

O/006/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
Nos. 2473428A & 2473428B
BY ADVANCE MAGAZINE PUBLISHERS INC.
TO REGISTER THE TRADE MARKS
GLAMMY & GLAMMIES
IN CLASSES 16, 35, 41 & 44**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER Nos. 98059 & 98060 BY
NATIONAL ACADEMY OF RECORDING ARTS AND SCIENCES, INC.**

BACKGROUND

1) On 27 November 2007, Advance Magazine Publishers Inc. (hereinafter the applicant), applied to register a series of two marks, which were subsequently split by the Registry:

| Number | Mark | Filing Date | Class | Specification |
|----------|----------|-------------|-------|---|
| 2473428A | GLAMMY | 27. 11.07 | 16 | Printed publications, magazines and magazine sections featuring beauty products and treatments. |
| 247348B | GLAMMIES | | 35 | Organising, conducting and providing market and customer surveys concerning beauty products and treatments, including via the Internet and computer networks. |
| | | | 41 | Organising, conducting and providing awards concerning beauty products and treatments, including via the Internet and computer networks. |
| | | | 44 | Provision of information relating to beauty products and beauty treatments. |

2) The applications were examined and accepted, and subsequently published for opposition purposes on 11 July 2008 in Trade Marks Journal No.6743.

3) On 13 October 2008 the National Academy of Recording Arts and Sciences Inc. (hereinafter the opponent) filed notices of opposition, subsequently consolidated. The grounds of opposition are in summary:

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

| Mark | Number | Filing date/ registration date | Class | Specification |
|--------|-------------|--------------------------------|-------|--|
| GRAMMY | CTM 4636262 | 02.09.05 / 14.07.06 | 9 | Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; computer software; fire-extinguishing apparatus; sound recordings and audiovisual recordings featuring music, musical performances, award show ceremonies and other entertainment, CD-ROMS featuring musical entertainment; downloadable electronic |

| | | | | |
|--------|-------------|---------------------|----|--|
| | | | | publications in the fields of music and entertainment; decorative magnets and computer mouse pads. |
| | | | 16 | Paper, cardboard and goods made from these materials, not included in other classes; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed matter, in particular tickets, invitations, posters, calendars, booklets, brochures, bulletins, circulars, newsletters, magazine sections, and pamphlets in the field of recording arts and sciences. |
| | | | 18 | Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; bags, in particular all purpose sport bags, all purpose carrying bags, beach bags, book bags, carry-all bags, gym bags, leather bags, school book bags, school bags and tote bags. |
| GRAMMY | 1472730 | 07.08.91 / 27.11.92 | 9 | Sound recording and sound reproducing apparatus and instruments; video recording and video reproducing apparatus and instruments; records, tapes and discs; video tapes and films; cinematographic films; computers and data processing apparatus; computer hardware, software and firmware; computer programmes; computer games; cameras; photographic apparatus and instruments; audio and video apparatus for entertainment purposes; parts and fittings for all the aforesaid goods; all included in Class 9. |
| GRAMMY | CTM 4524427 | 04.07.05 / 09.07.08 | 25 | Clothing; footwear, headgear. |
| GRAMMY | CTM 1301639 | 07.09.99 / 26.10.00 | 41 | Educational and entertainment services; namely, award ceremonies in the field of music and video recording arts and sciences. |
| | | | 42 | Association services; namely, promoting artistic progress and achievement in the field of recording arts and sciences. |
| GRAMMY | 1275363 | 01.10.86 / 19.05.89 | 42 | Association services provided to its members, relating to education and entertainment all included in Class 42. |

b) The opponent relies upon all its marks for all the grounds of opposition. The opponent states that its mark is very similar to the marks applied for and that the goods and services are also identical and /or very similar. Therefore the marks in suit offend against Section 5(2)(b). The opponent also contends that its mark is well known in the UK, and has been since 1964 when the Beatles were awarded their first Grammy award. The opponent states that it is an organisation for recording professionals dedicated to improving the quality of life and cultural condition for music and its makers. As a result it contends that the marks in suit also offend against Sections 5(3) and 5(4)(a) of the Act as they will diminish the attractiveness and strength of the opponent's mark and dilute its distinctiveness.

4) On 26 May 2009 the applicant filed two counterstatements (effectively identical) which denied the opponent's claims. The applicant puts the opponent to strict proof of use in respect of all the goods and services for which the opponent's marks are registered.

5) Both parties filed evidence, and both seek an award of costs in their favour. The matter came to be heard on 1 December 2011. At the hearing, the opponent was represented by Ms Bowhill of Counsel instructed by Messrs Olswang, the applicant was represented by Mr Bartlett of Messrs Beck Greener.

OPPONENT'S EVIDENCE

6) The opponent filed three witness statements. The first, dated 9 April 2010, is by Wayne J Zahner the Chief Financial Officer of the opponent company, a position he has held since 2004. He states that he is fully familiar with the history of his company's use of the trade mark GRAMMY. He states that his company was established in 1957 and is an organisation of musicians, producers, recording engineers and other recording professionals dedicated to improving the quality of life and cultural condition for music and its makers. He states that the GRAMMY awards have been presented annually since 1958 for outstanding achievements in the music industry. He states that the awards are significant as they are the only peer presented awards, without regard to sales or chart position. He states that many famous artists such as the Beatles and U2 have won awards and that those who are successful usually capitalise on their success by advertising the fact that they are GRAMMY winners. He states that use has been primarily in relation to the annual awards ceremony but that the mark has also been used extensively upon a wide range of merchandise including, *inter alia*, music recordings, clothing, books and other accessories.

7) Mr Zahner states that the awards ceremony is televised in the UK, and the ceremony also attracts considerable coverage in the press. He states that his company operates a website (www.grammy.com) which has been accessible in the UK since 16 March 1995. He states that the website received 88,910 visits from the UK in 2005, 213,144 in 2006 and 189,109 in 2007. The website is ranked the 303,428th most popular website in the UK. He states that the opponent also operates a website www.grammystore.com which he states stocks a wide range of goods branded with the mark GRAMMY which are available for purchase. He states that sales worldwide in respect of Grammy nominated CD's was over US\$5.5 million in 2007, and a further US\$5.5 million "in respect of the awards show in 2007".

8) Mr Zahner makes a number of claims regarding the applicant. These are:

- a) The applicant has provided, with their GLAMOUR magazine, compilation CDs which feature the mark GLAMOUR as part of their title on five occasions between April 2002 and 2005.

- b) It also offers, via its magazine, a Glamour Music jukebox tool where music can be heard and provides links to third parties where music can be purchased.
- c) The magazine hosts an annual Glamour Woman of the Year Awards ceremony where three out of seventeen categories relate to music related awards. These awards are now referred to by a number of UK publications as the “Glammies”.
- d) The applicant launched the Glamour.com website in 2001 which is visited by 500,000 unique users per month.

9) Mr Zahner provides the following exhibits:

- WJZ3: Copies of licensing agreements with the BBC (1999-2003 inclusive) and ITV (2005 – 2007 inclusive). In these agreements the television companies are under no obligation to actually broadcast the material. The agreements refer to the provision of a “film” entitled “THE GRAMMY AWARDS” and the relevant year. The agreements have been redacted in respect of payment other than for the following years: 2001-US\$140,000, 2002-US\$140,000 and 2003-US\$110,000. Although at exhibit WJZ14, there are sales figures given for various years. Despite being heavily redacted they do show figures for payments from ITV as follows: 2005 US\$115,000, 2006 US\$175,000, 2007 US\$175,000 and 2008 US\$175,000.
- WJZ-4: a sample of press articles regarding the GRAMMY awards ceremony, dated 2003-2006. These show stories of various celebrities in the UK which either mention that they have won a Grammy award or actually shows them receiving the award.
- WJZ-6: A selection of web-pages from the opponent’s website since 1996, courtesy of www.archive.org, these show use of the term GRAMMY in relation to awards being given to various artists.
- WJZ 13: Documents showing the range of goods available on www.gramystore.com and the sales history. These show cds, polo shirts, baseball caps, keyrings, T shirts, fleeces, cups, bags, posters, watches, soft toys. All priced in US\$.

10) The opponent also filed two witness statements which are almost identical in their wording and both offer simple speculation regarding the confusability of the marks in suit. I do not find these statements compelling.

APPLICANT’S EVIDENCE

11) The applicant filed a witness statement, dated 17 December 2010, by Pamela Rose Raynor the Finance Director (a position she has held since 1999) of The Conde Nast Publications Limited, a wholly owned subsidiary of the applicant company. She states

that the applicant is one of the world's largest and best known publishing businesses, with titles such as *Vogue*, *GQ*, *Tatler*, *House & Garden*, *Vanity Fair* and *Glamour*. The applicant licenses Conde Nast to publish *Glamour* in the UK. The magazine was first called *Glamour of Hollywood* when it was launched in the USA in 1939. It is now produced in a number of countries worldwide with a UK publication since 2001. Sales have averaged around 400,000 per issue. The magazine is also on-line and has a twitter site.

12) Ms Raynor states that each year the magazine organises the Glamour Woman of the Year awards. This was first held in the UK in 2004. She states that in addition to the formal title the awards are often referred to as "The GLAMMIES", or winning a "GLAMMY". The press also use these terms as is shown at exhibits PR5-8 where a number of UK press articles are shown to use the formal title and also the shorthand versions. These exhibits also show that the awards ceremony receives considerable press attention. Ms Raynor also provides information regarding the use of the marks in suit by the German subsidiary and also in the US by the parent company, but this information does not assist me with my decision.

OPPONENT'S EVIDENCE IN REPLY.

13) The opponent filed a second statement, dated 21 March 2011 by Mr Zahner. He states that his organisation was established in 1989 to cultivate the understanding, appreciation and advancement of the contribution of recorded music to American culture. The organisation also assists students preparing for a career in the music industry and provides assistance to musicians who have fallen upon hard times. He points out that the GRAMMY awards have been sponsored by business rivals of the applicant such as *InStyle* and *Vanity Fair* magazines. He states that the two awards ceremonies each attract "A list celebrities", achieve considerable press attention, and have shared winners. Mr Zahner also states that other magazines such as *Mojo* and *Q* have also arranged their own awards ceremonies and they are, unsurprisingly, named after the relevant magazine. He also states:

"25. This Second Witness Statement together with my first Witness Statement demonstrates that The Recording Academy (either itself or via licensees) has used the GRAMMY mark, in respect of the following goods and services:

- Sound recordings (see paragraphs 12 and 29 of my first witness statement);
- Video recordings;
- Records, tapes, and discs (see paragraphs 12 and 29 of my first witness statement);
- Educational and entertainment services; namely, award ceremonies in the field of music and video recording arts and sciences (see paragraphs 9-12 of my first witness statement); and

- Association services provided to its members, relating to education and entertainment and promoting artistic progress and achievement in the field of recording arts and sciences (see paragraph 8 of my first witness statement).”

APPLICANT’S ADDITIONAL EVIDENCE

14) The applicant filed a second witness statement, dated 14 November 2011, by Ms Raynor. She points out that the opponent is a US organisation and that all the GRAMMY awards ceremonies referred to have taken place in the USA. Further a recording can only be nominated for a GRAMMY if it has been released in the USA, and unless one releases recordings in the USA you cannot qualify to vote. She points out that all the grants, school activities and assistance to musicians is wholly within the USA, with a few exceptions relating to South America. She also points out that the events sponsored by competitors of her company and referred to by Mr Zahner, also took place in the USA.

15) Ms Raynor explains that the term GLAMMIES is an obvious diminutive of GLAMOUR and that it was devised by her parent company in the USA where there are lots of awards ceremonies with similar names such as EMMIES, SLAMMIES, RAZZIES, NAMMIES, JAMMYS, FAMMY awards, DAMMY awards, STREAMY awards, LAMMY awards, PAMMIES, TONY awards, WEBBY awards etc. At exhibit PR19 she provides details of these various awards. She denies that there was any intention of gaining an advantage from a link to the opponent, and states that there has never been any confusion that the applicant is aware of. She also points out that in the UK there are award ceremonies called GLAMMIES, SAMMIES and MILLIES. She provides details of these at exhibit PR22.

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

DECISION

17) As part of its skeleton argument the opponent amended its grounds of opposition. It no longer relied upon its UK registered trade marks numbers 1472730 and 1275363. It also narrowed the goods and services of its CTM registrations that it was relying upon under the various grounds, and also withdrew its opposition in respect of certain of the services sought to be registered. These changes will be reflected in each ground as it is dealt with.

18) I shall first consider the ground of opposition under Section 5(2)(b) which reads:

“5.-(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.”

19) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

20) In these proceedings the applicant is relying upon its three CTM marks, listed at paragraph 3, which have registration dates of 26 October 2000 (1301639), 14 July 2006 (4636262) and 9 July 2008 (4524427). These are clearly earlier trade marks. Only CTM 1301639 is subject to The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

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

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

21) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. In the instant case the publication date of the application was 11 July 2008, therefore the relevant period for the proof of use is 12 July 2003-11 July 2008. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

22) CTM 1301639 is registered for the following services:

Class 41: Educational and entertainment services; namely, award ceremonies in the field of music and video recording arts and sciences.

Class 42: Association services; namely, promoting artistic progress and achievement in the field of recording arts and sciences.

23) Ms Bowhill contended that it was unarguable that the opponent had shown use on all the services above. I disagree as does the applicant who contends that the opponent has only provided evidence of sales of a single film each year, and no evidence that the film sold was ever shown in the UK. The opponent holds an awards ceremony in the USA, which is filmed. The opponent has provided sales figures relating to the film in relation to UK television rights for each year during period 2005-2008 inclusive. These show payments averaging US\$160,000 per annum. The agreements refer to the provision of a "film" entitled "THE GRAMMY AWARDS" plus the relevant year. Although there is only one sale per annum and there is no obligation on the television company to actually broadcast the show I regard this activity as sufficient to satisfy the test in paragraph 21 above with regard to the following services in Class 41: "Award

ceremonies in the field of music and video recording arts and sciences.” I reject the applicant’s contention that the evidence does not show use in the UK, or in the alternative, if it does show use then that should be restricted to use of the mark upon “film”. I believe that this is too restrictive an interpretation. It is clear that all the evidence of use of the mark with regard to Class 42 services relates to use solely in the USA and so these services will not be taken into account later in this decision.

24) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

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

26) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion.

As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

27) In the instant case the opponent has provided what it contends is evidence of use of its mark GRAMMY in the UK. To my mind the only use which is actually within the UK relates to the sale of a television programme of the musical awards ceremony which takes place each year in the USA. The opponent has not provided any evidence of whether this programme was broadcast, let alone viewing figures. The opponent therefore cannot benefit from an enhanced reputation. However, I consider that the opponent’s mark is inherently highly distinctive for the goods and services for which it is registered.

28) I now turn to consider the goods and services of the two parties. The opponent amended its position in its skeleton argument and this new position is reflected below:

| Applicant’s goods | Opponent’s goods |
|--|---|
| Class 16: Printed publications, magazines and magazine sections featuring beauty products and treatments. | CTM 4636262: Class 16: Paper, cardboard and goods made from these materials, not included in other classes; bookbinding material; photographs; printed matter, in particular newsletters, magazine sections, and pamphlets in the field of recording arts and sciences. |
| Class 41: Organising, conducting and providing awards concerning beauty products and treatments, including via the Internet and computer networks. | CTM 4636262: Class 9: sound recordings and audiovisual recordings featuring music, musical performances, award show ceremonies and other entertainment. CTM 1301639: Class 41: Award ceremonies in the field of music and video recording arts and sciences. |
| Class 44: Provision of information relating to beauty products and beauty treatments. | CTM 4636262: Class 16: instructional and teaching material (except apparatus); |

29) The opponent contended that the average consumer should be considered to be women aged between 18-49. This is based upon Mr Zahner’s opinion and the opinion of the investigator (not included in my evidence summary) that this was the applicant’s target market, and that this corresponds with the opponent’s target audience which is said to be adults in the 18-34 age range. However, no evidence was supplied which showed that the applicant had stated that their target market would be so limited, nor why the opponent believed that its audience would effectively exclude anyone who is

middle aged or older. However, these views seem to be based upon who would wish to read articles or watch programmes regarding awards ceremonies, be they relating to beauty products or entertainment because it involves so called celebrities. To my mind the average consumer for the class 9, 16 and 44 goods and services is the general public. Whereas the class 41 services relating to awards ceremonies would be either a television company or companies involved in either industry and so it would be a somewhat restricted market.

30) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

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

31) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

32) As the goods and services of the applicant's two marks are identical a single comparison is sufficient. To my mind the class 16 goods of the two parties are similar and this was accepted by the applicant.

33) Moving onto the applicant's class 41 services the opponent made the following contentions at the hearing:

“ Starting off with class 9, sound recordings and audiovisual recordings featuring music, musical performances, award show ceremonies and other entertainment, that is similar to providing awards concerning beauty products and treatments, organising them and conducting them. The end product in both -- the class 41 is an award ceremony concerning beauty products and the class 9 is recordings which feature award show ceremonies which can include beauty award show ceremonies.”

34) Clearly the users of recordings will be the general public whereas the users of an awards ceremony will be an industry body or similar. The uses and physical properties are also very different, as would be the trade channels. Thus the goods and services are not similar. Nor are they complementary.

35) It was also contended that the class 41 services of both parties were similar as “In class 41, they are both award ceremonies, the only difference being that one is in the field of music and recording arts and the other is in the field of beauty products and treatments.” Whilst I accept that superficially there is a degree of similarity in that they are both awards ceremonies, the users will clearly be different, as will presumably the trade channels, and of course the ceremonies will not be in competition. Again, there is no similarity, or complementarity.

36) Lastly, I turn to the applicant’s services in Class 44. At the hearing the opponent contended that “The class 16, instructional and teaching material, is similar, if not identical, to provision of information relating to beauty products and beauty treatments, in that the provision of such information is instructional. It is instructional about beauty products and beauty treatments.” I do not accept that providing information in class 44 is similar to a good in class 16, nor do I accept that information regarding beauty products would necessarily be instructional or teaching material. The goods and services are not similar.

37) I now turn to consider the marks of the two parties. Whilst the opponent is relying upon a number of marks they are all identical and so I shall refer to them in the singular for the purposes of the comparison test. For ease of reference these are reproduced below:

| Applicant’s marks | Opponent’s mark |
|-------------------|-----------------|
| GLAMMY | GRAMMY |
| GLAMMIES | |

38) At the hearing the opponent contended:

“In terms of the similarity of the signs, I submit that GRAMMY and GLAMMY first of all visually are virtually identical. Five of the six letters are identical and they are produced in the identical order. When you glance at these words, that one letter difference, i.e. the R and the L is likely to go unnoticed by the average consumer. I would submit that, with the doctrine of imperfect recollection, it is not likely to be perceived and remembered. So visually those two marks are highly, highly similar, if not virtually identical. Phonetically obviously both of the marks comprise two syllables. They both start with "G" and they both end in "AMMY" which is obviously identical. So aurally GRAMMY and GLAMMY are highly similar. Conceptually I accept that there is no real similarity between these marks. However, that is offset by the very high level of visual and phonetic similarity. My friend says that the conceptual differences outweigh the other similarities. He

relies on *PICASSO* and *OBELIX* in support of that. I do not accept that because in *OBELIX* it was the name of a character from a famous comic strip. *PICASSO* is obviously the name of a famous painter. They both had clear and specific meanings which the public was capable of grasping immediately. That is what *PICASSO* says. That is the standard that you have to reach for conceptual considerations to outweigh any aural and visual similarities. In this case, that does not apply because the word GRAMMY does not scream "gramophone" at you and GLAMMY, and equally GLAMMIES, does not scream "glamour" at you, unlike GLAM, for example, which is a well known shortening of the word "glamour". So both GRAMMY and GLAMMY or GLAMMIES have a certain ambiguity to them which was not present in the word *PICASSO* or *OBELIX*. For that reason, those two cases do not apply here.

As for GRAMMY compared to GLAMMIES, obviously I accept that that is not as similar as GRAMMY and GLAMMY, but there is still a high level of similarity between them. In aural use, they both still start with the identical letter "G" and they contain the middle section "AMM" which is identical. Obviously that produces a certain amount of aural similarity. Visually that is quite important because, when you look at these two words, your eye is drawn to the "MM" and because that middle section is identical that produces overall a visual impression of similarity. Again my comments on conceptual similarity apply equally here."

39) Whilst I accept that the marks GRAMMY and GLAMMY have a number of visual similarities, there is a visual difference. Regarding the aural comparison, these are relatively short marks and the difference is at the start of the mark. Therefore whilst there are similarities there also aural differences. Conceptually, the marks are very different. The GLAMMY mark begins with the word "GLAM" which is a well known slang term for "glamorous" and the mark would be seen as having associations with glamour, whereas the mark GRAMMY if it brought to mind anything it would be images of weight as in "grammes" especially given the average literacy level of the general public. Taken overall I believe that whilst there are some similarities, given that both marks are short words the differences particularly the conceptual difference outweigh any similarity to such an extent that the marks are dissimilar.

40) When taking all the above into account and considering the matter globally I believe that even when the applicant's mark is used on goods which are identical and will be purchased with relatively little consideration such as those in class 16, and allowing for the fact that it is inherently highly distinctive, there is no likelihood of confusion. The ground of opposition under Section 5(2)(b) to the mark GLAMMY therefore fails.

41) I now turn to compare the applicant's mark GLAMMIES with the opponent's GRAMMY mark. Clearly most of the factors outlined in paragraph 38 above apply. To my mind these marks are even further apart than GRAMMY and GLAMMY, a point accepted by Counsel for the opponent. When taking all the above into account and considering the matter globally I believe that even when the applicant's mark is used on goods which are identical and will be purchased with relatively little consideration such as those in class 16, and allowing for the fact that it is inherently highly distinctive, there

is no likelihood of confusion. The ground of opposition under Section 5(2)(b) to the mark GLAMMIES therefore fails.

42) I now turn to consider the ground of opposition under Section 5(3) which, in its original form reads:

"5-(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier mark is protected,

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, 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."

43) By virtue of regulation 7 of the Trade Mark (Proof of Use, etc) Regulations 2004, Section 5(3)(b) has now been repealed. The equivalent provision in Section 10 of the Act dealing with infringement has also been amended. As the explanatory note indicates:

"These amendments implement the decision of the European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* of 9th January 2003 (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* of 23rd October 2003 (C-408/01). Those decisions determined that Article 5(2) of the Directive, which on the face of it, grants a right to the proprietor of a trade mark to prevent third parties from using an identical or similar trade mark in relation to goods or services which are *not similar* where the earlier trade mark has a reputation and use of that sign takes unfair advantage or is detrimental to the distinctive character of that earlier trade mark, also applies to goods or services which are similar or identical to those for which the earlier trade mark is registered."

44) The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 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 and, more recently *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7. Guidance in relation to reputation under Section 5(3) has been set out in *General Motors Corporation v Yplon SA* in paragraphs 23 to 27. Paragraphs 26 & 27 indicate the standard that must be reached:-

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

45) The onus is upon an opponent to prove that its earlier trade mark enjoys a significant reputation or public recognition and it needs to furnish the evidence to support this claim. In the instant case the opponent filed evidence that it sells a single film of its awards ceremony each year. It provided the sales figures, but apart from the assertion of Mr Zahner, an American, no evidence that the film was ever shown in the UK. It also supplied a number of articles from magazines and newspapers which show either pictures of the awards ceremony or mention when running a story about a musician that they have won a Grammy award. However, no circulation figures for these publications in the UK were provided. The opponent also relies upon its website which it asserts is visited by UK based individuals. However, there is no evidence of any sales from this website to the UK. In addition the opponent has not provided any credible independent evidence of reputation in the UK. To my mind the opponent has failed to clear the first hurdle, and so the opposition under Section 5(3) fails.

46) In case I am wrong on this I shall go onto consider the matter as though reputation had been shown. At best this reputation would subsist in either a television programme of the musical awards ceremony which takes place each year in the USA, or the awards ceremony itself. Once the matter of reputation is settled any opponent must then show how the earlier trade mark would be affected by the registration of the later trade mark. The opponent contends that its mark is unique, although there is evidence of numerous other awards ceremonies with very similar names, albeit mostly in the USA. In *Inlima S.L's* application [2000] RPC 61 Mr Simon Thorley QC, sitting as the Appointed Person, said:

“The word ‘similar’ is a relative term. One has to ask the question ‘similar for what purpose’. The question of similarity accordingly can only be answered within the context of a particular set of facts, once one has identified both the facts and the purpose for which similarity is required. In the case of section 5(3), the purpose of requiring similarity is so that the possibility of detriment or unfair advantage might arise. In any particular case, a conclusion as to whether it does arise must depend not only upon the degree of similarity but on all the other factors of the case, not least, the extent of the reputation.

I therefore conclude that the same global appreciation as is required for confusion under section 5(2) is likewise to be applied to the changed circumstances of section 5(3).”

47) More recently this matter was considered by Mr Daniel Alexander sitting as the Appointed Person in B/L O/307/10 where he said:

"37. The Decision in this case was handed down on 18th May 2009. On 18th June 2009, the ECJ handed down judgment in *L'Oréal v. Bellure*, Case C-487/07 in which it gave guidance on the proper approach to interpretation of Article 5(2) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), (the "Trade Marks Directive").

38. The ECJ said the following as regards Article 5(2) of the Trade Marks Directive and the requirement to show detriment or unfair advantage.

"40. As regards detriment to the repute of the mark, also referred to as 'tarnishment' or 'degradation', such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41 As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coattails of the mark with a reputation.

42 Just one of those three types of injury suffices for Article 5(2) of Directive 89/104 to apply (see, to that effect, *Intel Corporation*, paragraph 28).

43 It follows that an advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor.

44 In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of

distinctive character of the mark, the Court has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is also clear from the case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them (see, to that effect, Intel Corporation, paragraphs 67 to 69).

45 In addition, it must be stated that any such global assessment may also take into account, where necessary, the fact that there is a likelihood of dilution or tarnishment of the mark.

46 In the present case, it is a matter of agreement that Malaika and Starion use packaging and bottles similar to the marks with a reputation registered by L'Oréal and Others in order to market perfumes which constitute 'downmarket' imitations of the luxury fragrances for which those marks are registered and used.

47 In that regard, the referring court has held that there is a link between certain packaging used by Malaika and Starion, on the one hand, and certain marks relating to packaging and bottles belonging to L'Oréal and Others, on the other. In addition, it is apparent from the order for reference that that link confers a commercial advantage on the defendants in the main proceedings. It is also apparent from the order for reference that the similarity between those marks and the products marketed by Malaika and Starion was created intentionally in order to create an association in the mind of the public between fine fragrances and their imitations, with the aim of facilitating the marketing of those imitations.

48 In the general assessment which the referring court will have to undertake in order to determine whether, in those circumstances, it can be held that unfair advantage is being taken of the distinctive character or the repute of the mark, that court will, in particular, have to take account of the fact that the use of packaging and bottles similar to those of the fragrances that are being imitated is intended to take advantage, for promotional purposes, of the distinctive character and the repute of the marks under which those fragrances are marketed.

49 In that regard, where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

48) Earlier in this decision I determined that some of the goods of the two parties were identical. I also found that the opponent's mark is inherently highly distinctive for the goods and services for which it is registered, but it does not have an enhanced reputation. I also found that whilst there were some similarities in the marks the differences outweigh any similarity to such an extent that the marks are quite dissimilar, hence there is no link. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there is no advantage for the applicants to derive. As far as detriment is concerned, Ms Bowhill suggested that this would subsist in a reduction in the distinctiveness of the opponent's mark. I do not consider that registration of the applicant's marks could have an impact in this respect, be it to the distinctiveness of the mark or any reputation it might enjoy. The opposition under Section 5(3) therefore fails.

49) Lastly, I turn to section 5(4)(a) which reads:

"5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

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

50) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

"The question raised by the grounds of opposition is whether normal and fair use of the designation *WILD CHILD* for the purposes of distinguishing the goods of

interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

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

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

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

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

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

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

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

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

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

51) I also note the comments of Pumfrey J in *South Cone Incorporated v JackBessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation;

evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

52) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

“Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

53) First I must determine the date at which the opponent's claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

54) In its evidence the applicant has not sought to claim that it has used the marks in suit prior to their application for registration in 2007. The opponent claims to have used the term GRAMMYS in addition to its registered mark GRAMMY, although the evidence of use of either of the marks in the UK is underwhelming, almost to the point of non-existence. I am willing to accept that the opponent has at best goodwill in relation to

Award ceremonies in the field of music and video recording arts and sciences and at worst film of the same. I have found earlier in this decision that the opponent's mark GRAMMY was not similar to the marks applied for GLAMMY and GLAMMIES. Using the same criteria I find that the mark GRAMMYS is not similar to the marks in suit. Given this finding I am bound to conclude that there would be no misrepresentation. This requirement not being met the opposition under Section 5(4)(a) fails.

COSTS

55) The opponent has failed on all the grounds pleaded. As such the applicant is entitled to a contribution towards its costs. The applicant sought actual costs on account of the conduct of the opponent during the course of this case. This included issues such as requesting confidentiality for documents instead of merely redacting sensitive parts, failing to paginate evidence and when this was corrected failing to confirm that the evidence was identical other than the pagination, seeking disclosure and a stay, requesting an extension of time and a very late request to amend their pleadings. I agree that some of these issues should have been avoided by the opponent but not all of the issues would have caused significant additional work or costs. The applicant sought actual costs of £7,451 which I believe is too high. I order the opponent to pay the applicant the sum of £4,000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of January 2012

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