

O-018-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2426729
BY FILM 24 LIMITED TO REGISTER A
TRADE MARK IN CLASSES 9 AND 38**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 94989 BY CHANNEL FOUR TELEVISION CORPORATION**

BACKGROUND

1) On 10 July 2006, Film 24 Ltd, applied to register the trade mark:




for the following goods and services:

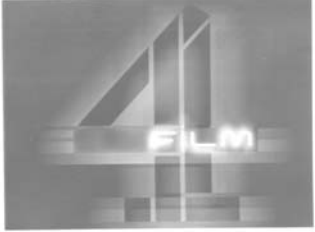
Class 9: Animated cartoons, cinematographic film, editing appliances for cinematographic films.

Class 38: Cable television broadcasting, computer aided transmission of messages and images, radio broadcasting, satellite transmission, television broadcasting.

2) On 19 February 2007, Channel Four Television Corporation (hereafter the opponent), filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Trade Mark	Number	Application Date and Registration Date	Goods
 <p>A series of two.</p>	2178392	30.09.98 & 08.10.99	<p>Class 9: Films; video and audio recordings, recorded radio and television programmes, films, tape, disks and other data storage media including databases; magnetic and optical data carriers.</p> <p>Class 16: Books and printed matter; instructional and teaching materials.</p> <p>Class 38: Broadcasting services including online services; relaying sound recordings, messages and images over telecommunication services and computer aided transmission of sound messages and images.</p> <p>Class 40: Services for the transfer of sound and/or images to video or audio tape or to other media including processing of sound and/or images; processing of films, video and audio recordings, and recorded radio and</p>

			television programmes. Class 41: Production of films video and audio recordings, and radio and television programmes; editing sound and/or images; editing of films, video and audio recordings; rental of films and of audio and video recordings.
	2171256	04.07.98 & 12.02.99	Class 9: Films; video and audio recordings, recorded radio and television programmes, films, tape, disks and other data storage media including databases; magnetic and optical data carriers.
			Class 16: Books and printed matter; instructional and teaching materials.
			Class 38: Broadcasting services including online services; relaying sound recordings, messages and images over telecommunication services, and computer aided transmission of sound messages and images.
			Class 40: Services for the transfer of sound and/or images to video or audio tape or to other media including processing; processing of films, video and audio recordings, and recorded radio and television programmes.
			Class 41: Production of films video and audio recordings and radio and television programmes; editing sound and/or images; editing of films, video and audio recordings, and recorded radio and television programmes; rental of films and of audio and video recordings.

b) The opponent states that these marks have been used on the goods and services for which they are registered since at least as early as 1999. The opponent states that as a result of this use it has reputation and goodwill in the marks above. The opponent claims that the goods and services applied for by the applicant are identical and/or extremely similar to the goods and services for which its marks are registered and that the marks of the two parties are very similar. The opponent states that the application offends against Section 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994.

3) On 23 May 2007, the applicant filed a counterstatement which denied the opponent's claims and put the opponent to proof of use.

4) Both sides filed evidence and seek an award of costs in their favour. The matter came to be heard on 1 December 2008 when the opponent was represented by Mr Stobbs of Messrs Boulton Wade Tennant and the applicant was represented by Mr Butler of Messrs Frank B Dehn & Co.

OPPONENT'S EVIDENCE

5) This consists of two witness statements, dated 18 January 2008 and 29 January 2008, both by Mr Nick Swimer a commercial lawyer working for the opponent. He states that he is authorised to make the statement on behalf of the opponent and that the facts contained within his statement come from his own knowledge and also the opponent's books and records.

6) He states that Channel 4 is a British television station which broadcasts to the whole of the UK and which began transmission in 1982. He states that in the year to 31 March 2006 the opponent's total revenue was £894.3 million, with £735.2 million generated by the main channel and the remainder by subsidiaries, digital channels (which includes the Film4 channel), sales of programme rights, feature films and "new media".

7) Mr Swimer states that the opponent uses the words FILMFOUR in respect of both its digital channel showing films and also for the production of films. In July 2006 both areas were re-branded as FILM4 when the digital channel went free-to air. He states that this re-branding brought the trading styles of the divisions in line with the Channels general trading style and that the public recognised FILMFOUR as being part of Channel 4's suite of channels. He states that FILM4 remains the only film channel available free on digital terrestrial television. Mr Swimmer states that the channel aims for "a more niche and highbrow market by showing a mixture of old and new independent, art house, British, foreign language and specialist cinema, along with critically acclaimed Hollywood films". He states that since 2003 Film4 Productions have commissioned approximately £160 million worth of films (by production budget) and that the channel shows many of its own products. He claims that the opponent enjoys a strong reputation in its name Channel Four/ Channel 4 and also the marks FILMFOUR/ FILM4.

8) Mr Swimer provides an historical background to Channel Four most of which I do not find helpful in regard to my decision and so it is not summarised. Only those aspects which I believe are relevant are summarised below:

- 1998:- separate pay film channel, FILMFOUR, launched. At the same time the film production arm was renamed FILMFOUR. Companion services such as FILMFOUR+1, FILMFOUR WORLD and FILMFOUR EXTREME were also made available on some digital services.
- 2001:- a dedicated entertainment channel E4 was launched.
- 2006:- the newly renamed FILM4 channel went free-to-view and was available on Digital Terrestrial Television (freeview).

9) Mr Swimer provides the following turnover figures:

Year	Channel 4 £millions	Film 4 Channel £millions	Film 4 Productions
2000	716.4	8.8	28.6
2001	730.7	13.3	17.6

2002	766.9	12.3	18.8
2003	769.6	13.8	17.2
2004	841.4	18.4	14.2
2005	894.3	17.9	9.2

10) Mr Swimer provides considerable details of UK box office figures and films produced by the opponent under the FILMFOUR mark. However, it would appear that most of this success was during the period 1994-2000. The box office figures for the period 2000-2003 which relate to films produced by the opponent appear to amount to approximately £6.9million out of total box office receipts of £2,189 million or 0.3%. Whilst the films mentioned by Mr Swimmer are stated to be examples it includes one which grossed less than £1 million and others which were just above this figure. It appears unlikely that he would have left out any major successes. He also states that during the period 2000-2004 the opponent earned approximately £21million from DVD/VHS sales. He states that “the large majority of DVDs or Videos distributed by Channel 4 bears the FILMFOUR trade mark in a very prominent position on the front cover and everyone purchasing such a DVD or Video will have seen the mark”.

11) Mr Swimer states that since 2000 Channel 4 (including S4C the Welsh arm) has averaged an audience share of approximately 10% per annum with only a slight downturn in numbers from year one to year six. Mr Swimmer states that FILM4 audience figures are not included in the figures for Channel 4. The audience figure for this channel is said to have averaged approximately 0.8% but only since September 2006 after the relevant date. Mr Swimer provides various exhibits which show use of the term FILMFOUR plus the Channel 4 logo. The word FILMFOUR is mostly shown with the word FILM in black and the word FOUR in white with the Channel 4 logo being in white on a black background. There are instances where the word FILM is in white and the word FOUR is in black with the logo remaining in white on a black background. In magazine or newspaper articles the term FILMFOUR occurs simply within the text as two words with each having a capital letter “F” at the start (Film Four), or as a single word with the same capital letters (FilmFour). Broadly these all show use of trade mark No. 2178392, there is no use of trade mark No.2171256.

12) Mr Swimer claims that:

“61. As a result of Channel 4’s huge weight of advertising and promotion, combined with the turnover achieved, and the very large usage of our services by our customers in the UK, the FILMFOUR and FILM4 brands have both achieved massive recognition in the marketplace and have come to be identified uniquely with Channel 4 in the minds of consumers.

62. This view is supported by two particular external matters, that is, the position that Channel 4 has achieved in the marketplace since 1982 and secondly, the recognition of Channel 4’s reputation within the British and International film industry.”

13) Mr Swimer summarises the position as follows:

“64. The numeral 4 has been used in relation to all services provided by Channel 4 since 1982. Channel 4’s entire broadcasting program stems from and evolves around the numeral 4. It is the inclusion of the numeral 4 within Channel 4’s various brands which is indicative of Channel 4. Channel 4 has without doubt acquired substantial goodwill in the numeral 4 in relation to television broadcasting and entertainment related goods and services. The originally branded FILMFOUR changed its name to FILM4 to bring it in line with this consistent use of the numeral, such as in Channel 4’s other channels E4 and MORE4.”

14) Mr Swimer also states:

“3. There are a large number of channels available to UK television viewers which are solely devoted to the broadcast of films. To the best of my knowledge, the film channel FILM4 is the only film channel available in the UK whose name contains the word “film” and the numeral “4”, other than the Applicant’s recently launched FILM24 channel. The public are used to seeing names such as SKY MOVIES but Channel 4’s FILM4 is unique in its combination of the word film and the numeral 4.”

15) At exhibit NS1 he provides a list of all the channels for which the Radio Times provide broadcasting listings. He states that of the 270 channels listed the only channels whose names contain the word film and the numeral 4 are Film4 and Film 4 + 1, both of which are Channel 4’s film channels.

APPLICANT’S EVIDENCE

16) The applicant filed a witness statement, dated 2 June 2008 by Timothy Greatrex the Chief Executive Officer of the applicant company. He states that the applicant company was set up to make films and short features and programmes about films for distribution as a cable and satellite channel as well as for cinemas, terrestrial television, DVD’s, the internet etc. He states that the Film24 channel was launched in July 2007 and is listed by SKY under its entertainment channels. He draws a contrast between this and the “movie channels” which SKY lists elsewhere. He states that the “24” part of the mark refers to it being available 24 hours a day, even though at present there are periods such as the early hours of the morning when the channel does not broadcast. He states that the numeral “4” in the opponent’s mark has no meaning other than to link it with Channel 4.

OPPONENT’S EVIDENCE IN REPLY

17) This consists of a further witness statement by Mr Swimer, dated 1 September 2008. He makes submissions regarding the activities of the parties and the similarity of the marks which are not “evidence”. He also disputes the applicant’s claims regarding audience share, which again are not relevant to my decision.

18) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

19) At the hearing the opponent withdrew all grounds of opposition relating to its trade mark number 2171256 as it accepted that it had not provided evidence of use of the mark.

20) The first ground of opposition is based upon section 5(2)(b) of the Act. This reads:

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

(a)

(b) it is similar to an earlier 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.”

21) An earlier right is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK), 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,”

22) Also of relevance are the provisions of Section 6A of the Act. Section 6A sets out the circumstances in which the provisions apply. In relation to opposition proceedings the relevant parts of which state:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes-
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

23) In these proceedings, the opponent is now relying upon one earlier trade mark, UK 2178392 which has a registration date of 8 October 1999 and qualifies as an earlier trade mark under the above provisions. The mark applied for was published for opposition purposes on 17 November 2006, more than five years after the earlier mark was registered. The mark relied on by Channel Four Television Corporation is subject, therefore, to the proof of use requirements set out above. In its counterstatement Film 24 Limited puts the opponent to proof of use of its mark. As trade mark UK 2178392 is a series of two marks I shall be referring to in the plural from now on.

24) Section 100 of the Act states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

25) In considering this issue I take into account the judgement in Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV* where the European Court of Justice, on 11 March 2003, stated at paragraphs 35-42:

“35. Next, as Ansul argued, the eighth recital in the preamble to the Directive states that trade marks ‘must actually be used, or, if not used, be subject to revocation’. ‘Genuine use’

therefore means actual use of the mark. That approach is confirmed, *inter alia*, by the Dutch version of the Directive, which uses in the eighth recital the words ‘werkelijk wordt gebruikt’, and by other language versions such as the Spanish (‘uso efectivo’), Italian (‘uso effettivo’) and English (‘genuine use’).

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of origin of goods or services to the consumer or the end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *viv-a-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations for by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market.

40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available.

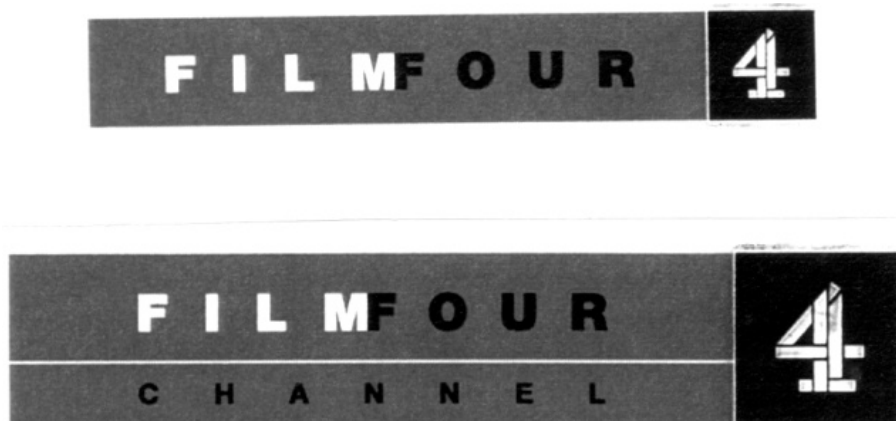
41. That applies, *inter alia*, where the proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold, and for which he makes actual use of the same mark under the conditions described in paras [35] to [39] of this judgement. Since the parts are integral to those goods and are sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor’s rights in respect of those goods.

42. The same may be true where the trade mark proprietor makes actual use of the mark, under the same conditions, for goods and services, which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.”

26) In its skeleton arguments the applicant conceded that:

“The use proved by the opponent in the period since 17 November 2001, consists of the use of the words FILM and FOUR reversed. The Applicant concedes that this change does not alter the distinctive character of the mark in the form in which it was registered, The use of this form of the mark proved in the period between 17 November 2001 and 17 Novemeber 2006 consists of Dvds and VHS videos (first witness statement of N Swimer, Paragraph 44, Exhibit NS2; Paragraph 43, Exhibit NS3) and the operation of a television film channel. (first witness statement of N Swimer, Paragraph 57, Exhibits NS7, NS8 and NS9).”

27) The opponent’s registered mark is a series of two marks as shown below:



28) The only difference between the marks is that the second mark in series has the word “CHANNEL” included. Clearly, when this was accepted as a series it was felt that the word “Channel” was not distinctive being more a descriptive term for a broadcasting company. I note that the applicant has not sought to draw any distinction between the marks and has conceded that the evidence provided should be regarded as use of the registered marks even though the evidence shows marks slightly different to that registered. I must agree with this view and am grateful for the very pragmatic stance taken by the applicant in this instance. In the remainder of this decision I shall therefore use the first mark in the series as the comparator, and cease to use the plural form when referring to the opponent’s mark.

29) The opponent’s registered specification is as follows:

Class	Films; video and audio recordings, recorded radio and television programmes, films,
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9	tape, disks and other data storage media including databases; magnetic and optical data carriers.
Class 16	Books and printed matter; instructional and teaching materials.
Class 38	Broadcasting services including online services; relaying sound recordings, messages and images over telecommunication services and computer aided transmission of sound messages and images.
Class 40	Services for the transfer of sound and/or images to video or audio tape or to other media including processing of sound and/or images; processing of films, video and audio recordings, and recorded radio and television programmes.
Class 41	Production of films video and audio recordings, and radio and television programmes; editing sound and/or images; editing of films, video and audio recordings; rental of films and of audio and video recordings.

30) The concession, regarding use, provided by the applicant covers the whole of the Class 9 specification with the exception of “magnetic and optical carriers” and I can see no evidence of use of the mark in suit on such items in the evidence provided. There is no evidence of use on any of the items in Class 16. The applicant’s concession covers the whole of the Class 38 specification. The evidence provided shows use on Class 40 and 41 as the opponent has both produced movies for broadcasting and also sold Dvds and VHS tapes of them. In stating this I am deliberately adopting a broad brush policy as this is clearly not an issue between the parties and there are clear overlaps in their specifications. When carrying out the comparisons under Section 5(2) (b) I shall exclude “magnetic and optical carriers” from the opponent’s Class 9 specification and shall disregard its Class 16 specification completely.

31) I now move onto consider the issue under section 5(2) (b). In determining the question under this section I take into account the following cases: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabusiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Kilsen Handel BV* [2000] 45 FSR 77, *Marca Mode CV v Adidas AG & Adidias Benelux* [2000] ETMR 723, Case C 120/04 *Medion* [2005] ECR 1-8551 and Case C 421/04 *Metratzen Concord v OHIM* [2002].

32) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant’s mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

33) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the

Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

34) At the hearing the applicant accepted that the opponent had reputation under the UK trade mark 2178392 in relation to, “in particular, DVDs, VHS videos and the operation of a television film channel”. Mr Stobbs, for the opponent, contended that I should not consider the box office figures for the opponent against the UK box office totals as the opponent produces what he termed “arthouse films”. This seems to me to be a case of Mr Stobbs wanting to have his cake as well as eating it. On the one hand the opponent claims to have a reputation because of films such as “Four Weddings and a Funeral” and on the other claims that it does not compete with Hollywood blockbusters but has a reputation for arthouse movies. As far as I am aware an Arthouse movie is one which is more devoted to the art of film-making than to mass entertainment. To my mind “Four Weddings”, would be seen by the average cinema goer as the very antithesis of an Arthouse movie. To my mind the average consumer should be regarded as the general public, not solely those who have an interest in arthouse movies. To my mind the opponent’s mark is inherently distinctive for the goods and services for which it is registered. I agree with the opponent that the word elements, “Film” and “Four”, of it’s mark are “weak” but globally the mark has enough to be described as distinctive albeit it is no Kodak.


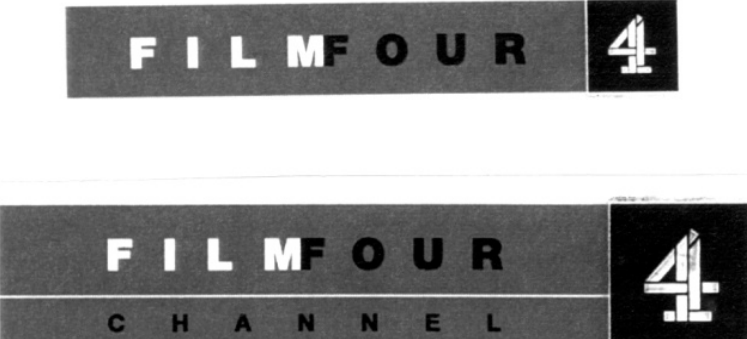
35) I now turn to consider the specifications of both parties, which are as follows:

Applicant’s specification	Opponent’s specification
Class 9: Animated cartoons, cinematographic film, editing appliances for cinematographic films.	Class 9: Films; video and audio recordings, recorded radio and television programmes, films, tape, disks and other data storage media including databases.
Class 38: Cable television	Class 38: Broadcasting services including online services; relaying

broadcasting, computer aided transmission of messages and images, radio broadcasting, satellite transmission, television broadcasting	sound recordings, messages and images over telecommunication services and computer aided transmission of sound messages and images.
	Class 40: Services for the transfer of sound and/or images to video or audio tape or to other media including processing of sound and/or images; processing of films, video and audio recordings, and recorded radio and television programmes.
	Class 41: Production of films video and audio recordings, and radio and television programmes; editing sound and/or images; editing of films, video and audio recordings; rental of films and of audio and video recordings.

36) The applicant accepts that “the application covers some goods and services that are identical to DVDs, VHS videos and the operation of a television film channel, which are covered by the earlier registration and on which use has been proved”. Clearly, with the exception of “editing appliances for cinematographic films” in the applicant’s specification, both parties goods in Class 9 must be regarded as identical or very similar. The same is true of the Class 38 services. Whilst some of the opponent’s services in Classes 40 and 41 are complimentary to the applicant’s goods and services they have a very low level of similarity.

37) I now turn to consider the marks of the two parties, which are as follows:

Applicant’s mark	Opponent’s marks
	

38) As stated previously, I shall be regarding the opponent’s marks as a single mark and using the first in the series for the comparison. Both marks contain more than one word or element and are, therefore, composite marks. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components. To my mind, even though the word “film” in each mark is at least allusive, if not actually descriptive, of the type of good or service it cannot be ignored. Neither do the other element/s of the marks, in either case, dominate the mark. Both marks have to be considered in their entirety. Indeed the opponent stated that both aspects of its mark “Film” and “four” were weak elements, but together they are distinctive.

39) Considering the marks visually, both have the word "Film" in them. The applicants mark also has the number "24" and a "searchlight" device which, to my mind, is quite prominent and distinctive. The opponent's mark also has the word "four" and the device of the number "4". Whilst there is a visual similarity caused by the initial word element "Film" this is, to my mind far outweighed by the differences. It was suggested that the number element of both marks would be confusing as both had the number "4". I do not accept this contention. The average consumer would see the word "four" and the device "4" in the opponent's mark and one would serve to emphasise the other. The applicant's mark has the number "24" which is wholly different. The opponent offered no reasoning as to why the average consumer would be confused by the numbers other than the fact that they both contained/consisted of the number four. I do not find this argument persuasive. I believe that the "searchlight" device in the applicant's mark is distinctive, it is not something which exists in the background or around the periphery but cuts through the heart of the mark and is a distinctive element.

40) When comparing the marks aurally the same contentions apply, although clearly the device element of the applicant's mark cannot be vocalised. I do not consider the numerical elements to be aurally close let alone similar.

41) With regard to the services in Class 38 it was contended that there was a conceptual significance to the use of "24" within the applicant's mark, signifying that the channel broadcast twenty-four hours a day. Whilst I accept that this may bring this to mind with regard to these services, for the bulk of the specification it has little meaning. In both cases the word "film" can be seen as descriptive of many of the goods and services but the marks as wholes do not have conceptual meaning for their respective goods and services.

42) The opponent referred me to the cases of OHIM Decision No. B 2668/2003 *Banco 21 v. Bank 121*; OHIM decision B.981/870 *Action 5 v. Action 10*; and also to UK O/037/98 *Club 24 v Club 240*. Having reviewed these cases I do not believe that they add anything to those that I have listed in paragraph 23. They would appear to me to have been decided on their own facts which are not exactly on all fours (no pun intended) with the instant case.

43) I take of all of the above into account when considering the marks globally, in particular the fact that the goods in Classes 9 (with one exception) and services in Class 38 are identical. To my mind the differences far outweigh any similarity in the marks such that even when used on identical goods or services I believe that there is not a likelihood of consumers being confused into believing that the goods and services provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

44) I now turn to the ground of opposition under section 5(4)(a) which reads:

"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, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

45) In deciding whether the mark in question “FILM 4” offends against this section, 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:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

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] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 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 the 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.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’

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.”

46) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the

date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. In the evidence the applicant claims to have first used their mark in July 2007, after the application date of 10 July 2006. Therefore, the relevant date is the date of application.

47) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision. The applicant accepts that the opponent has a reputation in the marks “Film Four” and “Film 4” which they regard as synonymous. This reputation is in relation to DVDs, VHS videos and the operation of a television film channel. The opponent has shown that it operates a television channel showing films under the mark FILM4, and I am also content that it produces films under the same mark, although I leave the issue as to whether they are Arthouse or mainstream open, as it is not relevant here. The opponent has therefore succeeded in overcoming the first hurdle of goodwill.

48) I now move to consider the issue of misrepresentation. I cannot rely upon my earlier views on the mark as registered with regard to similarity as the opponent has reputation in the mark “Film Four/ Film 4” which are regarded by both parties as being synonymous. For the sake of comparison I shall use “Film 4” as the applicant’s mark has a numeral. Clearly, both marks begin with the word “Film” and so visually and aurally the beginnings are identical. I accept that the beginning of a mark has particular significance (*Tripcastroid*). It was contended that both marks consist of the word film and a numeral and it was this combination that made the marks distinctive. The opponent itself described the word element of their marks as “weak”. The applicant’s mark has the same issues. The word “film” for what is essentially a TV channel showing films is hardly distinctive. The numeral “24” would be taken by most to refer to the channel showing films twenty four hours a day. However, in combination with the device element of a searchlight it is, in my view, quite distinctive. The device element, which cuts through the heart of the mark, would not be ignored or overlooked by the average consumer whether they are the general public or only those interested in arthouse movies. I accept that the device element would not be used aurally, but I do not accept the contention that the numeral “2” in the applicant’s mark would be lost.

49) The opponent contended that the “24” aspect of the applicant’s mark was not referring to a 24 hour service being available as the channel did not offer films or programmes on a 24 hour basis. Whilst this is currently the case I cannot ignore the applicant’s contention that when the mark was chosen it was, and still is, their intention to be broadcasting round the clock.

50) In my opinion the differences in these marks far outweigh the similarities even when used on identical goods or services. Consequently there is no misrepresentation, and so the ground of opposition under section 5(4)(a) fails.

51) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £2,000. 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 23 day of January 2009

**George W Salthouse
For the Registrar,
the Comptroller-General**