

O-019-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2376026
BY WOODBRIDGE ESTATES LIMITED TO REGISTER THE TRADE MARKS**

**THIRTYSOMETHING
THIRTY SOMETHING
THIRTY-SOMETHING
30SOMETHING
30 SOMETHING
30-SOMETHING**

IN CLASSES 9, 16, 25 AND 41

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 96239
BY METRO-GOLDWYN-MEYER STUDIOS, INC**

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**IN THE MATTER OF Opposition thereto under No. 96239
By Metro-Goldwyn-Meyer Studios, Inc.**

BACKGROUND

1) On 19 October 2004, Woodbridge Estates Limited ("Woodbridge"), of PO Box 4, Alresford, Hampshire, SO24 0WA applied under the Trade Marks Act 1994 ("the Act") for registration of the following series of six trade marks:

THIRTY SOMETHING
THIRTY-SOMETHING
30 SOMETHING
30-SOMETHING

2) The application is in respect of the following goods and services:

Class 09

Apparatus for recording, transmission, editing and/or reproduction of sound and/or images; magnetic and/or optical data carriers; recorded magnetic and/or optical data carriers; recording discs, compact discs; DVDs; records; films, video and audio recordings; recorded audio and/or video tapes; computer programs; computer games; digital music (downloadable) from the Internet; publications in electronic form and data supplied online or provided through the Internet; spectacles, sunglasses and cases for spectacles and sunglasses; parts and fittings for all the aforementioned goods.

Class 16

Printed matter; printed publications; books, magazines, journals; posters, photographs, postcards, greetings cards; song books, sheet music; wall charts; instructional and teaching material; writing and drawing materials and instruments; bags, packaging materials; calendars; stencils, decalcomanias; photograph albums; folders and files for papers; ring binders; note books; note pads.

Class 25

Clothing; footwear; headgear.

Class 41

Entertainment services; provision and presentation of live entertainment and/or recorded entertainment; production, presentation or rental of television and/or radio programmes, films, sound and video recordings; presentation, production and performance of shows, musical shows, concerts, videos and stage productions; information relating to entertainment; interactive entertainment services; digital music (not downloadable) provided from a computer database or the Internet; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; electronic games services provided on-line; nightclub and discotheque services; dance club services; club entertainment services.

3) On 9 February 2008, Metro-Goldwyn-Mayer Studios Inc. ("MGM") of 10250 Constellation Boulevard, Los Angeles, California 90067 – 6241, USA filed notice of opposition to the application. MGM relies upon the two earlier marks, detailed below:

Number and relevant dates	Mark	Use claimed in respect of:
Community Trade Mark (CTM) 144824 Filing date: 1 April 1996 Registration date: 13 August 1998	thirtysomething	Class 41: Entertainment and cultural activities
1578364 Filing date: 13 July 1994 Registration date: 2 June 1995	THIRTYSOMETHING THIRTYSOMETHINGS 30 SOMETHING 30 SOMETHINGS (series of 4)	Class 41: Production of television shows

4) The grounds of opposition are in summary:

- a) Woodbridge's application offends under Section 5(1) of the Act because the marks are identical to MGM's earlier marks and certain Class 41 services are identical to the corresponding services of MGM's earlier registrations.
- b) Woodbridge's marks offend under Section 5(2) (b) of the Act because they are identical or similar to two of MGM's earlier marks and all the goods and services claimed are identical or similar to MGM's services.
- c) Woodbridge's marks offend under Section 5(3) of the Act because they are identical or similar to the same two earlier marks that have a reputation.
- d) MGM has goodwill in the earlier sign THIRTYSOMETHING that is entitled to protection by virtue of the law of passing off and MGM's application therefore offends under Section 5(4) (a) of the Act.

5) The applicant subsequently filed a counterstatement denying the opponent's claims and requesting that MGM provide proof of use in respect of all the goods and services claimed.

6) Only MGM filed evidence in these proceedings. Both sides ask for an award of costs. Neither side requested a hearing, but both filed written submissions in lieu of such. After careful consideration of the paper, I give my decision.

Opponent's Evidence

7) This takes the form of a witness statement dated 8 December 2008 by David Angus Stone, a partner of Simmons & Simmons, MGM's representatives in these proceedings. He states that MGM first used the mark THIRTYSOMETHING in 1987 in the USA as the name of a television programme about a group of baby boomers living in Philadelphia. There was a total of eighty five episodes and a list of these, obtained from the Internet Movie Database website www.imdb.com, is provided at Exhibit DAS-1. The series was first broadcast in the UK in January 1989 and was later broadcast in the UK in 2006/7 on the channel More4. At Exhibit DAS-2, a licence agreement is provided relating to these latter broadcasts. This agreement is between Channel Four Television Corp and Sony Pictures Television International/Colombia Pictures Corp (UK) who, MGM explains, is a "related affiliate of the opponent" and who "were the sales agent/sub-distributor for the opponent at the time the licence agreement was concluded." This particular copy does not appear to be signed, but that said, it is not clear whether the pages exhibited constitute the whole agreement. A list of transmission dates and times is also provided, detailing twenty eight episodes

being aired in a condensed period between 21 August and 12 October 2006, shown in a mid-afternoon slot or at two o'clock in the morning.

8) Mr Stone also states that the series has been broadcast elsewhere in the European Union, including France (from 29 September 1987), Sweden (from 22 January 1989), Germany (from 27 October 1991), Spain (from August 1997), Italy, Portugal, the Netherlands and Luxembourg. In support of this, at Exhibit DAS-3, Mr Stone provides details of revenue received by MGM as a consequence of airing the series in the EU during the period 2001 - 2006. This revenue can be summarised as follows:

COUNTRY	YEAR						TOTAL (US\$)
	2001	2002	2003	2004	2005	2006	
Austria		74	125	315	623		1,137
Belgium					4,274	6,304	10,578
Denmark				15,354			15,354
Germany	2,002	10,499		17,909	7,540	6,457	44,407
Hungary					209		209
Italy	102,000	102,000					204,000
Netherlands			7,559	13,300	76,041	26,445	123,345
Portugal				36,689	14,311		51,000
Sweden		12			10		22
Slovakia					96		96
UK			145,000	57,000	38,388	376,157	617,545
TOTAL (US\$)	104,002	112,585	152,684	140,567	141,492	415,363	1,067,693

9) The tables exhibited by Mr Stone record a total of US\$ 1,081,327. The discrepancy between this figure and that recorded in the table above is explained by two additional entries in MGM's exhibit. The first records that US\$ 11,859 revenue was received from a territory identified as "EGR". The second attributes US\$ 1,988 revenue to a territory identified as "SCH". No explanation has been provided regarding the identity of these territories and for that reason, I have not included them in my summary.

10) Exhibit DAS-4 is a copy of a licence agreement dated 23 April 2004 and covers the period 1 June 2004 to 31 May 2006 in respect of the broadcast of the THIRTYSOMETHING programmes and others in Portugal, together with papers recording payments in respect of this agreement. Exhibits DAS-5, DAS-6 and DAS-7 are similar agreements, dated 28 February 2001, 29 December 2004 and 24 August 1998 respectively and relate to broadcasts in Italy, San Marino, parts of Switzerland and the Vatican City, the Netherlands, Luxembourg, Spain and Spanish Andorra.

11) Mr Stone states that the series is permanently available to licence for broadcast in the EU and MGM could therefore reach agreement to broadcast the series at any time. He also states that the series is actively marketed at an annual international conference held in Cannes, France and that the 2008 conference was attended by 13,360 participants.

12) Mr Stone states that the THIRTYSOMETHING series is available for sale in DVD format in the EU and that the soundtrack is also available. In support of this statement, at Exhibit DAS-8, Mr Stone provides copies of pages from www.amazon.co.uk, www.amazon.fr and www.amazon.de, all dated 25 November 2008 illustrating that the series soundtrack was available on CD in these territories at this time.

13) At Exhibit DAS-9, Mr Stone provides a list of awards and nominations achieved by the THIRTYSOMETHING programme, obtained from www.imdb.com. This list includes numerous Emmy Awards and two Golden Globe Awards, in the period 1988 to 1991. In further support of the reknown and cultural influence of the series, Mr Stone provides, at Exhibit DAS-10, an article from the website of the Museum of Broadcast Communications at www.museum.tv and he highlights, in particular, the following comments on the series:

“...its stylistic and story-line innovations led critics to respect it for being “as close to the level of an art form as weekly television ever get(s)”, as the New York Times put it...

...The series’ influence was evident long after it moved to syndication... That influence was evident in everything from the look and sound of certain TV advertisements, to other series with feminine sensibilities and preoccupations with the transition from childhood to maturity (Sisters), to situation comedies about groups of friends who talk all the time (Seinfeld)”

14) At Exhibit DAS-11, Mr Stone provides copies of two decisions, the first issued by the European trade mark office, known as the Office for Harmonization of the Internal Market (OHIM) in respect of Woodbridge’s attack on MGM’s CTM144824 for “thirtysomething” on the grounds of non-use. The second is a decision of the IPO (BL O-045-08) in respect of a similar attack on MGM’s UK registration 1578364. He draws attention to the fact that MGM was successful in defending the attack in respect of *entertainment and cultural activities* in the former and in respect of *production of television shows* in the latter. Mr Stone states that this demonstrates that the OHIM and the IPO both found that MGM had put the mark THIRTYSOMETHING to genuine use for these services in the relevant jurisdiction in the last five years.

DECISION

Proof of use

15) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case 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 of a kind falling within section 6(1)(a), (b) or (ba) 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, ...
- (5) In relation to a Community trade mark or international trade mark (EC), 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...”

16) The requirements for “genuine use” have been set out by the European Court of Justice (“the ECJ”) in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2005] ETMR 114.

17) In *Ansul*, the European Court of Justice held as follows:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

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 the origin of the goods or services to the consumer or end user...

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 its enforceability *vis-à-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 by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

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 service 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 service concerned on the corresponding market.”

18) In *La Mer* the ECJ held as follows:

“21. ... it is clear from paragraph [39] of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case by case assessment which it is for the national court to carry out....

...

25. In those circumstances it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.”

19) MGM's marks were registered on 13 August 1998 and 2 June 1995 respectively and the application in suit was published on 9 November 2007. The earlier marks were therefore registered more than five years before the publication of Woodbridge's application and, as such are subject to the proof of use requirements. The relevant period in which use must be shown is the five years ending with the date of publication, namely 10 November 2002 to 9 November 2007. In respect of its CTM, MGM are required to demonstrate use in the Community and in respect to its UK mark, it is required to show use in the UK. In its statement of grounds, MGM claim that genuine use has been made in respect of *entertainment and cultural activities* and *production of television shows*.

20) MGM, in its submissions, claims that its CTM has already been subject to an analysis in respect of genuine use in earlier proceedings before the OHIM and it was found that use was demonstrated in respect of *entertainment and cultural activities*. However, there is nothing in MGM's current evidence that supports such a broad claim. The fact that the issue has already been considered by the OHIM does not preclude a separate analysis in these proceedings. The relevant period in the CTM proceedings was 22 June 2001 to 21 June 2006. As this is

different to the relevant period in the current proceedings, there is no form of estoppel as MGM claim. Further, a decision of the OHIM is not binding upon me and I must consider the facts as presented in the evidence of use in the current proceedings. For the same reasons, there is no form of estoppel as a result of the earlier UK proceedings referred to by MGM. Here the two relevant periods spanned from 19 October 1999 to 21 June 2006.

21) MGM disclose turnover in excess of US\$617,000 in respect of the airing of the THIRTYSOMETHING programme in the UK during the relevant five year period. MGM support this by providing a copy of the relevant licence agreement. In its submissions, Woodbridge criticises the agreement on the grounds that it is not signed and because MGM have not supported its statement regarding its relationship to Sony Pictures Television International/Colombia Pictures Corp Ltd (UK), the named licensors in the agreement. In assessing these comments, I am mindful of the following comments of Richard Arnold Q.C. sitting as the Appointed Person in *EXTREME* Trade Mark BL O/161/07:

"Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence."

22) Woodbridge has not challenged any of this evidence by way of cross-examination, nor has it adduced evidence to contradict it. Rather, it has chosen to wait until filing its written submissions, after the completion of the evidence rounds have passed, before making such criticism. MGM's evidence is not self-evidently incredible and, therefore, I have no reason to disbelieve that it does not document MGM's licensing activities relating to the THIRTYSOMETHING programme in the UK. Neither do I have any reason to doubt the evidence that illustrates the activities of Sony Pictures Television International/Colombia Pictures Corp (UK) or that it was acting as MGM's sales agent/sub-distributor and with its consent. The use shown is not internal, it is actual use preserving a position in the market, and it is not token use. MGM also provides a list of transmission dates and times. Once again, Woodbridge cast doubt on the veracity of this list, however, as it is not obviously incredible, my comments, above, apply equally here. Taking all of this together, I find that MGM have provided sufficient evidence, albeit with some flaws, to support a claim of genuine use in the UK and in respect of the airing of the THIRTYSOMETHING television programme.

23) In respect of elsewhere in the EU, very small amounts of revenue have been stated in respect of Austria, Hungary, Sweden and Slovakia. Such small amounts

(in the case of Sweden, for example, it is only US\$22) cannot relate to the airing of the television programme and in the absence of specific information about what these small fees do relate to, I am left to conclude that there has been no use in these territories of the EU that would qualify as use of its CTM within the meaning attributed to Section 6A of the Act.

24) The position is somewhat different in respect to Portugal where the turnover figures provided are supported by a copy of a licence agreement detailing a breakdown of the licence fees for each series of the THIRTYSOMETHING programme and showing that it covered the period 1 June 2004 to 31 May 2006. Further there are six collaborative invoices, all relating to the years 2004 and 2005, together with copies of the corresponding entry in MGM's payment journal and corresponding cash receipt form. Similar exhibits have been provided in respect of the Netherlands even though, in this case, the invoices appear to relate generally to the licence agreement (that covers numerous other feature programmes and television series as well as THIRTYSOMETHING) and, as such, do not mention THIRTYSOMETHING specifically. Nevertheless, I have no reason to believe that a portion of these invoices was not payment in respect to that part of the licence agreement that related to the series THIRTYSOMETHING.

25) In respect of Italy, the copy of the licence agreement shows that it covered the period beginning 1 December 2000 and ended 30 November 2003. There is also a copy of a fax showing that the final payment was made 19 July 2002 in respect of this licence agreement. This is before the start of the relevant period and would appear to indicate that the transmission of the THIRTYSOMETHING programme, in Italy, took place before the commencement of this period. Certainly there is an absence of evidence to collaborate a different conclusion, such as a list of transmission dates showing use in the relevant period. The exhibits that relate to Spain, without doubt, relate to a period before the relevant five year period as the licence agreement covers the period 1 August 1997 to 31 July 2002.

26) In summary, the evidence supports the claim that THIRTYSOMETHING has been used in respect of a television programme, during the relevant period, in the territories of the UK, Portugal and the Netherlands. The evidence is less clear in respect of Italy. I also note that turnover figures for the relevant period have also been provided for Belgium, Denmark and Germany, and whilst these have not been collaborated in the evidence, neither has it been challenged by Woodbridge. MGM is relying, in part, upon a CTM and it has been recently confirmed by the ECJ in *Pago International GmbH v Tirol Milch (PAGO)*, C-301/07, that use of a community trade mark in only one Member State, such as the UK, can be sufficient to meet the proof of use provisions. Whilst the court was considering in which jurisdiction a CTM must be used to establish a reputation for the purposes of Article 9(1) (c) of the Community Trade Mark Regulation, it is highly relevant when considering the lower test of proof of use.

27) Taking all these factors into account, I conclude that use has been demonstrated in respect of the mark THIRTY SOMETHING and in respect of both the UK and the EU. There is no use of the 30 SOMETHING(S) variants covered by the series of marks in the UK registration.

28) This, however, is not the end of the matter, as MGM claim that such use is in respect of the wide term *entertainment and cultural activities* as well as *production of television programmes*. I must, therefore, make a finding as to the scope of this use. In this respect, I am mindful of the guidance provided in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the

court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

29) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant.

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

30) The evidence in the current proceedings principally relates to the distribution, via licence agreements, of the THIRTYSOMETHING programme to various broadcasters in Europe. The mark THIRTYSOMETHING is used in respect of the programme itself. There is no evidence that the mark is used in a wider context. The production of the programme appears to have been undertaken by the opponent and identified by its name or the abbreviation “MGM”. The distribution of the programme appears to have been undertaken on behalf of MGM by Sony Pictures Television International/Colombia Pictures Corp (UK).

31) Taking all of this into account, there is no evidence in these proceedings to conclude that MGM's CTM for the mark THIRTYSOMETHING has been used in respect of *entertainment* at large or in respect of *cultural activities*, as THIRTYSOMETHING is used only to identify a series of television programmes

produced by MGM. Neither does such use support the UK registration which is in respect of *production of television programmes*. The mark THIRTYSOMETHING has not been used to identify MGM's production services but rather, as I have said, it has been used to identify a specific series of television programmes. A production service is provided to other traders, such as broadcasters, and not the television viewing public who are the end consumers of the television programme itself. These services are different and with different end users. In this respect, my finding differs with that of the hearing officer in the earlier Registry decision BL O-045-08 where the Registry concluded that there was use of its mark in respect of *production of television shows*.

32) In light of my findings above, I conclude that there is no use shown that supports MGM's UK registration and with regard to its CTM, I must consider what will be an appropriate specification in light of my findings above and the guidance provided by the courts in *Thomson Holidays and Animal Trade Mark*. I am also mindful of the guidance provided by the Court of First Instance of the European Union ("the CFI") in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03:

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétouquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been

registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

...

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

33) Taking account of the above mentioned guidance, it would not be appropriate to permit MGM to retain the term *entertainment* at large in its specification, as there is just no evidence that the mark has been used in respect of such a wide range of services. The use shown is restricted to a television programme. As such, I find that in respect of CTM 144824 a fair specification to describe the activities of MGM, for the purposes of the comparison of goods and services under Sections 5(1) and 5(2)(b) of the Act and for the purposes of defining the assessment of the scope of any reputation under Section 5(3) of the Act, is *entertainment in the form of television programmes*.

Section 5(1)

34) Section 5(1) of the Act reads:

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

35) An earlier trade mark 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,”

36) MGM’s CTM was filed on 1 April 1996 and completed its registration procedure on 13 August 1998. Woodbridge’s mark was filed on 19 October 2004. MGM’s CTM is therefore an earlier mark in accordance with the Act.

Comparison of the marks

37) The leading authority on the question of whether marks are identical is the ECJ Case *LJT Diffusion SA v Sadas Vertbaudet SA* (“*Sadas*”), C-291/00 where the Court said in relation to Art 5(1)(a):

“Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it

contains differences so insignificant that they may go unnoticed by an average consumer.”

38) Whilst Art 5(1)(a) of the Directive 89/104EEC relates to the scope of rights available to a proprietor once a mark is registered, the Court in *Sadas* says the same interpretation given to Art 5(1)(a) applies also to Art 4(1)(a), being the relevant equivalent provision for these purposes.

39) The marks being compared are:

MGM's Earlier CTM	Woodbridge's Marks
thirtysomething	THIRTYSOMETHING THIRTY SOMETHING THIRTY-SOMETHING 30SOMETHING 30 SOMETHING 30-SOMETHING

40) Woodbridge's first mark differs from MGM's mark in that the latter is in lower case letters and the former is in upper case letters. In all other respects, they are identical. Woodbridge's second and third marks differ from MGM's mark in that, once again, one is in upper case, the other lower case and, in Woodbridge's marks, the words "thirty" and "something" are separated either by a space or a hyphen. There are no other differences. They consist of the same words without any embellishment or additions. Although the words are conjoined in the earlier mark, an average consumer will inevitably break down the mark into separate, recognisable parts or words to make sense of the conjoined word. In *Sadas* (paragraph 52), it was recognized by the Court that the assessment of whether the respective marks are identical should take account of the fact that consumers rarely have the chance to make a direct comparison between the respective marks and must instead rely on an imperfect picture of them kept in their minds. Taking account of this guidance, the addition of a space or a hyphen between to ordinary dictionary words is such as to go unnoticed by the average consumer, as is the fact that one is in lowercase, the others are in uppercase.

41) The considerations are somewhat different when considering Woodbridge's fourth, fifth and sixth marks. These all consist of the numeral "30" and the word SOMETHING either conjoined, separated by a space or separated by a hyphen. Here, the use of the numeral "30" in Woodbridge's marks provides a point of difference that will not go unnoticed by the consumer and despite the respective marks being aurally and conceptually identical, when all other factors are considered, the marks, as a whole, cannot be considered identical.

42) I therefore find that, taking account of the guidance provided in *Sadas*, the first, second and third of Woodbridge's marks are identical to MGM's mark. Woodbridge's fourth, fifth and sixth marks are not identical to MGM's mark.

Identicality of the services

43) In considering the question of identicality, I am mindful of the guidance provided by the CFI in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("Meric")* Case T-133/05, at paragraph 29, which states:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

44) I also bear in mind three further cases providing guidance on the way that specifications ought to be interpreted. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd ("Thomson")* [2003] RPC 32, at para 31, Aldous LJ, says:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use.”

45) Although this was in the context of arriving at a fair specification consequent to an attack of revocation on the grounds of non-use, the principle that it is the public and circumstances of the relevant trade that should underpin consideration as to the terms used in a specification nonetheless holds good. Secondly, there is the case of *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd ("Beautimatic")* [2000] FSR 267, in which the principle of giving words their ordinary (rather than an unnaturally narrow) meaning was enshrined. Finally, there is the case of *Avnet Incorporated v Isoact Ltd ("Avnet")* [1998] FSR 16 where Jacob J (as he then was) says:

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

46) In summary therefore, I must take an approach that is neither unnaturally narrow nor overly wide, and I must consider how the average consumer may perceive matters in the relevant trade.

47) With this guidance in mind, I must assess what, if anything, in Woodbridge's Class 41 specification is identical to *entertainment in the form of television programmes*. Bearing in mind the guidance provided in *Meric* it is self evident that the term *entertainment services* is a term that can include MGM's service and is therefore identical. In respect of Woodbridge's *provision and presentation of recorded entertainment*, these are also identical to MGM's services as television programmes can be accessed not only via a broadcast but also in recorded form. Indeed, television programmes can also be pre-recorded.

48) Woodbridge's *presentation and performance of shows, musical shows, concerts* are not self evidently identical to MGM's services. *Shows* and *concerts* are generally understood as referring to something other than a television programme. I acknowledge that, on occasions, the word *show* may be used to describe a television programme, but as Woodbridge's specification refers to the presentation and performance of the same, the term will be understood as relating to the performance of a live show of some kind. As such, I find that these services are not identical to MGM's. Finally, it is not altogether clear what is intended to be covered by the term *presentation and performance of videos*, but it would appear to allude to a service akin to the "showing" of a video and therefore may relate to the showing of a television programme in recorded form. Therefore, I find that these services are identical to MGM's services.

49) Next, I turn to consider Woodbridge's *production, presentation or rental of television programmes, films, sound and video recordings*. *Presentation of television programmes, sound and video recordings* is clearly identical to *entertainment in the form of television programmes* as the term "presentation" may include the "showing" of a television programme or video recording and associated sound track of the same. With regard to the production and rental services covered by this term, they are closely related to *entertainment in the form of television programmes*, but they are not identical to Woodbridge's services.

50) It is self evident that the Woodbridge's remaining Class 41 services are not identical. These are *provision and presentation of live entertainment; production, presentation or rental of radio programmes; presentation,[and] production of shows, musical shows, concerts, and stage productions; information relating to entertainment; interactive entertainment services; digital music (not downloadable) provided from a computer database or the Internet; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; electronic games services provided on-line; nightclub and discotheque services; dance club services; club entertainment services*.

51) The consequence of my finding is that the ground under section 5(1) is successful, but only in respect of the following list of services in Woodbridge's Class 41 specification of services:

[E]ntertainment services; provision and presentation of recorded entertainment; presentation of television programmes, sound and video recordings; presentation and performance of videos.

52) The remaining Class 41 services listed in Woodbridge's Class 41 specification are not identical to MGM's services. Therefore, these services together with all the goods listed in Woodbridge's application now fall to be considered under Section 5(2) of the Act.

Section 5(2)

53) Section 5(2) (b) read:

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

(a) ...

(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.”

54) MGM has based this ground of opposition upon Section 5(2) (b) of the Act. When considering the grounds in respect of Section 5(1), I found that the first three of Woodbridge's marks are identical to MGM's earlier mark. As Section 5(2) (b) relates only to marks that are similar, it follows that the opposition based upon these grounds is in respect to the fourth, fifth and sixth of Woodbridge's marks. I will therefore base my considerations on this premise.

55) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the 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] FSR. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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) 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.*,

(d) 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*,

(e) 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.*,

(f) 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 and Adidas Benelux BV*,

(g) 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.*

The average consumer

56) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue. In respect of MGM's *entertainment in the form of television programmes*, the average consumer will be the general television viewing public who will access the service through the watching of a free-to-air or paid-for television service. The purchasing act here may vary, from one of low consideration in the case of a casual viewer to one of a reasonably high level of consideration, as may be the case where the consumer is a follower of the programme.

57) In respect to Woodbridge's goods and services, these will involve a number of different average consumers. In respect of many of these, the average consumer will be the general public. However, I do not ignore the possibility that some goods and services, such as *production of shows, musical shows, concerts, and stage productions* may involve a more specialist purchaser with a greater knowledge of the industry. The purchasing act may vary from not being well considered, as is the case in respect of *magazines* for example, to a more considered act, as may be the case in respect of *computer programmes*.

Comparison of goods

58) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 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, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

59) Other factors may also be taken into account as identified in *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] R.P.C. 281, such as the trade channels of the goods concerned.

Woodbridge’s Class 9 goods

60) Whilst *apparatus for recording, transmission, editing and/or reproduction of sound and/or images* are goods that can be used in the making and broadcasting of a television programme, they are produced by distinctly different traders. Their nature and intended purpose are very different, with Woodbridge’s goods being physical apparatus that produce a technical effect, whereas MGM’s services are the provision of the television programmes themselves. The respective trade channels are different, with both the producers and suppliers being different. The end users of Woodbridge’s goods may be a range of consumers from the general public to those who have a specialist trade use for the goods. *Television programmes*, on the other hand, are provided to the television watching public via broadcasters. These may overlap with the end users for some of Woodbridge’s goods. Of course, it may also be argued that the respective goods and services are complementary. The CFI has provided some guidance on this point in relation to the analogous provision of the Community Trade Mark Regulation 40/94. It has said that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking: *Sergio Rossi SpA v OHIM (SISSI ROSSI)*, Case T-169/03. On this basis the CFI has held that wine and wine glasses are not complementary, but that there is a slight similarity between some types of bags in Class 18 and shoes and clothing in Class 25: *El Corte Ingles S.A. v OHIM*, Case T-443/05. Applying this guidance to the current comparison, I cannot conclude that Woodbridge’s goods are indispensable or even important in MGM’s *television programmes* and certainly the relevant consumer will not consider that they are provided by the same or linked undertaking. Therefore, I find there is no similarity.

61) In respect of Woodbridge's *magnetic and/or optical data carriers; recording discs* these too are physical goods and are therefore different in nature to MGM's services. Their intended purpose is to hold data that can be reproduced when the goods are played in suitable apparatus as opposed to MGM's services that is intended to entertain the user. Insofar as Woodbridge's goods may be sold to a segment of general consumers who are also television viewers, there may be some overlap in the respective end users. As such, there may be at least some overlap in trade channels. There is no complementarity in the sense identified in *SISSI ROSSI*. MGM, in its submissions, does not draw a distinction between blank and recorded media and argues that Registry decision BL O-045-08, where the hearing officer stated "I consider that the sale of a television series could be regarded as a trade in recorded media" provides support for its position. I believe there is a distinction between blank and recorded media and I will go on to consider the latter in the following paragraph. However, in respect of goods that can be described as blank media, the relevant consumer will not consider that they are provided by the same undertaking as those who provide *television programmes*. Therefore, I find there is no similarity between these goods and services.

62) On the other hand, Woodbridge's *compact discs; DVDs; records; recorded magnetic and/or optical data carriers; films, video and audio recordings; recorded audio and/or video tapes* are physical goods that contain content. In respect of all except *compact discs* and *records*, this content may be in the form of *television programmes*. The *compact discs* and *records* may contain content that features in a television programme. The nature of all of these goods may be quite different to MGM's services, however, because the content may be the recorded television programme, or in the case of *films*, a television programme made into a film, it follows that the intended purpose and end users will be the same. Taking all these points into account, I find there is a reasonably high level of similarity in respect of these goods and services.

63) In respect of Woodbridge's *computer programs* and *computer games*, MGM argue, in its submissions that the latter goods are often sold as merchandising items linked to films and television programmes. This is a proposition that is far from obvious. MGM has attempted to bolster its point by filing further evidence with its written submissions and strictly speaking, this is inadmissible. Nevertheless, it is helpful if I deal with this point. MGM states that a computer game has been released as a merchandising item to accompany the latest "Terminator" film. Firstly, this relates to the merchandising of a feature film and not a television programme and further, it is just one instance that I cannot accept as illustrating that this is normal practice in the trade. It does not, therefore, change my view that, when applying the criteria set down in *Canon*, it is self-evident that these goods are not similar. They are different in terms of nature and intended purpose and trade channels. Further, within the meaning set out in *SISSI ROSSI* they cannot be described as being complementary, and

neither are they in competition with MGM's services. As such I find there is no similarity.

64) Woodbridge's *spectacles, sunglasses and cases for spectacles and sunglasses; parts and fittings for all the aforementioned goods* are also self-evidently dissimilar to *entertainment in the form of television programmes*. Their nature, intended purpose, users and trade channels are all distinctly different and I find there is no similarity.

65) In respect of Woodbridge's *data supplied online or provided through the Internet; publications in electronic form*, such data and publications may relate to television programmes and as such, there may be some overlap of the users of the respective goods and services. However, a television programme would not normally be described as "data" and, as such, the first term would not be understood as supplying a television programme online. With regard to *publications in electronic form* use of marks identifying television programmes would not identify the trade source of the publications. Further, the intended purpose, nature of, and trade channels for data and electronic publications are different and there is nothing to suggest they may be complementary in the sense identified in *SISSI ROSSI*. Taking all these factors into account, I find that in respect to the first term, there is no similarity and in respect to the second term, if there is any similarity, it is only at a very low level.

66) Finally, in respect to *parts and fittings for all the aforesaid goods*, even where such parts and fitting relate to goods that share a reasonably high level of similarity to MGM's services, the parts and fittings themselves differ in their nature, intended purpose, method of use and trade channels. Neither is there any complementarity in the sense identified in *SERGIO ROSSI*. As such, in respect to all of the parts and fittings covered by Woodbridge's specification, I find that there is no similarity when compared to MGM's services.

Woodbridge's Class 16 goods

67) The following goods can all relate to the subject matter of television programmes: *Printed matter; printed publications; books, magazines, journals; posters, photographs, calendars*. However, use of marks identifying television programmes would not identify the trade source of the publication. As such, their respective natures are dissimilar. Further, they are different in their intended purpose and trade channels. Once again, MGM provides evidence on this point with its written submissions. This evidence shows a range of merchandising for sale in relation to the "Simpsons" television programme. My above comments on the admissibility of this evidence apply equally here, as do my comments regarding the impact of just one instance of such merchandising. Therefore, taking all factors into account, I find if there is any similarity this is only on the very low side.

68) In respect of Woodbridge's remaining Class 16 goods, namely *postcards, greetings cards; song books, sheet music; wall charts; instructional and teaching material; writing and drawing materials and instruments; bags, packaging materials stencils, decalcomanias; photograph albums; folders and files for papers; ring binders; note books; note pads*, these are self-evidently dissimilar.

Class 25

69) In respect of Woodbridge's *clothing; footwear; headgear*, it is self evident that the respective trade channels will be totally unrelated, their nature and intended purpose are very different and it follows that the respective users will also be different. Neither is there an obvious complementarity in the sense explained in *SISSI ROSSI*. Nevertheless, MGM also put forward its "merchandising" argument, supported by the same evidence relating to the "Simpsons" television series", in respect to these goods. My comments above are equally applicable here. Taking all factors into account, I find that if there is any similarity between these goods and MGM's services, it is only very low.

Class 41

70) Taking account of my finding in respect to the Section 5(1) grounds, Woodbridge's surviving Class 41 services are:

Provision and presentation of live entertainment; production, presentation or rental of radio programmes [and] films; production or rental of television programmes and video recordings; presentation, production and performance of shows, musical shows, concerts and stage productions; production of videos; information relating to entertainment; interactive entertainment services; digital music (not downloadable) provided from a computer database or the Internet; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; electronic games services provided on-line; nightclub and discotheque services; dance club services; club entertainment services.

71) Firstly, considering Woodbridge's *production of television, films, sound and video recordings* and *production of videos*, such services share some complementarity with MGM's *entertainment in the form of television programmes* in that a television programme must be produced before it can serve its function to entertain and the respective services are important or even indispensable for the other. Further, *films* and *sound and video recordings* may involve the same content, or be based upon the same content as a television programme. With all of this in mind, Woodbridge's services can be said to share a broadly similar purpose to MGM's services. However, the nature and trade channels may be different. One is the service of making a programme or similar for a trade consumer, the other is entertainment for general consumers through the showing of such a programme. That said, the end consumer of MGM's services may

come across the name of the producer of the programme. Taking all of this together, I find that these respective services share a reasonably high level of similarity.

72) Next, with regard to *rental of television programmes, sound and video recordings, presentation or rental of films* here the nature and intended purpose may be similar to MGM's services in that they involve "packages of entertainment" being made available for the purpose of entertaining. There may also be some overlap in the respective trade channels, especially where the television programme is also available in recorded format such as video. This would be the general way that *rental of television programmes* will be made available. In these circumstances, the respective services may be available from the same trade source. As such, there is a reasonably high level of similarity between the respective services.

73) In respect of *presentation of radio programmes*, they are similar to MGM's services in terms of nature and purpose. A radio programme may be an adaptation of a television programme or vice-versa and as such they may also share the same or similar content. The relevant public accesses such presentation through a broadcast of the programme, and as such shares a similarity with television programmes which are also accessed, predominantly, through a broadcast. Taking all of this into account, I find that these respective services also share a reasonably high level of similarity. The position is different in respect of *production or rental of radio programmes*. Such services relate to a business to business activity, but due to the nature of a television programme being slightly different to the nature of a television programme, such activity is not complementary to MGM's services. Further, whilst it is common for the service of *rental of television programmes* to be supplied direct to the general public, the same cannot be said for *rental of radio programmes*. It is not normal for such a service to be made available to the general public and the term will refer to the rental of programmes to broadcasters or similar. Taking all of this into account, I find that there is only a very low level of similarity to MGM's services.

74) In respect of *provision and presentation of live entertainment; presentation and performance of shows, musical shows, concerts and stage productions* there is some similarity to *entertainment in the form of television programmes*. However, whilst they share the same intended purpose, namely to entertain, the precise nature of the entertainment is different. Woodbridge's services involve the providing of essentially live entertainment to end users. MGM's service is also entertainment but aimed at the television watching public. Of course, there may be some overlap with Woodbridge's relevant public. However, taking all this into account, I find these respective services share only a lowish level of similarity.

75) The considerations regarding *production of shows, musical shows, concerts, and stage productions* are similar to the *production of television recordings* etc,

discussed at paragraph 70 above. However, because the nature of the end product here is different, there is no complementarity in the sense described in *SISSI ROSSI*. Once again, the nature, intended purpose and trade channels may be different. As such, these services do not share any similarity with MGM's services.

76) It is less clear to me whether *information relating to entertainment* is similar and if so to what extent. Information relating to entertainment services could be provided by an unrelated third party and as such, it is not obvious that the relevant consumer would assume a trade connection between the respective services. Where MGM may provide such information, it is likely to be in the form of promotion of the television programme rather than undertaking in any trade in such information. They are also different in terms of nature and intended purpose. They can be described as complementary in the sense that the entertainment services are important or even indispensable to the provision of information relating to the same, but the converse is not true. Taking all of this into account, I find that if there is any similarity it is only at a low level.

77) With regard to *interactive entertainment services and electronic games services provided on-line*, there is similarity at a general level, in that their intended purpose is to entertain, but beyond this, there is nothing self-evident to point to a more specific similarity. Woodbridge's services are interactive and therefore differ in their nature to *television programmes*, their mode of delivery is different in that one is provided over the Internet, the other broadcast on a television station. It is not obvious to me how there may be any overlap in respect to trade channels. In summary, I find that any similarity is on the low side.

78) Similar considerations exist in respect to *digital music (not downloadable) provided from a computer database or the Internet*. Again, this is also an entertainment service, but in all other respects the service is different to that of Woodbridge's and I find similarity is only on the low side.

79) Next, I consider *providing on-line electronic publications (not downloadable) and publication of electronic books and journals on-line*. Here the considerations are similar as the physical equivalents in Class 16. They may relate to the subject matter of *television programmes* and as such they may share some of the same relevant consumers of MGM's services. Nevertheless, in all respects they are dissimilar. They are different in their nature, intended purpose, and trade channels and I find if there is any similarity this is only very low

80) Finally, with regard to *nightclub and discotheque services; dance club services; club entertainment services*, these are self evidently different to MGM's services with the only commonality being that, at a general level, they are all entertainment services. But in terms of their respective nature, users and trade channels, they are different. Therefore, I find if there is no similarity.

Comparison of marks

81) I have already found that MGM's mark is identical to Woodbridge's first three marks. I will therefore go on to consider the similarity, or otherwise, between MGM's mark and Woodbridge's fourth, fifth and sixth marks and these are reproduced below:

MGM's Mark	Woodbridge's mark
thirtysomething	30SOMETHING 30 SOMETHING 30-SOMETHING

82) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). From a visual perspective the respective marks differ in that MGM's mark begins with the word "thirty", whereas Woodbridge's marks all begin with the numeral "30" (that is followed by a space and hyphen respectively, in its last two marks). All the marks are aurally and conceptually identical in that they will all be pronounced as the same four syllables THIR-TY-SOME-THING and understood as being a reference to someone's age being between thirty and thirty nine years old. Taking account of all these similarities and differences, I find that the respective marks, when viewed as a whole, share a very high level of similarity.

Distinctive character of the earlier trade mark

83) I have to consider whether MGM's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. It consists of the conjoined words THIRTY and SOMETHING. The conjoining of the words has little impact upon the degree of distinctive character as the overriding impression remains the same, namely a term to describe a person aged between thirty and thirty nine. Therefore, the mark has a clearly understood meaning that may have an allusive quality in respect of the *television programmes* in that it may describe the age of the characters in the programme. As such, the mark has only a low degree of inherent distinctive character.

84) I must also consider the effect of reputation, of MGM's CTM in the UK, on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen 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 distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

85) MGM has disclosed revenue of nearly €620,000 in the UK during the five year period prior to the publication date of Woodbridge’s application. Further, it discloses that the programme was successful when originally first aired in the late 1980s. However, no information has been provided in respect of the size of the relevant market, nor have any viewing figures been provided. The revenue figure, referred to above, appears to have been derived from a single licence arrangement with the television channel More4 in respect of re-runs of the programme and illustrates a level of use that would have a minimal impact upon the distinctive character of the mark. Set against this is the success of the programme first time around, as evidenced by the number of awards it received or was nominated for. However, as this relates to a period significantly before the relevant date here, I do not consider that it would have any significant impact. I therefore conclude that the low level of inherent distinctive character, if enhanced by MGM’s use of the mark in the UK in 2006/7, this will not be to any significant degree.

Likelihood of confusion

86) In my assessment of the relevant factors, I found that:

- the earlier mark has a low level of distinctive character, and that is not enhanced to any significant degree by the use made of it;
- Woodbridge’s fourth, fifth and sixth marks share a very high level of similarity to MGM’s earlier mark;

- there is a reasonably high level of similarity between MGM's services and Woodbridge's *compact discs; DVDs; records; recorded magnetic and/or optical data carriers; films, video and audio recordings; recorded audio and/or video tapes* in Class 9 and *production of television programmes, films, sound and video recordings; rental of television programmes, sound and video recordings; presentation and rental of films; presentation of radio programmes; production of videos* in Class 41;
- there is only a low or very low level of similarity between MGM's services and Woodbridge's *data supplied online or provided through the Internet* in Class 9; *[p]rinted matter; printed publications; books, magazines, journals; posters, photographs; calendars* in Class 16; *clothing, footwear, headgear* in Class 25 and *provision and presentation of live entertainment; production or rental of radio programmes presentation and performance of shows, musical shows, concerts and stage productions; information relating to entertainment; interactive entertainment services; digital music (not downloadable) provided from a computer database or the Internet; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; electronic games services provided on-line* in Class 41;
- there is no similarity between MGM's services and Woodbridge's remaining Class 9 or any of the parts and fittings listed in the same, or its Class 16 goods or its *production of shows, musical shows, concerts, and stage productions; nightclub and discotheque services; dance club services; club entertainment services* in Class 41;
- the average consumer for MGM's services is the television viewing general public and the purchasing act will vary from casual viewing to a more considered approach by viewers who follow the programme;
- there are a number of different average consumers for Woodbridge's goods and services and in respect of many of these, the average consumer will also be the general public. I also note that in relation to *production of television and radio programmes, films, sound and video recordings* and *production of shows, musical shows, concerts, and stage productions*, the average consumer may be a more specialist purchaser.

87) As I have already commented upon, MGM has based these grounds upon Section 5(2) (b) of the Act. When considering the grounds in respect of Section 5(1), I found that the first three of Woodbridge's marks are identical to MGM's earlier mark. Section 5(2) (b) relates to marks that are similar and not identical. Therefore, it follows that this ground of opposition only relates to Woodbridge's fourth, fifth and sixth marks. That said, I do not believe this to be a determinative point in the case as the similarities between Woodbridge's first three marks and its second three are such as not to have any different impact upon the outcome

of this case regardless of whether it is determined under Section 5(2) (b) or if MGM had pleaded a ground under Section 5(2) (a) on the basis that the respective marks are identical.

88) I must adopt the global approach advocated by the case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). Applying this global approach to my findings, I find that, given the identity or very high level of similarity between the respective marks and the reasonably high level of similarity between the respective goods and services that there is a likelihood of confusion regarding the following of Woodbridge's Class 9 goods and Class 41 services:

[C]ompact discs; DVDs; records; recorded magnetic and/or optical data carriers; films, video and audio recordings; recorded audio and/or video tapes

[P]roduction of television programmes, films, sound and video recordings; rental of television programmes, sound and video recordings; presentation and rental of films; presentation of radio programmes; production of videos

89) In respect of these services, I find that the relevant consumer will, upon seeing the respective marks, confuse the marks and therefore assume that the respective goods and services originate from the same undertaking.

90) In respect to all of Woodbridge's goods and services that have not fallen foul of the grounds under Section 5(1) or listed in paragraph 86 above, I find that there is no likelihood of confusion. Here, Woodbridge's goods and services share low, very low or no similarity with MGM's services. In addition, I have taken account of all other the relevant factors including the fact that the distinctive character of the earlier marks is only at a low level. This is because of the meaning endowed in the phrase THIRTYSOMETHING may take on a more descriptive, non-trade mark significance when used on goods and services less closely associated, or not associated at all, with MGM's television programme. This is despite there being identity or a very high level of similarity between the respective marks.

91) In summary, the opposition under Section 5(2) of the Act has been partially successful insofar as it relates to the goods and services I have identified in paragraph 88.

Section 5(3)

92) I turn to consider the ground for opposition under Section 5(3) of the Act which 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.”

93) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA (CHEVY)* [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited (TYPHOON)* [2000] FSR 767, *Daimler Chrysler v Alavi (MERC)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (VISA)* [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines (LOADED)* O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7, *Davidoff & Cie SA v Gofkid Ltd (DAVIDOFF)* [2003] ETMR 42 and *Intel Corporation Inc. v CPM United Kingdom Ltd (INTEL)* C-252/07.

94) The applicable legal principles arising from these cases are as follows:

a) ‘Reputation’ for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by that trade mark: paragraph 26 of the ECJ's judgment in *CHEVY*.

b) Under this provision the similarity between the trade marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier trade mark and the later trade mark or sign: *Adidas Salomon v Fitnessworld*, paragraphs 29-30.

c) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier trade mark with a reputation and the later trade mark must be assessed globally, taking into account all factors relevant to the circumstances of the case: *INTEL*

d) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of

such a link between the conflicting marks, within the meaning of *Adidas-Salomon and Adidas Benelux: INTEL*

e) The stronger the earlier trade mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the ECJ in *CHEVY*, paragraph 30).

f) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous trade mark or an attempt to trade upon its reputation: *Spa Monopole v OHIM*.

g) Whether use of the later trade mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case: *INTEL*

h) The use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique; a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark; proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future: *INTEL*

95) Before considering the extent of reputation MGM enjoys in respect of its THIRTYSOMETHING mark, I should point out that I will consider the grounds under Section 5(3) insofar as they may improve MGM's case beyond what I have already found in respect to its grounds under Sections 5(1) and 5(2) of the Act. It is, therefore, useful to highlight the surviving goods and services in Woodford's application following my findings in respect of these other grounds. These are:

Class 09

Apparatus for recording, transmission, editing and/or reproduction of sound and/or images; magnetic and/or optical data carriers; recording discs; computer programs; computer games; digital music (downloadable) from the Internet; publications in electronic form and data supplied online or provided through the Internet; spectacles, sunglasses and cases for spectacles and sunglasses; parts and fittings for all the aforementioned goods; parts and fittings for compact discs; DVDs; records; recorded magnetic and/or optical data carriers; films, video and audio recordings; recorded audio and/or video tapes.

Class 16

Printed matter; printed publications; books, magazines, journals; posters, photographs, postcards, greetings cards; song books, sheet music; wall charts; instructional and teaching material; writing and drawing materials and instruments; bags, packaging materials; calendars; stencils, decalcomanias; photograph albums; folders and files for papers; ring binders; note books; note pads.

Class 25

Clothing; footwear; headgear.

Class 41

Provision and presentation of live entertainment; production or rental of radio programmes; presentation, production and performance of shows, musical shows, concerts and stage productions; information relating to entertainment; interactive entertainment services; digital music (not downloadable) provided from a computer database or the Internet; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; electronic games services provided on-line; nightclub and discotheque services; dance club services; club entertainment services.

Reputation

96) From the ECJ's comments in *CHEVY* it is known that for a reputation to exist, the relevant marks must be known by a significant part of the public concerned and that particularly important considerations are the market share held by the marks, the intensity, geographical extent and duration of use and the level of promotion undertaken. Further, the ECJ also comments, in its recent judgment in *PAGO*, that a reputation in one Member State may be sufficient for the purposes of establishing a reputation of a CTM. MGM, has, in fact, shown use in a number of Member States in addition to the UK, such as in the Netherlands and in Italy. The use in these countries is, however, significantly less than in the UK and, in the case of Italy, ceased in 2002. Therefore, even taking account of this wider use, the totality is insubstantial and relates to licences to air re-runs of the programme originally shown more than fifteen years earlier. As such, I am unable to conclude that the market share was significant. MGM have provided some evidence regarding the intensity of use in the form of a list of transmission dates and times in the UK, but this list only relates to twenty eight of the eighty five episodes, shown in a compressed period between 21 August and 12 October 2006 and either in a mid-afternoon slot or at around two o'clock in the morning. These facts suggest that these episodes were not watched by a large viewing

audience. MGM also states that it actively markets the programme at an annual conference held in Cannes, France each year. I do not find such use to be conclusive as to the existence of a reputation. I do note the success of the programme when it was originally aired in the late 1980s but there is no evidence to support the fact that any reputation, resulting from the original airing of the programme, remains in the minds of the relevant public.

97) In summary, the evidence does not provide any convincing information as to the existence of a reputation at the date of application, but if a reputation exists at all, it will only be as a result of the original success of the programme in the late 1980s and will not be known by a significant part of the relevant public. Therefore, taking everything into account, I conclude that MGM has not demonstrated a reputation in the mark THIRTYSOMETHING at the date of application in respect of *entertainment in the form of television programmes*.

98) In light of such a finding, it is not necessary for me to consider the issue of the existence of the necessary link or of detriment. Even if there is a qualifying reputation, it is small and the mark is still of limited distinctiveness. In these circumstances the public for the remaining services would not call to mind the earlier CTM for *entertainment in the form of television programmes* if encountering the same mark used for the remaining services.

99) In conclusion, MGM is no better off in respect of its grounds of opposition based upon Section 5(3) of the Act than it is in respect of its grounds under Sections 5(1) and 5(2) of the Act.

Section 5(4) (a)

100) I have already considered the likelihood of confusion under Section 5(1) and 5(2) of the Act, based upon MGM's established use. MGM's case under Section 5(4) (a) requires misrepresentation and this requires confusion. Consequently, MGM's case under Section 5(4) (a) can be no better than the case I have already considered under Section 5(1) and Section 5(2). As such, I do not intend to consider these grounds further.

SUMMARY

101) Taking account of my findings in respect of all the grounds for opposition, MGM is successful in respect of the following of Woodbridge's goods and services:

Class 09

Compact discs; DVDs; records; recorded magnetic and/or optical data carriers; films, video and audio recordings; recorded audio and/or video tapes

Class 41

Entertainment services; provision and presentation of recorded entertainment; production, presentation or rental of television programmes, films, sound and video recordings; presentation of radio programmes; presentation, production and performance of videos

102) The opposition is, however, unsuccessful in respect of the following list of Woodbridge's goods and services:

Class 09

Apparatus for recording, transmission, editing and/or reproduction of sound and/or images; magnetic and/or optical data carriers; recording discs, computer programs; computer games; digital music (downloadable) from the Internet; publications in electronic form and data supplied online or provided through the Internet; spectacles, sunglasses and cases for spectacles and sunglasses; parts and fittings for all the aforementioned goods; parts and fittings for compact discs; DVDs; records; recorded magnetic and/or optical data carriers; films, video and audio recordings; recorded audio and/or video tapes.

Class 16

Printed matter; printed publications; books, magazines, journals; posters, photographs, postcards, greetings cards; song books, sheet music; wall charts; instructional and teaching material; writing and drawing materials and instruments; bags, packaging materials; calendars; stencils, decalcomanias; photograph albums; folders and files for papers; ring binders; note books; note pads.

Class 25

Clothing; footwear; headgear.

Class 41

[P]rovision and presentation of live entertainment; production or rental of radio programmes; presentation, production and performance of shows, musical shows, concerts and stage productions; information relating to entertainment; interactive entertainment services; digital music (not downloadable) provided from a computer database or the Internet; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; electronic games services provided on-line; nightclub and discotheque services; dance club services; club entertainment services.

COSTS

103) As both parties have enjoyed a measure of success with the opposition being only partially successful, I order that both parties bear their own costs.

Dated this 20 day of January 2010

**Mark Bryant
For the Registrar,
the Comptroller-General**