

O-138-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2261190  
BY STORM RADIO LIMITED TO REGISTER A  
TRADE MARK IN CLASSES 38, 41 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 90323  
BY GWR GROUP PLC**

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## **BACKGROUND**

1. On 13 February 2001 Storm Radio Limited applied to register the trade mark BRAND STORM in Classes 38, 41 and 42 of the register for the following specifications of services:

**Class 38:**

Delivery of digital music by telecommunications; creation of digital communication channels; broadcasting radio on-line; broadcasting of disc jockeys on-line; broadcasting of radio programmes; broadcasting of digital communications; provision of information, advice and consultancy in relation to all of the aforesaid services.

**Class 41:**

Radio entertainment services; provision of radio programmes; production of radio programmes; disc jockey services; including such services provided on-line or on the Internet; information, advice and consultancy relating to entertainment and radio, the provision of digital music from the Internet, radio entertainment services, provision and production of radio programmes and disc jockey services.

**Class 42:**

Information provided on-line from a computer database or from the Internet; creating and maintaining websites; commissioned writing, all for the compilation of web pages on the Internet; computer consultancy.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 25 July 2001 GWR Group Plc, through its agent, David Keltie Associates, filed Notice of Opposition in relation to Classes 38 and 41 of the application only. The grounds of opposition were as follows:

- (i) Under Section 5(1) of the Act, or in the alternative Section 5(2)(a) or Section 5(2)(b) because the mark is identical or alternatively similar to the following earlier trade marks owned by the opponent and is to be registered for the same or similar services and goods and there exists a likelihood of confusion on the part of the public –

No.	Mark	Search Significant Date	Specification of Services/Goods
UK Registration No. 2224424	THE STORM STORM (series of 2)	2 March 2000 (Mark Registered)	<p><b>Class 16:</b> Printed matter, printed publications, periodicals, stationery, paper, envelopes, notepads, writing implements, pens, pencils, crayons, magazines, books, diaries, agendas, calendars, sheet music, newspapers, stickers, posters, photographs, greetings cards, gift wrapping paper, decalcomanias, transfers; but not including any such goods relating to DNA analysis and research or instruction manuals.</p> <p><b>Class 38:</b> Radio and television broadcasting services; radio station services.</p> <p><b>Class 41:</b> Radio and television programme production services; radio entertainment services; presentation and rental of radio and television programmes; interactive information provided on-line from the Internet; provision of information for accessing via communication and computer networks; arranging, organising, presentation and provision of concerts, live entertainment, musical performances; organisation of competitions and awards.</p>
European Community Trade Mark Application No. 1845346	THE STORM	2 March 2000 (Mark Published)	<p><b>Class 16:</b> Writing implements, pens, pencils and sheet music.</p> <p><b>Class 38:</b> Radio and television broadcasting services; radio station services; telecommunication services.</p> <p><b>Class 41:</b> Radio and television programme production services; radio entertainment services; presentation and rental of radio and television programmes; interactive information relating to entertainment, current</p>

			affairs, cultural and sporting activities provided on-line from the Internet; provision of information relating to entertainment, current affairs, cultural and sporting activities for accessing via communication and computer networks; arranging, organising, presentation and provision of concerts, live entertainment, musical performances; organisation of competitions and awards.
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(ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off as a result of the opponent's earlier use of their trade marks since at least as early as 2 March 2000.

4. The applicant through its agent, The GSCP Partnership, filed a Counterstatement denying the grounds of opposition. Both sides asked for an award of costs in their favour. The opponent filed evidence. Both parties were content for a decision to be reached without recourse to a hearing and neither party forwarded written submissions for the hearing officer's consideration.

**Opponent's evidence**

5. The opponent's evidence consists of a witness statement by Gregory Watson dated 12 February 2003. Mr Watson is Group Corporate Development Director of GWR Group Plc (the opponent company).

6. Mr Watson explains that THE STORM radio station is a modern rock music station aimed primarily at the 15 to 34 year old audience currently broadcasting across the UK and Europe on *Sky Digital* channel 860, on DAB Digital Radio in Bristol & Bath, Coventry, Wolverhampton & The Black Country, Bournemouth, Greater London, Essex, Swindon & West Wiltshire, on cable, as well as globally via the Internet via [www.stormradio.co.uk](http://www.stormradio.co.uk).

7. THE STORM radio station was launched on 31 January 2001 and Mr Watson adds that, since that date, it has been broadcast 24 hours a day, 365 days a year on Sky Digital Channel 860, on DAB Digital Radio, on cable and through its website at [www.stormradio.co.uk](http://www.stormradio.co.uk).

8. Mr Watson states that even before its launch in January 2001 his company had already acquired a reputation in THE STORM trade mark which arose from the bid established in late 1999 for the analogue regional West Midlands FM licence advertised by the Radio Authority. GWR undertook extensive activities under THE STORM trade mark as part of the bid process and Mr Watson points out these activities, promoting the application for a new radio station under the STORM brand name, commenced at least as early as March 2000. Mr Watson explains that the process for winning a bid for an analogue broadcasting license involves substantial promotional activity in the market place because it is vital to promote the awareness of the proposed new radio station to attract the public's support. In this case, GWR generated awareness of THE STORM radio station through public presentations and one-to-one meetings

with members of the local business community. Other promotional activities included the launch of an interactive website at [www.stormradio.co.uk](http://www.stormradio.co.uk), and poster and ambient advertising, as well as special events such as roadshows featuring live local rock bands, and adventure sports days. These included the events referred to in the press releases dated 27 June 2000 and 12 July 2000 attached at Exhibit GW 1 to Mr Watson's statement. Also attached at Exhibit GW 2 is a photograph, taken in July 2000, of a promotional vehicle bearing THE STORM trade mark – one of the opponent's "Storm Chasers" which Mr Watson explains are used across the West Midlands region to meet the public and potential listeners.

9. Mr Watson goes on to state that the application for the analogue license for THE STORM station was also the subject of extensive coverage in the national press such as *The Times* and *The Financial Times*, as well as the West Midlands press. He draws attention to Exhibit GW 3 to this statement, a selection of press releases and true and faithful copies of press articles, relating to The Storm's bid for the West Midlands analogue regional licence made in 2000, as follows:

#### Press releases

- ? Towers Outlines Bid (23 May 2000)
- ? Business Trio Join The Storm (17 June 2000)
- ? Storm Six Figure Health Investment (10 October 2000)

#### Press Coverage

- ? Broadcast – 29 March 2000
- ? Birmingham Post – 27 April 2000
- ? Western Daily Press – 28 April 2000
- ? Birmingham Post – 29 April 2000
- ? The Times – 29 April 2000
- ? The Times – August 2000
- ? Financial Times – 23 August 2000
- ? Birmingham Post – 23 October 2000
- ? Birmingham Post – 24 October 2000

10. However, the opponent's bid for the West Midlands regional FM licence was not successful this time around, being narrowly beaten by Saga Radio. Nevertheless, separately from its bid for the West Midlands analogue license during 2000, the opponent's wholly owned subsidiary, NowDigital, submitted applications to the Radio Authority for the Bristol & Bath and Coventry DAB Digital Radio multiplexes. These applications were also the subject of much media coverage. The following selection of press articles relating to the application for the digital radio multiplex and referring to THE STORM brand name are attached at Exhibit GW4 to Mr Watson's statement:

- ? Heartland Evening News Nuneaton – 11 May 2000
- ? Rugby Telegraph – 15 May 2000
- ? Coventry Telegraph – 15 May 2000
- ? Evening Telegraph Leamington – 15 May 2000
- ? Evening Nuneaton Telegraph - 15 May 2000
- ? Bath Chronicle – 12 June 2000

11. Mr Watson states that as a result of its successful applications for the Bristol & Bath and Coventry DAB Digital Radio multiplexes in 2000, his company's radio station was launched, under the brand THE STORM, on 31 January 2001 on these DAB Digital Radio multiplexes, as well as on the Wolverhampton & The Black Country DAB Digital Radio multiplex, on *Sky Digital* at channel 860 and on the Internet at [www.stormradio.co.uk](http://www.stormradio.co.uk). At Exhibit GW5 to Mr Weston's statement are copies of press articles from local newspapers referring to the launch of THE STORM radio station on DAB Digital Radio, as follows:

- ? Bristol Evening Post – 31 January 2001
- ? Shropshire Star (Telford) – 31 January 2001
- ? Shropshire Star (Shrewsbury) – 31 January 2001
- ? Shropshire Star – 31 January 2001
- ? Telford Journal – 1 February 2001
- ? Leamington Evening Telegraph – 6 February 2001
- ? Coventry Evening Telegraph - 6 February 2001
- ? Rugby Evening Telegraph – 6 February 2001
- ? Coventry Citizen – 9 February 2001

12. Mr Watson adds that the opponent's THE STORM trade mark appeared again in the press as a result of its being part of a consortium that submitted an application to the Radio Authority for the North West Regional DAB multiplex on 16 January 2001, in which his company proposed to provide THE STORM radio services. A copy of a press release relating to this application and referring to THE STORM is attached at Exhibit GW6.

13. Mr Watson explains that it is impossible to provide any audience figures relating to THE STORM radio station because the established radio research (RAJAR) does not yet include DAB Digital Radio services. However, he points out that on 31 January 2001, his company's THE STORM radio station became instantly available to anybody in the UK with access to the Internet or Sky Digital, via their television sets, in addition to the three local DAB digital multiplexes.

14. Turning to expenditure figures, Mr Watson states that costs spent on THE STORM radio station project prior to the launch on 31 January 2001 amounted to approximately £269,362. This figure includes the research and development costs, costs of applying for the West Midlands analogue licence, development of the website at [www.stormradio.co.uk](http://www.stormradio.co.uk), printing of leaflets promoting the application for licence bearing the trade mark THE STORM, consumer research costs, consultancy fees, and press agency fees, as well as trade mark registration fees. Examples showing promotion of THE STORM radio station are at Exhibit GW7 to Mr Watson's statement and comprise a Christmas card, letterhead and wallet.

15. Mr Watson submits that there is no distinction between the marks THE STORM or STORM and STORM BRAND. He notes that the press have referred to THE STORM as a brand and examples are attached as Exhibit GW8 to Mr Watson's statement.

16. This completes my summary of the evidence filed in this case. I turn now to the decision.

## DECISION

Section 5(1) and 5(2).

17. These read:

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

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

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

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

18. An earlier right is defined in Section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

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

19. Both Section 5(1) and Section 5(2)(a) turn on the respective marks being found to be identical. The ECJ has recently given the following guidance on the approach to be adopted in assessing whether marks are identical in *S.A. Societe LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/100, [2003] FSR 34:

“..... in answer to the question referred ..... Article 5(1)(a) ..... of the Directive ..... must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

20. Clearly, the applicant’s mark contains an additional word to the opponent’s earlier marks ie. the word BRAND. While this word is an ordinary dictionary word which can obviously refer to the origin of a product or service, it seems to me that it constitutes an addition to the opponent’s

marks and that this addition or difference would be noticed by the average consumer. It follows that the objections under Section 5(1) and 5(2)(a) must fail.

### **Section 5(2)(b)**

21. In my considerations under Section 5(2)(b) I take account of the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, page 224;
- (g) account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*, paragraph 29;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, page 224;



- (i) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

22. The reputation of a trade mark is an element of which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection of such a mark. The opponent has filed evidence relating to the reputation of its mark THE STORM covered by its prior registrations. On the basis of this evidence, THE STORM trade mark has been in use as a radio station since 31 January 2001, under two weeks prior to the relevant date for these proceedings ie. 13 February 2001. Notwithstanding that THE STORM digital radio station has been available on a national basis since 31 January 2001 and that the setting up and establishment of THE STORM station was subject to considerable media attention and pre-publicity, I am not convinced the evidence demonstrates that, at the relevant date, the opponent's trade mark had a significant reputation amongst the relevant public. The evidence filed provides no indication of the opponent's market share or listening figures and no supporting evidence from third parties or the trade has been submitted.

23. The onus is upon the opponent to prove that its earlier marks enjoy a reputation or public recognition and on the basis of the evidence filed in this case I do not believe the opponent has discharged this onus. In *DUONEBS* (BLO/048/01) a decision of Simon Thorley QC sitting as the Appointed Person, it was said:

“In my judgement I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that the ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark”.

24. I conclude that the opponent cannot claim an enhanced distinctive character for its marks. However, even if I am wrong in relation to reputation of the opponent's marks I would point out that reputation is only one element which forms part of a global consideration under Section 5(2). It was held in *Marca Mode v Adidas AG* [2000] E.T.M.R. 723:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18).

Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

25. In essence the test under Section 5(2) is whether there are similarities in marks and services and/or goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the services and/or goods, the category of services and/or goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the mark applied for and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the services and/or goods within the respective specifications.
26. Turning first to a consideration of the respective services covered by the specifications of the application in suit and the opponent’s earlier registrations it is obvious that the applicant’s Class 38 and 41 services are identical and similar to the Class 38 and 41 services covered by the opponent’s registrations. The applicant’s Class 38 services include broadcasting services and radio station services and it is my view that advice and consultancy in relation to such services is manifestly a similar service. Turning to Class 41, once again the respective specifications cover identical services relating to entertainment and radio production services and radio entertainment etc.
27. I now go on to compare the mark in suit (BRAND STORM) with the opponent’s earlier marks THE STORM and STORM.
28. The mark applied for consists of two obvious dictionary words which, in totality, have no obvious meaning in relation to the relevant services.
29. The opponent’s mark also comprise words with no reference to the services in question. Both the opponent’s marks are inherently highly distinctive and would be perceived as such.
30. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sabel BV c Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and prominence of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade. I must bear this in mind when making the comparisons.
31. Turning to a visual and aural comparison of the marks, a difference is apparent in that the mark applied for contains the word BRAND. Furthermore, one of the opponent’s mark contains the indefinite article, the word THE. Notwithstanding the differences, the marks share a common element, the word STORM. In my view the word STORM is the distinctive, dominant component within the respective marks. While the word BRAND is visually and aurally prominent, it would in my view be perceived by the average customer as merely indicating the

origin or source of the services. It seems to me that considerable visual and aural similarity exists between the respective marks.

32. Going to a conceptual comparison, I have little doubt that the common element, the word STORM, will share the same fanciful connotation to the relevant consumer and that the word BRAND would merely denote origin. In my view the respective marks share a conceptual similarity.

33. In assessing the degree of similarity between the respective marks and whether it is likely to give rise to confusion I must also consider the services at issue, the average customer for the services and make allowance for imperfect recollection.

34. The customers for radio broadcasting, radio entertainment and entertainment services etc. are the public at large, although the customer for advice and consultancy in relation to these services is likely to be a specialised business. While I have no evidence before me on the point, it seems to me that the relevant customer is likely to be fairly discriminating in his/her choice of entertainment and that advice and consultancy services are likely to be chosen with care by business customers.

## CONCLUSION

35. Notwithstanding that there are differences in the marks, I take into account my earlier finding that the common element, the word STORM, comprises a distinctive, dominant and striking component of the respective marks. Taking into account the average customer for the services and that identical and closely similar services are involved, it seems to me that the word STORM will be retained in the minds of customers. On a global appreciation it is my view that the applicant's mark would capture the distinctiveness of the opponent's STORM and THE STORM trade marks in the market place.

36. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Canon*:

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *Sabel*, paragraphs 16 to 18).”

37. The respective services are identical and closely similar and the respective marks are similar visually, aurally and conceptually in that the common element (STORM) would suffice the relevant public to believe that the services emanated from the same undertaking.

38. The opposition under Section 5(2)(b) of the Act (which is in relation to Classes 38 and 41 of the application only), is successful. If within twenty-eight days of the expiry of the appeal period the applicant files a Form TM21 deleting Classes 38 and 41, the application will be allowed to proceed in relation to Class 42. If the applicant fails to file a Form 21 deleting Classes 38 and 41, the application will be refused.

**Section 5(4)(a)**

39. In light of my decision under Section 5(2)(b) I have no need to go on and consider the ground of opposition based upon passing off. I would only add that I do not believe the opponent to have any stronger case under this ground.

**COSTS**

40. The opponent is entitled to a contribution towards costs and I order the applicant to pay the opponent the sum of £850 which takes into account that no hearing took place on this case and that the applicant did not file evidence. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 18<sup>th</sup> day of May 2004**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**