of that jurisdiction is limited under art.98(2):

Article 98

Extent of jurisdiction

1. *A Community trade mark court whose jurisdiction is based on Article 97(1) to (4) shall have jurisdiction in respect of:*
 - (a) *acts of infringement committed or threatened within the territory of any of the Member States;*
 - (b) *acts within the meaning of Article 9(3), second sentence, committed within the territory of any of the Member States.*
2. *A Community trade mark court whose jurisdiction is based on Article 97(5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.*

83. Even where art.98(2) does not apply, the geographical extent of the relief which may be granted by a national court can be limited by other factors, see the discussion by Arnold J in *Enterprise Holdings Inc v Europcar Group UK Ltd* [2015] EWHC 300 (Ch), at [4]-[32]. For present purposes, however, it is enough for me to consider just the terms of arts.97 and 98.

This case

84. At the case management conference UOGB had agreed that it would only seek relief in the UK and Germany if it succeeded in its claim for infringement of the CTM. At trial the defendants pointed out that both were domiciled in Germany and therefore the court only had jurisdiction pursuant to art.97(5) of the CTM Regulation. It followed that relief was only available in respect of acts committed or threatened in the United Kingdom, see art.98(2). UOGB's response was that the defendants had entered an appearance before this court within the meaning of art.97(4)(b) and so the court had jurisdiction to order relief in Germany.

85. I do not accept UOGB's argument. When the Particulars of Claim were served on the defendants they were entitled to assume that the jurisdiction of this court invoked by

UOGB was the only one available under the CTM Regulation: that under art.97(5). In those circumstances it was not incumbent on the defendants to challenge jurisdiction in order to avoid entering an appearance within the meaning of art.97(4)(b). Consequently if the CTM had been validly registered, relief could have been ordered only in respect of the United Kingdom.

Passing Off

The law

86. It was agreed that the law is as stated by the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C. 341, at 406. Each side advanced another authority in support of propositions of law, both of which I accept.
87. UOGB referred to *British Telecommunications plc v One in a Million* [1999] F.S.R. 1 for the proposition that a domain name, any realistic use of which would result in passing off, is an instrument of fraud.
88. The defendants relied on *Office Cleaning Services v Westminster Office Cleaning Association* (1946) 63 R.P.C. 39 for the proposition that where the name of a business is descriptive of that business, a slight difference between the claimant's and the defendant's respective trade names will, in the absence of fraud, be sufficient to avoid liability for passing off.

This case

89. The case against Mr Clausen rested on his ownership of the domain name www.ukulele-orchestra.co.uk. There is nothing inherent in that domain name which means that its use is bound to result in passing off and no attempt was made to prove otherwise. This part of the passing off claim fails.
90. The case against Yellow Promotion depends on proving the usual three elements of passing off. It seems to me that the evidence relied on by UOGB to establish acquired distinctiveness in respect of the CTM is sufficient to prove that the goodwill which subsists in UOGB's business in England and Wales is associated with the trade name 'The Ukulele Orchestra of Great Britain', that trade name having acquired in the public mind a secondary meaning, i.e. it identifies UOGB as the source of concert services given under that name, see *Reddaway v Banham* [1896] A.C. 199, at 212-213.
91. In my view *Office Cleaning Services* does not assist Yellow Promotion. I considered this case and its relationship with the law on secondary meaning in passing off in *Cranford Community College v Cranford College Ltd* [2014] EWHC 2999 (IPEC); [2015] E.T.M.R. 7 at [13]-[22]. It is enough here to make the short point that the principle of law in *Office Cleaning Services* relied on by the defendants does not apply where the claimant's trade name has acquired a secondary meaning.
92. I am satisfied that the evidence adduced in support of the likelihood of confusion pursuant to art.9(1)(b) establishes that Yellow Promotion's use of the trade name 'The United Kingdom Ukulele Orchestra' misrepresents to a substantial proportion of the public in this country who recognise 'The Ukulele Orchestra of Great Britain' as the

trade name of a particular musical group, that UOGB and UKUO are the same group or are otherwise commercially connected. I am also satisfied that this has caused damage to UOGB's goodwill, particularly by way of loss of control over UOGB's reputation as performers.

93. UOGB's case against Yellow Promotion for passing off succeeds.

Copyright in dramatic works

94. UOGB claims that in about 1985 it created a dramatic work in which copyright subsists (referred to in the Particulars of Claim as "the First Dramatic Work"). The dramatic work relied on is said to comprise the following elements:

- (1) a group of musicians the majority of which play ukuleles, one of which plays a bass instrument;
- (2) those instruments being of differing musical registers;
- (3) all of the musicians are formally attired;
- (4) all of the musicians (other than the double bass player) play their respective instruments in seated positions on chairs;
- (5) all of the musicians read music from music stands positioned in front of those musicians;
- (6) all of the musicians play music which is not originally recorded for the ukulele;
- (7) the musicians also sing as well as play in one other of the musical pieces they play;
- (8) the musicians all speak scripted or improvised humorous monologues;
- (9) the musicians introduce themselves as "We are the Ukulele Orchestra of Great Britain".

95. UOGB goes on to claim that in about February 1989 it modified the First Dramatic Work in the following way:

- (1) the double bass was replaced by a bass ukulele;
- (2) the formal attire of the male musicians became black tie and of the female musicians black and white formal evening wear gowns.

The elements as amended are said to constitute "the Second Dramatic Work".

96. In the Particulars of Claim UOGB was identified as the author of the First and Second Dramatic Works. Mr Hinchliffe's evidence was that he was the author. In series of 'confirmatory assignments' all dated 14 September 2014, Mr Hinchliffe and each of the members of UOGB assigned their interest in copyright to UOGB.

97. The Particulars of Claim plead that the First Dramatic Work was recorded in a photograph and by means of a sound recording in or around October 1985. The Second Dramatic work was said to have been recorded in a video, dated with remarkable vagueness as having been created between October 1987 and July 1989.
98. I will assume that copyright could subsist as a dramatic work in the performance of a musical group.
99. Section 3(2) of the Copyright, Designs and Patents Act 1988 (“the 1988 Act”) states:

(2) *Copyright does not subsist in a literary, dramatic or musical work until it is recorded, in writing or otherwise; and references in this Part to the time at which such a work is made are to the time at which it is so recorded.*

Section 3(2) implies that it is possible for a dramatic or other type of work to exist before it is recorded but until that happens copyright will not subsist in the work, though for the purposes of the 1988 Act the work is deemed to have been made at the time of its recording. Thus, a copyright work is not the medium on which the recording was made, it is the expression of the author’s intellectual creation. Here, for instance, the work is not the photograph, tape or other medium used for visual or sound recording, it is the performance itself by UOGB. By contrast art.2(b) of Directive 2001/29/EC, on the harmonisation of certain aspects of copyright and related rights in the information society, requires Member States to provide for the protection of *fixations* of performances. The 1988 Act must now be construed in accordance with the Directive but for present purposes it makes no difference. And because it is easier and clearer to talk about copyright in a performance, rather than in the fixation of a performance, that is what I will do.

100. Both the Act and the Directive require fixation before copyright can subsist so that the precise nature of the work can be communicated by the copyright owner, not least to those alleged to infringe. (I leave aside instances where the medium on which the work was recorded no longer exists and which bring in train problems (for the copyright owner) of proof of the precise nature of the work.) In *Green v Broadcasting Corporation of New Zealand* [1989] R.P.C. 700, Lord Bridge of Harwich said this at 702:

“The protection which copyright gives creates a monopoly and ‘there must be certainty in the subject matter of such monopoly in order to avoid injustice to the rest of the world:’ *Tate v. Fulbrook* [1908] 1 K.B. 821, per Farwell J. at page 832.”

101. The copyright works that could potentially have been relied on in the present case were the two particular recorded performances referred to in the Particulars of Claim. In the normal course one would have expected UOGB to have presented to the court the photograph, sound recording and video which would have communicated the detailed nature of the two performances. Assuming both to be original works, each would have been compared to one or more performances by UKUO and there would have been argument as to whether UOGB had established (a) copying of one or other of UOGB’s dramatic works and (b) if so, whether there had been copying in substantial part.

102. That is not how UOGB's case was advanced. Although the photograph and the sound recording of the first performance were in evidence, neither was drawn to my attention. I was supplied with a number of DVDs of UOGB's performances of which I watched one (*Live at the Sydney Opera House*) outside court. I was told that the others would have given me a sense of the continuous nature of the style of performance over the years, nothing more, so I did not watch anything else. The two particular performances in which dramatic copyright might subsist were not addressed at trial. Instead the two lists of nine or ten elements were each themselves characterised as the dramatic works relied on, in the form of a 'format'. It was argued that most of the elements of the two formats could be found in UKUO's performances and so the latter infringed the two dramatic works.
103. Difficulties lie in the way of claiming any kind of copyright work as a format. I have already referred to *Green v Broadcasting Corp of New Zealand*. The appellant, Mr Green, was the author and presenter of a television show called 'Opportunity Knocks'. He alleged that the copyright in 'the scripts and dramatic format' of his show had been infringed by the respondent. The dramatic format was defined by a list of features of the show which were repeated each time: the title, catch phrases and the use of a device called a 'clapometer'. Lord Bridge said this at page 702:

"It is stretching the original use of the word "format" a long way to use it metaphorically to describe the features of a television series such as a talent, quiz or game show which is presented in a particular way, with repeated but unconnected use of set phrases and with the aid of particular accessories. Alternative terms suggested in the course of argument were "structure" or "package". This difficulty in finding an appropriate term to describe the nature of the "work" in which the copyright subsists reflects the difficulty of the concept that a number of allegedly distinctive features of a television series can be isolated from the changing material presented in each separate performance (the acts of the performers in the talent show, the questions and answers in the quiz show etc.) and identified as an "original dramatic work". No case was cited to their Lordships in which copyright of the kind claimed had been established."

Lord Bridge went on to emphasise the importance of certainty in the subject matter of a copyright work in the passage I have quoted above and held that certainty was conspicuously lacking in the format of 'Opportunity Knocks'. He then said this:

"Moreover, it seems to their Lordships that a dramatic work must have sufficient unity to be capable of performance and that the features claimed as constituting the "format" of a television show, being unrelated to each other except as accessories to be used in the presentation of some other dramatic or musical performance, lack that essential characteristic."

104. It does not follow that it is impossible to claim copyright in, say, what would in reality amount to a TV format. This has been held to be arguable, see *Robin George Le Strange Meakin v British Broadcasting Corporation* [2010] EWHC 2065 (Ch), at [30]. Each case will turn on its facts. But to succeed a claimant would still have to base its case on particular copyright works – in the case of dramatic works, fixed by some means of recording the performances. In the present instance, because the works relied on by UOGB are cut free from particular performances it seems to me

that UOGB's case suffers from the two vices identified in *Green*. First, the alleged dramatic works lack certainty. It is not enough for UOGB to say that the pleaded lists of elements are certain – so were their equivalents in *Green*. There is, at the least, uncertainty about the number of musicians, the precise nature of their formal attire, the particular music played (any will do and in any order), which songs are to be sung and in what order and what is to be spoken by way of jokes or otherwise. Secondly, the vast array of alternative performances which would infringe the two formats gives rise to the second vice: lack of unity.

105. If UOGB's case had been properly tethered to two particular performances fixed by recording, it may or may not have been possible to prove copying at all, and then copying in substantial part. As to the latter, most of the pleaded elements of the First and Second Dramatic Works could be found in a symphony orchestra. The additional features are that (i) the instruments are solely (or in the case of the First Dramatic Work almost solely) ukuleles, (ii) the musicians sing, (iii) the musicians deliver monologues and (iv) they introduce themselves with the words "We are the Ukulele Orchestra of Great Britain". Clearly performances by UKUO do not involve the last of these, so attention would have focussed on the first three, but also on the differences in songs, theme tunes and spoken words performed. Perhaps for that reason this approach to infringement was not pursued by UOGB.
106. In my view no copyright subsists in the First and Second Dramatic Works relied on. Accordingly UOGB's claim to copyright infringement fails.

Joint liability of Mr Clausen and the claim for additional damages

107. Mr Clausen's alleged joint liability with Yellow Promotion was only pleaded in respect of copyright infringement. I need take that no further.
108. In addition a claim to additional damages pursuant to s.97(2) of the 1988 Act was raised. The claim was pleaded in the body of the Particulars of Claim although it formed no part of the prayer for relief. I have found that there has been no infringement of copyright so this does not arise.

Conclusion

109. UOGB's CTM is invalidly registered, although would have been infringed had the registration been valid. UOGB's claim for passing off succeeds. Its claim for copyright infringement is dismissed.