

O-369-04

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2293328
IN THE NAME OF ALAN BROWN
OF THE TRADE MARK:**

PUB IDOLS

IN CLASSES 9 AND 41

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY
THERE TO UNDER NO 81534
BY FREMANTLE MEDIA OPERATIONS BV AND 19 TV LIMITED**

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by FremantleMedia Operations BV and 19 TV Limited**

BACKGROUND

1) Registration no 2293328 of the trade mark **PUB IDOLS**, the trade mark, is in the name of Alan Brown. The application for registration was filed on 20 February 2002 and the trade mark was registered on 30 August 2002. The registration is for the following goods and services:

karaoke machines;

rental of karaoke machines; musical entertainment services; karaoke competitions, entertainment competitions, singing competitions.

The above goods and services are in classes 9 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 8 December 2003 FremantleMedia Operations BV and 19 TV Limited, which I will refer to as Fremantle, filed an application for invalidation of the registration. Fremantle is the owner of the following United Kingdom trade mark registrations:

- Registration no 2277463 of the trade marks (a series of two):



The colours blue and black are claimed as an element of the first trade mark of the series. The trade marks are registered for the following goods and services:

cinematographic films; animated cartoons; film strips; movies; magnetic recordings; optical recordings; magneto-optical recordings; solid-state recordings; audio-visual teaching apparatus; amusement apparatus adapted for use with television receivers; electronic books and publications; electronic games; games adapted for use with television receivers; electrical and video amusement apparatus and instruments; multi-media discs and publications; multi-media recordings and publications; laser-readable discs; video discs and publications; computer software; computer programs; digital recordings; media bearing, or for recording, sound and/or video and/or data and/or information; apparatus and instruments for recording and/or reproducing sound and/or video and/or information; holograms; floppy disks; sound recordings; pre-recorded disks; recording disks; compact discs; gramophone records; audio tapes; tape cassettes; video tapes; laser discs; compact discs-interactive CD ROMS; digital video discs (DVD); slot machines and gaming devices; communications apparatus and instruments; telephones; mobile phones; chargers; chargers for mobile phones; hands-free apparatus for mobile phones; printed audio cassette containers; printed video cassette containers; printed compact disc, video disc, laser disc, and computer disc containers; parts and fittings for all the aforesaid goods;

paper; cardboard; paper articles; cardboard articles; printed matter; books; annuals; publications; comic books; song books; magazines; newsletters; newspapers; albums; periodicals; journals; catalogues; manuals; maps; pamphlets; leaflets; posters; stationery; labels; office requisites; drawing and painting materials, apparatus and instruments; writing instruments; instructional and teaching materials; instructional and teaching materials in the form of games, apparatus and instruments; book binding materials; book covers; book marks; printing sets; drawings; paintings; photographs; prints; pictures; calendars; pens; pencils; pencil top ornaments; paints; paintbrushes; paint kits; tags; gift wrap; gift wrap cards; gift wrap tissue; gift boxes; wrapping paper; note pads; playing cards; decalcomanias; paper napkins and other decorative paper items; paper party goods and paper party decorations; paper tablecloths and table covers; paper mats; paper party streamers; embroidery patterns; decorative transfers; rulers; erasers; greetings cards; stickers; paper signs; banners; charts; parts and fittings for all the aforesaid goods;

articles of clothing; footwear; boots; shoes; slippers; sandals; socks; hosiery; trainers; headgear; hats; caps; scarves; gloves; mittens; belts (being articles of clothing);

games, toys; playthings; gymnastic and sporting articles; electronic toys and electronic games; dolls and dolls' clothing; teddy bears; parts, fittings and accessories for all the aforesaid goods;

coffee; coffee substitutes; coffee-based beverages; tea; cocoa; preparations made from cereals; bread; pastry; confectionery;

the bringing together, for the benefit of others, of a variety of images of, or descriptions of, goods, thereby to enable customers conveniently to view and to purchase those goods from a general merchandise web site; the bringing together, for the benefit of others, of a variety of images of, or descriptions of, general merchandise, thereby to enable customers conveniently to view and to purchase that merchandise on-line; the bringing together in a general merchandise catalogue for the benefit of others, of a variety of images of, or descriptions of, goods, thereby to enable customers conveniently to view and to purchase those goods by mail order; advertising services;

broadcasting; television broadcasting; radio broadcasting; satellite television broadcasting; cable television broadcasting; communications by telephone; interactive telephone services; communication services by means of radio waves, telephones, the Internet, the worldwide web, cable, satellite, microwaves and the electricity grid; telephony for voting purposes; telephony for entertainment purposes;

education and entertainment services all relating to television, cinema, radio and theatre; production and presentation of radio and television programmes, films and shows; education by or relating to television and radio; entertainment by or relating to television and radio; organization of competitions (education or entertainment); interactive telephone competitions; publishing; production of cinematographic films, shows, radio programmes and television programmes; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the Internet; organization of shows; rental of sound recordings and of pre-recorded shows, films, radio and television performances; production of video tapes and video discs; radio entertainment; television entertainment; cinema entertainment; theatre entertainment; game shows; television entertainment services involving telephonic audience participation.

The above goods and services are in classes 9, 16, 25, 28, 30, 35, 38 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

The application for registration was filed on 9 August 2001 and the trade marks were registered on 13 September 2002.

- Registration no 2277479 of the trade mark **POP IDOL** for the following goods and services:

audio-visual teaching apparatus; amusement apparatus adapted for use with television receivers; amusement apparatus adapted for use with television receivers, in the nature of karaoke apparatus; electronic games; games adapted for use with television receivers; electrical and video amusement apparatus and instruments; electrical and video amusement apparatus and instruments, in the nature of karaoke apparatus; apparatus and instruments for recording and/or reproducing sound and/or video and/or information; floppy disks; recording disks; slot machines and gaming devices; communications apparatus and instruments; telephones; mobile phones; chargers; chargers for mobile phones; hands-free apparatus for mobile phones; parts and fittings for all the aforesaid goods;

paper; cardboard; cardboard articles; maps; stationery; office requisites; drawing and painting materials, apparatus and instruments; writing instruments; instructional and teaching materials; book binding materials; book covers; printing sets; pens; pencils; pencil top ornaments; paints; paintbrushes; paint kits; gift boxes; paper napkins and other decorative paper items; paper party goods and paper party decorations; rulers; erasers; parts and fittings for all the aforesaid goods;

articles of clothing; footwear; boots; shoes; slippers; sandals; socks; hosiery; trainers; headgear; hats; caps; scarves; gloves; mittens; belts (being articles of clothing);

gymnastic and sporting articles; teddy bears; dolls' clothing; games, toys, electronic toys and electronic games; parts, fittings and accessories for all the aforesaid goods;

coffee; coffee substitutes; coffee-based beverages; tea; cocoa; preparations made from cereals; bread; pastry; confectionery;

the bringing together, for the benefit of others, of a variety of images of, or descriptions of, goods, thereby to enable customers conveniently to view and to purchase those goods from a general merchandise web site; the bringing together, for the benefit of others, of a variety of images of, or descriptions of, general merchandise, thereby to enable customers conveniently to view and to purchase that merchandise on-line; the bringing together in a general merchandise catalogue for the benefit of others, of a variety of images of, or descriptions of, goods, thereby to enable customers conveniently to view and to purchase those goods by mail order; advertising services;

broadcasting; television broadcasting; radio broadcasting; satellite television broadcasting; cable television broadcasting; communications by telephone; interactive telephone services; communication services by means of radio waves, telephones, the Internet, the worldwide web, cable, satellite, microwaves and the

electricity grid; telephony for voting purposes; telephony for entertainment purposes.

The above goods and services are in classes 9, 16, 25, 28, 30, 35 and 38 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

The application for registration was filed on 9 August 2001 and the trade mark was registered on 6 August 2004.

3) Fremantle claims that its trade marks are similar to that of the registration and that the respective registrations encompass identical or similar goods and/or services. Consequently, there is a likelihood of confusion and the registration of the trade mark was contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) Fremantle claims a reputation in relation to its trade marks. It states that in so far as any goods or services of the registration are not similar to those encompassed by those of its earlier registrations, the registration of the trade mark was contrary to section 5(3)(a) of the Act. Fremantle also claims that owing to the reputation of its trade marks use of the trade mark is liable to be prevented under the law of passing-off. Consequently, the registration of the trade mark was contrary to section 5(4)(a) of the Act.

5) Fremantle claims that it is no coincidence that the application was filed eleven days after the final of the Pop Idol television series. It believes that registration was obtained in order to cash-in on and take unfair advantage of the fame and reputation of its trade marks. Consequently, the registration was made in bad faith and its registration was contrary to section 3(6) of the Act.

6) Fremantle claims that its POP IDOL trade mark is well-known in the United Kingdom and entitled to the remedies afforded by section 56(2) of the Act. Consequently, the registration of the trade mark was contrary to section 5(4)(a) of the Act.

7) Mr Brown filed a counterstatement in which he denies the grounds for invalidation. However, he accepts that the trade mark POP IDOL enjoys a reputation in the United Kingdom in respect of television programmes.

8) Only Fremantle filed evidence.

9) The matter came to be heard on 2 December 2004. Fremantle was represented by Mr Lynd of Marks & Clerk. Mr Brown was not represented at the hearing. However, Ms Withers of Marks & Clerk provided written submissions, which I take into account in reaching my decision.

EVIDENCE

10) The evidence of Fremantle shows that the Pop Idol television series ran from 6 October 2001 to 9 February 2002. The series was a form of television talent show for would-be pop stars, where judges commented upon the performers and viewers voted who was to win. The series was very popular. It received extensive press coverage, especially in the “red tops” where the performers were often front page news. There was spin-off merchandising in the form of a book and a video. Fremantle has entered into a licence agreement with a company called Acoustic Solutions to allow the use of the POP IDOL trade mark in connection with electronic audio equipment, including such equipment for karaoke. Evidence is exhibited from the websites of Littlewoods, 24-7 electrical, Comet and WH Smith showing use of POP IDOL for DVDs, videos, games software, CD-roms, books and karaoke equipment. All the pages were downloaded on 25 November 2003. The evidence of Fremantle indicates that the term pop idol is not in common usage to indicate a pop star.

DECISION

11) Section 47 of the Act reads:

“ (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall 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.

(2) The registration of a trade mark may be declared invalid on the ground——

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that——

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

12) I need to consider section 48(1) of the Trade Marks Act 1994 which states:

“Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right-

(a) to apply for a declaration that the registration of the later trade mark is invalid,

or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.”

13) In this case the trade mark had not been registered for five years at the time of the filing of the application for invalidation and so acquiescence cannot come into play.

14) I will deal firstly with the claim in relation to a well-known trade mark. Fremantle has related its claim to a well-known trade mark to section 5(4)(a) of the Act . The Act gives specific implementation and effect to article 6bis of the Paris Convention in section 6(1)(c) of the Act. Section 6 of the Act states:

“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,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

Consequently, a well-known trade mark has the same footing as a trade mark registration and the same form of protection ie sections 5(1), 5(2) and 5(3) of the Act. This is the way that article 6bis is also given effect in First Council Directive 89/104 of December 21, 1988; in article 4(2)(d). Therefore, any claim in relation to a well-known trade mark should be on the basis of these sections of the Act and not section 5(4)(a). I cannot see that Fremantle can be in any better position in relation to its claim of owning a well-known trade mark than in relation to its registrations. I will, therefore, say no more about the claim to a well-known trade mark.

Likelihood of confusion – section 5(2)(b) of the Act

15) According to section 5(2)(b) of the Act, a trade mark shall not be registered if because:

“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.”

The definition of an earlier trade mark is given in paragraph 14 above. Both the registrations upon which Fremantle relies are earlier trade marks within the meaning of section 6 of the Act.

16) In determining the question under section 5(2)(b), I take into account 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 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

Comparison of goods and services

17) The goods and services of the registration are:

karaoke machines;

rental of karaoke machines; musical entertainment services; karaoke competitions, entertainment competitions, singing competitions.

I cannot see how *karaoke machines* cannot but fall within the terms of *apparatus and instruments for recording and/or reproducing sound and/or video and/or information* of registration no 2277463 and *electrical and video amusement apparatus and instruments, in the nature of karaoke apparatus* of registration no 2277479. **Consequently, *karaoke machines* are identical to the goods of the earlier registrations.**

18) *Musical entertainment services; karaoke competitions, entertainment competitions, singing competitions* of the registration must, in my view, fall within *provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the Internet; organization of competitions (education or entertainment); education and entertainment services all relating to television, cinema, radio and theatre and organization of shows* of registration no 2277463. **Consequently, *musical entertainment services; karaoke competitions, entertainment competitions, singing competitions* are identical to the services of registration no 2277463.**

19) This leaves *rental of karaoke machines* to be considered. In his skeleton argument Mr Lynd claims that “the rental of karaoke machines (within Class 41) is so similar to the sale of karaoke machines (within Class 9) as to create a likelihood of confusion in the minds of the public”. In her written submissions Ms Withers makes no comment on the similarity or otherwise of the respective goods and services.

20) In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

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

21) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, the European Court of Justice held in relation to the assessment of the similarity of goods and services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. I do not consider that there is any dissonance between the two tests. However, taking into account the judgment of the European Court of Justice, I may need to consider whether the goods and services are complementary.

22) I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). In relation to the consideration of services I firmly bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 (also see *Reed Executive plc and Reed Solutions plc v Reed Business Information Ltd and Reed Elsevier (UK) Ltd, totaljobs.com Ltd* [2004] ETMR 56):

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

23) Mr Lynd seems to almost conflate goods with their rental. The ultimate purpose of the goods and the rental is the same in this case, the performance of karaoke. The services are dependant upon the goods, although the goods are not dependant upon the services. Consequently, the respective goods and services are not mutually dependent; however, there is a complementary nature, if in only one direction. The user of the goods and of the service can be the same, someone who wants to perform karaoke. Use of the services and purchase of the goods are alternative ways for the user to perform or get others to perform karaoke; consequently, I consider that the respective goods and services are in competition. For some goods and services there is a common use of trade marks for both goods and rental of the goods, the supplier of the goods also renting the goods. This is normal, for instance, in relation to office equipment such as photocopiers. Equally, the opposite can be the case. I know of no common link between the manufacturers of skips and those who hire them out. In this case there is no indication that the respective goods and services share the same channels of trade. The respective goods and services clearly satisfy a goods number of the criteria set out in the case law. However, it is dangerous to take a too mechanistic approach. I am of the view that there is a degree of similarity between *rental of karaoke machines* and the machines themselves, which are encompassed by the class 9 specifications of the registrations of Fremantle.

Comparison of trade marks

24) I will consider the stylised trade marks of Fremantle. If these are considered to be similar to that of the registration, then the position can only be stronger for the word only trade mark in terms of similarity. (The word only trade mark does not include class 41 services.) There is no need to consider the coloured version of the trade marks. Consequently, the trade marks to be compared are:

Fremantle's trade mark:



**Mr Brown's trade mark:
PUB IDOLS**

25) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHMI - DaimlerChrysler (PICARO) Case T-185/02*).

26) Mr Brown’s trade mark clearly lacks the device element and stylisation of the lettering of Fremantle’s trade mark. However, I consider that the distinctive and dominant element of the latter’s trade mark is the words Pop Idol. The trade marks coincide in the use of the word Idol and so in the phonetic, visual and conceptual identity in relation to this coincidence. I note that in Mr Brown’s trade mark this is in the plural, however, I do not consider that anything turns upon this. Mr Lynd has submitted that the Pop and Pub idol elements are phonetically very similar. Both are three letters long and both begin with the letter p. The p and b sounds do have a good deal of similarity. Hence, in languages such as Welsh where sandhi is reproduced in the orthography, the letter p in various circumstances mutates into the letter b. I am of the view that the vowel sounds are not particularly similar. The problem with Mr Lynd’s submission is that it tries to divorce the words from their meanings. These are two common words in the English language and their meanings will militate against aural confusion, in my view. The meaning defines the perception. Both trade marks have a word at the beginning that qualifies the idol or idols. This word is three letters long in both cases and begins with the same letter. So there is a similar shape and form in relation to the word elements. I am not aware that there is any specific public for the respective goods and services under consideration, the average consumer for the goods and services of the respective trade marks is the public at large. I am of the view that there is a degree of similarity between the respective trade marks.

Conclusion

27) The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case all the goods and services of Mr Brown’s registration have been found to be identical to those of the earlier registrations, with the exception of *rental of karaoke machines*. In respect of the latter services it has been decided that there is a degree of similarity. The distinctive character of the earlier trade mark has to be taken into account. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the

relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). In his counterstatement, Mr Brown claims that POP IDOL does not have a high degree of inherent distinctiveness as it is a phrase that has been employed in general language to refer to pop stars. Mr Brown has submitted no evidence to support his claim that the phrase is in common usage. The evidence of Fremantle suggest that it is not in common usage. However, even if it is not in common usage this does not mean that it enjoys a great deal of distinctiveness. Words can tell the consumer what the goods or services are without being in common parlance in conjunction. However, the degree of distinctiveness will depend upon the goods or services in question. In use in relation to books or videos POP IDOL, without use, is likely to be seen as a descriptor more than an indicator of origin. However, in relation to karaoke goods and services it is allusive to their use rather than directly descriptive; alluding to the imitation of pop stars. I cannot see that it is completely descriptive. The reputation clearly rests with a television series. However, that does not really tell the story in the context of this case. The reputation Fremantle has is not for the identical/similar goods and services. However, I do not consider that the reputation can be ignored in the global appreciation. It might not be for the same goods and services but it has the same core as the purposes of the goods and services of the registration. The reputation has a clear link to the goods and services of the registration. The television series was about persons who aspired to be pop stars; karaoke and singing competitions are also about those who aspire to be pop stars or for a few minutes pretend to be pop stars. It is to be borne in mind that the evidence clearly shows that the reputation of the series transcended television and became a hot topic of the press. When Mr Brown made his application this reputation would have been at its zenith. Ms Withers states that there has been no confusion in the market place. However, no evidence has been furnished to show when or how or if Brown has used the trade mark. So the claimed absence of confusion tells me nothing. In relation to the *rental of karaoke machines*, where I have found a degree of similarity, the nature of the reputation of POP IDOL adds to the likelihood of confusion. I am of the view that the average consumer, the public at large, will consider that in use in relation to the respective goods that the goods and services come from the same undertaking or an economically linked undertaking. It is quite likely that the average consumer will believe that the goods and services of Fremantle are being specifically designed for the pub. There is far more, in my view, than association in the strict sense or a mere bring to mind. **Taking into account that the relevant public is the public at large, I am of the view that from a global assessment there is a likelihood of confusion in relation to all the goods and services of the registration.**

Section 5(3) of the Act

28) Fremantle pleaded section 5(3) of the Act contingent on any of the goods and services of the registration not being found similar or identical. As I have found that they are all identical or similar this ground falls away.

Passing-off – section 5(4)(a) of the Act

29) Section 5(4)(a) of the Act states:

“4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented——

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

30) I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case* [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

.....Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that; “To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact. In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.””

31) The first matter that I have to decide is the material date. It is well established that the material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark”.

The material date cannot, therefore, be later than the date of the application for registration. In this case there is no evidence of the use of the trade mark of Mr Brown and so the material date is the date of the application, 20 February 2002.

32) Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and

its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

The evidence of Fremantle does not fall strictly within the parameters set out by Pumfrey J. However, Professor Annand, sitting as the appointed person, in *Loaded* BL0/191/02, accepted that proof of goodwill could be accomplished by other means. In this case Mr Brown accepts the reputation of the television programme. I have no doubt that Fremantle has the requisite goodwill and reputation in relation to POP IDOL for television of the programmes described. There is no requirement in passing-off for goods or services to be similar. However, in *Harrods Ltd v Harrodian School* [1996] RPC 697 Millett LJ stated:

"The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration."

and

"The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything."

In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade LJ said:

"even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one."

Millet LJ in *Harrods Ltd v Harrodian School* also stated:

"It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection

which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services."

33) The claims in relation to the distinctiveness of POP IDOL made by Mr Brown have to be taken into account in relation to passing-off also. Laddie J in *Associated Newspapers Limited and others v Express Newspapers* [2003] FSR 51 stated:

"25. The jurisprudence to the effect that it is difficult if not impossible to succeed in a passing off action where the mark relied on is descriptive is based on the principle that no trader should be allowed to secure a monopoly over words which customers would regard not as an indication of origin but as merely descriptive of the type of goods or services being offered and which, for that reason, other traders are likely to want to use. Where a mark possesses the ability to convey to the customer an indication of a particular trade origin for goods made available under it, it can be protected by passing off proceedings."

In this case I am of the view that POP IDOL, in relation to the television programme, will speak to the public concerned of the business of Fremantle. I do not consider that it will be seen primarily as a descriptor. At the date of application for registration I doubt that it would have any meaning other than the television programme for the public concerned.

34) In this case I am of the view that the nature of Fremantle's reputation and the goods and services of the registration create a connection; the connection between singing competitions and karaoke goods and services. All of the services of the registration are connected with or are part and parcel of the reputation of Fremantle.

35) Fremantle has licensed use of its trade marks in relation to karaoke equipment. This shows the not unsurprising connection between its reputation and karaoke. I note that the evidence relating to this emanates from well after the material date. However, it seems to me to represent concretely a reasonably foreseeable expansion in trade.

36) Taking into account all the relevant factors I am of the view that the public concerned are likely to believe that goods or services offered by Mr Brown are the goods or services of Fremantle.

37) Consequent upon this I consider that there would be damage in the following forms:

- Diverting trade from Fremantle to Mr Brown.
- Potentially injuring the trade reputation of Fremantle if there were any failings in the goods and services of Mr Brown.
- By the injury which is inherently likely to be suffered by any business when on frequent occasions it is confused by customers or potential customers with a business owned by another proprietor or is wrongly regarded as being connected with that business.

(See *Habib Bank Limited v Habib Bank AG Zurich* [1982] RPC 1)

38) Fremantle succeeds in its grounds of opposition under section 5(4)(a) of the Act.

Bad faith –section 3(6) of the Act

39) The grounds for the claim of bad faith are inextricably linked to the issues dealt with under sections 5(2)(b) and 5(4)(a). Consequently, I do not consider that it is necessary to deal with them, taking into account my findings above.

40) Under sections 47(2)(a) and (b) of the Act I find that registration no 2293328 is invalid in respect of all goods and services in that it was registered in breach of sections 5(2)(b) and 5(4)(a) of the Act. The registration is to be cancelled in respect of all goods and services. In accordance with section 47(6), the registration is deemed never to have been made.

COSTS

41) FremantleMedia Operations BV and 19 TV Limited having been successful are entitled to a contribution towards their costs. I order Mr Alan Brown to pay FremantleMedia Operations BV and 19 TV Limited the sum of £1050. 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 16th day of December 2004

David Landau
For the Registrar
the Comptroller-General