

O-106-07

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2352792 IN THE NAME
OF NEW CENTURY INTELLECTUAL PROPERTY INVESTMENTS LIMITED
TO REGISTER A TRADE MARK IN CLASSES 32 & 33**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 93253 IN THE NAME OF
FREMANTLE MEDIA OPERATIONS B.V. AND 19 TV LIMITED**

Trade Marks Act 1994

**IN THE MATTER OF trade mark application No. 2352792
in the name of New Century Intellectual Property Investments Limited
to register a trade mark in Classes 32 and 33**

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**IN THE MATTER OF opposition thereto under No. 93253
in the name of FremantleMedia Operations B.V. and 19 TV Limited**

BACKGROUND

1. On 7 January 2004, New Century Intellectual Property Investments Limited made an application to register the trade mark POP IDOL in Classes 32 and 33. The specifications of goods are as follows:

Class 32 Non-alcoholic beverages; beer, lager, ale; mineral and aerated waters; drinks containing not more than 1.2% (by volume) of alcohol; preparations for making the aforesaid goods, including essences, syrups and other preparations for making beverages; fruit drinks and fruit juices; lemonades; table waters; vegetable juices.

Class 33 Alcoholic beverages; spirits, liquors, wines; alcoholic pre-mix drinks; cocktails and ciders.

2. On 7 March 2005, FremantleMedia Operations B.V. and 19 TV Limited filed notice of opposition to the application, the grounds of opposition in summary being:

1. Under Section 5(1) because the mark applied for is identical to the opponents' earlier marks, and is sought to be registered in respect of goods that are identical to those for which these earlier marks are registered, such that there exists a likelihood of confusion.

2. Under Section 5(2)(a) because the mark applied for is identical to the opponents' earlier marks, and is sought to be registered in respect of goods that are similar to those for which this earlier mark is registered, such that there exists a likelihood of confusion.

3. Under Section 5(3) because the mark applied for is identical or similar to the opponents' earlier marks in which the opponents have a reputation.

4. Under Section 5(4)(a) by virtue of the law of passing off.

5. Under Section 56 because the opponents earlier marks are well know

trade marks.

3. Details of the earlier marks relied upon by the opponents in these proceedings can be found as an annex to this decision.

4. The applicants filed counterstatements in which, in relation to the ground under Section 5(2)(b) they admit there is similarity between the mark applied for and the opponents' earlier trade marks, but deny that the goods and/or services covered the opponents' earlier marks are the same or similar to those for which they seek registration. They deny all other grounds on which the opposition is based. Both sides ask that an award of costs be made in their favour.

5. Both sides filed evidence which insofar as it may be relevant to these proceedings I have summarised below. Neither side took up the offer of an oral hearing, instead electing to have a decision from the papers, and in the case of the opponents, supported by written submissions. After a study of the evidence and submissions I now go on to give my decision.

Opponents' evidence

6. This consists of a Statutory Declaration dated 18 November 2005, from Isabelle Brender, Trade Marks Manager at FremantleMedia Limited, a sister company of FremantleMedia Operations B.V., a position she has held for four and a half years.

7. Ms Brender refers to Thames Television Ltd, another sister company of FremantleMedia Operations B.V. having made and aired a series of television programmes between 6 October 2001, and 9 February 2002, called "POP IDOL, POP IDOL FINAL, POP IDOL RESULTS and POP IDOL RESULT. The programmes were broadcast on ITV, and involved the television audience in voting for a particular singer, the performer attracting the lowest number of votes each week being eliminated from the competition until a winner is found. Exhibit IB1 consists of a spreadsheet giving details of the programmes broadcast within the dates above, listing their ratings, the number of people who watched each programme and the market share captured. A second spreadsheet gives similar information relating to the POP IDOL RESULTS SHOW that appears to have been broadcast later in the evening after each main show. Ms Brender highlights that the series Final, broadcast on 9 February 2002 was watched by over 13 million people, which she approximates to 60% of the television viewing public, and more than 70% of adults aged between 16 and 44. She states that this made it the highest rated, live entertainment show, and the number one show for young adults. Ms Brender puts the voting figures into perspective by comparing the number of votes cast during the series (32.2 million) with those made in the 2001 General Election (26.3 million). She says that the programme claimed the highest UK telephone vote, with 9 million votes being received in just two hours.

8. Ms Brender says that there were eleven thousand auditions, the largest ever held in the UK, and generated the largest ever web-chat in the UK with some 70,000 hits being recorded after the results show. The programme won the Golden Rose of Montreux Award, a BAFTA award for the best entertainment programme or series, and a Tric Award for the television entertainment programme of the year. Ms Brender mentions that the first album released by the winner and runner-up, Will Young and Gareth Gates went "triple platinum" and "double platinum" respectively. A book entitled POP IDOL was also sold to accompany the series,

which became the number one best seller in the UK with sales of over 100,000 units. Over 120,000 video tapes of the programmes entitled “A Star is Born” have been sold to date.

9. Ms Brender goes on to refer to Exhibit IB3, which consists of copies of advertisements placed by, or on behalf of FreemantleMedia, Ms Brender referring to the mention of the nomination/award of the Golden Rose of Montreaux for POP IDOL. The final page of the exhibit lists the details for the UK final, stating this to have achieved 13.9 million viewers, representing 59.4% of the audience share, a “record-breaking” 9 million phone votes in less than 2 hours, and the achievement of 21 top rating episodes. The exhibit refers to POP IDOL competitions/programmes having also been broadcast in the US, Poland and South Africa.

10. Ms Brender refers to the press coverage generated by the show, examples of which she shows as Exhibit IB4. The articles dating from January/February 2002 come from many of the UK’s national daily newspapers, and mention POP IDOL in relation to the show, the participants and the judges. The exhibit also contains a number of articles that mention POP IDOL having given ITV the “best ratings win” for years.

11. A second series entitled POP IDOL 2 was broadcast on ITV1 between August and December 2003, the winners debut single reaching the top position in the UK pop charts where it stayed for three weeks. Ms Brender says the number of telephone calls made to the second series final exceeded those for the final of the first series.

12. Ms Brender says that to exploit the goodwill created by the success of the POP IDOL television series in the UK, the company licensed others to use the name in merchandising, mentioning computer and video games, karaoke apparatus, CDs, DVDs, T-shirts, calendars, posters and baseball caps. As evidence in support they provides Exhibit RBF5, which consists of pages taken from the eBay UK auction site that list various goods being sold under the POP IDOL name. The prints were taken on 24 October 2005, which is after the relevant date in these proceedings. There is nothing that shows the position at the time that the application was filed, or that these goods were, or are being sold under license. Ms Brender says this shows that some two years after the last broadcast, the British public is still selling merchandise connected with the programmes, and that she believes them to identify POP IDOL merchandise as being associated with the company and the television programme.

13. Ms Brender states that her company has not yet licensed a third party to use its POP IDOL trade mark in relation to the products covered by the application, but does possess a registration in Class 30. She goes on to refer to Exhibit RBF6 (should be IB6), which consists of a photograph of a Smarties packaging tube that she says was issued in conjunction with the television programme. The tube contains details of a competition, the winner getting to meet the winner of the POP IDOL competition. Ms Brender asserts that she considers it inevitable that the British public will assume any item bearing the POP IDOL mark has been authorised by her company. In support she goes on to refer to, and cite passages from an earlier Decision of the Registrar, a copy of which is shown as Exhibit IB7

Applicants’ evidence

14. This consists of a Statutory Declaration dated 17 February 2006, from Puravee Shah, a

Trade Mark Agent employed by Murgitroyd & Company. Ms Shah's Statement consists of submissions on the merits of Ms Brender's Statement and the accompanying Exhibits. Whilst I do not consider it to be either necessary or appropriate that I summarise this as evidence, I will take them fully into account in my determination of this case.

Opponents' evidence in reply.

15. This consists of a Witness Statement dated 4 July 2006, from Isabelle Brender. Being evidence in reply it is perhaps not surprising that Ms Brender's Statement consists substantially of submissions on the merits of Ms Shah's criticisms of her earlier Statement and evidence. Where further exhibits have been provided, or there is evidence of fact I have summarised this below. Otherwise, I do not consider it to be either necessary or appropriate that I summarise the submissions, but will, of course, take them fully into account in my determination of this case.

16. Ms Brender further explains that FremantleMedia Limited, FremantleMedia Operations B.V. and Thames Television Ltd are part of the same group, Exhibit 2IB1 being an organogram detailing the relationship. She goes on to refer to the licensing of the POP IDOL mark, introducing a constructed table setting out details of the licences granted as Exhibit 2IB2. The exhibit lists licences said to have been granted between February 2002, and November 2003, although in a number of cases this is stated simply as "2002" or "Autumn 2003". In no case is there a specific date or any documentary evidence. The goods stated to have been licensed bear the POP IDOL mark in a sort of handwritten script, placed over a "star", often contained within an oval border. The goods shown consist of confectionery, cake, video, CD, book and magazine, karaoke apparatus and software, dance-mat, video game and board game, hats and t-shirts and mobile phone fascias,

17. Ms Brender goes on to introduce Exhibit 2IB3 as further evidence of her company's licensing activities. The exhibit consists of details extracted from the eBay auction site, including www.ebay.co.uk. Ms Brender says that although dating from June 2006, they are representative of the position at the relevant date, although does not say how she knows this to be the case. She further says that the fact that twenty POP IDOL items are on sale some two and a half years after the last programme of the POP IDOL series is illustrative of the extent and longevity of the reputation and goodwill of the mark. Ms Brender specifically mentions a mobile phone holder brought out by Nestle under the name CHOC IDOLS, drawing attention to the words "POP IDOL TM FremantleMedia Ops BV & 19TV Ltd as evidence of licensing.

18. Ms Brender next introduces Exhibit 2IB4, which consists of an extract from the www.smlxtralarge.com website entitled "Pop Idol – American Idol", drawing attention to a passage from the second and third pages that gives details of the revenue ITV was set to derive from POP IDOL. The extract contains a reference to Nestle paying £6 million as a sponsor, and a general reference to there being revenue derived from merchandising.

19. Exhibit 2IB5 consists of pages from the www.codemasters.com/popidol/sub/pop_idol.php website, extracted on 27 June 2006, listing POP IDOL merchandise, including a video game, T-shirts, baseball cap, drawstring bag, mug, an interactive recording studio, board game, pens, video and DVD and books. All bear the POP IDOL name placed over a star and

contained within an oval border.

20. The final exhibit, 2IB6, consists of an article dated 11 August 2003, taken from the online website of The Guardian. This refers to the impact of POP IDOL on the merchandising market, and to the show licensing t-shirts, a book, a video and mobile phone cover during the first series, expanding to include make-up, hair gel, clothing, song book, video game, electronic dance mat, karaoke interactive recording studio and perfume. The article contains a quote from the Chief Executive Office of FremantleMedia Licensing Worldwide that the IDOL brand will be the “biggest TV licensed brand this Christmas.” The article goes on to look at the viewer demographics, and to refer to Nestle producing their own version of the show under the name CHOC IDOLS that allowed viewers to vote for their favourite animated chocolate character. The article also mentions the creation of an on-line karaoke machine which had been promoted in 16 of the largest shopping centres in the UK.

21. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

22. Turning first to the grounds founded on Section 5(1), 5(2)(a) and 5(2)(b). These sections read as follows:

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

(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.”

23. An earlier trade mark is defined in Section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or International trade mark (EC) 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.”

24. In my consideration of a likelihood of confusion or deception 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, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [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*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,
- (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*,
- (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*,
- (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*,
- (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*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (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*,
- (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 & Adidas Benelux BV*,
- (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*.

25. The opponents rely on two earlier trade mark registrations, both of which achieved

registration within five years prior to 14 January 2005, the date on which the application in suit was published. This being the case, the provisions of Section 47(2)(A) introduced under The Trade Marks (Proof of Use, etc.) Regulations 2004 do not apply.

26. The opponents' earlier marks are for the words POP IDOL in a plain block font, and the same words in an italicized script placed over a star and contained within an oval border. The latter is a series of two marks, with the first mark having the words in white over a blue star; the oval being black, and the second mark in monochrome. I note the applicants' admission in their Counterstatement that these earlier marks are similar to their mark insofar as the ground under Section 5(2)(b) is concerned. Apart from denying any similarity in the respective goods and/or services, the applicants do not comment one way or the other on whether the opponents' earlier marks are identical, as required by the grounds under Section 5(1) and 5(2)(a).

27. On a visual comparison, it is clear that the opponents' first mark POP IDOL in a plain font is identical to the mark for which registration is sought. In the case of the composite POP IDOL mark, to my mind the words are the dominant element. Placed as they are over the star and oval the words relegate these graphical elements to supporting roles as backgrounds, although I would not go so far as to say that in combination they lack any distinctive character. They, and the italicized script in which the words are shown have an impact on the overall appearance, but as I have already said, it is the words that are the dominant, distinctive element, and in that the respective marks are the same. Accordingly, I find the opponents' POP IDOL mark to be visually identical, and their POP IDOL composite mark to be very similar.

28. There can be no argument that the opponents' word only mark and the mark applied for will sound the same when spoken; they are, after all composed of the same words. I have already indicated that I consider the words to be the dominant, distinctive element of the opponents' composite mark. It is generally accepted that in marks composed of words and figurative elements that it is the words that speak, or to put it another way, a consumer is more likely to refer to a mark by use of the words, than to embark on a description of the elements. It therefore follows that the opponents' earlier marks and the mark of the application are aurally identical.

29. The words POP and IDOL are ordinary English words, POP being a reference to "popular music", which when combined with "IDOL" creates the idea of some iconic "pop artist". This is a fairly obvious meaning, and this being the case is more likely than not going to be the way that the majority of the consumers will understand the mark. Having determined that the public will see and refer to the respective marks as POP IDOL marks, I do not see that there can be any dispute that if the respective marks say anything, they must say the same.

30. Taking all of these factors into account, I have no difficulty in determining that the opponents' mark consisting of the words POP IDOL without any addition or embellishment, is identical to the mark in suit, and that their composite mark is similar.

31. As I have said, the mark POP IDOL is a combination of two ordinary words that convey the idea of a performer of popular music who has achieved the status of stardom. Unless they

have been educated otherwise, the consumer is likely to regard use of this mark in respect of goods such as printed matter and visual/audio media (CDs, DVDs and video tapes) as a description rather than an indicator or origin. Whilst the “message” conveyed by the mark will remain whatever goods or services the mark is used in connection with, in respect of goods other than of the type I have mentioned, this reference will be an allusion rather than a description. There is no evidence that POP IDOL is a term used by other traders in relation to a trade in any goods or services, let alone those covered by the opponents’ registrations or the application in suit. To my mind, other than in the use outlined above, the words POP IDOL should be regarded as possessing a distinctive character.

32. The name was used in respect of a series of television programmes involving a competition amongst aspiring pop stars, first aired between 6 October 2001 and 9 February 2002, with a second series being shown between August and December 2003. The main programmes are broadcast under the name “POP IDOL”, with variants such as “POP IDOL FINAL”, “POP IDOL RESULTS” and “POP IDOL RESULT” being used to denote a different stage of each competition. The programmes were broadcast on national television, and involved the audience in voting for performers. Each evening after the main show, a “results” programme would follow announcing the outcome. There can be no doubt from the ratings, number of viewers and the market share captured, that the first POP IDOL series reached a very significant proportion of the public, many of whom would notionally be consumers of the respective goods and services involved here. A second spreadsheet gives similar information relating to the POP IDOL RESULTS SHOW that appears to have been broadcast later in the evening after each main show. Ms Brender highlights that The Final of the POP IDOL competition was the highest rated live entertainment show, holding the top position amongst young adults, apparently being watched by over 13 million people, representing approximately 60% of the television viewing public. Over 32.2 million votes were said to have been cast by the public during the series, which even allowing for repeat calls made by the same person, is a staggering amount.

33. Eleven thousand auditions were held in the UK, with some 70,000 web-chat hits recorded after the results show. A book entitled POP IDOL sold to accompany the series, became the number one best seller in the UK with sales of over 100,000 units, with over 120,000 video tapes of the programmes entitled “A Star is Born” being sold to date.

34. During the period January/February 2002, the programme, and in particular the Final, received an enormous amount of press coverage in many of the UK’s national daily newspapers and magazines, a number of which mention POP IDOL as having given ITV the “best ratings win” for years.

35. There can be little argument that the evidence shows that at the end of the first series in February 2002, the POP IDOL name was extremely well known and had a substantial reputation in relation to the television series, but that reflects the position nearly two years prior to the relevant date. There is no evidence that the name POP IDOL has received any attention in the media since the ending of the first series, but to my mind the continued success of the POP IDOL participants, in particular, Will Young and Gareth Gates is likely to keep the POP IDOL name alive in the mind of the consumer who will recall their rise to fame via the programme. I have no doubt that the press will have quoted this link in features about these performers.

36. The opponents did not provide the same level of detail in respect of the second series of POP IDOL, which means that it is more difficult to gauge the impact. All that they say is that the number of telephone calls received for the final exceeded those of the first series final. I do not consider it unreasonable to infer that a proportion of these 9 million plus callers will have watched earlier episodes from the series, and that the second series attracted a significant amount of attention from the public.

37. To my mind, the evidence establishes that at the end of the first television series, the POP IDOL name was so well known in connection with the television series that it could not easily be severed from the show. There is sufficient to suggest that in the period between the first and second series the POP IDOL name is likely to have remained in the public eye. The rather bald evidence relating to use thereafter illustrates that at the end of the second series in December 2003, the name was still high in the consciousness of the public. I therefore have little hesitation in concluding that at the relevant date in these proceedings, which it should not be overlooked is early in the month following the second series final, the opponents had a reputation, in the name POP IDOL, in respect of a television series.

38. What is far less clear is the extent this reputation may have extended into goods and services outside of the television show. Apart from the book and video linked to the first series, the evidence relating to the opponents' merchandising activities lacks the sort of detail needed to be of any assistance. It is also, to a very large extent an activity from their past. An article dated 11 August 2003 taken from the online website of The Guardian refers to the impact of the show on the merchandising market, referring to the licensing of t-shirts, book, video and a mobile phone cover during the first series, expanding to include make-up, hair gel, clothing, song book, video game, electronic dance mat, karaoke interactive recording studio and perfume during the second. The Chief Executive Office of FremantleMedia Licensing Worldwide stated that the IDOL brand would be the "biggest TV licensed brand this Christmas". Nestle also produced their own version of the show under the name CHOC IDOLS, and the creation of an on-line karaoke machine which had been widely promoted in shopping centres in the UK. This would seem to be an indication that the name POP IDOL, in the "star-oval" logo form had been substantially merchandised, but as I have already said, the evidence lacks detail and is largely an historical activity. The evidence from the eBay auction site shows there to be an active interest and trade in POP IDOL linked merchandise well after the relevant date, but it is extremely difficult to quantify what this means in terms of a reputation, or consumer expectations.

39. With most merchandising, the products licensed reflect or complement some aspect of the core business, the perceived or desired brand identity, or the demographic group that is seen as the target consumer. The POP IDOL merchandising appears to have followed this. The core business is a television programme involving music, singing and dancing, hence the merchandising of karaoke machines, videos, books, T-shirts, dance mats, video games, etc. The image of the participants would also be an influence in trend-setting, with clothing, hair gel, make-up, etc, being related products. These are also items likely to be of interest to the target viewers, namely, young persons and young adults. No matter how popular the show may have been, the reputation established through this merchandising, and the likely perception of the consumer should the POP IDOL mark be used on any other goods should both be taken to exist within these parameters.

40. Turning to the respective goods and services. The applicants are seeking registration in Classes 32 and 33 in respect of a range of alcoholic and non-alcoholic beverages and preparations for making such goods. Although not stated in the Statement of Case, the opponents' written submissions focus their arguments on there being similarity between these goods and those covered by Class 30 of their earlier marks. To my mind this is a much more realistic approach, for the remaining goods and services covered by the opponents' earlier mark are self-evidently quite different from those of the application.

41. There could be some question regarding the specification of services for Class 35 of the opponents' earlier marks which covers the general retailing of goods via an Internet website. Whilst this would notionally encompass the retailing of the goods that are covered by the application, the specification of the opponents' earlier mark does not actually mention the retail activity includes such goods. For reasons given in PAN 7/06 issued 25 May 2006, which sets out the ex-parte examination practice in relation to retail services and searching of the register, I do not need to consider this question further.

42. So the question is whether goods in Class 30 are similar to those that fall in classes 32 and 33? The opponents put their argument as follows:

"...At least some of the Class 30 goods of the Opponents' registrations are confusingly similar to the Class 32 goods of the Application in suit. To support this proposition we file herewith a spreadsheet composed of two columns headed respectively Class 30 and Class 32. The entries in these columns are taken from the Registry's own "trade mark classification search", to be found on line at <http://www.patent.gov.uk/tm/dbase/goodsclass/index.htm>, as a result of inserting into the search engine the word "beverage" and the words "soft drinks". It is clear that there is in fact a considerable degree of overlap between Class 30 and Class 32 specifications. It is commonplace these days for restaurants, inns and bars to sell tea and coffee etc. Simultaneously with sales of alcoholic drinks and non-alcoholic drinks, to the same customers and at the same tables or counters. To make a simple analogy, could the purchasing public in the United Kingdom, knowing the Coca Cola was a trade mark for soft drinks and beverages falling in Class 32 conceivably imagine that Coca Cola branded tea or coffee Beverages in Class 30 did not emanate from the Coca Cola company or that the trade mark was being applied to those Class 30 beverages without the consent of the Coca Cola company? The word "beverages" appearing in both the Class 30 specifications of the Opponents' registrations and in the Class 32 specification of the Application in Suit is very broad in scope in support of that contention we rely upon the definition in "Collins English Dictionary" (5th Edition 2000) the word "beverage" meaning "*any drink; usually other than water*"."

43. For the record, the submissions did not include the spreadsheet referred to, but even it had, all that it would have established is that beverages can be found in several goods classes, including Classes 30 and 32. This does not mean that such goods are similar, nor does the fact that the word "beverages" has a broad meaning, namely, "*any drink; usually other than water*". This simply indicates that beverages of whatever type have a similar use; they are all for drinking.

44. In my view the Coca Cola analogy does not assist. If the consumer were to make the connection claimed, this would be because Coca Cola has a highly distinctive mark with a

strong reputation for soft drinks and beverages, which is no doubt why the opponents chose to use this brand. From this it is not unreasonable to infer that should Coca Cola be used by another trader in respect of goods for the same purpose as those for which it is so well known, the consumer may well believe there to be a link. The opponents in this case might have a strong reputation for what is, in relation to most goods or services a distinctive mark, but as I have already pointed out, this has not been established in relation to any sort of beverage or anything similar.

45. In deciding whether the goods are similar, I will consider the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 (pages 296, 297) as set out below:

“...the following factors must be relevant in considering whether there is or is not similarity:

- (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 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 the trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors.”

46. Whilst I acknowledge that in the view of the *Canon* judgement the *Treat* case may no longer be wholly relied upon, as can be seen from the following paragraph, the ECJ said the factors identified by the UK government in its submissions (which are listed in *Treat*) are still relevant in respect of a comparison of goods:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

(see paragraph 56 of Case T-169/03 explaining the change from “end consumers” to “intended purpose”. This appears to have resulted from a mis-translation of the original text.)

47. Because of the licensing laws relating to the sale and consumption of alcoholic drinks, those over 18 years of age will constitute the users of all beverages, be it tea, coffee, beer or spirits, whereas those beneath this age will be users of only non-alcoholic drinks. This is the position whether the goods are obtained in from a shop, or served on licensed premises. Apart from this, there is nothing in the respective specifications that limits the goods in any way, and this being the case, I must assume that the respective end users are notionally the same.

48. The description “alcoholic beverages” can be put into various categories, such as “wines”, “spirits” and “beers” that are quite distinct in their nature. Within these groupings can be found sub-categories containing goods of the same “general” description, but even so may be different in their nature, for example, wines can be sparkling, still or fortified, spirits may be made from grain, grape, or be natural or synthetic based, and beers can be lagers, ales, stouts, bitter, etc. These goods may have the same raw ingredient base, but apart from that may be quite different in nature. Non-alcoholic beverages such as juices, lemonade, etc are somewhat closer in nature with it being commonplace for them to have a similar flavour, or for one to be mixed with the other. These are all drinks that may be consumed as they are, or may, according to taste, be mixed with another beverage, such as beer and lemonade, gin and tonic. However, whether alcoholic or non-alcoholic, such beverages are in the main very different in nature from coffee, tea, cocoa, etc, which are generally drinks that are made by adding another liquid, usually heated. I do, however, recognise that there are ready-made coffee, chocolate and tea based beverages on the market that would be covered by the opponents’ specification that are similar in nature to soft drinks.

49. Goods such as coffee, tea, lemonade, beers, wine and spirits are bought by most households as part of their ordinary shopping, and even without evidence it is possible to say that these goods almost certainly meet in the wholesale/retail sectors on their journey to the end consumer. There are, however, retail circumstances, such as “off licences, where goods such as coffee and tea are far less likely, if ever found.

50. In general retail establishments such as supermarkets, tea, coffee, soft drinks and alcoholic beverages are usually obtained by self-selection, although in smaller outlets this may be on request to a sales assistant. However they are obtained, in my experience the normal practice is for goods of a particular (and similar) generic type to be displayed together. For example, coffee will be alongside tea, drinking chocolate and the like, with alcoholic beverages such as whiskies, brandies, wines and beers etc., being displayed together in their different generic versions. Coffee, tea, etc will be displayed in distinct areas from alcoholic and even non-alcoholic drinks, how distinct will depend upon the size of the retailer and the extent of the range they carry, but even in small establishments these will be on different shelves. These are, I believe, circumstances with which the consumer of the goods in question will be familiar and expect.

51. The opponents argue that it is commonplace for restaurants, inns and bars to sell tea and coffee etc., alongside alcoholic and non-alcoholic drinks, to the same customers and at the same tables or counters. Despite the lack of supporting evidence, I do not consider this to be an unreasonable statement of the trade mentioned, but this is just one aspect of the trade in beverages. It also does not take into account the fact that in the premises mentioned, the tea, coffee, etc will be sold prepared for consumption, and usually obtained by request using the

generic product name rather than brand. To the extent that the respective goods are all beverages they can be considered as alternatives, or in other words, in competition. They may also be complementary in that brandy and coffee can be after-dinner drinks, sometimes even in the same drink.

52. There is, however, no evidence that a producer of the beverages found in Class 30 also makes those of the type found in Classes 32 and 33, nor anything that establishes that the relevant trade, or one connected with it consider these to be goods from within the same category or classification.

53. Whilst there are similarities in some aspects, taking a balanced view of all the factors for and against, I come to the position that the differences are such that the beverages (and preparations for making them) covered by Classes 32 and 33 of the application are not similar to the goods covered by Class 30 of the application.

54. Whilst the evidence supports the contention that at the relevant date, the opponents had a strong reputation, this existed in respect of a television series, and potentially to a range of goods with varying degrees of connection to the genre of the show, but in all respects not in relation to any goods or services that would be considered similar to those covered by the application. As was stated in *Marca Mode CV v Adidas AG and Adidas Benelux BV*, the fact that a mark may have a reputation “does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense.” What is required is for that association to cause the public to wrongly believe that the use of the mark applied for in relation to the goods for which they seek registration, is use by the opponents, or an economically linked undertaking. Even though the respective marks are identical and similar, taking into account all of the particular circumstances of this case, I do not consider there to be a likelihood of confusion. The grounds under Section 5(1), 5(2)(a) and 5(2)(b) are dismissed accordingly.

55. Turning next to the ground under Section 5(3). That section reads as follows:

“5.-(3) A trade mark which - (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

56. The European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01) determined that Article 5(2) of the Directive granted a right to the proprietor of an earlier trade mark with a reputation, to prevent others from using an identical or similar trade mark in relation to goods or services where such use would, without due cause, take unfair advantage or be detrimental to the distinctive character of the earlier trade mark. In relation to section 5(3) a connection must be established between the earlier trade mark and the goods/services for which it has a reputation and the later trade mark and the goods/services it encompasses. In *Daimler Chrysler AG v Javid Alavi trading as MERC* [2001] RPC 42) Pumfrey J stated:

“there must be actual unfair advantage or detriment. But, for this to happen, there must be some sort of connection formed (I avoid the word association) between the sign used by the defendant and the mark and its associated reputation.”

57. In its judgment in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd*, the ECJ confirmed this view:

“29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).

58. In paragraph 30 the ECJ indicated that whether there are factors that contribute to that connection being made is part of a global appreciation.

59. As I have already stated in my determination of the earlier grounds, the applicants’ mark is identical to one of the opponents’ earlier marks, and similar to the other, so the first part of Section 5(3) is met.

60. The next requirement is that the applicants’ mark possesses a reputation in the UK to the extent set out by the ECJ in *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 122 (*Chevy*). In this case the Court concluded that the requirement implies a certain degree of knowledge amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

61. Earlier in this decision I stated that I considered the evidence to support the view that at the relevant date, the opponents’ were likely to have possessed a reputation of some substance in relation to their television show, and achieved a significant level of success in the share of the viewing public attracted. What is far less clear is the extent that this reputation may have extended into goods and services outside of the television show. The only goods for which any sort of sales details have been given is a book and video linked to the first series, for which the sales appear to have been significant. An article dated 11 August 2003 from the online website of The Guardian refers to the licensing of t-shirts, books, videos and mobile phone covers during the first series having expanded to include make-up, hair gel, clothing, song books, video games, electronic dance mats, karaoke interactive recording studios and perfume during the second. There are references such as in exhibit 2IB5 that suggests the merchandising from the show would be highly successful, and the Chief Executive Office of FreemantleMedia Licensing Worldwide stated that the IDOL brand would be the “biggest TV licensed brand this Christmas.”, but what it does not say is in relation to what, or what this means in terms of the market share achieved. In paragraph 6 of

her Statement, Ms Brender quotes figures taken from Exhibit 2IB4, which say that “POP IDOL is set to make a massive £122 million profit for ITV”, going on to give a breakdown for each aspect of the income bar the merchandising. Adding the figures together seems to leave some £2 million derived from merchandising, which does not seem that significant. Again, what this does not say what any goods or services were licensed, or the extent that they were actually merchandised. There are also references to Nestle having their own version of the show named CHOC IDOLS, and on-line karaoke machine having been promoted in many of the largest shopping centres in the UK, but does not give any detail to put this into context.

62. The evidence gives a strong indication that the name POP IDOL (in the “star-oval” logo form) has been substantially merchandised, but there is no way to put it into context of the market and gauge the impact on the consumer. It also, to a very large extent shows the merchandising to be an activity from their past. The evidence from the eBay auction site shows there to be an active interest and trade in POP IDOL linked merchandise well after the relevant date, but it is impossible to quantify what this means in terms of a reputation, or consumer expectations. To my mind the evidence may have placed the concept of POP IDOL being used in relation to goods in the minds of the public, but does not go anywhere near to proving the existence of a reputation in anything other than the television show, a book and a video, amongst a “significant part” of the relevant sectors of the public, primarily because it is lacking in the very detail identified in *Chevy*.

63. It was stated in *Premier Brands UK v Typhoon Europe* [2000] FSR 767, “Section 10(3) is not intended to have the sweeping effect of preventing the use of any sign which is the same or similar to, a registered trade mark with a “reputation” or have the intention of enabling the proprietor of a well known registered mark “... to be able to object as a matter of course to the use of a sign which may remind people of his mark.”. The question is whether advantage will be unfairly gained, or detriment caused by the applicants’ use of POP IDOL in relation to the goods for which they seek registration. In the *Chevy* case, the ECJ said the following:

“43. It is to be noted in particular that Article 5(2), in contrast to Article 5(1)(b), does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: “takes unfair advantage of, or is detrimental to”. Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say, properly established to the satisfaction of the national court: the national court must be satisfied by evidence of actual detriment, or of unfair advantage. The precise method of adducing such proof should in my view be a matter for national rules of evidence and procedure, as in the case of establishing likelihood of confusion: see the tenth recital of the preamble.”

64. The registered proprietors have not provided any evidence that damage or detriment has occurred, which may well be explained by the fact that there is no evidence that the applicants have actually used the mark. The applicants focus their case on the assertion that the applicants are hitching a free ride on the reputation established by the success of their activities, namely, their television series. In his written submissions, Mr Lynd quotes the following passage from *Adidas-Salomon AG, Adidas Benelux BV v. Fitnessworld Trading Ltd* [2003] E.T.M.R. 91:

AG39 The concepts of taking unfair advantage of the distinctive character or repute of the mark in contrast must be intended to encompass instances where there is clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation [FN18]. Thus by way of example Rolls Royce would be entitled to prevent a manufacturer of whisky from exploiting the reputation of the Rolls Royce mark in order to promote his brand [FN19]. It is not obvious that there is any real difference between taking advantage of a mark's distinctive character and taking advantage of its repute; since however nothing turns on any such difference in the present case, I shall refer to both as free-riding.”

65. He went on to cite part of a paragraph from the decision in the opposition by QS Holdings SARL to an application by *New Century Intellectual Property Investments Limited*, (BL O-087-06), in which the applicants had sought to register the name QUICKSILVER for use in relation to “non-alcoholic beverages; fruit drinks and fruit juices; mineral, aerated and carbonated water; preparations for making non-alcoholic drinks; beer” in Class 32.

“79) Mr Garrad states that he wished to ensure that the drink would be free of any of the slightly tainted values associated with high sugar drinks, such as Coca Cola, and the high caffeine levels associated with the more extreme energy drinks, such as Red Bull. He states that he coined the name QUIKSILVER as he felt that it alluded to the brand values which he wished to associate with the product. Quick is suggestive of the flow of the drink and is evocative of vitality, freshness and an active life-style, silver reflects the clear, crisp colour of the product. It seems to me that the brand image that he is aiming for is that already achieved by QS. Use of the trade mark QUIKSILVER for beverages, taking into account all the factors I have listed above, would, in my view, have a free ride on the very positive young image that is part and parcel of the reputation of QS. It would take advantage of all the promotion that QS has taken over many years to build up its brand. Especially for young people I consider that use of QUIKSILVER for beverages would come freighted with reputation of QS. I am of the view that a link with the reputation of QS would be made. With the high profile and positive image of QS’s QUIKSILVER, I have no doubt that use for beverages would have a definite economic effect. New Century would not just be riding on the coat tails of QS, QS’s reputation would be acting as a spring board for New Century’s product.”

66. I have quoted the paragraph in full because it contains references to two points that Mr Lynd considers relevant to this case. The first is that the applicants in these proceedings were also the applicants for the QUICKSILVER mark, and are also the owners of a registration that he says is “a blatant reference to the well known series ““Only Fools and Horses””. He suggests that “...someone with a suspicious mind might possibly have cause to believe that the Applicants make a deliberate practice of trading on the reputation of the trade marks of others.” On its face this could be taken as a clue to the applicants’ motive for seeking registration, but without something else this is no more than conjecture. What is interesting is that in the QUICKSILVER case the applicants sought to explain how they came to adopt the mark. As Mr Lynd points out, in these proceedings they have remained silent, a fact that I will take into account when considering the question of “due cause”.

67. The opponents contend that the use of the mark applied for by the applicants will divert their valuable goodwill to the applicants, and as a consequence they will be deprived of its benefit, and being unable to control the manner in which the applicants use the mark, their reputation in the mark may be prejudiced.

68. As I have already mentioned, despite these challenges the applicants have said nothing that explains how, or why they chose the name POP IDOL and now seek to register it as their trade mark. Would they have adopted the name had the television show not been so successful in bringing the name to the attention of the public? I believe the answer is obvious. It is not an ordinary description that someone could conceivably and innocently just happen upon by accident. I am conscious of the comments in the *Premier Brands UK* case regarding the intended effect of Section 10(3).

69. Taking all of the factors into account, I come to the view that the findings of the Hearing Officer in the QUICKSILVER are apt for the circumstances of this case. To my mind, use of the trade mark POP IDOL for beverages, taking into account all the factors I have listed above, would, in my view, have a free ride on the very positive young image that is part and parcel of the reputation of the show. It would take advantage of all the effort in creating the POP IDOL name and reputation. The brand may not have been built through use and promotion over many years, but the medium by which it came into the public eye has an immediate and significant impact, and the image associated with the name is of paramount importance to the success of the show, and its attractiveness and viability as a vehicle for merchandising. I consider that use of POP IDOL for beverages, alcoholic or otherwise, and preparations for making such goods would come freighted with the reputation built by the opponents, and I am of the view that a link with that reputation would be made. With the high profile and positive image of the POP IDOL television show, I have no doubt that use for beverages would have a definite economic effect. New Century would not just be riding on the coat tails of the POP IDOL reputation, the reputation would be acting as a spring board for New Century's product.

70. This leaves the question of whether the "due cause" proviso to Section 5(3) applies. In the *Premier Brands UK Ltd v Typhoon Europe Ltd* case, Neuberger J dealt with the issue of "without due cause" in the concluding part saying:

The conclusions I have reached on the facts of this case, whether Premier's analysis of the law is correct (as I believe to be the case) or if TEL's analysis is correct, are reached irrespective of where the onus of proof lies. However, it is right to record that in my view on either analysis the onus of proof would rest on TEL. I cannot pretend that the point is straightforward, because there is obvious force in Mr Bloch's contention that, where a proprietor of a trade mark alleges infringement under a particular statutory provision, it is up to him to establish each of the prescribed statutory ingredients necessary to establish infringement. However, as I see it, the words "being without due cause" although not plainly expressed as such, really represent a proviso or exception to the generality of section 10(3). In those circumstances, if an alleged infringer, such as TEL, wishes to rely on those words, it is up to it to establish that it falls within the exception, rather than up to a proprietor of the mark to establish that the proviso does not apply. It is fair to say that this is a conclusion I would have reached even if I had held that TEL's analysis was correct. It follows that Premier will succeed in establishing infringement under section 10(3) provided that it can show that TEL's use of the TYPHOON sign "takes unfair advantage of" and/or "is detrimental to" "the distinctive character or repute of the [TY.PHOO] mark".

71. So if the applicants wish to rely on the “due cause” proviso, they must expressly do so by presenting their case. Apart from a denial of the grounds on which the opposition is based, and some specifics such as the lack of similarity in the respective goods and services, the applicants have not sought to argue that they had due cause to adopt and use POP IDOL. I do not therefore see that there is anything from which I can infer that they had.

72. Given the nature of the mark and the timing of the application so close to the end of the second series, I do not consider it unreasonable to infer that the applicants chose the name POP IDOL in the full knowledge of its use in relation to the television series. It is immaterial whether or not this is the case. In *Julius Sämann Ltd and others v Tetrosyl Limited* [2006] EWHC 529 (Ch) Kitchin J stated:

“84..... The fact that the sign complained of was innocently adopted is not sufficient to invoke the exception. The defendant must show not only that the use complained of is "with due cause" but also that the taking of unfair advantage or causing of detriment are not "without due cause". All of these matters point to a relatively stringent test.....”

73. Taking all of the above into account, I arrive at the conclusion that the use of the name POP IDOL, by the applicants, in respect of the goods covered by the application would, without due cause, take unfair advantage of the reputation that exists in an earlier mark owned by the opponents by freeriding off that reputation. The proprietor of that earlier trade mark should be able to prevent them from using what is an identical (and similar) trade mark in relation to the goods of the application because doing so would, without due cause, be detrimental to the distinctive character of the earlier trade mark in that its distinctiveness may be diluted and reputation tarnished. The ground under Section 5(3) succeeds accordingly.

74. Turning next to the ground under Section 5(4)(a). That section states:

“5.-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,”

75. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case* [1998] 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.””

76. 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 429 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”.

77. Consequently, the material date cannot be after the date of application. There is no evidence of use of the trade mark by New Century, so the behaviour complained of is the act of filing the application which occurred on 7 January 2004.

78. I have already accepted that the opponents have established a reputation in the trade mark POP IDOL in respect of a television programme. Whilst there is information that supports the view that this extends to a book and a video produced to coincide with the first series, there is insufficient detail in the evidence to be able to say that this reputation extended to any other goods. The items for sale on eBay are a reasonably clear indication that there have been sales of, and potentially, a goodwill established in respect of other types of goods, but this cannot be quantified or even placed in time. They are also goods quite different from those covered by the application in suit, and to me there is no natural relationship or progression in trade from goods such as hair gels, clothing, confectionery, etc, to beverages, be they alcoholic or non-alcoholic.

79. The difficulty of establishing confusion where there is a distance between the fields of activities was considered by Millet L.J. in *Harrods v Harrodian School* [1996] RPC 697 Millet LJ 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.”

And

“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.”

80. In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade LJ considered the difficulty of establishing damage where the parties are in different lines of business:

“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 a minimal loss is in my opinion a heavy one.”

81. In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31, Lord Fraser emphasised the substantial nature of the damage that a plaintiff must establish:

“That he has suffered, or is *really likely* to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.”

82. Christopher Wadlow in “The Law of Passing-Off” (third edition) at 4-23 puts forward the following proposition:

“Most of the authorities may perhaps be reconciled with the proposition that the risk of damage is sufficiently real if:

1. Confusion between the parties will be widespread and inevitable, even though there may be no immediate reason to believe that actual damage in any particular form will occur, or
2. There will be some confusion of the parties, and the defendant’s business poses a special risk to the claimant because of the way it is currently conducted or because of future developments which can actually be expected.

If confusion with the claimant is slight and tangible damage speculative then there is no liability for passing off.”

83. Even though the respective trade marks are identical and similar, the distinction in the respective activities does not necessarily mean that amounts to a misrepresentation that would lead to confusion or deception, but even if there were, the distance between the spheres of activity means that it does not automatically follow that there would be damage. It is also important to bear in mind that in *Mastercard International v Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) Smith J held that there “must be real possibilities as opposed to theoretical possibilities” of the damage claimed. In *Electrocoin Automatics Limited v Coinworld Limited and others* [2004] EWHC 1498 (Ch) Mr Geoffrey Hobbs QC (sitting as a deputy judge) stated:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, 'the link' established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that

purpose.”

84. As I have already mentioned, whilst there is evidence that shows the opponents had been engaged in the licensing of the POP IDOL mark, this is in the main unquantifiable and historical. The goods merchandised fall within a category either aimed at reflecting some aspect of genre of the show, or that would be likely to be of interest to the target audience. These are very different goods to those for which the applicants seek registration, which are in a market that the opponents have never entered, or expressed any plans or intentions to enter. Whilst the use of POP IDOL on beverages might confuse the consumer, I see no reason why they would be deceived into buying these goods believing them to have directly or indirectly originated from the opponents. As Millet LJ in *Harrods v Harrodian School* stated, “To be known to everyone is not to be known for everything.”. In my view there is no likelihood of damage, and the opposition under Section 5(4)(a) fails.

85. The opponents’ claim that POP IDOL is a well-known trade mark and entitled to protection under section 56 of the Act. Section 56 of the Act states:

“56. - (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well known in the United Kingdom as being the mark of a person who-

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.”

86. Apart from ticking the box on the pro forma to indicate that they object under Section 56 of the Act, the opponents have said nothing about their claim. It is difficult to consider this ground when the goods and services for which the opponents claim to be well known and have a reputation have not been identified in the first instance. Given that the opponents’ earlier marks encompass a range of goods and services far wider than has been demonstrated in the evidence, and the fact that where the evidence shows use of the mark in respect of goods, these are different to those of the application. I cannot see that this claim advances the opponents’ case beyond the protection afforded by Section 5. In essence, the fact that the POP IDOL name was used in connection with a highly successful television show, and has

acquired a reputation in respect of this and a limited range of connected merchandise, does not make POP IDOL entitled to the protection of Section 56. To repeat the words of Millet LJ in another context, “to be known to everyone is not to be known for everything”. I reject this ground of opposition.

87. In summary, the ground under Section 5(3) has been successful, but the other grounds under Sections 5(1), 5(2)(a), 5(4)(a) and 56 all fail.

89. The opposition as founded having been successful, the opponents are entitled to a contribution towards their costs. I therefore order that the applicants pay the opponents the sum of £1,200 towards their costs. This sum 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 18th day of April 2007

**Mike Foley
for the Registrar
the Comptroller-General**